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Subject: U.S. TRADEMARK APPLICATION NO. 78852808 - DWG - 5477-TM1002 -
EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NOS.78852808

78852808
78852813
78852822
78852843



MARKS: DWG

DWG and design
DWG TRUEVIEW
DWG TRUECONVERT
DWG EXTREME

CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Autodesk, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

5477-TM1002

CORRESPONDENT E-MAIL ADDRESS:

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EXAMINING ATTORNEY'S CONSOLIDATED APPEAL BRIEF

Applicant has applied to register five marks consisting of DWG alone or with other matter for:

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 marks are:

DWG (Serial No. 78852798)
DWG and design (Serial No. 78852808)
DWG TRUEVIEW (Serial No. 78852813)
DWG TRUECONVERT (Serial No. 78852822), and
DWG EXTREME (Serial No. 78852843).

Registration has been refused in the first listed application on the ground that DWG is merely descriptive of applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act. Registration has been refused in the other applications because of applicant's refusal to disclaim the merely descriptive terminology DWG under Section 6 of the Trademark Act. In response to these refusals, applicant has claimed that DWG has acquired distinctiveness under Section 2(f) of the Trademark Act. In its response filed March 13, 2007, applicant stated:

Although Applicant maintains that the mark is not descriptive of its goods, Applicant elects to submit evidence that the mark has acquired distinctiveness through extensive use, promotion and publicity.

However, applicant did not present any arguments at that time, or since, that DWG is not merely descriptive of applicant's CAD software under Section 2(e)(1) of the Trademark Act. Its statement of issues in the appeal brief does not include mere descriptiveness as being in issue. Thus, applicant has effectively conceded the mere descriptiveness of DWG in relation to its goods. Because the evidence submitted by applicant is insufficient to establish acquired distinctiveness, the refusals were made final.

ISSUES

In view of the fact that applicant has never made any arguments to support its initial contention that DWG is not merely descriptive of its CAD computer software, the primary issue presented by these appeals is whether DWG has acquired distinctiveness for applicant's CAD (computer-aided design) software. That determination rests upon a resolution of the following issues:

1. Whether a claim of acquired distinctiveness can be based in any part on the term's use as a file format name.
2. Whether the memorandum opinion of the U.S. District Court for the Northern District of California in a case involving DWG precludes applicant from taking the position that its use of a file format name can support the registrability of its marks.
3. Whether the concept of analogous use may be applied in an *ex parte* proceeding involving mere descriptiveness and, if so, whether applicant's use of DWG as a file format name is use analogous to trademark use.
4. Whether applicant's survey and declarations demonstrate recognition of DWG as a trademark.
5. Whether third-party uses of DWG inure to applicant's benefit in evaluating the acquired distinctiveness of DWG.
6. Whether foreign registrations of applicant's DWG marks or third-party registrations in the United States for marks which are also file format names support the registrability of applicant's marks
7. Whether dictionary definitions of DWG support the registrability of applicant's marks.

MERE DESCRIPTIVENESS

DWG is a recognized abbreviation for "drawing." *The American Standard Abbreviations for Use on Drawings* (Exhibit 11), the *American National Standard Abbreviations for Use on Drawings and in Text* ((Exhibit 15), *the Acronyms and*

Initialisms Dictionary (Exhibit 16) (all exhibits to the Letter of Protest granted March 16, 2010), and *Acronym Finder* (attached to the Office action of June 9, 2011) all show that DWG is an abbreviation for “drawing.” The declaration of Mickey Wohlmuth, co-founder of CADMAX Corporation, filed with the Letter of Protest, and referenced in the Office action of August 24, 2010, states:

5. At least as early as 1981, CADMAX’s software saved and read drawing files with a file extension of ‘.dwg’ and referred to such drawing files as DWGs. CADMAX software continues to read and create DWGs today without the use of Autodesk software.
6. It has always been my understanding throughout the more than 30 years that I have worked in the CAD industry that DWG and the file extension .dwg reflect a contraction of the word ‘drawing’ and are intended to identify files that contain drawings.

