

October 13, 2011

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RE: Application Serial No.: 78/852798
Mark: DWG
Filing Date: April 3, 2006
Applicant: Autodesk, Inc.
Office Action Mailing Date: June 9, 2011
Examining Attorney: Paul E. Fahrenkopf, Law Office 101
Attorney Reference No.: 5477-TM1001

REQUEST FOR RECONSIDERATION

I. Introduction

Applicant Autodesk, Inc. (“Applicant”) hereby responds to the Final Office Action dated June 9, 2011 (“Final Office Action”). In the Final Office Action, the USPTO has maintained objections to register the mark DWG on the grounds that the mark is merely descriptive of Applicant’s goods under Section 2(e)(1) of the Trademark Act and that Applicant has not established that the mark has achieved acquired distinctiveness under Section 2(f). For the reasons previously stated and based on the additional evidence submitted with this request, Applicant respectfully requests that the USPTO reconsider its objections to registration of the mark and approve the application for publication.

II. Additional Evidence Submitted by Applicant

Applicant has previously submitted substantial evidence of distinctiveness of its DWG mark. Applicant now presents to the USPTO the following additional evidence:

- Additional evidence of the company's use of the distinctive DWG icon, DWG (AND DESIGN), from 2008 to present (Exhibit A (October 6, 2011 Declaration of Shawn Gilmour, hereinafter "Gilmour Decl. #2"), Exhibits 1-11);
- Examples of competitor recognition of Applicant's trademark rights in DWG (Gilmour Decl. #2, Exhibits 12-15);
- Registration certificates for Applicant's DWG mark from the United Kingdom and Brazil (Gilmour Decl. #2, Exhibits 16-17);
- Registration certificates for Applicant's DWG (AND DESIGN) mark, without a disclaimer for "dwg", from the People's Republic of China and the Russian Federation (Gilmour Decl. #2, Exhibits 18-19);
- Recent examples of glossary publisher entries associating DWG with Applicant (Gilmour Decl. #2, Exhibits 20-24); and
- USPTO TARR records for 3rd-party U.S. trademark registrations for the computer software file extensions referenced in Applicant's February 24, 2011 Office Action Response:
 - FBX (reg. no. 2676937) (Exhibit B);
 - PAGES (reg. no. 3044896) (Exhibit C);
 - JAVA (reg. no. 2178784) (Exhibit D);
 - NES (reg. no. 1721018) (Exhibit E);
 - X3F (reg. no. 2939661) (Exhibit F);
 - DNG & DESIGN (reg. no. 3484827) (Exhibit G);
 - BSB (reg. no. 3026152) (Exhibit H);
 - SAT (reg. no. 2342417) (Exhibit I); and
 - DPOF (reg. no. 3245699) (Exhibit J).

Applicant has also identified the following additional U.S. trademark registrations that correspond to the names of computer software file extensions, and copies of USPTO TARR records for these registrations are also attached as exhibits:

File Extension Name	Mark as Registered	Reg. No.	Software Type	Registration Owner	Exhibit
.acl	ACL & DESIGN	3234097	Auditing software	ACL Services Ltd.	K
.air	AIR	3548718	Web page software	Adobe Systems Inc.	L
.sgi	SGI	2517897	Graphics software	Silicon Graphics, Inc.	M
.sgi	SGI & DESIGN	2517956	Graphics software	Silicon Graphics, Inc.	N
.xsi	XSI	2572022	Visual effects and game development software	Autodesk, Inc.	O
.zip	ZIP	2806052	File compression software	Iomega Corporation	P

III. Applicant's Section 2(f) Claim of Acquired Distinctiveness

The evidence filed with the USPTO in support of Applicant's claim of secondary meaning -- which now includes prior evidence and newly-submitted additional evidence -- should be more than adequate.

Applicant emphasizes that "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 § 1212.06(b). Here, through Applicant's longtime and extensive use of DWG, including use of ".dwg" as a file extension for Applicant's highly popular and proprietary software products, Applicant has achieved success in

establishing secondary meaning in its DWG mark. *See, e.g.*, Declaration of E. Deborah Jay submitted with Applicant's March 13, 2007 Office Action Response.

IV. Letter of Protest Evidence Provides Minimal, If Any, Evidentiary Value

In the Final Office Action the USPTO cites evidence submitted in a Letter of Protest that should be afforded minimal, if any, evidentiary value. Certain exhibits from the Letter of Protest lack any foundation or authentication. Specifically, Exhibits 26, 28, 30 and 32 from the Letter of Protest, referenced in the Office Action of August 24, 2010, do not contain information which identifies the source of the documents. Nor does the related Letter of Protest contain an affidavit of any witness identifying and/or authenticating the documents. In short, "we have no information establishing either the authenticity or the exact nature or source of the documents." *In re Urbano*, 51 USPQ2d 1776, 1779 (T.T.A.B. 1999). Because "the record includes no affidavits or other evidence establishing any foundation for these documents... they are of minimal evidentiary value." *Id.*; *see also Trademark Trial and Appeal Board Manual of Procedure* § 1208 (USPTO, 3rd ed. 2011) ("[D]ocuments submitted by a third party by letter of protest must still comply with *inter partes* evidentiary requirements of foundation and authentication to have evidentiary value.").¹

Other Letter of Protest exhibits cited in the Final Office Action do not support the USPTO's position. For example, the USPTO asserts that Exhibits 18, 19, 25 and 31 from the

¹ Letter of Protest exhibits not cited by the USPTO in the Final Office Action also lack sufficient foundation and authentication for the same reasons. *See, e.g.*, Exhibits 27 and 36 from the Letter of Protest, referenced in the Office Action of August 24, 2010.

Letter of Protest, referenced in the Office Action of August 24, 2010, “show use of ‘dwg’ or ‘dwgs’ as abbreviations of ‘drawing’ and ‘drawings,’ respectively.” Exhibit 18 uses the term “dwg,” but not interchangeably with “drawing” and not clearly as a substitute for the term. Exhibits 19 and 31 both use the term “dwgs,” but here as well not interchangeably with “drawings” and not clearly in lieu of the term. Only Exhibit 25 includes both the terms “dwgs” and “drawings,” but the terms are not clearly used as substitutes for one another.

V. Conclusion

Applicant respectfully requests reconsideration of the objections to this application and further requests that the application be forwarded to publication.

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI
A Professional Corporation



John L. Slafsky
Matthew J. Kuykendall
Attorneys for Applicant