ESTTA Tracking number: **ESTTA627947**
Filing date: **09/18/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058543
Party	Defendant Razer (Asia-Pacific) Pte Ltd.
Correspondence Address	KEITH A BARRITT FISH & RICHARDSON PC PO BOX 1022 MINNEAPOLIS, MN 55440-1022 UNITED STATES barritt@fr.com, tmdoctc@fr.com, erickson@fr.com
Submission	Opposition/Response to Motion
Filer's Name	Keith Barritt
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Signature	/Keith Barritt/
Date	09/18/2014
Attachments	sj brief.pdf(555503 bytes) Edge Exhibits.pdf(4170944 bytes)

Attorney Docket 39771-0019PP1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EDGE GAMES, INC. Petitioner, v. RAZER (ASIA-PACIFIC) PTE LTD, Registrant.	Cancellation No.: 92058543 Mark: EDGE Registration No. 4,394,393 Registered: September 3, 2013

REGISTRANT'S REPLY BRIEF IN OPPOSITION
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT

and

REGISTRANT'S REQUEST FOR SANCTIONS

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I. INTRODUCTION

Razer (Asia-Pacific) Pte Ltd. ("Razer") hereby responds to Petitioner's Motion for Summary Judgment filed on August 15, 2014. Razer notes that although it has never received the service copy allegedly sent via first class mail by Petitioner on August 15, 2014,[1] even if such a service copy had been mailed Razer would have until September 19 to files its brief in reply, pursuant to Section 502(b) of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), and therefore this brief is timely.

Petitioner's motion is frivolous and wholly without merit. It has been filed with the sole purpose of harassing Razer in an effort to force Razer to expend resources defending itself in the hope of causing Razer to seek a settlement with Petitioner. Not only should Petitioner's motion be swiftly denied, but appropriate sanctions should be issued against Petitioner to preclude any similar future filings.

II. SUMMARY JUDGMENT PRECLUDED DUE TO FAILURE TO SERVE INITIAL DISCLOSURES

Petitioner's motion is premature, as Petitioner never served any initial disclosures as required by 37 CFR § 2.127(e)(1) and Section 528.02 of the TBMP. Indeed, as demonstrated further below, Petitioner has a history of concocting false documents in various judicial proceedings, and any averments that it did serve its initial disclosures should be dismissed.

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1 See Declaration of Sergio Pantano enclosed as Exhibit 1.

III. PETITIONER IS NOT ENTITLED TO SUMMARY JUDGMENT

A. Summary Judgment Standard

Summary judgment is appropriate only in cases where the record, when viewed in the non-movant's favor, conclusively shows "that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." FED. R. CIV. P. 56(c). Petitioner bears an impossibly heavy burden in this case of demonstrating (1) the complete absence of any disputed factual issue that could support a judgment in favor of Razer, and (2) that it is entitled to judgment as a matter of law.

When ruling on a motion for summary judgment, the Board must view the evidence presented in the light most favorable to Razer, affording Razer the benefit of all reasonable inferences. *See Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574 (1986); *see also Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766,767 (Fed. Cir. 1993) ("The evidence must be viewed in a light favorable to the non-movant and all justifiable inferences are to be drawn in its favor."). Under the controlling legal standard, Petitioner has failed to show it is entitled to summary judgment. There is an issue of material fact regarding all of Petitioner's allegations, none of which warrant summary judgment in any event. Accordingly, summary judgment in favor of Petitioner should be denied without hesitation.

A factual dispute is "genuine" if sufficient evidence is presented such that the Board could decide the question in favor of the non-moving party. As set forth in Section 528.01 of the TBMP, a fact is "material" if it may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings. The existence of even one genuine issue of material fact is sufficient to defeat Petitioner's motion.

B. Petitioner's Claims Are Spurious and Without Merit

Petitioner claims that it is entitled to summary judgment because Razer allegedly:

(1) "made no attempt itself to enter into any . . . Discovery Conference"

(2) "failed/refused" to respond to Petitioner's letter of March 28, 2014

(3) "refused to respond" to Petitioner's proposal to enter into mediation or arbitration, and

(4) refused to participate in the discovery process despite Petitioner's alleged "numerous efforts to encourage" such participation

All four of these spurious claims can be swiftly dismissed.

1. Razer Did Fully Comply with its Discovery Conference Obligations

By letter to Petitioner dated March 24, 2014, Razer initiated a written record of its compliance with the parties' discovery conference obligations, addressing each item as required by 37 CFR §2.120(a)(2) (see Exhibit 2). Petitioner acknowledged receipt and responded by letter dated March 28, 2014 (see Exhibit 3). Thus, it is a brazen falsehood to the Board for Petitioner to now claim that Razer "made no attempt" to comply with the parties' discovery conference obligations. To the contrary, Razer took the initiative to address the issues and ensure that the entire process was documented.

Indeed, Petitioner was evidently so impressed by the idea of complying with parties' discovery conference obligations by letter that it took Razer's March 24, 2018 letter nearly verbatim and used it a few days later in another proceeding against Future Publishing Limited before the Trademark Trial and Appeal Board (see Exhibit 4). Thus, for Petitioner to now claim to the Board that Razer has "made no attempt" to comply with the parties' discovery conference obligations is simply absurd. Petitioner can hardly be

heard now to complain that Razer's written efforts to satisfy the parties' discovery conference obligations were insufficient in the pending case but sufficient when initiated by Petitioner in another case.

2. Razer Did Respond to Petitioner's Letter of March 28, 2014

Petitioner would have the Board believe that Razer "failed/refused" to respond to Petitioner's letter of March 28, 2014. The simple truth, as Petitioner is aware, is that Razer did respond by letter dated April 3, 2014 (see Exhibit 5). In that letter, Razer agreed to produce privilege logs (the only remaining issue per the discovery conference correspondence) and advised Petitioner why it believed Petitioner's case would fail.

3. Razer Did Respond to Petitioner's Proposal for Mediation or Arbitration

As noted above, Razer did respond to Petitioner's proposal for mediation or arbitration by letter dated April 3, 2014 (see Exhibit 5), despite Petitioner's false claim to the contrary in an effort to deceive the Board.

4. Petitioner Did Not Make "Numerous Efforts" to Resolve the Matter

Despite the claims in Petitioner's motion for summary judgment motion that it made "numerous efforts to encourage" Razer to participate in the discovery process, in fact Petitioner made no such efforts since Razer's letter of April 3, 2014 and has submitted no evidence of any such efforts.

IV. Request for Sanctions

A. Petitioner's Current and Long History of Frivolous and Harrassing Motions and Unethical and Deceitful Behavior

In addition to this frivolous and harassing motion, Petitioner has also filed an equally frivolous and harrassing motion to compel Razer's discovery responses. That motion was filed on September 9, 2014 alleging service of discovery requests by mail directly to Razer's counsel's Washington, D.C. office address on August 10, 2014 -- a Sunday. Razer's undersigned counsel has never received the mailed service copies of the discovery requests. Based on past practices of Petitioner as discussed below, it is likely they were never sent.

Assuming for a moment that such service was indeed made -- despite the inherently suspect claim of placing documents in the mail on a day when there is no mail service -- Razer's response deadline was September 14, 2014, pursuant to 37 C.F.R. §1.120(a)(3) and Section 403.03 of the TBMP. Rather than wait until the September 14 response deadline, Petitioner brashly filed a premature motion to compel on September 9, the service copy of which was received by Razer via U.S. priority mail on September 15, 2014. In the interim, Razer timely served its discovery response by U.S. certified mail on September 12, 2014.

Petitioner's predisposition to file frivolous, harassing, and abusive motions is not limited to the current proceeding, but rather is fully consistent with the well-established history of Petitioner in proceedings at the Trademark Trial and Appeal Board, U.S. federal court, and other litigation. For example, as noted above Petitioner is currently engaged in another opposition matter against its long-time adversary Future Publishing Limited (Opp. No. 91214673). Petitioner filed a similar premature motion for summary

judgment in that case that was swiftly dismissed by the Board, followed by a similar frivolous and harassing motion to compel discovery (see Exhibit 6).

Moreover, in its long-running -- and ultimately unsuccessful -- defense of its various cancelled registrations for EDGE and related marks, a quick look at the TTAB docket sheet demonstrates that Petitioner's *modus operandi* is to submit a seemingly endless succession of frivolous and harassing filings and motions (see Exhibit 7). More importantly, the Board's ruling of May 1, 2013 in that proceeding speaks volumes regarding Petitioner, finding that Petitioner twisted and modified legal citations in an effort to meet its own ends. As stated by the Board:

> To say the least, Edge Games' conduct is unacceptable. Edge Games is admonished against any further attempts to mislead the Board and against filing serial submissions. Any further filing by Edge Games in this proceeding will receive no consideration. . . [Edge Games' allegations] are supported only by improper, misleading argumentation and citations and are, in fact, frivolous. (Exhibit 8 at pages 4-5.)

Petitioner's disregard for the truth also extends to federal court. Specifically, the U.S. District Court for the Northern District of California, in denying Petitioner's motion for a preliminary injunction against Electronic Arts regarding the MIRROR'S EDGE mark based on Petitioner's claim of ownership of EDGE, made numerous findings regarding Petitioner and its CEO (and current pro se representative) Tim Langdell, as shown in Exhibit 9, including:

- EA raised "serious questions regarding the veracity of Dr. Langdell's entire declaration." Exhibit 9 at page 8.
- EA presented "compelling evidence that there was no bona fide use of the 'EDGE' mark in commerce by [Edge Games, Inc.]" Exhibit 9 at page 10.

- "Even more egregious, according to Marvel Vice President and Deputy General Counsel Walter Bard, neither Marvel nor Mailbu Comics are or were ever licensees of Dr. Langdell's companies for any of these marks." Exhibit 9 at page 10.

- "Compelling evidence of fraud on the USPTO has also been submitted by EA with respect to [Edge Games, Inc.'s] 'THE EDGE' mark." Exhibit 9 at page 11.

- "Even more evidence of fraud is seen in the comic-book specimen submitted to the USPTO by Dr. Langdell in November 2005." Exhibit 9 at page 12.

- "Based upon this apparently doctored specimen submitted by Dr. Langdell, the 'GAMER'S EDGE' mark was issued to [Edge Games, Inc.]" Exhibit 9 at page 14.