Exhibit 4, Letter of Protest granted March 16, 2010.

Thus, “drawing” is obviously at least merely descriptive of software used to create drawings, and thus, so is DWG. An abbreviation, initialism, or acronym 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 for which it represents or stands. E.g., *Modern Optics, Inc. v. Univis Lens. Co.*, 234 F.2d 504, 506, 110 USPQ 293, 295 (C.C.P.A. 1956); *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); *see also 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).

.dwg is a file extension name used for CAD drawings, both by applicant and others in the industry. DWG is the equivalent of .dwg and therefore merely describes software which assists in the creation of drawings which use a .dwg file extension. Thus, DWG merely describes applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act. Applicant is now seeking registration under Section 2(f), claiming that DWG has acquired distinctiveness.

ARGUMENTS

1. Whether a claim of acquired distinctiveness can be based in any part on the term's use as a file format name.

Yes. Contrary to applicant's arguments, the examining attorney does believe that it is possible for a designation to function both as a trademark and as the name of a file format. The unpublished TTAB case cited by applicant, *In re Fuji Photo Film Co., Ltd.*, Serial No. 75-580,709 (December 19, 2006), provides some useful guidance, in spite of its lack of precedential value. In that case, the applicant, along with its business partners, developed a proprietary technical specification and licensed it to others, using a "specification agreement," which set forth the terms and conditions for use of the trademark. In that case, applicant did not use a file format name for over 20 years before deciding to try to protect the letters as a trademark. That applicant controlled third-party uses of the mark. This applicant does not seem to do so. In this case, applicant's delay in asserting its trademark rights, its lack of exclusive rights to the file format name, and others' use of DWG all serve to demonstrate that, in this case, a file format name is not registrable.

Further, applicant has disavowed any proprietary rights in .dwg as a file extension designation, as indicated in *Autodesk, Inc. v. Dassault Systemes Solidworks Corporation*, Case No. 3:08-cv-04397-WHA in the United States District Court for the Northern District of California. As stated in the Memorandum Opinion on the Use of “DWG” as a File Extension and Autodesk’s Disavowal Thereof, dated December 31, 2009 (a copy of which is attached to the response filed February 24, 2011):

....Autodesk must stand by its disavowal of trademark rights in .dwg as a file extension – a disavowal that is binding on Autodesk....” (page 8)

No one has ownership of file extension designations under the Lanham Act because such designations are inherently functional. (Page 6)

Because applicant has no proprietary rights in .dwg as a file extension name, applicant’s use of DWG as a file extension name certainly cannot be used to support registration of DWG as a trademark.

2. Whether the memorandum opinion of the U.S. District Court for the Northern District of California in a case involving DWG precludes applicant from taking the position that its use of a file format name can support the registrability of its marks.

Yes. As indicated above, the United States District Court for the Northern District of California has stated that “....Autodesk must stand by its disavowal of trademark rights in .dwg as a file extension – a disavowal that is binding on Autodesk....” (page 8) and that: “No one has ownership of file extension designations under the Lanham Act

because such designations are inherently functional. (Page 6).” DWG is the equivalent of .dwg. Thus, the federal court opinion would seem to preclude applicant’s reliance on use of DWG as a file format name as a basis for acquired distinctiveness under Section 2(f).

3. Whether the concept of analogous use may be applied in an *ex parte* proceeding involving mere descriptiveness.

No. Applicant claims that its use of DWG as a file format name is use analogous to trademark use and that applicant should thus be allowed to tack-on such use to bolster its claim of distinctiveness. Further, applicant argues that, despite significant case law to the contrary, that:

.... Application of the analogous use doctrine in an *ex parte* proceeding concerning secondary meaning is appropriate because in both an *ex parte* proceeding 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.

