

Hearing:
August 28, 2011

**THIS OPINION IS NOT
A PRECEDENT OF
THE TTAB**

Mailed:
September 30, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Autodesk, Inc.

Serial Nos. 78852798, 78852808, 78852813,
78852822 and 78852843

John L. Slafsky and Matthew J. Kuykendall of Wilson Sonsini
Goodrich & Rosati for Autodesk, Inc.

Paul Fahrenkopf, Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

Before Zervas, Wellington and Greenbaum, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Autodesk, Inc. ("applicant") is the owner of four
applications for registration of the following three
standard character marks and single combination mark, all
filed pursuant to Trademark Act §1(a), 15 U.S.C. §1051(a):

1. DWG (Serial No. 78852798, claiming first use and
first use in commerce on November 28, 2005);



2. (Serial No. 78852808, claiming first use and first use in commerce on March 22, 2006);¹
3. DWG TRUEVIEW (Serial No. 78852813, claiming first use and first use in commerce on November 28, 2005); and
4. DWG TRUECONVERT (Serial No. 78852822, claiming first use and first use in commerce on November 28, 2005).

Applicant is also the owner of an application for the standard character mark DWG EXTREME (Serial No. 78852843), filed under Trademark Act §1(b), 15 U.S.C. §1051(b).

The recited goods in each application are the following International Class 9 goods:

computer software for data management and creation and manipulation of engineering and design data, particularly adapted for engineering, architecture, manufacturing, building, and construction applications, together with instruction manuals sold as a unit; computer-aided design software; computer software for animation, graphics and design modeling applications.

The examining attorney refused registration of the proposed DWG standard character mark under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the basis that applicant's proposed mark is merely descriptive of

¹ Applicant entered the following description of the mark; "The mark consists of a folder for storing design documents and data."

applicant's goods. Applicant maintains that the examining attorney did not establish that the proposed mark is merely descriptive, and in the alternative submitted evidence to establish that the proposed mark had acquired distinctiveness under the provisions of Trademark Act §2(f), 15 U.S.C. §1052(f). The examining attorney was not persuaded by applicant's showing of acquired distinctiveness and ultimately issued a final Office action maintaining the Section 2(e)(1) mere descriptiveness refusal and his finding that applicant's Section 2(f) showing is insufficient.

As to the remaining marks, the examining attorney refused to register them in view of his requirement pursuant to Trademark Act §§2(e)(1) and 6(a), 15 U.S.C. §§1052(e)(1) and 1056(a), that applicant disclaim DWG because, again, DWG is merely descriptive of the identified goods.

Background

We provide now some background about applicant, taken from the declaration of Mark Strassman, applicant's Vice President of Marketing. In the early 1980s, applicant developed and distributed software allowing architects, engineers, manufacturers, and other design professions to build two-dimensional and three-dimensional virtual models

of their buildings, consumer products, and other physical objects. Applicant's software is the computer-aided design ("CAD") software program of choice for world-renowned architects to design skyscrapers, bridges, aqueducts and other large-scale projects. AutoCAD - launched in 1982 - is applicant's most successful and best known product, and is used for design and drafting. There are currently more than seven million registered users of AutoCAD, and its sales have totaled over \$11 billion, with a substantial portion of that revenue derived from AutoCAD.

"DWG is Applicant's name for the file format and technology underlying AutoCAD® and other of Applicant's CAD software products." Strassman at ¶10. AutoCAD applications allow users to create and store user files in the DWG file format, which bear a .dwg file extension. Since 1985, applicant realized approximately \$10 billion in revenue from software featuring the DWG file format.