- "EA has submitted evidence demonstrating that Dr. Langdell's claimed sales of video games supposedly bearing the 'GAMER'S EDGE' mark are highly suspect." Exhibit 9 at page 14.

- "EA has put forth substantial evidence calling into severe question many of the representations made by Dr. Langdell in his declaration submitted to the Court. Indeed, the declarations provided by EA from two of plaintiff's supposed 'licensees' – Marvel Entertainment and Future Publishing – revealed that many of Dr. Langdell's assertions in his declaration were materially misleading or downright false. These falsehoods infect all of Dr. Langdell's assertions regarding the bona fide and continuous use of the asserted marks in commerce and the purported 'sales' of his company's video-game products. In other words, all of his representations have become highly suspect in light of the evidence presented by EA." Exhibit 9 at page 18.

- [T]he majority of [Edge Games, Inc.'s] arguments on this issue [the likelihood of confusion] are tainted by the suspect evidence set forth in Dr. Langdell's declaration." Exhibit 9 at page 19.

- "All of [Edge Games, Inc.'s] representations regarding the validity and use of the asserted marks are infected by evidence of deceit." Exhibit 9 at page 22.

Petitioner has also been found to be mendacious by a court in the United Kingdom in a case against Future Publishing Limited. In particular, as shown in Exhibit 10, the High Court of Justice, Chancery Division, found as follows:

- Dr. Langdell's story regarding computer disk evidence of use was "absurd." Exhibit 10 at page 4.

- Dr. Langdell produced a "long and tortuous explanation" of email correspondence he allegedly had with Future Publishing's computer disk expert, the court finding "I have no doubt not merely that [the email] was not received but that it was never in fact sent. The overwhelming inference is that the suspect . . . email was concocted as support for Dr. Langdell's story that he had created a cloned disk. . . Dr. Langdell's story is incredible. The truth is a prosaic one, namely that Dr. Langdell concocted disk 1 in support of his claim that he had invented the EDGE logo in 1991. When this was exposed by the claimant's expert he constructed an elaborate explanation and created disk 3, having learned from the [expert's] Report how to avoid the mistakes he made the first time." Exhibit 10 at pages 4-5.

- "It is hard to escape the inference that crucial emails, said to have been sent by Dr. Langdell but not received . . . were never in fact sent at all." Exhibit 10 at page 6.

- "[V]arious statements made by Dr. Langdell, combined with his use of the EDGE logo, are designed to confuse visitors to his website." Exhibit 10 at page 9.

In addition, in 2010 the Board of Directors of the International Game Developers Association, Inc. voted to remove Tim Langdell due to "lack of integrity or unethical behavior." Exhibit 11.

In sum, it is beyond doubt that Petitioner is not interested in following the Board's rules or a fair process, but rather only in twisting the truth or engaging in outright falsehoods for its own self-interest.

B. <u>Sanctions Requested</u>

The Trademark Trial and Appeal Board has the inherent authority to order appropriate sanctions to manage the cases on its docket, pursuant to Section 527.03 of the TBMP. This authority is further shaped by 37 CFR §10.18, which provides that sanctions may be imposed against non-lawyers. Thus, Petitioner cannot hide behind the

fact that it is avoiding any legal expenses or cumbersome entanglements with the ethical rules that govern attorneys by appearing *pro se*. In addition, it is clear that the Board can – and should – consider the past unethical behavior of parties appearing before it in appropriate circumstances when deciding on sanctions. *See, e.g.*, Letter to Leo Stoller dated July 14, 2006 enclosed herewith as Exhibit 12.

Based on Petitioner's and its CEO Tim Langdell's past behavior, Razer respectfully requests the Board to issue any or all of the following requirements and sanctions and any other sanctions it deems appropriate (including dismissal of the petition to cancel):

1. Require Petitioner to serve all documents by U.S. certified mail, without which service shall be deemed ineffective and any such documents of no effect and treated as if never filed or served;

2. Require Petitioner to have all signatures notarized for every document served or filed, without which such document shall be deemed of no effect and treated as if never filed or served;

3. Prohibit Petitioner from filing any further motions in this case, consistent with the Board's ruling in *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987), or at the very least require that Petitioner obtain Board approval prior to filing any further motions, consistent with *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597 (TTAB 2002); and

4. Prohibit Petitioner from objecting to any of Razer's discovery requests

WHEREFORE, for the reasons set forth above, Razer respectfully requests the Board to deny Petitioner's motion, and impose such sanctions as requested and any others that it deems appropriate.

Respectfully submitted,

Razer (Asia-Pacific) Pte Ltd.

Keith A. Barritt, Esq.
Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022

Attorneys for Registrant

September 18, 2014
Date

90815840.doc

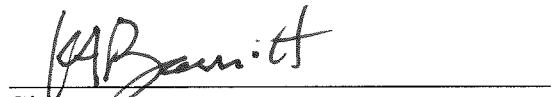
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EDGE GAMES, INC. Petitioner, v. RAZER (ASIA-PACIFIC) PTE LTD, Registrant.	Cancellation No.: 92058543 Mark: EDGE Registration No. 4,394,393 Registered: September 3, 2013

CERTIFICATE OF SERVICE

It is hereby certified that on September 18, 2014 a true copy of the foregoing REGISTRANT'S REPLY BRIEF IN OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT and REGISTRANT'S REQUEST FOR SANCTIONS was deposited in the U.S. certified mail, first-class, postage prepaid, addressed to:

Tim Langdell
Edge Games Inc.
530 South Lake Avenue 171
Pasadena, CA 91101



Signature

90815840.doc

EXHIBIT 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EDGE GAMES, INC. Petitioner, v. RAZER (ASIA-PACIFIC) PTE LTD, Registrant.	Cancellation No.: 92058543 Mark: EDGE Registration No. 4,394,393 Registered: September 3, 2013

EXHIBIT 2

FISH & RICHARDSON P.C.

1425 K Street, N.W.
11th Floor
Washington, DC 20005

Telephone
202 783-5070

Facsimile
202 783-2331

Web Site
www.fr.com

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

March 24, 2014

Via Email
tim@edgegames.com

Tim Langdell
Edge Games Inc.
530 South Lake Avenue , 171
Pasadena, CA 91101

Re: EDGE Trademark Cancellation No. 92058543
'overy Conference
29631-0019PP1

us fulfill our discovery conference obligations in
'er 37 CFR Section 2.120(a)(2) applicable to
and Appeal Board.

nses are clear from its answer to the
liation or arbitration nor utilize the
time.

' Defenses

roposal in my email to you

vith the initial disclosure

ments stored in electronic
ectronic format in a readily
vebsite.

c) Privilege Logs: We propose that the parties dispense with the production of privilege logs.

d) Introduction of Evidence: We do not have any proposals regarding the introduction of evidence beyond the procedures established by the Trademark Trial and Appeal Board, with the exception that we propose the parties stipulate pursuant to 37 CFR 2.123(b) that testimony may be entered by affidavit or written declaration under 37 CFR 2.20.

e) Protective Order: We do not have any proposed changes to the Board's standard protective order.

I look forward to hearing from you.

Sincerely,

Keith A. Barritt

40990462.doc

EXHIBIT 3

Mr Keith A. Barritt, Esq
Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005

March 28, 2014 Via Facsimile & Email

Re: EDGE Trademark Cancellation Action in the U.S.
Your Ref.: 29631-0019PP1
Discovery Conference

Dear Mr Barritt:

We also write regarding fulfillment of our discovery conference obligations under 37 CFR Section 2.120(a)(2).

We wish a telephone conference with you, since we do not believe that written exchanges will adequately and acceptably fulfill the requirements for this conference stage.

1. Nature and Basis of Defenses.
We do not accept that your answer to the petition makes clear what the basis for defense is. Indeed, Razer would appear to have no acceptable or adequate defense, and if your client has one then we would very much like to be made aware of it so that we may consider what it considers this "defense" to be.

2. Possibility of Settlement/Narrowing of Claims and Defenses
We have made our offer for settlement which your client has rejected despite it being a very fair and reasonable offer. At the least the parties should consider at this stage the possibility of narrowing the claims and defenses. For instance, your client would appear to have no defense whatsoever against our claim that we have (via our licensee Velocity) used the exact mark for the effectively exact same goods and services for well over a decade prior to your client's first use. We suggest at least that the parties agree that your client has no defense to this key claim.

3. Disclosures etc.
a) We see no reasonable argument as to why we should dispense with initial disclosure requirements, not least since we cannot see that your client has any defense against our

EDGE Games, Inc.,
530 South Lake Avenue, 171, Pasadena, California, 91101
T: 626 449 4EDGE F: 626 844 4EDGE W: www.edgegames.com E:corp@edgegames.com

key claims. Having initial disclosure might assist us in understanding why your client is fighting our claim or may perhaps clarify to your client that it has indeed no defense.

b) Agreed

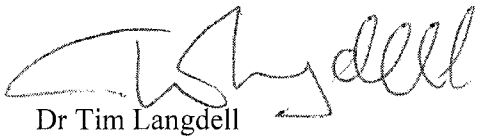
c) Why do you ask this? We will make our decision following your clarification.

d) We too have no other proposals at this stage but reserve the right to make such at a later time.

e) Agreed.

We look forward to hearing from you,

Kind regards,



Dr Tim Langdell
CEO.

EXHIBIT 4

EDGE™
GAMES

Robert N Phillips
Reed Smith LLP
101 Second Street
Suite 1800
San Francisco
CA 94105

March 31, 2014

Re: Applications Serial Nos. 85153958 & 85153981
Mark "EDGE" in the name Future Publishing Limited
Opposition thereto by Edge Games Inc, No. 91214673

Dear Mr. Phillips,

The purpose of this letter is to help us fulfill our discovery conference obligations in the EDGE trademarks cancelation under 37 CPT Section 2.120(a)(2) applicable to proceedings before the Trademark Trial and Appeal Board.

1. Mediation/Arbitration

Edge Games Inc wishes further detail and clarification as to the nature and basis of Future's defense in order to more fully understand Future's alleged position. Edge Games would welcome exploration of either mediation or arbitration with Future, and may wish to utilize the Board's Accelerated Case Resolution process.

2. Settlement/Narrowing of Claims and Defenses

Edge Games has indicated what it would be willing to accept in settlement, but notes that Future has never responded to the proposal. Edge is not currently aware of how either the claims or defenses might be narrowed.