Appeal Brief, page 12.

However, the concept of analogous use relates to priority of use and simply does not apply in *ex parte* proceedings. Use analogous to trademark use has been described as being:

... 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. *See: Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 173 USPQ 673 (CCPA 1972); *National Cable Television Ass’n., Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed.Cir. 1991).

Shalom Children's Wear Inc. v. In-Wear A/S, 26 USPQ2d 1516, 1519 (TTAB 1993).

Also, see *Oromeccanica, Inc. v. Ottmar Botzenhardt GmbH & Co.*, 223 USPQ 59 (TTAB 1983). Use analogous to trademark use may be used in an attempt to establish priority in *inter partes* proceedings, not to establish acquired distinctiveness under Section 2(f) in an *ex parte* proceeding.

Applicant is unquestionably the world leader in CAD (computer-assisted design) software and has enjoyed enormous success, as the evidence clearly demonstrates. But, the fact is, that although applicant developed the DWG file format in the early 1980s, it did not start using DWG as a trademark (or as part of a trademark) until over 20 years later. The issue is not, as applicant claims in its statement of issues, whether “the name of a file format for computer software can also function as a trademark.” Appeal Brief, page 7. The issue is whether an applicant can wait more than twenty years to assert trademark rights in a file format name when it does not have exclusive rights to the file format name.

Even if applicant were able to convince a tribunal that the concept of analogous use should or could be applied in an *ex parte* Section 2(f) situation, applicant’s use is not analogous to trademark use, as that concept is applied in *inter partes* proceedings.

Applicant first used the file format name in the early 1980s but did not use DWG as a mark for over two decades, which is certainly not a commercially reasonable time in the computing environment of those decades. “Actual, technical trademark use must follow the use analogous to trademark use within a commercially reasonable time.” *Dyneer*

Corp. v. Automotive Products Plc, 37 USPQ2d 1251 (TTAB 1995). Also, applicant claims that use of the mark on its packaging is akin to advertising use and thus should be considered analogous use because advertising use has been considered as use analogous to trademark use in priority situations (Response filed February 24, 2011). But, although “use analogous to trademark use is sufficient to create a proprietary right in the user for purposes of a likelihood of confusion claim, analogous use must be more than mere advertising.” *Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215, at 1218 (TTAB 2007). Further, use on packaging is not advertising.

In arguments against long-standing case law, in its brief, applicant has cited a single case and states:

.... At least one federal court has acknowledged the similarities between the analogous use and secondary meaning inquiries. *Archer Daniels Midland Co. v. Narula*, No. 99 C 6997, 2001 WL 804025 *9 (N.D. Ill. July 12, 2001) (noting whether analogous use achieved a priority right is ‘ another way of saying that a trade name... must be inherently distinctive, or have attained secondary meaning, to be entitled to protection.’

Appeal brief, pp. 12-13. The examining attorney disagrees. This case is hardly support for the application of the concept of analogous use in an *ex parte* mere descriptiveness situation. It was not *ex parte* and it did not involve mere descriptiveness.

4. Whether applicant’s survey and declarations demonstrate recognition of DWG as a trademark.

No. The survey and all but two of the declarations are of minimal evidentiary value because no distinction is made between use of DWG as a trademark and use of DWG as a file format name.

Survey

Applicant claims that a consumer data survey demonstrates that its mark has acquired distinctiveness. The survey respondents were persons who make the software purchasing decisions for companies that purchase, license, or upgrade design software.

The questions referring to DWG were phrased in this manner:

My next question concerns the name or term 'DWG.' Do you associate the name or term 'DWG' with design software from 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?"

See Deborah Jay declaration, Para. 2 (submitted with response filed March 13, 2007).

The survey, as applicant notes:

found that 43% of decisionmakers associated 'DWG' with design software from a single company or source, and 42% of decisionmakers said they associated 'DWG' with design software from Autodesk and/or AutoCAD® exclusively.