Issue on Appeal

Applicant states at footnote 2 in its appeal brief that it "does not concede that the mark DWG is merely descriptive of CAD software, but, given the compelling evidence of acquired distinctiveness in the USPTO record, is not appealing the Section 2(e)(1) refusal." Thus, the only issue before us is the sufficiency of applicant's

claim of acquired distinctiveness, in whole for the proposed DWG mark, and in part for the DWG component of the remaining marks.²

Evidentiary Issue

The record contains two communications from the Office of the Deputy Commissioner for Trademark Examination Policy forwarding material submitted by Letters of Protest to the examining attorney. In his Office action of August 24, 2010, the examining attorney "incorporated" this material, which included three unverified "statements" from third-parties. Applicant objected to the examining attorney's reliance in his brief on one of the statements, namely, the statement of Mickey Wohlmuth, a co-founder of CADMAX Corporation. The examining attorney stated in the final Office action that he "agree[d]" that the statements are legally defective or insufficient because none contain "a perjury warning." For the examining attorney to now rely on Mr. Wohlmuth's statement in his brief is unfair to applicant. Applicant's objection is therefore sustained and we do not further consider Mr. Wohlmuth's statement. In addition, we do not further consider the other

² The question of whether, in general, a designation may function as both a trademark and as the name of a file format is also not before us, because the examining attorney conceded in his brief that a designation may function as both a trademark and as the

statements submitted with the Letters of Protest in light of what the examining attorney said in his final Office action.

Analysis

It is applicant's burden to establish a prima facie case of acquired distinctiveness. See *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). In determining whether a term has acquired distinctiveness, the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage and consumer studies (linking the name to a source).³ *Cicena Ltd. v. Columbia Telecomms Group*, 900 F.2d 1546, 14 USPQ2d 1401 (Fed. Cir. 1990). "On this list, no single factor is determinative." *In re Steelbuilding.com*, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). The amount and character of

name of a file format. Examining attorney's brief at unnumbered 5.

³ See also TMEP §1212.06 (October 2012), stating:

Under Trademark Rule 2.41(a), 37 C.F.R. §2.41(a), an applicant may submit affidavits, declarations under 37 C.F.R. §2.20, depositions, or other appropriate evidence showing the duration, extent, and nature of the applicant's use of a mark in commerce that may lawfully be regulated by Congress, advertising expenditures in connection with such use, letters, or statements from the trade and/or public, or other appropriate evidence tending to show that the mark distinguishes the goods or services.

evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. See *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (CCPA 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (CCPA 1960); and *In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985).

The Federal Circuit, our primary reviewing court, has stated that "the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning." *In Re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990). Thus, we consider next the degree of descriptiveness of the term in relation to the goods identified in the application.

The record reflects that "dwg" is an abbreviation for "drawing." See *American Standard Abbreviations for Use on Drawings* (American Standards Association, 1947 and 1950); *Architectural and Graphic Standards* (John Wiley & Sons, Inc., 5th ed. 1956); *American National Standard Abbreviations for Use on Drawings and in Text* (Am. Soc. Mechanical Engineers, rev. 1950); *Acronyms and Initialisms Dictionary* (4th ed. 1960). An abbreviation of a merely descriptive or generic term is also merely descriptive or

generic if it is readily understood by the relevant purchasers to be "substantially synonymous" with the merely descriptive or generic wording which it represents or for which it stands. See *Modern Optics, Inc. v. Univis Lens. Co.*, 234 F.2d 504, 506, 110 USPQ 293, 295 (CCPA 1956); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712 (TTAB 2011) (finding that consumers would recognize the mark NKJV as an abbreviation for "new King James version" and thus is merely descriptive of bibles); *In re BetaBatt Inc.*, 89 USPQ2d 1152 (TTAB 2008) (finding DEC substantially synonymous with "direct energy conversion" and thus merely descriptive of a type of batteries). Applicant's goods are used to create drawings, i.e., drawings for engineering, architecture, manufacturing, building, and construction applications. DWG, therefore, as a recognized abbreviation for "drawing," is highly descriptive of a primary feature of applicant's goods.

We now consider whether applicant has submitted sufficient evidence to establish acquired distinctiveness of this highly descriptive term.

During the oral hearing, applicant's attorney represented that the evidence demonstrates that applicant used DWG in three phases. The first phase extended from the early 1980s until the mid-1990s, when applicant used

.dwg only as a file extension in connection with files for its program AutoCAD. The second phase extends extended from the mid-1990s until the early 2000s, when applicant intermittently used DWG to identify the source of its software, and, of course, used .dwg as a file extension. The third period spans from 2003 when applicant allegedly used DWG consistently as a source indicator, as well as .dwg, until the present.