3. Disclosures, Discovery and Introduction of Evidence

a) Initial Disclosures. We propose that these take place and in a timely fashion per the TTAB timetable.

b) Electronic Documents: We propose that documents stored in electronic format be produced either as printed pages, in electronic format in a readily available commercial standard, or via an ftp website.

EDGE Games, Inc.,
530 South Lake Avenue, 171, Pasadena, California, 91101
T: 626 449 4EDGE F: 626 844 4EDGE W: www.edgegames.com E:corp@edgegames.com

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing MOTION FOR SUMMARY JUDGMENT was served on Applicant via first class mail, postage prepaid, this day 23 April 23, 2014:

Mr. Robert N Phillips
Reed Smith LLP
101 Second Street, Suite 1800
San Francisco
CA 94105

Rev Dr Tim Langdell

EXHIBIT 5

FISH & RICHARDSON P.C.

1425 K Street, N.W.
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Web Site
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Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

April 3, 2014

Via Email
tim@edgegames.com

Tim Langdell
Edge Games Inc.
530 South Lake Avenue, 171
Pasadena, CA 91101

ATLANTA
AUSTIN
BOSTON
DALLAS
DELAWARE
HOUSTON
MUNICH
NEW YORK
SILICON VALLEY
SOUTHERN CALIFORNIA
TWIN CITIES
WASHINGTON, DC

Re: EDGE Trademark Cancellation No. 92058543
Discovery Conference
Our Ref.: 29631-0019PP1

Dear Mr. Langdell:

In response to your letter of March 28, 2014, Razer will agree to the production of privilege logs in the normal course of discovery.

As for the remaining matters, we believe the evidence will show that Edge Games does not have any rights as a trademark licensor under U.S. trademark law, and that further discussion of this issue at this time would not be productive.

Sincerely,

Keith A. Barritt

40995022.doc

EXHIBIT 6

Search:

Opposition

Number: 91214673 **Filing Date:** 01/28/2014
Status: Pending **Status Date:** 01/28/2014
General Contact Number: 571-272-8500
Interlocutory Attorney: ANN LINNEHAN

Defendant

Name: Future Publishing Limited
Correspondence: ROBERT N PHILLIPS
REED SMITH LLP
101 SECOND STREET, SUITE 1800
SAN FRANCISCO, CA 94105
UNITED STATES
IPDocket-CHI@reedsmith.com, robphillips@reedsmith.com, nborders@reedsmith.com, dkalahele@reedsmith.com
Serial #: 85153981 Application File
Application Status: Opposition Pending
Mark: EDGE
Serial #: 85153958 Application File
Application Status: Opposition Pending
Mark: EDGE

Plaintiff

Name: Edge Games, Inc.
Correspondence: REV DR TIM LANGDELL
EDGE GAMES INC
530 SOUTH LAKE AVENUE , 171
PASADENA, CA 91101
UNITED STATES
uspto@edgegames.com, tim@edgegames.com
Serial #: 78807446 Application File **Registration #:** 3381826
Application Status: Cancelled by Court Order (Section 37)
Mark: GAMER'S EDGE
Serial #: 78208607 Application File **Registration #:** 3105816
Application Status: Cancelled by Court Order (Section 37)
Mark: EDGE
Serial #: 77352656 Application File **Registration #:** 3585463
Application Status: Cancelled - Section 7(D)
Mark: EDGEGAMERS
Serial #: 75077113 Application File **Registration #:** 3559342
Application Status: Cancelled by Court Order (Section 37)
Mark: THE EDGE
Serial #: 74556730 Application File **Registration #:** 2219837
Application Status: Cancelled by Court Order (Section 37)
Mark: EDGE
Serial #: 85891791 Application File

Application Status: Report Completed Suspension Check - Case Still Suspended
Mark: EDGE PC
Serial #: 85891810 Application File
Application Status: Report Completed Suspension Check - Case Still Suspended
Mark: EDGE GAMING PC
Serial #: 85147499 Application File
Application Status: Report Completed Suspension Check - Case Still Suspended
Mark: EDGE GAMES

Prosecution History

#	Date	History Text	Due Date
9	09/14/2014	PAPER RECEIVED AT TTAB	
8	09/14/2014	D MOT TO STRIKE	
7	09/12/2014	P MOT TO COMPEL DISCOVERY	
6	04/30/2014	TRIAL DATES REMAIN AS SET	
5	04/23/2014	P MOT FOR SUMMARY JUDGMENT	
4	03/07/2014	ANSWER	
3	01/28/2014	PENDING, INSTITUTED	
2	01/28/2014	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	03/09/2014
1	01/28/2014	FILED AND FEE	

Results as of 09/15/2014 04:09 PM **Search:**

EXHIBIT 7

TTABVUE. Trademark Trial and Appeal Board Inquiry System v1.6

Cancellation

Number: 92051465 **Filing Date:** 09/11/2009
Status: Terminated **Status Date:** 05/13/2013
General Contact Number: 571-272-8500
Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: Edge Games, Inc., and Future Publishing, Ltd.
Correspondence: TIM LANGDELL
EDGE GAMES INC
530 SOUTH LAKE AVENUE, #171
PASADENA, CA 91101
UNITED STATES
uspto@edgegames.com

Serial #: 74556730 Application File **Registration #:** 2219837
Application Status: Cancelled by Court Order (Section 37)
Mark: EDGE

Serial #: 74662343 Application File **Registration #:** 2251584
Application Status: Cancelled by Court Order (Section 37)
Mark: CUTTING EDGE

Serial #: 78208607 Application File **Registration #:** 3105816
Application Status: Cancelled by Court Order (Section 37)
Mark: EDGE

Serial #: 78807446 Application File **Registration #:** 3381826
Application Status: Cancelled by Court Order (Section 37)
Mark: GAMER'S EDGE

Serial #: 75077113 Application File **Registration #:** 3559342
Application Status: Cancelled by Court Order (Section 37)
Mark: THE EDGE

Plaintiff

Name: EA Digital Illusions CE AB and Electronic Arts Inc.
Correspondence: VINEETA GAJWANI
ELECTRONIC ARTS INC
209 REDWOOD SHORES PARKWAY
REDWOOD CITY, CA 94065
UNITED STATES
vgajwani@ea.com

Prosecution History

#	Date	History Text	Due Date
114	12/26/2013	TERMINATED	
113	12/26/2013	CT DECISION: DISMISSED	
112	06/08/2013	APPEAL TO CAFC	

Prosecution History

#	Date	History Text	Due Date
111	05/07/2013	COPY OF #109	
110	05/14/2013	BD ORDER	
109	05/10/2013	D RESPONSE; NO CERT OF SERVICE	
108	05/02/2013	P OPP/RESP TO MOTION	
107	01/16/2014	DELETE ENTRY	
106	05/01/2013	D REQ FOR RECON DENIED	
105	04/29/2013	P OPP/RESP TO MOTION	
104	04/22/2013	RESUBMISSION OF REPLY IN SUPPORT OF MOTION	
103	04/22/2013	RESUBMISSION ON REQ FOR RECON	
102	04/18/2013	D REPLY IN SUPPORT OF MOTION	
101	04/18/2013	D REQ FOR RECON	
100	04/17/2013	COMMR ORDER CANCELLING REG	
99	04/11/2013	D MOTION	
98	04/11/2013	REQ FOR RECON OF FINAL BD DCSN	
97	04/11/2013	REQ FOR RECON OF FINAL BD DCSN	
96	04/10/2013	REQ FOR RECON OF FINAL BD DCSN	
95	04/09/2013	REQ FOR RECON OF FINAL BD DCSN	
94	04/09/2013	BD DECISION: GRANTED	
93	04/08/2013	P RESP TO BD ORDER/INQUIRY	
92	04/08/2013	P RESP TO BD ORDER/INQUIRY	
91	04/08/2013	P RESP TO BD ORDER/INQUIRY	
90	04/01/2013	P RESP TO BD ORDER/INQUIRY	
89	03/28/2013	D RESP TO BD ORDER/INQUIRY	
88	03/25/2013	D RESP TO BD ORDER/INQUIRY	
87	03/19/2013	DEF'S MOT TO CONFIRM COURT JUDGMENT/ORDERS VOID	
86	03/18/2013	DEF'S MOTION TO CONFIRM COURT JUDGMENT/ORDERS	
85	03/13/2013	P SUBMISSION OF COURT ORDERS	
84	03/08/2013	RESPONSE DUE 30 DAYS (DUE DATE)	04/07/2013
83	08/23/2012	D REPLY IN SUPPORT OF MOTION	
82	08/17/2012	P SUPPLEMENTAL NOTICE OF COURT ORDER	
81	07/26/2012	D REPLY IN SUPPORT OF MOTION	
80	07/25/2012	P NOTICE OF DISTRICT COURT ORDER	
79	07/06/2012	D REPLY IN SUPPORT OF MOTION	
78	06/13/2012	P REPLY IN SUPPORT OF MOTION	
77	06/03/2012	D MOT TO SUSP PEND DISP CIV ACTION	
76	05/25/2012	D MOT TO SUSP PEND DISP CIV ACTION	
75	05/24/2012	D MOT TO SUSP PEND DISP CIV ACTION	
74	05/17/2012	D REPLY RESPONSE TO MOTION	
73	05/02/2012	P'S OPPOSITION/RESPONSE TO MOTION	
72	04/23/2012	D RESP TO BD ORDER/INQUIRY	
71	04/22/2012	D RESP TO BD ORDER/INQUIRY	
70	04/17/2012	D REQUEST FOR RECONSIDERATION	
69	04/17/2012	D MOT FOR RECONSIDERATION	
68	04/17/2012	D RESP TO BD ORDER/INQUIRY	