Because of the fact that .dwg is a file extension popularized by, but not used exclusively by, applicant, the survey asked the wrong questions. As indicated in the *Trademark*

Manual of Examining Procedure:

.... the survey must show that the public views the proposed mark as an indication of the source of the product or service. *Boston Beer Co. L.P. v. Slesar Bros. Brewing Co., Inc.*, 9 F.3d 175, 28 USPQ2d 1778 (1st Cir. 1993) (survey found insufficient to establish acquired distinctiveness where survey demonstrates product-place association rather than product-source association). The applicant must document the procedural and statistical accuracy of this type of evidence and carefully frame the questions contained therein. *See In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) ("[T]he survey asked the wrong question. The issue is not whether the term 'Office Movers' identifies a specific company. Rather, it is whether the term 'OFFICE MOVERS, INC.' identifies services which emanate from a single source.");

TMEP section 1212.06(d) ("Survey Evidence, Market Research and Consumer Reaction Studies").

The survey does not show that the public views DWG as an indication of the source of applicant's goods. The survey questions were constructed in such a way that it is not clear if the reference to DWG is as a trademark or as a file extension name, or something else. The survey does not ask the understanding of respondents with regard to DWG, e.g. whether it is a trademark or a file extension name. Because the words "name" and "term" used in the survey questions could encompass use of DWG as a file format name, this survey does not serve to establish whether consumers of applicant's goods recognize DWG as a trademark. Thus, the survey results are not compelling because that familiarity could well be with the file format use of ".dwg" and not with the trademark use thereof. The survey certainly does not establish that the respondents understood DWG to be a trademark for applicant's goods.

Applicant, however, has argued that it does not make a difference whether the survey respondents recognized DWG as a trademark or as a file format name:

For purposes of demonstrating reputation and, in particular, acquired distinctiveness, it should make no difference whether survey respondents associate the file format name '.dwg' or the mark DWG with Applicant, or both. The fundamental question is not how reputation was established, but whether reputation has been established and how strong that reputation is.

Response filed May 12, 2008, page 9. The law is otherwise. The relevant use must be as a mark, not as a file extension name. The substantially exclusive and continuous use must be "as a mark." 15 U.S.C. §1052(f). *See In re Craigmyle*, 224 USPQ 791 (TTAB 1984) (registrability under §2(f) not established by sales over a long period of time where there was no evidence that the subject matter had been used as a mark); *In re Kwik Lok Corp.*, 217 USPQ 1245, 1248 (TTAB 1983) (declarations as to sales volume and

advertising expenditures held insufficient to establish acquired distinctiveness. “The significant missing element in appellant’s case is evidence persuasive of the fact that the subject matter has been used as a mark.”). TMEP section 1212.05(c) (“Use as a Mark”). Simply stated, in this situation, use other than as a mark is not relevant for purposes of establishing acquired distinctiveness of DWG.

In response to the little weight accorded the survey by the examining attorney, applicant argues:

Here, the survey design [sic] by a prominent trademark expert employed well-recognized survey standards including but not limited to use of a control group, rotating questions, interviewer training and the use of relevant purchasers as respondents. Jay Decl., Ex. A at 6-10. The firm that performed the survey holds over 25 years of experience conducting large-scale surveys and is considered “one of the oldest and most respected marketing and public opinion research firms in the United States.” Jay Decl., Ex. A at 3.

Appeal brief, page 16. In spite of whatever experience and expertise the survey firm may have, the fact remains that the survey questions did not distinguish between use of DWG as a file format name or as a trademark. At best, the survey establishes that a significant portion of the respondents associated DWG with applicant, which is not the same as recognition as a trademark.