A central question in this appeal, and integral to applicant's description of the evolution of its alleged mark, is whether applicant's use of .dwg as a file extension can inure to applicant's benefit in establishing trademark rights in the designation DWG.⁴ As we see it, this encompasses uses in the first phase, i.e., when opposer had no trademark use, as well as in the second and third phases, when applicant was or is using both DWG and .dwg.

Applicant argues at pp. 11 - 13 of its brief (citations omitted):

There are no restrictions on how acquired distinctiveness can or should be established. Here, Applicant's evidence of substantial and ongoing use and promotion of the .dwg file

⁴ Indeed, at p. 7 of its brief, applicant characterizes the issue as "[w]hether applicant's claim of acquired distinctiveness for the mark DWG is supported by Applicant's longstanding and continuous use and promotion of the .dwg file extension and of various DWG-related marks."

format, of promotion of a series of DWG-related brands, of promotion of DWG desktop icons since at least 2003 and other efforts pre-dating 2005 are of great consequence.

Applicant's pre-2005 use of the .dwg file format and DWG-related marks are relevant, for example, as "use analogous to trademark use." Courts have long-recognized the concept of "use analogous to trademark use," permitting a party to establish proprietary rights in a mark even when its use falls short of the technical use required to obtain a federal trademark registration. ...

The Examining Attorney has disregarded Applicant's evidence of analogous use on the grounds that the theory is inapplicable to *ex parte* proceedings. ... Indeed, application of the analogous use doctrine in an *ex parte* proceeding concerning secondary meaning is appropriate because in both an *ex parte* secondary meaning inquiry and in an *inter partes* proceeding, the key issue is whether a brand owner can show it has promoted a term such that the public now associates the term with the owner's products and services. ... To determine whether a party's use of a term rises to the level of analogous use, courts ask whether the "use is of such a nature and extent as to create public identification of [the] target term with the [party's] product or service." ... Likewise, in a secondary meaning analysis courts consider whether a party has presented evidence showing "an association formed in the minds of the consumers between the mark and the source or origin of the product."

Indeed, application of the analogous use doctrine in an *ex parte* proceeding concerning secondary meaning is appropriate because in both an *ex parte* secondary meaning inquiry and in an *inter partes* proceeding, the key issue is whether a brand owner can show it has promoted a term such that the public now associates the term with the owner's products and services.

In any event, even if Applicant's pre-2005 use of the .dwg file format and DWG-related marks is not deemed analogous use, it remains compelling circumstantial evidence of the evolution of secondary meaning for the DWG mark. There is no basis for the Examining Attorney's extraordinary position that such use -- spanning over two decades -- is "irrelevant" and should be disregarded.

However, at page 5 of its appeal brief, applicant states that it "is not claiming trademark protection in the file format '.dwg' and has no intention of exercising its trademark rights to prevent or restrict others from using the '.dwg' software file format." This was not the first time applicant disclaimed trademark rights in the file extension .dwg; in *Autodesk, Inc. v. Dassault Systemes Solidworks Corp.*, 685 F.Supp.2d 1023, ___ USPQ2d ___ (N.D. Cal. 2009), an action for, *inter alia*, trademark infringement of applicant's asserted common law trademark DWG, the Northern District of California held that Autodesk was judicially estopped from asserting trademark protection to the ".dwg" file format. According to the Court, "Autodesk disavowed any such claims against the use of ".dwg" as a file extension, and sought trademark protection only for its use as a word mark - namely, to have exclusive use of 'DWG' in packaging, advertising, and marketing materials used in connection with the sale of its goods and services." The court commented:

Autodesk's arguments [that it only disavowed uses of ".dwg" as a file extension when needed to achieve interoperability with the DWG file format defined by Autodesk] raise grave and serious concerns regarding the potential for trademark holders to monopolize the use of file extensions. The purpose of the Lanham Act is to protect consumers against deceptive designations of the origin of goods and, conversely, to enable producers to differentiate their products from those of others. ... Additionally, the targeted unauthorized use of a trademark must be a use "in connection with a commercial transaction in which the trademark is being used to confuse potential consumers." ... By contrast, the primary purpose of a file extension is to tell *the computer* the type of the file it is handling. A computer is not a consumer. Its "reading" of the file extension is not in connection with a commercial transaction. It doesn't care who made the file format it is trying to read. Whether the proper terminology for this use is a "functional use" or "non-trademark use," a file extension is not actionable under trademark law.

