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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

AUTODESK, INC., a Delaware corporation,
Plaintiff,
v.
DASSAULT SYSTÈMES SOLIDWORKS
CORPORATION, a Delaware corporation,
Defendant.

Case No. 3:08-cv-04397-WHA

**AUTODESK'S MOTION IN
LIMINE NO. 2 TO EXCLUDE
EVIDENCE OR ARGUMENT
REGARDING AUTODESK'S
APPLICATIONS TO REGISTER
DWG AND DWG-BASED MARKS**

Date: December 30, 2009
Time: 9:00 a.m.
Place: Courtroom 9, 19th Floor
Judge: Hon. William H. Alsup

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I. INTRODUCTION

In its briefing and oral argument in this case, SolidWorks has emphasized the PTO examination histories of Autodesk's applications for registration of DWG-based trademarks, suggesting it intends to rely on these histories at trial. This material is irrelevant and highly prejudicial. The Court should, in accordance with Federal Rules of Evidence 402 and 403, exclude any evidence or argument regarding the prosecution histories of Autodesk's applications to register the marks DWG, MAX DWG, and DWG UNPLUGGED.

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II. ARGUMENT

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A. Solidworks Should Be Precluded from Introducing any Evidence or Argument regarding Autodesk's Application to Register the Mark DWG

In its briefing, SolidWorks relies on the prosecution history of Autodesk's trademark application for the mark DWG for the contention that the "PTO refused Autodesk's registration," and quotes extensively from the Notice of Suspension issued by the PTO. (SolidWorks' Mot. for Summ. J. ("SW Mot.") (D.I. 91) at 4.) According to that prosecution history, on April 3, 2006, Autodesk applied to register its mark DWG. (Declaration of Jacqueline Bos ("Bos No. 2 Decl."), filed herewith, ¶ 2, Ex. 1 (Trademark Application at SW0005373).) In the course of examination, the PTO issued three non-final Office Actions. (Bos. No. 2 Decl., ¶ 3, Ex. 2 (Transaction history at SW0004838).) In the first Office Action, dated September 14, 2006, the PTO examining attorney refused registration of the DWG mark "because the proposed mark merely describes applicant's goods," but continued the examination by permitting Autodesk to "respond to the refusal to register by submitting evidence and arguments in support of registration." (Bos. No. 2 Decl., ¶ 4, Ex. 3 (Office Action at SW0005362-63).) Following a response from Autodesk, the PTO issued the second Office Action, dated May 19, 2007, in which the examining attorney withdrew the requirements for a substitute specimen and supporting declaration, but "maintained and continued" the refusal to register before inviting additional argumentation against the refusal. (Bos. No. 2 Decl., ¶ 5, Ex. 4 (Office Action at SW0005241-43).) Following a response from Autodesk, the PTO issued the third Office Action, dated November 13, 2007, in which the examining attorney "maintained and continued" the

1 refusal to register, and invited additional argumentation in addition to requesting answers to specific
2 questions. (Bos. No. 2 Decl., ¶ 6, Ex. 5 (Office Action at ADSK0010125-10127).)

3 On June 22, 2008, the PTO issued a Notice of Suspension of examination pending the
4 disposition of proceedings before the Trademark Trial and Appeal Board between Autodesk and the
5 ODA regarding “OPENDWG,” and between Autodesk and SolidWorks regarding
6 “DWGGATEWAY,” and “DWGEDITOR.” The examining attorney specifically stated that these
7 proceedings “could affect the registrability” of the DWG mark, and continued the refusal of
8 registration on the grounds that “DWG is a file format . . . Applicant is not the exclusive source of
9 files with the format name DWG . . . [and] Applicant does not control the use of DWG by others.”
10 (Bos. No. 2 Decl., ¶ 7, Ex. 6 (Roberts Decl. Ex. 26 (D.I. 100-1) at SW0004840-41).) The TTAB
11 proceedings were subsequently suspended pending the disposition of this civil action. *See* Bos No. 2
12 Decl., ¶ 8, Ex. 7 (PTO Electronic Record at ADSK0072111.)