Applicant suggests that recognition of DWG as a file format name associated with applicant is relevant:

Furthermore, even if some of the respondents associated the surveyor’s use of ‘name or term D-W-G’ with the file extension .dwg, the survey evidence would still be appropriate and compelling. Section VI.a. supra. See McCarthy § 7.2 (4th Ed. 2006) (‘The fact that the owner of a mark uses it in association with accessory symbols or words does not deprive him of what the public recognizes as a mark.’).

Appeal brief, page 16. Again, mere association with applicant or its products is not enough.

As indicated above, the evidence must establish that the public views the mark as an indication of source. A file extension name and a trademark are not the same. Since DWG is also a file extension designation, a survey which did not distinguish between use of the subject term as a trademark or as a file extension name carries virtually no weight in demonstrating that distinctiveness of DWG as a trademark has been acquired.

Declarations

In addition to the declaration of Deborah Jay regarding the survey, applicant also has submitted the declarations of:

- applicant's vice president of marketing, Mark Strassman (filed with response of March 13, 2007)
- applicant's director of Digital Systems Design, Shawn Gilmour (filed with response of February 24, 2011 and the Request for Reconsideration filed October 13, 2011)
- five individuals who work in the CAD field but who are not employees of applicant (filed with response of May 12, 2008)

Strassman Declaration

In his declaration, Mr. Strassman states:

- One hundred percent of the Fortune 100 companies use Applicant's products. Applicant itself is a Fortune 1000 company, providing goods and services to over 7 million registered users in all 50 states and worldwide.
- Since 1985, Applicant has realized over \$10 billion in revenue from software featuring the DWG file format.
- Applicant has been using DWG continuously since the early 1980s.

- A search for articles in the Lexis-Nexis news database referring to DWG and also referencing AutoCAD® or Applicant revealed over 2,200 articles. A similar search in Westlaw's news database revealed over 1,800 articles.

The fact that applicant's goods may be popular is irrelevant to the issue of whether consumers recognize DWG as a trademark for the specified goods. *See In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars -- two million of which were spent on promotions and promotional items which included the phrase THE BEST BEER IN AMERICA -- found insufficient to establish distinctiveness, in view of the highly descriptive nature of the proposed mark); *Mattel, Inc. v. Azrak-Hamway International, Inc.*, 724 F.2d 357, 221 USPQ 302, 305 n. 2 (2d Cir. 1983). The ultimate test in determining whether a designation has acquired distinctiveness is applicant's success, rather than its efforts, in educating the public to associate the proposed mark with a single source. TMEP section 1212.06(b) ("Advertising Expenditures"). Applicant has not demonstrated its success in proving that consumers recognize DWG as a trademark for applicant's goods.

Applicant's statement that it has been using DWG continuously since the early 1980s is irrelevant. Applicant has claimed first use dates of November 28, 2005, which directly contradicts the statement in the Strassman declaration. Obviously, Mr. Strassman is referring to use of ".dwg" as a file format name and not as trademark use of DWG, which is not relevant to the acquired distinctiveness of DWG as a trademark.

Gilmour Declarations

In his declaration filed February 24, 2011, Mr. Gilmour refers to a chart of revenue data as being for “Autodesk products featuring DWG technology.” (Para. 3). No distinction is made between revenues for goods sold actually bearing the DWG trademark and those simply featuring “DWG technology.” Thus, the revenues generated from the sales of goods with the mark thereon cannot be determined and the submitted revenue figures therefore do not support the claim of acquired distinctiveness.

Mr. Gilmour also discusses use of DWG as part of an icon:

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.”

(Para. 5). The icons are depicted in Exhibit 1 to Gilmour’s declaration filed February 24, 2011. Further, with its Request for Reconsideration, applicant has submitted numerous examples of how a DWG icon has been used on its product packaging since 2008. The relevance of this evidence in establishing acquired distinctiveness is not clear. Simply because applicant has used the DWG icon does not mean that the DWG portion thereof is recognized as exclusively belonging to applicant and not regarded as being merely descriptive terminology in relation to CAD drawing software. While the icon may have been seen by millions, there is no reason to think that those encountering the DWG icon viewed the DWG part of it as exclusively referring to applicant or that it was a trademark of applicant.