Prosecution History

#	Date	History Text	Due Date
67	03/30/2012	RESPONSE DUE (20 DAYS)	
66	11/15/2011	D EDGE GAMES REPLY ON MOT TO REVERSE DIVISION OF 2219837	
65	10/27/2011	D FUTURE OPP TO MOT TO REVERSE DIVISION OF 2219837	
64	10/28/2011	D EDGE GAMES REPLY ON MOT TO REVERSE DIVISION OF 2219837	
63	10/27/2011	D EDGE GAMES OPP/RESP TO OBJECTION TO #53-56	
62	10/24/2011	duplicate # 61	
61	10/24/2011	P OPP/RESP TO MOT TO REVERSE DIVISION OF 2219837	
60	10/20/2011	P CHG OF CORRESP/ATTY	
59	10/13/2011	D FUTURE OBJECTION TO #53-56	
58	10/04/2011	D EDGE GAMES MOT TO REVERSE DIVISION OF 2219837	
57	10/03/2011	D EDGE GAMES RE COUNSEL	
56	10/03/2011	D EDGE GAMES RESP TO MOT TO CANCEL 3105816	
55	10/03/2011	D EDGE GAMES REPLY ON MOT W/D SURRENDER OF 3559342 & 2219837	
54	09/29/2011	D EDGE GAMES RESP TO MOT TO CANCEL 3105816	
53	09/29/2011	D EDGE GAMES REPLY ON MOT TO W/D SURRENDERS	
52	09/23/2011	D FUTURE RESPONSE RE COUNSEL	
51	09/25/2011	D EDGE GAMES RESP RE COUNSEL	
50	08/29/2011	P OPP/RESP TO EDGE GAMES MOT TO W/D SURRENDER OF 3559342 & 2219837	
49	08/23/2011	D FUTURE REPLY ON MOT TO CANCEL 3105816	
48	08/25/2011	SUSPENDED PENDING DISP OF OUTSTNDNG MOT	
47	08/23/2011	D FUTURE OPP/RESP TO MOT TO W/D SURRENDER OF 3559342 & 2219837	
46	08/09/2011	D EDGE GAMES RESP TO MOT TO CANCEL 3105816; NO CERT OF SERVICE	
45	08/03/2011	D EDGE GAMES MOT W/D SURRENDER OF 3559342 & 2219837	
44	07/28/2011	D FUTURE MOT TO CANCEL 3105816 PURSUANT TO DISTRICT CT JUDGMENT	
43	07/28/2011	D EDGE GAMES RESPONSE	
42	07/11/2011	RESPONSE DUE 30 DAYS (DUE DATE)	08/10/2011
41	03/23/2011	D EDGE GAMES RESPONSE	
40	03/04/2011	D FUTURE RESPONSE	
39	03/06/2011	D REPLY BRIEF	
38	02/25/2011	P'S OPPOSITION/RESPONSE TO MOTION	
37	02/18/2011	D MOT TO W/D SEC 7 SURRENDER OF REG	
36	02/01/2011	NO CONSIDERATION OF D'S COMMUNICATION	
35	01/26/2011	D'S COMMUNICATION	
34	12/13/2010	BD DECISION; DISMISSED W/O PREJUDICE; REGS TO BE CANCELLED	
33	11/15/2010	P REQ TO W/D 10/18/2010 REQ FOR ENTRY OF JUDGMENT	
32	11/14/2010	D EDGE GAMES RESP TO SHOW CAUSE ORDER	
31	11/14/2010	D EDGE GAMES VOLUN SURRENDER 2219837, 2251584, 3105816, 3381826, 3559342	
30	10/27/2010	duplicate #29	

Prosecution History

#	Date	History Text	Due Date
29	10/27/2010	SHOW CAUSE ORDER	
28	10/18/2010	P NOTICE OF DISPOSITION OF CIVIL ACTION; FINAL JUDGMENT	
27	10/07/2010	RECON DENIED; SUSP PENDING CIVIL ACTION	
26	07/14/2010	D'S REPLY IN SUP OF MOT TO SUSPEND	
25	07/14/2010	D REPLY ON MOT TO SUSPEND	
24	07/14/2010	D REPLY ON MOT TO SUSPEND	
23	07/06/2010	P OPP/RESP TO MOT TO SUSP PENDING CIVIL ACTION	
22	06/15/2010	D'S MOT TO SUSP PEND DISP CIV ACTION	
21	06/01/2010	D'S OPP/RESP TO MOT TO STRIKE REPLY BRIEF	
20	05/18/2010	P'S MOTION TO STRIKE REPLY BRIEF	
19	04/30/2010	D'S REPLY ON MOTION FOR RECONSIDERATION	
18	03/31/2010	P'S OPP/RESP TO MOT FOR RECONSIDERATION	
17	03/29/2010	SUSPENDED	
16	03/24/2010	AMENDED PET TO CANCEL	
15	03/19/2010	D'S MOTION FOR RECONSIDERATION	
14	02/22/2010	D'S MOT FOR SUMMARY JGMT DENIED	
13	11/25/2009	SUSPENDED PENDING DISP OF OUTSTNDNG MOT	
12	11/22/2009	D'S REPLY IN SUPPORT OF MOT TO DISMISS	
11	11/19/2009	D'S PAPER	
10	11/09/2009	D'S RESP TO P'S REQ FOR BOARD PARTICIPATION IN DISCOVERY CONF.	
9	11/06/2009	P REQUEST FOR DISCOVERY CONFERENCE-ESTTA	
8	11/06/2009	P'S REQ FOR JUDICIAL NOTICE IN SUP OF OPP/RESP TO MOTION TO DISMISS	
7	11/06/2009	P'S RESP/OPP TO MOTION TO DISMISS	
6	10/30/2009	D'S MOTION TO DISMISS - RULE 12(B)	
5	10/27/2009	D'S MOTION TO DISMISS - RULE 12(B)	
4	09/12/2009	P'S CERTIFICATE OF SERVICE	
3	09/17/2009	PENDING, INSTITUTED	
2	09/17/2009	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	10/27/2009
1	09/11/2009	FILED AND FEE	

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EXHIBIT 8

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

KS

Mailed: May 1, 2013

Cancellation 92051465

EA Digital Illusions CE AB
and Electronic Arts Inc.

v.

Edge Games, Inc., and Future
Publishing, Ltd.

By the Trademark Trial and Appeal Board:

On March 13, 2013, petitioners filed a certified copy of the October 8, 2010, Final Judgment of the United States District Court for the Northern District of California, San Francisco Division,[1] entering an order that the parties stipulated to the disposition of the claims, and ordering the Director of the United States Patent and Trademark Office to cancel United States Trademark Registrations Nos. 2219837, 2251584, 3105816, 3381826, and 3559342. Pursuant to the orders of the Court, and in accordance with Trademark Act Section 37, 15 U.S.C. § 1119, the Board on April 9, 2013, granted the petition to cancel and Registration Nos.

[1] Petitioner's submission also included a certified copy of the Court orders of July 23, 2012.

2219837, 2251584, 3105816, 3381826, and 3559342 were cancelled in due course.

Subsequent to the Board's order of April 9, 2013, co-registrant Edge Games, Inc., has filed two series of motions and other papers.[2] The Board construes these filings collectively as a motion for reconsideration of the order.

Edge Games raises numerous objections to the order, including allegations that the District Court's order is void on its face for failure to join a necessary or indispensable party, that the Board's order has violated the parties' settlement agreement, that the District Court's order was not certified by the court "to the Director" as required by Trademark Act Section 37, 15 U.S.C. § 1119, and that the District Court's order is not final because it is a void order that can be challenged at any time.

In support of its allegations, Edge Games has in its subject papers or in its earlier filings referred to in its subject papers misquoted or misleadingly quoted from several legal decisions. For example, in an effort to establish that the entire court record must be inspected to determine whether an order is void on its face (that is, that an order void on its face is one NOT void on its face), Edge Games cited the opinion of *Plotitsa v. Superior Court*, 140 Cal.

[2] Edge Games has repeatedly engaged in such serial filings in this proceeding. Such tactics unnecessarily complicate and confuse the proceedings and should be avoided.

App. 3d 755 (1983), as stating at p. 761, "It is well settled that a judgment or order which is void on its face [is one] which requires only an inspection of the judgment-roll or record to show its invalidity."[3] That language, however, appears nowhere in the opinion. To the contrary, the opinion is directed to matters "void on the face of the record," not void on the face of the order.

In fact, the quote cited by Edge Games appears in several other opinions, such as *Hayashi v. Lorenz*, 42 Cal. 2d 848 (1954). However, a reading of those opinions shows that word Edge Games replaced with the words "is one" is "and" and that Edge Games also omitted the end of the quote. The complete, original quote is, "It is well settled that a judgment or order which is void on its face <u>and</u> which requires only an inspection of the judgment-roll or record to show its invalidity, may be set aside on motion at any time after its entry, by the court which rendered the judgment or made the order. [emphasis added]"

Thus, in the original form, the quote states that to set aside an order it must be void on its face <u>and</u> shown to be invalid simply by an inspection of the record --two separate requirements. Edge Games has revised the quote to read as if the inspection requirement is a definition of

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[3] "Co-Edge Games Edge Games Inc.'s Response to the Board's Order dated 30 March 2012" at p. 6.

"void on its face." Edge Games' revision, therefore, changes the meaning of the quote from one contradicting Edge Games' argument to one supporting it.

Similarly, Edge Games added the words "or reverse" and "or reversal" to a quote from an improperly cited California state appellate case,[4] the in turn quotes from another case[5] as follows: "That a void order is appealable does not permit us to consider the appeal on its merits and to affirm [or reverse] the order if we were so disposed, because our affirmance [or reversal] would impart no validity and would be similarly void."[6] The words "or reverse" and "or reversal" do not replace terms of similar meaning, but are additions not embraced by the original language. Edge Games, therefore, changed the meaning of the quote from the obvious statement that an appellate court cannot affirm a void order to the incongruous statement that an appellate court also cannot reverse a void order.

To say the least, Edge Games' conduct is unacceptable. Edge Games is admonished against any further attempts to mislead the Board and against filing serial submissions. Any further filing by Edge Games in this proceeding will receive no consideration. Turning now to the merits of Edge Games'

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[4] The case is cited as *Mendez Trucking, Inc. v. California Compensation Insurance, Co.*, 2nd Civ. B126064.
[5] Edge Games incompletely cites this case as "*Pioneer Land Co. v. Maddux*, supra [*sic*], 109 cal [*sic*] at p642 [*sic*]."
[6] "Co-Edge Games Edge Games Inc.'s Response to the Board's Order dated 30 March 2012" at p. 7.

allegations, it is found that they are supported only by improper, misleading argumentation and citations and are, in fact, frivolous. The simple fact is that the Board must comply with the District Court orders. Edge Games' papers amount to an improper collateral attack on the validity of those orders. As explained in the March 30, 2012, order, the Board is not the forum for such attacks. Accordingly, Edge Games' request for reconsideration is **denied**.