13 The introduction at trial of the non-final Office Actions, Notice of Suspension, and other
14 documentation from the prosecution history of Autodesk’s application to register the mark DWG will
15 be of limited probative value and greatly prejudice Autodesk because of the undue weight that will be
16 accorded to this evidence by the jury. In *Everest Capital Ltd. v. Everest Funds Management., LLC*,
17 the Eighth Circuit Court of Appeals affirmed the district court’s decision in similar circumstances to
18 exclude a Notice of Suspension from evidence. *See Everest Capital*, 393 F.3d 755, 764 (8th Cir.
19 2005). There, the court found that “[t]he Trademark Office suspension notice had little probative
20 value because it stated a tentative opinion, not an administrative finding of fact based upon an
21 adequate record. But the agency opinion had the potential to unfairly prejudice the defendants if the
22 jury mistakenly viewed it as an official government position on the critical confusion issue that the
23 jury had to decide.” *Id; cf. United States v. Perry*, 857 F.2d 1346, 1351 (9th Cir. 1988) (“admission
24 of a prior judicial opinion as substantive evidence of a fact then in issue presents the danger that a
25 jury may give the judicial opinion undue weight or be confused, believing the earlier court’s findings
26 somehow binding on it”).

27 Here, the PTO’s non-final Office actions as well as its Notice of Suspension are tentative
28 opinions that are not final administrative agency opinions. As such, the concern expressed by the
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1 Eighth Circuit is equally valid in this case, where the jury may mistakenly view these preliminary
2 opinions as the official government position on issues that must ultimately be decided by the jury.
3 Moreover, these documents address the precise issues the parties will present to the jury –
4 specifically, whether DWG is generic and whether Autodesk is the source of DWG. *Compare* Bos
5 No. 2 Decl., Ex 6 (Roberts Decl. Ex. 26 at SW0004840-41) *with* Court’s Order Granting in Part &
6 Denying in Part Pl.’s and Def.’s Mot. for Summ. J. (D.I. 195) at 6 (“Defendant submits that DWG
7 now denotes a particular file type or format and does not identify or distinguish the source of a
8 particular product. Plaintiff replies that DWG is not generic. Users associate the mark with plaintiff,
9 it counters . . . [¶] Both sides will have to try and convince a jury.”). The potential is high that the
10 jury will mistakenly view the PTO’s preliminary opinions as the official government position on the
11 exact issues that it must decide. To avoid unfairly prejudicing Autodesk, the Court should exclude
12 any evidence or argument regarding the prosecution history of Autodesk’s application to register the
13 mark DWG.

14 In analogous circumstances in the patent context, it is well-established that evidence regarding
15 non-final PTO Office Actions pertaining to patents in reexamination proceedings should be excluded
16 from trial because of its irrelevant and highly prejudicial nature. *See Hoechst Celanese Corp. v. BP*
17 *Chems., Ltd.*, 78 F.3d 1575, 1584 (Fed. Cir. 1996) (“the grant by the examiner of a request for
18 reexamination is not probative of unpatentability”); *Fresenius Med. Care Holdings, Inc. v. Baxter*
19 *Int’l, Inc.*, No. C 03-1431 SBA, 2006 WL 1330003, at *4 (N.D. Cal. May 15, 2006) (finding *Hoechst*
20 persuasive as “indicating that it may be appropriate to exclude the reexamination orders at trial if
21 their probative value is outweighed by their potential to prejudice the jury” and granting party leave
22 to raise this issue in motion in limine); *3M Innovative Prop. Co. v. Dupont Dow Elastomers LLC*,
23 No. 03-3364 MJD/AKB, 2005 WL 2216317, at *2 (D. Minn. Sept. 8, 2005) (“On the other hand,
24 admission of evidence of an incomplete reexamination would have low probative value, would
25 distract from the core issues of the case, and would be highly prejudicial”) (internal citations
26 omitted); *Amphenol T & M Antennas, Inc. v. Centurion Int’l, Inc.*, No. 00-C-4298, 2002 WL
27 32373639, at *1-2 (N.D. Ill. Jan. 17, 2002) (granting motion in limine to exclude evidence of

28 incomplete patent reexamination proceedings). Because the reasoning and considerations behind
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1 these decisions are applicable to non-final Office Actions issued in trademark applications, the Court
2 should also exclude the aforementioned evidence from trial for the reasons identified in the numerous
3 decisions above.