Gilmour, in his declaration filed February 24, 2011, notes that between September 1, 2010 and October 30, 2010, applicant's website had 4.7 million unique users located in the United States. (Para. 8). While the website contains a DWG logo, those viewing it on applicant's website at best would associate it with applicant. That is a far cry from them perceiving DWG as a trademark for computer software.

Other Declarations

All of the declarations from non-employees submitted with applicant's response filed May 12, 2008 suffer from the same flaw: none distinguish between use of DWG as a file extension name or as a trademark for applicant's goods. The pertinent parts of these declarations appear below:

Donnia Tabor- Hanson, technical specialist at ABC CAD Solutions, Inc.:

Based on my experience in the CAD field, I believe purchasers and users of CAD software associate the term DWG with Autodesk exclusively. (Para. 3)

The .dwg file format has always, to my knowledge, been spoken of as meaning 'compatible with AutoCAD.' CAD users may sometimes use non-Autodesk packages to create .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. (Para. 4)

Thomas Short, of Thomas Short, P.E.:

Based on my experience in the CAD field, I believe purchasers and users of CAD software universally associate the term DWG with Autodesk and especially with the AutoCAD software file format. (Para. 3)

I understand 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.
(Para. 4)

Larry Swinea, Senior CAD Designer with the Griggs Group:

Based on my experience in the CAD field, I believe purchasers and users of CAD software associate the term DWG with Autodesk exclusively.
(Para. 3)

I understand 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’.” (Para. 4)

Martin Fischer, Professor of Civil and Environmental Engineering and Director of the Center of Integrated Facility Engineering at Stanford University:

Based on my experience in the CAD field, I believe purchasers and users of CAD software associate the term DWG with Autodesk primarily.
(Para. 3)

B. Rustin Gesner, IT & CAD Director of Group Mackenzie:

Based on my experience in the CAD field, I believe purchasers and users of CAD software primarily associate the term DWG with Autodesk software. (Para. 3)

I understand that other software providers may, like Autodesk, use the .dwg computer file format, primarily for the benefit of AutoCAD users, to write files in a format compatible with AutoCAD so they can easily be opened in AutoCAD and other Autodesk program users. [sic] (Para. 4).

It is little wonder that the declarants associated DWG with applicant, the largest player in the CAD software field. In determining trademark rights, an association is not enough. Again, as with the survey, there is no distinction made between use of DWG as a trademark or as a file format name in these declarations. It is not clear that the declarants understand DWG to be a trademark for applicant’s goods, which is, of course,

the whole point. All simply indicate that the declarants “associate” DWG with applicant and/or its software.

The Tabor-Hanson and Swinea declarations state that the declarants “associate the term DWG with Autodesk exclusively.” But, then both go on to state that they are aware that others use the .dwg file format:

Tabor-Hanson: “CAD users may sometimes use non-Autodesk packages to create .dwg files....”

Swinea: “I understand that other software providers may.... use the .dwg computer file format.”

Declarant Short states that “users of CAD software universally associate the term DWG with Autodesk” but then also acknowledges “that other software providers may use the dwg computer file format.” Short also notes that purchasers and users of CAD software “especially (associate DWG) with the AutoCAD software file format.” This is evidence of recognition of DWG as a file format name, not as a trademark. It is not understood how these declarants can claim that DWG is associated exclusively or universally with applicant while at the same time acknowledging that DWG is also is used by others as a file format name. This clearly does not reflect recognition of DWG as a trademark by these declarants.

Both the Fischer and Gesner declarations use the word “primarily” in conjunction with the word “associate”:

Fischer: “associate the term DWG with Autodesk primarily”

Gesner: “primarily associate the term DWG with Autodesk software.”