In view of the cancellations of the registrations pursuant to the Court's order, this proceeding is being terminated in due course. Any further remedy Edge Games' intends to seek must be by way of a timely appeal. Trademark Rule 2.145(d).

EXHIBIT 9

United States District Court
For the Northern District of California

IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

EDGE GAMES, INC., a California corporation,

Plaintiff,

v.

ELECTRONIC ARTS, INC., a Delaware corporation,

Defendant.

No. C 10-02614 WHA

ORDER DENYING MOTION FOR PRELIMINARY INJUNCTION

INTRODUCTION

In this trademark infringement action involving video-gaming giant Electronic Arts, Inc. and its "revolutionary" first-person, action-adventure video game "Mirror's Edge," plaintiff Edge Games, Inc. — a so-called "small video-gaming company" based in Pasadena — moves to preliminarily enjoin defendant Electronic Arts from using the "MIRROR'S EDGE" mark while this dispute unfolds in court. Because plaintiff has failed to establish that it is likely to succeed on the merits, that it is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in its favor, or that an injunction is in the public interest, the motion for a preliminary injunction is **DENIED**.

Dockets.Justia.com

STATEMENT

1. PLAINTIFF EDGE GAMES, INC.

Edge Games, Inc. is "one of the oldest surviving video game development and publishing businesses" on the planet — at least, that's what its founder, chief executive officer, and sole shareholder, Dr. Tim Langdell, would have a jury believe (Langdell Decl. ¶¶ 1–3). According to Dr. Langdell's declaration, he began using the "EDGE" mark in connection with video-game marketing and sales back in 1984 through a London-based video-game company called Softek (*id.* at ¶ 2). Softek is supposedly a predecessor-in-interest to Edge Games. After Dr. Langdell moved to Los Angeles in 1990, he reincorporated Softek as Edge Interactive Media (another supposed predecessor-in-interest to Edge Games). He then incorporated Edge Games — the alleged trademark holder herein — in 2005 (*id.* at ¶ 3).

Plaintiff Edge Games and its predecessors supposedly developed, distributed, and sold several dozen video games from the mid-1990s through 2010 bearing the asserted marks (*id.* at ¶ 17). Examples of recent video-game products purportedly marketed by Edge Games and bearing one or more of the asserted marks include "Bobby Bearing," "Raffles," "Mythora," "Pengu," "Battlepods," and "Racers" (*id.* at ¶ 14, Exhs. K–T). Between 2003 and 2009, Edge Games purportedly sold over 11,000 units of Raffles, Mythora, and Racers, which are "packaged PC video game" products, as well as over 45,000 units of Bobby Bearing, Pengu, and BattlePods, which are games that can be played on certain mobile phones (*id.* at ¶¶ 15–16). In addition to PC and mobile-phone video games, Dr. Langdell also claims that Edge Games develops, publishes, and/or licenses games for major gaming consoles such as the Sony PlayStation 3, and that various releases are currently being developed for gaming consoles and platforms including Microsoft's Xbox 360, the Nintendo Wii, and the Apple iPhone and iPad (*id.* at ¶ 15).

According to Dr. Langdell, these "upcoming" releases from Edge Games will supposedly be sold through the same retailers that the accused products were (and are still being) sold, such as Amazon.com, Best Buy, and Target (*id.* at ¶ 20). In sum, based upon Dr. Langdell's declaration, Edge Games is a legitimate "small video-gaming company" that is active in the video-gaming industry.

2. DEFENDANT ELECTRONIC ARTS, INC.

Electronic Arts — or EA for short — is a leading "interactive entertainment" company that develops, publishes, and distributes video games and related software for modern gaming consoles including Microsoft's Xbox 360, the Sony PlayStation 3, and the Nintendo Wii, as well as for PCs, Macs, and various mobile-gaming devices. Since its formation in 1982, EA has grown to become an international, publicly traded corporation with more than ten video-game development studios spanning the globe. In 2009 alone, EA had sales exceeding one million units for at least 31 of its active video-game franchises (Hershberger Decl. ¶ 2).

"Mirror's Edge" is one of EA's modestly successful video-game franchises. Developed by EA Digital Illusions CE AB (or "EA DICE" for short) in Stockholm, Sweden — one of EA's ten video-game development studios — the "Mirror's Edge" franchise stands at the heart of the instant trademark dispute (*id.* at ¶ 3).

3. THE "MIRROR'S EDGE" FRANCHISE

In July 2007, EA announced in "Edge Magazine" — a leading print and online video-game magazine published by Future Publishing — that its EA DICE development studio was creating a "revolutionary new take on the first-person action adventure game" entitled "Mirror's Edge" (*id.* at ¶ 4). The announcement was a cover story in the magazine, and it was accompanied by a press release issued by EA on July 11, 2007, officially announcing the development of the "Mirror's Edge" video game (*id.* at Exh. A; Binns Decl. ¶ 3, Exh. F). According to EA's senior marketing director, Lincoln Hershberger, "Mirror's Edge" was widely known and discussed throughout the gaming industry and became one of the most anticipated video-game releases of 2008 (Hershberger Decl. ¶ 5). Tens of millions of dollars were invested by EA in the game's development, which spanned three years and involved a team of over 60 individuals (*id.* at ¶ 8).

The game itself is set in a city of gleaming skyscrapers with reflective surfaces and empty streets, whose population has been marginalized by a totalitarian regime. Players interact with and explore this world through the eyes of a character named "Faith," who is a messenger (or, as the game describes her, a "runner") tasked with covertly delivering information, messages, and other items within the city while evading government surveillance. The network of rooftops and

aerial skyways that Faith and other "runners" utilize to make these deliveries and evade the government is dubbed the "Mirror's Edge" (*id.* at ¶ 6).

Prior to its official release, "Mirror's Edge" was demonstrated and publicized at numerous industry events, including the Game Developers Conference in February 2008 and the Electronic Entertainment Expo (or "E3") in July 2008. E3 is widely regarded as the most important expo in the video-game industry (*id.* at ¶ 9). Also in July 2008, "Mirror's Edge" was showcased at Comic-Con, the largest comic-book convention in the world, where a limited-run comic-book adaptation of "Mirror's Edge" was announced. The six-issue "Mirror's Edge" comic "mini-series" was published in 2008 and 2009 by a division of DC Comics (*id.* at ¶ 10). In total, EA invested over $9 million to market "Mirror's Edge" in North America (*id.* at ¶ 11).

In November 2008, "Mirror's Edge" was released for the Sony PlayStation 3 and Microsoft's Xbox 360. A PC version followed in January 2009 (*id.* at ¶ 13). These games were sold through retail channels including mass merchandisers (*e.g.*, Walmart, Target), electronics sellers (*e.g.*, Best Buy), video-game resellers (*e.g.*, GameStop), club stores (*e.g.*, Costco), and online retailers (*e.g.*, Amazon.com) (*id.* at ¶ 14). Since its initial release, over two million units of "Mirror's Edge" have been sold worldwide, including over 750,000 units in North America alone (*id.* at ¶ 17). While EA is no longer manufacturing or distributing copies of "Mirror's Edge" for the Sony PlayStation 3, the Microsoft's Xbox 360, or the PC for third-party retailers, the PC version of the game remains available for download on EA's online store (*id.* at ¶ 18).

Due to its modest success, additional products were developed for the "Mirror's Edge" franchise. In February 2009, EA released "additional downloadable context" for the game, which was sold as "Mirror's Edge Pure Time Trials Map Pack" (*id.* at ¶ 15). Additionally, a separate and "substantially scaled down" side-scrolling version of the game was announced in December 2009 and developed from scratch for the Apple iPad, iPhone, and iPod Touch (Correa Decl. ¶¶ 2–6). This side-scrolling version of the game — published in 2010 — was entitled "Mirror's Edge 2D." It is currently available for purchase through Apple's App Store, where over 37,000 units have already been downloaded for the Apple iPad (*id.* at ¶¶ 4–6; Hershberger Decl. ¶ 15).

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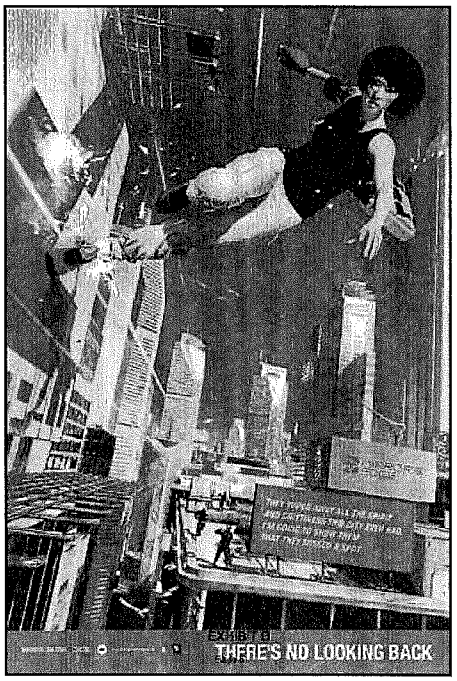
For the Northern District of California

Finally, a Mac version of the original "Mirror's Edge" video game is currently under development and is slated for release later this year (Hershberger Decl. ¶ 13).

4. THE ASSERTED AND ACCUSED MARKS

As should be obvious by this point, this trademark battle centers on EA's use of the word "Edge" in the "Mirror's Edge" franchise. The logo for "Mirror's Edge" and examples of how "Mirror's Edge" appeared in advertising and product packaging are reproduced below (*id.* at ¶¶ 11–13, Exhs. D–E; Shafer Decl. ¶ 2, Exhs. A–H):



As shown, the logos for both EA and EA DICE were prominently displayed on the game's packaging and advertising. In the reproductions above, the logos for EA and EA DICE are most clearly seen on the bottom right of the Xbox 360 cover art. The logos for EA and EA DICE were also placed on the advertisement (to the left of "There's No Looking Back"). While difficult to see in the reproduction above, the logos are clearly visible on the normal sized version.