4 Finally, it should be noted that there is a significant, prejudicial factual error in the third
5 Office Action. There, the examining attorney stated that “[t]wo registrations are already of record in
6 which the marks include DWG. If applicant thought it owned DWG, it *would have moved* to cancel
7 these registrations.” (Bos. No. 2 Decl., ¶ 6, Ex. 5 (Office Action at ADSK0010126) (emphasis
8 added).) Autodesk had long since filed cancellation actions on the registration of marks including
9 DWG. On December 7, 2006 (consolidated petition dated January 16, 2007), eleven months before
10 the third Office Action, Autodesk had filed a petition for cancellation of OPENDWG. (Bos. No. 2
11 Decl., ¶ 12, Ex. 11 (Petition for cancellation of OPENDWG).) On February 14, 2007, nine months
12 before the third Office Action, Autodesk filed a petition for cancellation of RASTERDWG. (Bos.
13 No. 2 Decl., ¶ 13, Ex. 12 (Petition for cancellation of RASTERDWG).) Given the erroneous,
14 prejudicial assertion in the third Office Action, the Court should exclude the aforementioned
15 evidence from trial.

16 **B. The Court Should Exclude Any Evidence or Argument that Autodesk’s**
17 **Date of First Use of the Mark DWG was November 28, 2005 Because the**
Record Directly Contradicts Such a Claim

18 In its April 3, 2006 application to register its trademark DWG, Autodesk represented to the
19 PTO that the “First Use Anywhere Date” and the “First Use in Commerce Date” were both “[a]t least
20 as early as 11/28/2005.” (Bos No. 2 Decl., ¶ 2, Ex. 1 at SW0005374.) “[I]ndefinite terms in
21 describing dates” such as “at least as early as” are acceptable in trademark applications, and are “not
22 considered to be misleading, because [they] do[] give notice that, when called upon to do so, the
23 applicant may undertake to prove a date earlier than the one stated.” Trademark Manual of
24 Examining Procedure (“TMEP”) § 903.06 (6th ed. 2009); *see also Hydro-Dynamics, Inc. v. George*
25 *Putnam & Co., Inc.*, 811 F.2d 1470, 1473 (Fed. Cir. 1987) (same). Nevertheless, indefinite terms are
26 not entered into the automated records of the PTO, or printed in the *Official Gazette* or on certificates
27 of registration. TMEP § 903.06. Thus, if the applicant states that the mark was first used “at least as
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1 early as 11/28/2005,” the only information printed in the aforementioned documents will be the date
2 itself, without qualification. *Id.*

3 Here, SolidWorks has produced the PTO’s automated records for Autodesk’s DWG
4 application, which specifically state: “FIRST USE: 20051128. FIRST USE IN COMMERCE:
5 20051128.” (Bos. Decl., ¶ 7, Ex. 6 at SW0004830.) SolidWorks has also argued that the “Court
6 should hold Autodesk to that date,” signifying that SolidWorks will present evidence or argument to
7 the jury that November 28, 2005 is Autodesk’s date of first use in commerce for the DWG mark.
8 (SW Mot. at 15.)

9 The introduction of documents listing Autodesk’s date of first use of the DWG mark as
10 November 28, 2005 do not reflect the reality of Autodesk’s claim to a first use date *at least as early*
11 as November 28, 2005, and are likely to mislead the jury and confuse the issue of when Autodesk
12 actually first used the DWG mark. Moreover, SolidWorks’ contention attempts to undermine the
13 accepted policies of the PTO by transforming a permissible claim to an indefinite term to an
14 irrebuttable claim of a date certain. Because Autodesk’s representation to the PTO was solely a claim
15 to a preliminary date and a preservation of its right to claim an earlier date of first use, the Court
16 should, in accordance with Federal Rule of Evidence 403, exclude any evidence or argument
17 regarding the prosecution history of Autodesk’s application to register the mark DWG, and more
18 particularly, any evidence or argument that Autodesk’s date of first use of the DWG mark was
19 November 28, 2005.