This remains true even if computer users associate a particular file extension with a particular manufacturer (e.g. ".xls" with Microsoft, ".pdf" with Adobe, or for argument's sake, ".dwg" with Autodesk). While there is no question that a file extension could serve a tangential purpose of communicating the source of the file or file format, this effect - in the vast majority of instances - would be incidental. The primary function of a file extension to both a computer and its user is to identify a file or file type. Even if the function were solely to identify the format in which the contents are stored, that would still be a functional use. Functional uses are not protected under trademark law.

Id. at 1028.

In addition, applicant's reliance on the doctrine of analogous use is misplaced. In *Shalom Children's Wear Inc.*

v. *In-Wear A/S*, 26 USPQ2d 1516, 1519 (TTAB 1993), the Board explained (citations omitted, emphasis added):

Use analogous to trademark use ... is non-technical use of a trademark in connection with the promotion or sale of a product under circumstances which do not provide a basis for an application to register, usually because the statutory requirement for use on or in connection with the sale of goods in commerce has not been met. Although never considered an appropriate basis for an application to register, such use has consistently been held sufficient use to establish priority rights as against subsequent users of the same or similar marks.

Further, the Board explained in *Central Garden & Pet Co., Inc. v. Doskocil Manuf'g Co., Inc.*, Opp. No. 91188816, ___ USPQ2d ___ (TTAB August 16, 2013), that "the Trademark Act defines 'use' of a trademark as the sale or transport in commerce of goods bearing the mark [and that] [w]hile such use (sometimes called 'technical' trademark use) is required to support an application for registration, a party may establish priority in a proceeding based on 'analogous use,' i.e., any non-technical use of a mark which is sufficient to create in the mind of the relevant public an association between the goods and their source." The Board distinguished between "technical" trademark use which is required to support an application for registration and "analogous use" which is "non-technical"

trademark use relevant to a proceeding in which priority is an issue.

Thus, the doctrine of analogous use is inapplicable to the present application. As the examining attorney correctly noted, the doctrine is used in *inter partes* proceedings, and not in *ex parte* proceedings. Applicant has not cited any Board or Federal Circuit precedent in which the doctrine has been applied in an *ex parte* proceeding. Indeed, the doctrine is unnecessary in *ex parte* proceedings, because priority is not an issue. And, in cases where the issue is acquired distinctiveness, the Federal Circuit has set forth a comprehensive list of evidence that an applicant may use to demonstrate that its applied-for term is a trademark; analogous use was not included. See *Steelbuilding.com*, 75 USPQ2d 1424 ("the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source).").

We do not ignore applicant's use of .dwg as a file extension and its contention that numerous individuals know of its file extension. Indeed, the Federal Circuit stated that "the determination [of acquired distinctiveness] examines all of the circumstances involving the use of the

mark." *Steelbuilding.com*, 75 USPQ2d at 1424. And, as quoted above, the *Dassault Systemes* court allowed that "While there is no question that a file extension could serve a tangential purpose of communicating the source of the file or file format, this effect - in the vast majority of instances - would be incidental." *Dassault Systems*, 685 F.Supp.2d at 1028.

We therefore must determine whether this case involves an "incidental situation" where a file extension serves a tangential purpose of communicating the source of the file or file format, mentioned by the district court, when applicant stated that it "is not claiming trademark protection in the file format '.dwg' and has no intention of exercising its trademark rights to prevent or restrict other[] [third-parties] from using the '.dwg' software file format." Brief at 5.