The "MIRROR'S EDGE" mark is owned by EA DICE. The application was filed in September 2009 and — over a letter of protest filed by Edge Games — the United States Patent and Trademark Office approved the registration of the "MIRROR'S EDGE" mark on June 22,

2010, for computer and video game software, comic books, and online video games (Schatz Decl. ¶ 21, Exh. S).

Turning next to the asserted marks in this action, Edge Games is the purported owner of six federally registered trademarks that it supposedly "uses and selectively licenses" to other companies. These marks are: (1) "EDGE," (2) "THE EDGE," (3) "GAMER'S EDGE," (4) "EDGE OF EXTINCTION," (5) "CUTTING EDGE," and (6) "EDGEGAMERS." Edge Games also claims common-law trademark rights over the "EDGE" logo (Langdell Decl. at ¶¶ 4–12, Exh. T). Each mark will be described briefly below.

A. "EDGE"

Edge Games purportedly owns two valid USPTO registrations for the mark "EDGE" as used in connection with printed matter and publications relating to video games and comic books. According to Dr. Langdell, the "EDGE" mark was in continuous use since 1985, and — for at least one of the two registrations — is incontestable. Edge Games also asserts ownership over the common-law mark "EDGE" for use in connection with video-game software and related goods and services, with continuous use supposedly extending back to 1984 (*id.* at ¶ 6, Exhs. A–C).

B. "THE EDGE"

Plaintiff also supposedly owns a valid registration for the mark "THE EDGE," issued by the USPTO in 2009 for use in connection with video-game software, video-game controllers, and video-game magazines, with continuous use allegedly extending back to 1995 (*id.* at ¶ 7, Exh. D).

C. "GAMER'S EDGE"

Another registered mark purportedly owned by Edge Games is "GAMER'S EDGE," issued by the USPTO in 2008 for use in connection with video-game software and various video-game accessories, with continuous use supposedly extending back to 1986 (*id.* at ¶ 8, Exh. E). Again, Dr. Langdell asserts that the plaintiff owns a valid registration over this mark.

D. "EDGE OF EXTINCTION"

Ownership of the "EDGE OF EXTINCTION" mark is also claimed by Edge Games. This mark was originally registered by a non-party and issued by the USPTO in 2003 for use in connection with computer-game software, with continuous use purportedly extending back to

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2000. The mark was later assigned to Edge Games by the original registrant. According to Dr. Langdell, the "EDGE OF EXTINCTION" mark is incontestable (*id.* at ¶ 9, Exh. F, G)

E. "EDGEGAMERS"

Edge Games also asserts ownership over the supposedly valid registered mark "EDGEGAMERS," issued by the USPTO in 2008 for use in connection with an online computer-gaming club, with continuous use extending back to 2006 (*id.* at ¶ 11, Exh. J).

F. "CUTTING EDGE"

The last registered mark purportedly owned by Edge Games — "CUTTING EDGE" — is *not* related to video games. This mark was issued by the PTO in 1999 for use in connection with comic books. The mark has supposedly been in continuous use extending back to 1995 and has become incontestable (*id.* at ¶ 10, Exh. H, I).

G. The "EDGE" Logo

Finally, Edge Games claims ownership over a common-law mark, reproduced below, that it asserts has been used continually as a trademark and service mark in connection with its video-game software and related websites since 2001 (*id.* at ¶ 12):

5. PLAINTIFF'S LICENSING PRACTICES

According to Dr. Langdell's declaration, plaintiff's licensing practices have been prolific, extending the reach of its asserted marks well beyond video-game software to gaming-related print publications and websites, comic books, video-game hardware, and computers (*id.* at ¶ 21). Licensed products supposedly include "Cross Edge," a video game for the Sony PlayStation 3 published by NIS America, and Edge Magazine, a leading video-gaming news magazine and website published by Future Publishing, Inc. (*ibid.*; *id.* at Exhs. U, V). Additional products purportedly licensed by Edge Games include (*id.* at ¶ 22):

- The "Edge" line of high-performance gaming computers sold by Velocity Micro, Inc. (*id.* at Exh. W).

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- The online computer game "Edge of Extinction" by Cybernet Systems Corp. (*id.* at Exh. Z).
- The website and video game "Edge of Twilight" by Fuzzyeyes Stupio Pty. Ltd. (*id.* at Exh. AA).
- The "Cutting Edge," "Over the Edge," and "Double Edge" comic-book series published by Marvel Comics, as well as the "Edge" comic-book series published by Malibu Comics (which is owned by Marvel) (*id.* at Exh. BB).
- The video-game controller for the Nintendo Wii called "The Edge," sold by Datel Design & Development Ltd. (*id.* at Exh. T).
- The "EdgeGamers" video-gaming website, operated by EdgeGamers Organization, LLC (*id.* at Exh. Y).

6. ALLEGATIONS OF FRAUD AND ABANDONMENT

According to EA, almost nothing set forth above regarding Edge Games and its asserted marks can be trusted. Indeed, EA's opposition brief invests a substantial number of pages to a no-holds-barred attack on the validity of each of plaintiff's asserted marks and the credibility of Dr. Langdell's sworn representations made to both the USPTO and the Court. These attacks and supporting evidence — which raise serious questions regarding the veracity of Dr. Langdell's entire declaration — are set forth in detail below.

A. Fraud and Abandonment Regarding "EDGE"

According to EA, the two registrations obtained by plaintiff for the "EDGE" mark were soaked in fraud. *First*, in January 1999, Edge Interactive Media (a predecessor to Edge Games) registered the "EDGE" mark for use in connection with various paper goods, including magazines related to video games (RJN Exh. K).[1] Five years later, in 2004, Edge Interactive Media filed a "Combined Declaration of Use and Incontestability under Sections 8 & 5," wherein Dr. Langdell certified to the USPTO that (1) his companies had made continuous use of the "EDGE" mark in commerce for at least five years following the January 1999 registration date, and (2) were continuing to use the mark in commerce as reflected in a specimen described as a "Color scan of the front cover of our EDGE Games magazine, July 2004 edition, with the registration serial

[1] Defendants' request for judicial notice of the records and documents cited herein is GRANTED.

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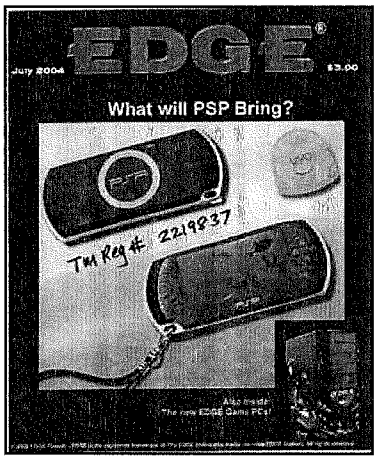
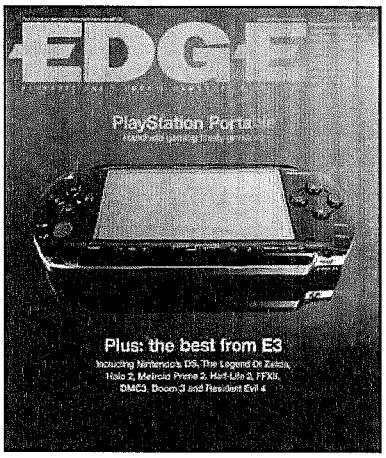
number written clearly on it" (*id.* at Exh. L).[2] According to a declaration submitted by the publisher of Edge Magazine, however, the magazine cover submitted to the USPTO by Dr. Langdell was *not* a genuine copy of any magazine cover that had ever been published (Binns Decl. ¶ 13, Exh. C). *It was faked.* The specimen submitted by Dr. Langdell to the USPTO (left) and the actual Edge Magazine cover for July 2004 (right) are shown below:



As Submitted to the USPTO



Actual Cover

The USPTO apparently relied upon Dr. Langdell's declaration and false specimen and maintained the "EDGE" registration (RJN Exh. M).

Second, in January 2003, Edge Interactive Media filed a separate application with the USPTO for the "EDGE" mark in connection with various paper goods, including comic books (RJN Exh. S). As evidence of his company's "use" of the "EDGE" mark in commerce, Dr. Langdell submitted to the USPTO a "[s]canned cover of our comic book EDGE issue 2." The comic-book cover submitted as a specimen, however, had been published by an entirely different and unrelated company *more than a decade earlier* (Bard Decl. ¶ 11). Even more remarkable, according to the magazine's publisher, Marvel Entertainment, LLC, the last "Edge" comic book ever published was in the spring of 1995 (*id.* at ¶¶ 9–11). Nevertheless, the USPTO registered the "EDGE" mark on June 20, 2006, in apparent reliance on Dr. Langdell's sworn representation that

[2] This order notes that all of the USPTO filings and declarations signed by Dr. Langdell contained a clear warning that "willful false statements . . . are punishable by fine or imprisonment" and could jeopardize the validity of the document.

the comic book cover was representative of plaintiff's *current use* of the "EDGE" mark in commerce (RJN Exh. T).

In this connection, EA also presents compelling evidence that there was no bona fide use of the "EDGE" mark in commerce by plaintiff, its licensees, or its predecessors in interest *at all* between 1989 and to at least 2003.[3] In presenting this evidence, EA asserts that Dr. Langdell's declaration filed in support of the instant motion contains numerous misrepresentations. For example, in his declaration, Dr. Langdell asserts (Langdell Decl. ¶ 22) (emphasis added):

> 22. Attached hereto as Exhibits W, X, Y, Z, AA, BB & CC are true and correct exemplars of product packaging and services *currently marketed by Edge's duly authorized licensees* that display one or more of the EDGE family of marks. These include:
>
> * * *
>
> f. Licensee Marvel Comics' "CUTTING EDGE," "Over the EDGE," and "Double EDGE" comic book series, and licensee Malibu Comics' "Edge" comic book series, as promoted at www.edgegames.com. *See* Exhibit BB.

As stated, however, the last installment of the "Edge" comic-book series was published by Malibu Comics (owned by Marvel) in the spring of 1995 (Bard Decl. ¶ 11). Similarly, the last publication of Marvel's "Cutting Edge" comic book was in December 1995, the last publication of Marvel's "Over the Edge" comic mini-series was in August 1996, and the last publication of Marvel's "Double Edge Alpha" and "Double Edge Omega" comics was in October 1995 (*id.* at ¶¶ 4–6). In other words, none of these comic books is being "currently marketed" — all have been out of print for nearly 15 years. Even more egregious, according to Marvel Vice President and Deputy General Counsel Walter Bard, neither Marvel nor Malibu Comics are or were ever licensees of Dr. Langdell's companies for any of these marks (*id.* at ¶¶ 7, 10).