Such “primary association” means more often than not. This is hardly compelling evidence of acquired distinctiveness.

However, applicant argues that:

In actuality, the declarations of ... Tabor-Hanson, ... Short,... Swinea and Gesner all expressly distinguish between, on the one hand, the ‘term ‘DWG’ and, on the other hand, the ‘.dwg file,” the .dwg format’ and/or ‘.dwg computer filed format.

Appeal brief, page 17. The examining attorney disagrees. These declarations simply do not distinguish between use of DWG as a file format name and use of DWG as a trademark.

With its Request for Reconsideration, applicant has submitted four examples of competitor statements purportedly recognizing applicant’s trademark rights in DWG. Two (Parametric Technology Corp. and Bentley Systems, Inc.) clearly state that DWG is a trademark of applicant. However, the statement from the Open Design Alliance states: “DWG is the native and proprietary file format for AutoCAD and a trademark of Autodesk, Inc.” The Corel Corporation press release indicates that its CorelCAD product “uses DWG TM as its native file format.” These latter two examples do not support applicant’s claim of acquired distinctiveness because applicant has disavowed any proprietary rights in .dwg as a file extension designation, as indicated in the *Autodesk, Inc. v. Dassault Systemes Solidworks Corporation*, Case No. 3:08-cv-04397-WHA in the United States District Court for the Northern District of California, *supra*.

5. Whether third-party uses of DWG inure to applicant's benefit in evaluation the acquired distinctiveness of DWG.

No. Applicant has contended that third-party uses occur:

in order to suggest consumer compatibility with Applicant's technology. This kind of referential use is not inconsistent with a claim of secondary meaning; rather, it reinforces the fact that the marketplace associates DWG with applicant.

(Response filed November 13, 2007, page 7). In the same vein, applicant argues that "... third-party use of the .dwg file format actually emphasizes the close association of the mark DWG with Applicant." Appeal brief, page 13. However, third-party use of a file format name, to which applicant does not have exclusive rights, can hardly be used to support a claim of acquired distinctiveness. These uses are not like "IBM-compatible," but clearly show use of DWG in at least a merely descriptive sense. As indicated on the Apple website:

DWG files are industry-standard, and software tools on the Mac can help you manage and manipulate them easier and more powerfully than ever. See how ArchiCAD, eDrawings and VectorWorks allow you to view, edit and manipulate DWG files on the Mac, in addition to providing other capabilities....

See evidence attached to Office action of November 13, 2007. It is also noted that applicant disclaimed DWG in two U.S. trademark applications, which have since been abandoned (Serial Nos. 75-156,366 and 75-125,408). See copies attached to Office action of November 13, 2007.

During the prosecution of this application, it has been established that others use marks which include DWG for similar goods. These include, for example, the uses of AnyDWG, AutoDWG, and EasyDWG (made of record with the Office action of November 13, 2007). In response to the examining attorney's question, applicant

indicated it did not have any license agreements with the users of those marks.

(Response filed May 12, 2008, page 5). Further, all of the non-employee declarants acknowledge that software providers use .dwg as a file format name.

6. Whether foreign registrations of applicant's DWG marks or third-party registrations for marks which are also file format names support the registrability of applicant's marks.

No. Applicant has made of record copies of registrations for DWG marks issued by Canada, Australia, Japan, China, Spain, Mexico, the Benelux countries, the United Kingdom, Brazil, the People's Republic of China, and the Russian Federation. Applicant contends that these submissions serve to support its claim of acquired distinctiveness. However, registration in a foreign country does not automatically ensure eligibility for registration in the United States. *In re Rath*, 402 F.3d 1207, 1214, 74 USPQ2d 1174, 1179 (Fed. Cir. 2005); *In re Mastic Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987); *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *Order Sons of Italy in America v. Marofa S.A.*, 38 USPQ2d 1602 (TTAB 1996). Thus, the existence of foreign registrations for DWG marks is not relevant to the establishment of acquired distinctiveness of DWG as a trademark in the United States.