We turn, then, to the evidence of third-party uses of .dwg (as opposed to DWG). The declarations in the record acknowledge that third parties create software that is to be used with applicant's software applications and that in doing so, they create files with the .dwg file extension. See, e.g., the declarations of:

- Donnia Tabor-Hanson, a Technical Specialist employed by AEC CAD Solutions, Inc., who stated that "CAD users may sometimes use non-Autodesk

packages to create the .dwg files, but if so they typically choose the .dwg format so that they can transfer the files to others using Autodesk's AutoCAD technology";

- Thomas Short, of Thomas Short, P.E. who stated that "other software providers may, like Autodesk, use the .dwg computer file format but more often than not they are designing software that is to work with AutoCAD for specialized applications"; and

- Larry Sinea, Senior CAD Designer with The Griggs Group who stated that "other software providers may, like Autodesk, use the .dwg computer file format. It is my personal opinion that they do this to be compatible with AutoCAD. And I have seen this as a marketing approach. I have seen companies release a new add on or CAD program, and promote it as 'uses a dwg format that is compatible with AutoCAD.'"

Use of "dwg" as a file extension by third-parties thus occurs without objection by applicant, and applicant does not have any license agreements with these third-parties. See May 12, 2008 response at 5. We therefore find that applicant in practice does not exclusively use .dwg as a file extension and that third-parties do not consider applicant to have proprietary rights in .dwg as a file extension. Indeed, this is reflected in applicant's website, which, according to applicant, states in relevant part, "the status of DWG as both an Autodesk® file format name and an Autodesk trademark means that certain uses of DWG, without prior permission from Autodesk, are permissible while others are not."

Because (i) applicant does not intend the .dwg file format as trademark use, and takes the position that it "is not claiming trademark protection in the file format '.dwg' and has no intention of exercising its trademark rights to prevent or restrict others from using the '.dwg' software file format," brief at 5, and, (ii) third-parties are using the .dwg file extension without objection by applicant, applicant has not persuaded us that its use of .dwg as a file extension aids the consuming public in recognizing DWG as a source indicator for applicant's claimed goods.

With the foregoing in mind, we turn to the evidence applicant relies on to demonstrate that DWG (and not .dwg) has acquired distinctiveness as a mark, beginning with its survey.

Applicant commissioned a double blind survey from Deborah Jay of the Field Research Corporation in San Francisco, California. The survey, conducted by telephone in late 2005 and early 2006, was structured so as to be directed to individuals who make software purchasing decisions in companies that purchase, license, or upgrade design software (the "decisionmakers"). It questioned these decisionmakers on whether they associate "DWG" with design software from a single company or source, and if so, whether they associate it with design software from

applicant and/or AutoCAD exclusively.⁵ See Jay Decl. ¶2. The Field Research survey found that 43 percent of decisionmakers associated "DWG" with design software from a single company or source, and 42 percent of decisionmakers associated "DWG" with design software from Autodesk and/or AutoCAD® exclusively. *Id.* at ¶3.

The examining attorney correctly points out that the survey does not distinguish between use of DWG as a trademark or as a file extension name. "Name or term" in the survey questions encompass both use of DWG as a trademark and as a file format. At p. 7 of its reply, applicant argues that there is ample evidence in the record suggesting that the survey respondents were referring to use of DWG as a trademark. Relying on the declaration of Shawn Gilmour, applicant's Director of Digital Systems Design, applicant notes that the survey was conducted between November 28, 2005 and January 20, 2006, and at that time:

⁵ The relevant questions were:

"My next question concerns the name or term 'DWG.' Do you associate the name or term 'DWG' with design software form any particular company or companies?"

- (IF YES) "With what company or companies?"
- (IF DIDN'T KNOW COMPANY NAMES) "Do you associate the name or term 'DWG' with design software from one company or more than one company?"

- Applicant had been offering products under DWG-related brands for at least 7 years;
- Applicant had been posting trademark notices identifying DWG-related brands as Applicant's trademarks for at least 8 years; and
- Millions of Applicant's users saw the file icon (of application Serial No. 78852808) on their computer screens for nearly two years.