Similar alleged untruths plague Dr. Langdell's representations with respect to Edge Magazine's status as a licensee. Although the magazine's publisher — Future Publishing — confirmed that it was a licensee of Edge Interactive Media between 1996 and 2004, the publisher also confirmed that the license only covered the use of the "EDGE" mark in relation to print and

[3] This evidence is presented by EA to support its claim that the asserted marks have been abandoned.

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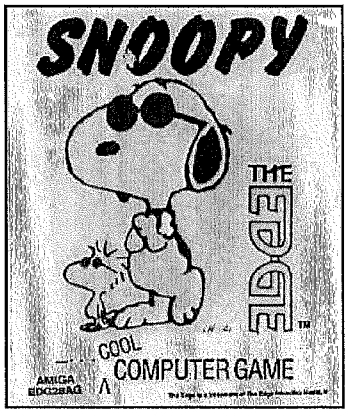
online versions of Edge Magazine *in the United Kingdom* (Binns Decl. ¶ 6). During that time period, Edge Magazine was not even distributed within the United States (*ibid.*). Then, in October 2004, Future Publishing and Edge Interactive Media entered into a new agreement wherein Future Publishing was granted a worldwide license to the marketing and promotion of electronic versions of Edge Magazine (*id.* at ¶¶ 7–8). Critically, neither of these licensing agreements granted plaintiff the right to exercise quality control over the use of the "EDGE" marks. They were "naked" licenses.

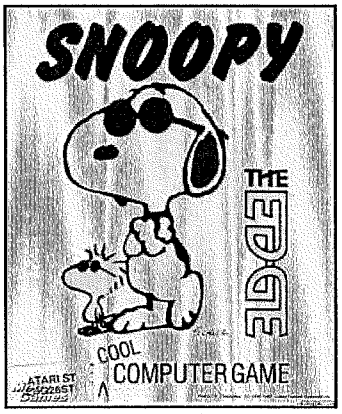
Even after 2003, the evidence that plaintiff had been making bona fide use of the "EDGE" mark in commerce is suspect. For example, Dr. Langdell's declaration asserted that Edge Games has been selling the video game Mythora (supposedly bearing the "EDGE" mark) since 2004. Curiously, while the exterior packaging submitted by Dr. Langdell to the USPTO for the Mythora video game included a website address "www.mythora.com," this website wasn't even registered by Edge Games until October 2008 — nearly four years after the game's purported release (RJN Exhs. O, P). The USPTO relied upon this questionable video-game packaging when it renewed plaintiff's "EDGE" mark in 2009 (*id.* at Exh. R).

B. Fraud and Abandonment Regarding "THE EDGE"

Compelling evidence of fraud on the USPTO has also been submitted by EA with respect to plaintiff's "THE EDGE" mark. For example, in March 1996, in his application to register the mark "THE EDGE" for use with various goods, including video-game software and comic books, Dr. Langdell submitted as evidence of supposed use of the mark a box cover of a game entitled "Snoopy: The Cool Computer Game" (*id.* at Exh. E). The game, however, was already seven years old at the time of the application, rendering it doubtful that it was still being sold in 1996 (Klieger Decl. ¶ 4, Exh. C). Even more disturbing, it appears as though the specimen of the box cover for the video game submitted by plaintiff to the USPTO was doctored. The specimen submitted by Dr. Langdell (left) and the actual box cover for "Snoopy: The Cool Computer Game" (right) are shown below:



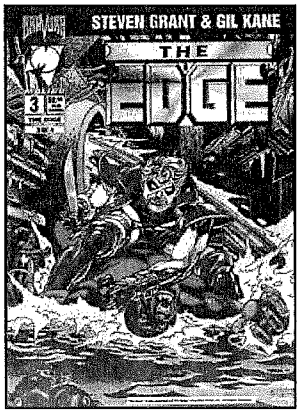
As Submitted to the USPTO



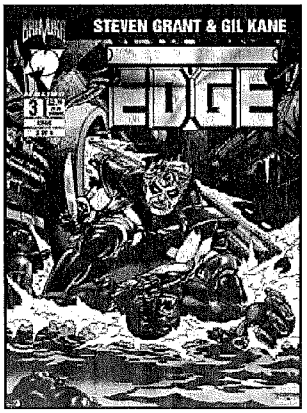
Actual Box Cover

As shown, the "box cover" specimen submitted to the USPTO by Dr. Langdell and the actual box cover of the video game differ in two key respects. *First*, a "TM" has been added next to the logo for "THE EDGE" in the specimen submitted to the USPTO. *Second*, instead of a copyright disclaimer for the "PEANUTS characters," which appears on the bottom right of the genuine box, the specimen submitted to the USPTO contained an entirely different disclaimer that stated "The Edge is a trademark of The Edge Interactive Media, Inc."

Even more evidence of fraud is seen in the comic-book specimen submitted to the USPTO by Dr. Langdell in November 2005 for his application to register "THE EDGE" in connection with comic books (RJN Exh. F). In support of the application, Dr. Langdell submitted the cover of the "Edge" comic book — which, as stated, was last published a decade earlier by an unrelated company who was *never* a licensee of plaintiff — as a specimen. The specimen submitted to the USPTO (left) and the *actual* comic book (right) are shown below (Klieger Decl. ¶ 5, Exhs. D, E):



As Submitted to the USPTO



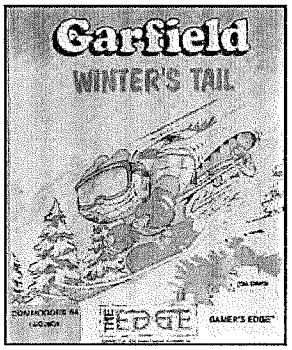
Actual Comic Book

Once again playing "spot the differences," the specimen submitted to the USPTO appears to have been doctored in three material ways. *First*, and most egregious, the name of the comic book was changed from "Edge" to "The Edge" in the specimen. This was done apparently to show that "THE EDGE" mark was being used in commerce in connection with comic books. *Second*, a "TM" was added to the manipulated title (it is visible on the top right of the last "E" in "EDGE"). *Third*, a disclaimer was tacked on to the bottom of the specimen that stated "'The Edge' is the trademark of The Edge Interactive Media, Inc. All Rights Reserved." These "enhancements" were not present in the original comic-book cover. Nevertheless, the USPTO relied upon Dr. Langdell's application when it issued the registration for "THE EDGE" in 2009 (RJN Exh. G).

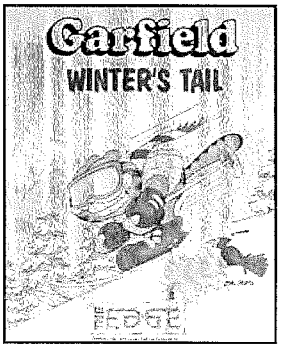
In light of these misrepresentations, EA argues that there are serious doubts over whether "THE EDGE" mark was actually being used on *any* products by Edge Games during the period between 1989 and 2003.

C. Fraud and Abandonment Regarding "GAMER'S EDGE"

Evidence of fraud infects plaintiff's registration for "GAMER'S EDGE" as well. In February 2006, Dr. Langdell submitted an application to the USPTO to register "GAMER'S EDGE" for various goods, including video-game software (*id.* at Exh. H). As a specimen of his company's use of the mark in commerce, Dr. Langdell submitted the box cover of a video game entitled "Garfield: Winter's Tail," which had been released by Softek (a predecessor-in-interest to Edge Games) *over seventeen years earlier* in 1989. The specimen submitted to the USPTO (left) and what EA asserts as being the *actual* box cover for the video game (right) are shown below (Klieger Decl. ¶ 7, Exh. F):



As Submitted to the USPTO



Actual Box Cover

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One critical difference stands out: the "GAMER'S EDGE" mark that is visible on the specimen submitted to the USPTO is *not* present anywhere on the genuine box cover for the video game. Based upon this apparently doctored specimen submitted by Dr. Langdell, the "GAMER'S EDGE" mark was issued to plaintiff in February 2008 for use with video games (RJN Exh. J).

In addition to this evidence assaulting the validity of plaintiff's "GAMER'S EDGE" registration, EA has also submitted evidence calling into question whether plaintiff made bona fide use of the "GAMER'S EDGE" mark over the past two decades. In particular, EA has submitted evidence demonstrating that Dr. Langdell's claimed sales of video games supposedly bearing the"GAMER'S EDGE" mark are highly suspect (Opp. 13). For example, when counsel for EA attempted to purchase various video games that Dr. Langdell represented in his declaration as being *currently sold* by Edge Games, they only received error messages stating that "[t]he resource requested . . . cannot be found" (Langdell Decl. Exhs. K, N, O, R; Klieger Decl. Exhs. G–R).[4] Additionally, it is unclear from Dr. Langdell's exhibits whether certain games were being sold in the United States rather than the United Kingdom (Langdell Decl. Exh. T). In any event, given disturbing evidence that the "GAMER'S EDGE" mark may have been grafted retroactively onto product packaging by plaintiff, the record is tainted as to whether the mark has actually been used continuously by Edge Games or has been abandoned.

Finally, while Dr. Langdell claimed in his declaration that both "EDGE" and "GAMER'S EDGE" were used in connection with the sale of personal computers since 1998, EA has presented evidence that the vendor of these computers — Velocity Micro — did not even become a licensee of plaintiff until 2008, when plaintiff sued Velocity Micro for trademark infringement (*id.* at ¶ 23; RJN Exh. D). In sum, there is no clear evidence — at least on this record — that plaintiff or its licensees made any bona fide use of the "GAMER'S EDGE" mark prior to 2008.