20 **C. The Court Should Exclude any Evidence or Argument that Autodesk**
21 **Disclaimed the Mark DWG in Other Trademark Applications Because**
22 **Such Information is Likely to Mislead the Jury**

23 In 1996, Autodesk filed applications to register the marks “MAX DWG” and “DWG
24 UNPLUGGED.” (Bos No. 2 Decl., ¶ 9, Ex. 8 (SW0007334-35 - Max DWG); ¶ 10, Ex. 9
25 (SW0007332-33 - DWG Unplugged).) For the purpose of quickly advancing the registration of these
26 marks, Autodesk disclaimed the exclusive right to use “DWG” apart from the marks as stated in the
27 applications. (Bos No. 2 Decl., ¶ 11, Ex. 10 (Roberts Decl. Ex. 23 (D.I. 99-7) at Responses to RFAs
28 Nos. 5-6).) SolidWorks has argued that these disclaimers are evidence of Autodesk’s failure to treat
DWG as a trademark. (SW Mot. at 3.)

1 Under 15 U.S.C. § 1056(a), an applicant may be required to disclaim a component of a mark
2 sought to be registered. “The purpose of the disclaimer practice is to enable, not to bar, registration.”
3 *In re K-T Zoe Furniture*, 16 F.3d 390, 394 (Fed. Cir. 1994). The Lanham Act makes clear that a
4 disclaimer does not affect the applicant’s underlying rights in the disclaimed term or rights that may
5 arise after the disclaimer is entered; disclaimed matter may even be registered at a later date if it has,
6 with time and use, acquired distinctiveness. 15 U.S.C. § 1056(b). In *Official Airline Guides, Inc. v.*
7 *Goss*, the Ninth Circuit Court of Appeals found that a party’s “disclaimer of the phrase ‘Travel
8 Planner’ in its registration does not deprive it of any common law rights it may have in the
9 disclaimed matter. The determination whether [the party] has obtained a common law mark over the
10 term ‘Travel Planner’ constitutes a serious question going to the merits.” *Official Airline Guides*,
11 856 F.2d 85, 87 (9th Cir. 1988) (internal citations omitted).

12 Here, Autodesk’s disclaimer took place approximately thirteen years ago. Since the Lanham
13 Act permits applicants to establish that they had or have developed common law rights in disclaimed
14 matter, Autodesk’s earlier disclaimer in a trademark application has no bearing on whether it has
15 common law rights in DWG. Because the relevant time frame for the issues raised by this lawsuit
16 begins with the date of SolidWorks’ alleged infringement in 2004, a disclaimer from 1996 would not
17 be probative of this issue. Accordingly, the Court should exclude as irrelevant to any claim in this
18 case any evidence or argument regarding the prosecution histories of Autodesk’s applications to
19 register the marks MAX DWG and DWG UNPLUGGED, and more specifically, any evidence or
20 argument that Autodesk disclaimed the exclusive right to use “DWG” apart from the marks in its
21 other trademark registration applications. Fed. R. Evid. 402. Moreover, because official government
22 records from the PTO showing the disclaimers are likely to mislead the jury and confuse the issue of
23 whether Autodesk has common law rights in the DWG mark, the Court should also exclude such
24 evidence or argument under Federal Rule of Evidence 403.

25 **III. CONCLUSION**

26 For the reasons stated above, Autodesk respectfully requests an order granting Motion in
27 Limine No. 2 and excluding from trial, in accordance with Federal Rules of Evidence 402 and 403,
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1 any evidence or argument regarding the prosecution histories of Autodesk's applications to register
2 the marks DWG, MAX DWG, and DWG UNPLUGGED.

3 Dated: December 14, 2009

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