Applicant is assuming that the decisionmakers were referring to *trademark* use when responding to the survey. There is no direct evidence that this is the case, and the survey questions - which were spoken on the telephone and were not in writing so the decisionmakers would know that a distinction existed between .dwg and DWG - do not exclude the possibility that decisionmakers were thinking of the file extension when responding to the questions. Thus, even under the circumstances pointed out in Mr. Gilmour's declaration, the survey does not distinguish between uses of DWG as a file extension and as a trademark. We do not presume that decisionmakers were consistently referring to DWG as a trademark, especially when the record contains evidence - of recent vintage - of use of DWG as a file extension.

Applicant argues at p. 16 in its main brief that "[n]othing in the survey would suggest to respondents that they were being asked about file formats." However, it is

applicant's burden to establish acquired distinctiveness, and the survey allows that the decisionmakers could have considered the .dwg file format in their responses.

Applicant also argues that "even if some of the respondents associated the surveyor's use of 'name of term 'D-W-G'' with the file extension .dwg, the survey evidence would still be appropriate and compelling." Brief at 16. There are two problems with this argument; (i) there is no way of knowing how many decisionmakers associated the survey's reference to "DWG" with the file extension .dwg, and (ii) it is not clear how the survey results should be discounted.

Thus, for the reasons stated above, we find that the survey has limited probative value.

We next turn to a declaration in the record which applicant heavily relies on, the declaration of Mark Strassman, applicant's vice-president of marketing. He states, in relevant part:

10. "DWG is Applicant's name for the file format and technology underlying AutoCAD® and other of Applicant's CAD software products."

11. "For nearly 25 years, computer files that AutoCAD® users have created, edited, or viewed - the number of these files likely totals in the billions - have incorporated the distinctive suffix DWG."

12. "Since 1985, Applicant has realized approximately \$10 billion in revenue from software featuring the DWG file format."

16. Applicant maintains the website www.autodesk.com, which prominently features Applicant's proposed DWG mark and gets approximately 775,000 page views and 115,000 unique visitors each business day.

19. There are over 2,200 articles in the Lexis-Nexis database and 1,800 articles in the Westlaw news databases referring to DWG and also referencing AutoCAD® or Applicant.

Mr. Strassman concludes:

21. In sum, because DWG is the name of the proprietary computer file format associated so closely with Applicant's software, and because of Applicant's efforts to promote DWG over time, consumers of CAD software are highly familiar with the name DWG and link it with Applicant. This connection between DWG, on the one hand, and Applicant on the other, began with and has persisted since the launch of Applicant's initial AutoCAD® product in the early 1980s.

We have several problems with Mr. Strassman's declaration. First, paragraph 10 includes both the file extension and the asserted mark in the definition of "DWG." Second, paragraphs 11 and 12 appear to be referring to the file extension, and not the proposed mark, and the income noted evidently includes income from the period from 1985 to 2005, prior to the time when applicant began (consistently) using its proposed mark. Third, regarding applicant's website discussed in paragraph 16, various

webpages from applicant's website include references to the file extension; this is not a situation where there is consistent trademark use on a website. Indeed, as mentioned earlier in this decision, applicant's website asks consumers viewing the website to distinguish between different uses of "dwg" on the website, stating, "the status of DWG as both an Autodesk® file format name and an Autodesk trademark means that certain uses of DWG, without prior permission from Autodesk, are permissible while others are not." Fourth, the testimony regarding the articles mentioned in paragraph 19 is not helpful because a representative sampling of the articles is not in the record. We therefore are unable to determine whether the articles refer to DWG as a trademark or as a file extension. Also, there is no indication as to how many articles in the databases are duplicates and no indication of when and where the articles were published, and particularly whether they were published prior to 2003, before applicant allegedly was consistently promoting DTG as a trademark.

Turning next to Mr. Gilmour's declaration, this declaration suffers from several of the same deficiencies noted with Mr. Strassman's declaration. Specifically, the figures regarding sales, revenue and authorized users

relate to "DWG technology" rather than exclusively for software sold under the proposed mark. Figures for "DWG technology" may include figures for software sold under the .dwg file extension, and even under different marks.