Applicant also claims that registrations issued by the USPTO for marks which are also purportedly file format names support the registrability of DWG as a trademark. Applicant submitted copies of these registrations into evidence, which include the following marks:

FBX
PAGES
JAVA
NES
X3F
DNG
BSB
SAT
DPOF

It is noted, however, that unlike we have here, none seem to be abbreviations for merely descriptive terms. Further, it is not known if there was evidence of others using the file format designations or how long these registrants took to assert their trademark rights. Most important, third-party registrations are not conclusive on the question of descriptiveness. Each case must be considered on its own merits. An applied-for mark that is merely descriptive does not become registrable simply because other similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517 (TTAB 1977); TMEP §1209.03(a).

7. Whether dictionary definitions of DWG support the registrability of applicant's marks.

No. Applicant has made of record ten dictionary definitions of DWG, all of which refer to Autodesk (applicant) or AutoCAD (applicant's registered trademark) and suggest that DWG is applicant's proprietary file format. In his declaration filed February 24, 2011, Mr. Gilmour states:

.... these publishers identify DWG as a format exclusively associated with Autodesk or with Autodesk's well-known CAD software product, AutoCAD.

Para 17. However, these definitions are now outdated. Applicant has disavowed any proprietary rights in .dwg as a file extension designation, as indicated in *Autodesk, Inc. v.*

Dassault Systemes Solidworks Corporation, Case No. 3:08-cv-04397-WHA in the United States District Court for the Northern District of California in the Memorandum Opinion on the Use of “DWG” as a File Extension and Autodesk’s Disavowal Thereof, dated December 31, 2009, *supra*.

Because applicant has no proprietary rights in .dwg as a file extension name, applicant’s use of DWG as a file extension name cannot be used to support registration of DWG as a trademark. Therefore, these dictionary definitions are irrelevant and cannot serve to support applicant’s claim of acquired distinctiveness.

CONCLUSION

As the evidence clearly establishes, DWG is a recognized abbreviation for “drawing.” .dwg is a file format name used for CAD drawings, both by applicant and others in the industry. DWG is the equivalent of .dwg and therefore merely describes software which assists in the creation of drawings which use a .dwg file extension. Thus, DWG merely describes applicant’s goods within the meaning of Section 2(e)(1) of the Trademark Act.

The examining attorney is not persuaded by the evidence of distinctiveness because use as the name of a file format is not use analogous to trademark use, and the survey is entitled to little weight because, from the manner in which the questions were phrased, it is unclear if the respondents understood DWG to be applicant’s trademark applicant or whether the respondents merely associated the file format .dwg with applicant.

An applicant cannot wait more than twenty years to assert trademark rights in a file format name when it does not have exclusive rights to the file format name. Further, the memorandum opinion issued by the U.S. District Court for the Northern District of California precludes applicant from taking the position that its use of a file format name can support the registrability of its marks. Thus, a claim of acquired distinctiveness cannot be based in any part on the term's use as a file format name. The concept of analogous use may not be applied in an *ex parte* proceeding involving mere descriptiveness. Applicant's survey and declarations do not demonstrate recognition of DWG as a trademark because no distinction was made between use of DWG as a file format name and as a trademark. The third-party uses of DWG do not inure to applicant's benefit in evaluating the acquired distinctiveness of DWG. Foreign registrations for similar marks do not support the registrability of applicant's marks in the United States. Applicant does not control the use of DWG by others, either as a trademark or as a file format name. While applicant created the .dwg file extension designation, it does not have proprietary rights thereto.

DWG is merely descriptive of applicant's software. The Section 2(f) evidence is deemed insufficient to establish that DWG has acquired distinctiveness as a trademark. Thus, the Section 2(e)(1) refusal based on mere descriptiveness is proper and should be affirmed by the Board.

Respectfully submitted,

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