In addition, Mr. Gilmour addresses applicant's use of four icons in connection with its software. He states:

For many years, users of Autodesk's software products featuring DWG technology have been presented with a distinctive DWG icon on their computer screens when saving design and image files created or edited using Autodesk's products. Autodesk estimates that the DWG icon has been displayed on the computer screens of millions of software users.

Decl. ¶5. Only the following two icons, which were not used before 2004, include "DWG":



In discussing the icons as used on computer screens, Mr. Gilmour's declaration does not distinguish between those icons which do, and those icons which do not, include the DWG designation.

Further, at paragraph 7 of his declaration, Mr. Gilmour refers to the icon depicted above with DWG written horizontally and several exhibits to his declaration demonstrating use of the icon on product packaging for

applicant's software. He states, "[t]he number of consumers of CAD software who have purchased software with such packaging is in the millions." An examination of the sample packaging in the record reveals that the icon is depicted in the back of the packaging, and the primary marks for the product are AUTOCAD and AUTODESK. From the limited statements in the declaration and the samples of packaging, we are not able to assess the impact on consumers of a small combination mark depicted in the back of the product.

Finally, at paragraph 8 of the declaration, Mr. Gilmour states that applicant displayed its DWG-related marks on its various websites including its primary website, and that in a two-month period in 2010, over 4.7 million unique users located in the United States visited its websites. The statement is not specific as to what marks were viewed, how the marks were displayed and how many webpages actually contained the asserted DWG mark(s). Additionally, the statement only addresses a two-month period in 2010, and is silent about other periods of time.

In addition to the declarations of Messrs. Strassman and Gilmour, applicant submitted declarations from the following five individuals, employed by third-parties:

(i) Donnia Tabor-Hanson, who states that she believes that "purchasers and users of CAD software associate the term DWG with Autodesk exclusively"; and the ".dwg file format has always ... been spoken of as meaning 'compatible with AutoCAD'";

(ii) Thomas Short, who states that he believes "purchasers and users of CAD software universally associate the term DWG with Autodesk and especially with the AutoCAD software file format";

(iii) Larry Swinea who states that he believes "purchasers and users of CAD software associate the term DWG with Autodesk exclusively";

(iv) Martin Fischer, who states that he believes "purchasers and users of CAD software associate the term DWG with AutoCAD primarily"; and

(v) Rustin Gesner, who states that he believes "purchasers and users of CAD software primarily associate the term DWG with Autodesk software."

The examining attorney maintains that these declarations are flawed in that they do not distinguish between use of DWG as a file extension name or as a trademark for applicant's goods. We agree. Furthermore, the declarations have limited probative value because they do not state the basis for each declarant's conclusion that purchasers and users of CAD software associate the term DWG with applicant. They declare that their statements are based on their experience in the CAD field, but do not describe what it is in their experience that lead them to their conclusion. In addition, the declarations are only

five in number. See *In re Dimitri's Inc.*, 9 USPQ2d 1666, 1668 (TTAB 1988) (stating with regard to seventeen declarations in evidence, "The existence of a relatively small number of people who associate the term 'SUMO' with applicant is simply insufficient for us to find that the term functions as a trademark for applicant's goods.").

We also point out that the sworn declaration of Abhijit Oak, applicant's Senior Director of Enterprise Application Development, filed in *Autodesk, Inc. v. Open Design Alliance*, Civ. No. C06-1637-MJP in the Western Division of Washington, and submitted to the Office with one of the Letters of Protest, states in relevant part:

Like many software application, the AutoCAD program implements a proprietary file format for storing user data files - in the case of AutoCAD, user design data. That file format and related technology is known as 'DWG.'" ... The DWG file format serves to organize the information and relationships within the file, allowing that information to be used in the AutoCAD program.

(Emphasis added.) Mr. Oak's statement suggests that the term "DWG" as used in the declarations is intended to include the file extension .dwg, and not just the designation DWG.

With regard to the U.S. trademark registrations from the USPTO's TARR database which applicant submitted and maintains are for computer software file extensions, we

find them unpersuasive; it does not appear that mere descriptiveness and hence acquired distinctiveness were issues in obtaining the registrations, or that they all involved use of the registered trademarks as file extensions. Further, as is often noted, the Board is not bound by prior decisions of examining attorneys. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009).

Applicant also argues that its marks should be registered because the USPTO has registered two of applicant's other marks, namely REALDWG and RASTERDWG. These marks differ from the terms involved in this appeal. They likely registered for reasons unrelated to the issues now before us, where the term DWG stands alone or as a separate term. Each case must stand on its own merits, and a mark that is merely descriptive must not be registered on the Principal Register simply because other such marks appear on the register. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062 (TTAB 2011); *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517 (TTAB 1977).

Applicant also asserted that it "protects its rights in the mark DWG," and offered evidence of six legal actions - two in the district courts and four before the Board - in

which it was a plaintiff. The evidence regarding the four actions before the Board does not reflect what mark(s) applicant sought to oppose or cancel, and hence have no probative value. With respect to the two district court actions, the papers submitted from the action against Dassault Systemes Solidworks Corporation do not reflect a victory for applicant in the proceeding. The papers from the district court action against the Open Design Alliance reflect a settlement of the action, which did not involve the proposed mark DWG, but involved "trademark infringement and false designation of origin based on [Open Design Alliance's] improper simulation of Autodesk's TrustedDWG™ authentication mechanism and use of the AUTODESK® trademark" This consolidated appeal does not involve either of the TrustedDWG or AUTODESK marks.

Next, applicant submitted copies of several foreign registrations for DWG and DWG formative marks. In *In re Hag Aktiengesellschaft*, 155 USPQ 598 (TTAB 1967), the Board stated, "[t]he foreign registrations ... are not persuasive on the issue before us because it has not been demonstrated that the criteria for registration in these countries involve examination systems in any way analogous to that of this country; and manifestly applicant's right of registration must be determined under the provisions of the

Lanham Act as interpreted by the various judicial tribunals in this country." Thus, the foreign registrations have no probative value.

We have also considered the other evidence submitted and arguments made by applicant in support of its claim of acquired distinctiveness, including the asserted recognition by third-parties of applicant's trademark rights, and references to DWG by "glossary publishers" such as "Free On-Line Dictionary of Computing." Such evidence and arguments fail to persuade us that applicant has acquired distinctiveness in the term DWG.

We also point out that applicant did not submit other types of evidence which the Board typically considers in determining acquired distinctiveness. Specifically, there is no evidence regarding advertising expenditures or the quantity, frequency and scope of any advertising of software under the applied-for marks. Clearly, DWG is not the primary mark for applicant's goods, and it is not apparent from the material submitted by applicant to what extent the DWG-formative marks have made an impression on purchasers as a source indicator for applicant's goods.

Thus, in view of the foregoing, and given the highly descriptive nature of the designation DWG, we would need substantially more evidence than what applicant has

Ser. No. 78852798, 78852808, 78852813, 78852822 and 78852843

submitted in order to find that the designation has become distinctive of applicant's goods. *In re Lens.com Inc.*, 83 USPQ2d 1444 (TTAB 2007). Because the applied-for term has been used in association with a highly successful product does not mean the term has acquired distinctiveness.

Decision: The examining attorney's finding that the Section 2(f) showing is insufficient in application Serial No. 78852798 is affirmed. The requirements for disclaimers of DWG in application Serial Nos. 78852808, 78852813, 78852822 and 78852843 are also affirmed.

Application Serial Nos. 78852798, 78852808, 78852813, 78852822 and 78852843 are all refused registration.

However, the disclaimer requirements will be set aside if, within thirty (30) days of the mailing date of this decision, applicant submits to the Board a proper disclaimer of the term "DWG" in each of application Serial Nos. 78852808, 78852813, 78852822 and 78852843. See Trademark Rule 2.142(g), 37 U.S.C. § 2.142(g); and TBMP § 1218 (3d ed. rev.2, June 2013). A proper disclaimer should state as follows:

No claim is made to the exclusive right to use the term "DWG" apart from the mark as shown.