D. Fraud and Abandonment Regarding "CUTTING EDGE"

Fraud is also alleged by EA surrounding plaintiff's registration of the "CUTTING EDGE" mark. In April 1995, Marvel filed an application with the USPTO to register "CUTTING EDGE"

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[4] While counsel for plaintiff attempted to explain these error messages at the hearing, the suspect legitimacy of plaintiff's current sales activities — including plaintiff's misleading representation that its products were sold on Amazon.com rather than Amazon.com Marketplace — cannot be ignored.

for use as the title of a comic book (Bard Decl. ¶ 3). A single issue of "Cutting Edge" was then published in December 1995. No other "Cutting Edge" comic book has ever been published by Marvel since that single issue (*id.* at ¶ 3). In November 2006, Dr. Langdell filed a Notice of Opposition to Marvel's registration of "CUTTING EDGE," claiming that his companies had made "extensive use" of the mark since October 1984 (RJN Exh. U). Marvel responded by assigning its rights in the mark, including the pending application, to plaintiff in September 1997. The registration issued in June 1999 (*id.* at Exh. V).

Fast-forward six years to November 2005. Despite the fact that only *one* issue of the "Cutting Edge" comic was ever published by Marvel in 1995, Dr. Langdell filed a "Combined Declaration of Use and Incontestability under Sections 8 & 15" wherein he certified that the "CUTTING EDGE" mark had been in *continuous use* in commerce for at least five years after the June 1999 registration date. To support this contention, he attached as a specimen what he described as: "Cover of *currently on sale* comic book sold via our licensee bearing the mark" (*id.* at Exh. W) (emphasis added). The specimen submitted to the USPTO, however, was the cover of the same *single-issue* "Cutting Edge" comic published by Marvel in 1995. In other words, the specimen was most certainly *not* the cover of a comic book "currently on sale" in November 2005. Additionally, the comic book was not, and had never been, "sold via [plaintiff's] licensee." As stated, Marvel was never a licensee of any of Dr. Langdell's companies.

7. EVIDENCE OF DELAY IN FILING SUIT

By his own admission, Dr. Langdell knew about the release of "Mirror's Edge" shortly after it was announced in July 2007. Indeed, he claims to have mailed a cease-and-desist letter to EA (which was attached to his declaration) two days after "Mirror's Edge" was publicly announced (Langdell Decl. ¶ 25, Exh. DD). EA's legal department has no record of this July 2007 letter and Dr. Langdell did not receive a reply to it (*id.* at ¶ 25; Schatz Decl. ¶ 3). According to his declaration, Dr. Langdell then purportedly sent numerous letters to EA's legal department in January, March, May, July, and September 2008, and left voice mails with the department in February, April, June, and August of that year (Langdell Decl. ¶ 26). Despite these assertions, EA claims that it received *no* voice mails from Dr. Langdell during this time period and that the

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first letter it received from him was on September 24, 2008 (Schatz Decl. ¶ 3).[5] In response to the September 2008 letter, EA — through outside counsel — sent a letter in reply to Dr. Langdell explaining EA why its "Mirror's Edge" video game did not infringe. EA's reply letter also requested additional documentation regarding the ownership and use of the asserted "EDGE" marks (*id.* at ¶ 4, Exh. B). A back-and-forth between EA's outside counsel, EA DICE, and Dr. Langdell continued through December 2008, with Dr. Langdell threatening to seek a preliminary injunction against EA in a letter dated November 10, 2008, and representing to EA that his companies had recently prevailed in a similar trademark action against a third party "with judgments in our favor" and "on the merits" (*id.* at ¶¶ 5–12, Exhs. C–J).[6] Numerous purported "final warnings" were given by Dr. Langdell to EA in these communications. Meanwhile, sales of "Mirror's Edge" began in earnest on November 11, 2008, with a PC version released shortly thereafter on January 16, 2009 (Hershberger Decl. ¶ 13).

Instead of immediately seeking a preliminary injunction to halt these sales, Dr. Langdell waited until June 2009 to re-attempt negotiations with EA (*id.* at ¶ 13; Langdell Decl. ¶ 28). In these negotiations, EA reiterated its position to Edge Games that there was no likelihood of confusion between "Mirror's Edge" and the "EDGE" marks purportedly owned by Dr. Langdell. The talks ended in July 2009 without an agreement (Schatz Decl. ¶ 13). EA did not receive another communication from Dr. Langdell until March 2010, shortly after EA had announced the release of "Mirror's Edge" for the Apple iPad and iPhone. In this communication, Dr. Langdell once again called upon EA to cease using the "Mirror's Edge" name. EA did not respond to the email, and had no further interactions with Dr. Langdell until this action was filed three months later (*id.* at ¶¶ 14–15).

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[5] Dr. Langdell did *not* attach to his declaration any copies of these "numerous letters" that were supposedly sent to EA in January, March, May, July, and September 2008.

[6] In fact, that separate action, in which Velocity Micro filed suit against Dr. Langdell's companies in the United States District Court for the Eastern District of Virginia, ended pursuant to a confidential settlement agreement.

Edge Games filed this action on June 15, 2010 (Dkt. No. 1). Nearly two months passed without any motions being filed. Finally, on August 20, over 21 months after EA first began selling the "Mirror's Edge" video game to the public, the instant preliminary injunction motion was filed (Dkt. No. 16). This order follows a hearing held on September 30.

ANALYSIS

A plaintiff seeking a preliminary injunction must establish that he is likely to succeed on the merits, that he is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in his favor, and that an injunction is in the public interest. *Winter v. Natural Resources Defense Council*, ---- U.S. ----, ----, 129 S.Ct. 365, 374 (2008). As explained below, plaintiff Edge Games has failed to establish — based upon the preliminary injunction record detailed herein — that any of these factors weigh in its favor.

1. LIKELIHOOD OF SUCCESS ON THE MERITS

To prevail on its claim of trademark infringement, Edge Games "must demonstrate that it owns a valid mark, and thus a protectable interest." *Lahoti v. VeriCheck, Inc.*, 586 F.3d 1190, 1197 (9th Cir. 2009) (citation omitted). If ownership of such a mark is established, Edge Games must then show that EA's "use of the mark 'is likely to cause confusion, or to cause mistake, or to deceive.'" *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 602 (9th Cir. 2005) (quoting 15 U.S.C. 1114(1)(a)–(b)).

A. Trademark Validity

On the issue of whether plaintiff has sufficiently demonstrated that it owns a protectable interest in the asserted "EDGE" marks, the preliminary injunction record speaks for itself. As detailed above, the record contains numerous items of evidence that plaintiff wilfully committed fraud against the USPTO in obtaining and/or maintaining registrations for many of the asserted "EDGE" marks, possibly warranting criminal penalties if the misrepresentations prove true. If EA's evidence is credited, such fraud could (and likely would) strip these registered marks of their "presumption of validity." *See Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002). These misrepresentations also support EA's argument that many (if not all) of plaintiff's marks have been abandoned, which would also render them invalid.

Additionally, EA has put forth substantial evidence calling into severe question many of the representations made by Dr. Langdell in his declaration submitted to the Court. Indeed, the declarations provided by EA from two of plaintiff's supposed "licensees" — Marvel Entertainment and Future Publishing — revealed that many of Dr. Langdell's assertions in his declaration were materially misleading or downright false. These falsehoods infect all of Dr. Langdell's assertions regarding the bona fide and continuous use of the asserted marks in commerce and the purported "sales" of his company's video-game products. In other words, all of his representations have become highly suspect in light of the evidence presented by EA. They cannot be credited to justify the extraordinary relief requested herein.

In sum, based upon the evidence in the record, this order finds that plaintiff has not demonstrated a likelihood of success in proving that the asserted marks are valid. *See Tie Tech,* 296 F.3d at 783; *see also* 15 U.S.C. 1127 ("Nonuse [of a mark] for 3 consecutive years shall be prima facie evidence of abandonment. 'Use' of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark."). Since a valid trademark is a prerequisite to a finding of infringement, Edge Games has failed to establish that it is likely to succeed on the merits.

B. Likelihood of Confusion

Even if the asserted marks were presumed valid and protectable, the preliminary injunction record does not support a likelihood of confusion between the asserted and accused marks. As such, Edge Games has not established that it is likely to succeed on the merits.

To determine whether a "likelihood of confusion" exists, this order must examine the eight factors set forth in *AMF Inc. v. Sleekcraft Boats*: (1) strength of the mark, (2) proximity of the goods, (3) similarity of the marks, (4) evidence of actual confusion, (5) marketing channels used, (6) type of goods and the degree of care likely to be exercised by the purchaser, (7) defendant's intent in selecting the mark, and (8) likelihood of expansion of the product lines. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979); *One Industries, LLC v. Jim O'Neal Distributing, Inc.*, 578 F.3d 1154, 1162 (9th Cir. 2009)

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The preliminary injunction record and the *Sleekcraft* factors do not support a finding that a "reasonably prudent consumer" in the marketplace is likely to be confused as to the origin, endorsement, or approval of the competing products herein. Indeed, the majority of plaintiff's arguments on this issue are tainted by the suspect evidence set forth in Dr. Langdell's declaration. For example, according to Dr. Langdell, Edge Games is currently selling (or plans to sell) numerous "EDGE"-branded video games for modern gaming consoles through the exact same retail channels used by EA to distribute "Mirror's Edge." The evidence to support this assertion — beyond Dr. Langdell's bare statements in his suspect declaration — is paper thin. Indeed, Dr. Langdell never states exactly how much capital he has invested in developing, marketing, and selling his company's current and future video-game products. Given that "Mirror's Edge" was marketed with significant monetary investments through sophisticated, high-profile channels, including pre-announcements and demonstrations at major industry events, and was sold by *major* retailers, plaintiff has not established that the marketing channels used or the proximity of the goods in the marketplace support its claims of infringement. Indeed, EA has produced compelling evidence that plaintiff's video-game products may not even be available for sale to consumers at all.

Additionally, there is no evidence in the record that EA chose to call it's product "Mirror's Edge" for any reason but to describe the visual and thematic aspects of the video game. This conclusion is bolstered by the fact that the word "edge" in "Mirror's Edge" is used to modify the word "Mirror." In this connection, the "strength" of plaintiff's asserted marks is also highly susceptible to attack. Even if the "EDGE" marks were deemed "arbitrary," as plaintiff argues, there is no evidence of actual confusion (despite over 21 months of "Mirror's Edge" being sold to the public). Moreover, plaintiff has failed to show that each of the asserted marks is confusingly similar to the "Mirror's Edge" mark or that purchasers of "Mirror's Edge" would exercise such a low degree of care as to be confused as to the publisher or developer of the competing products.[7] Similarly, under plaintiff's "reverse confusion" theory of infringement, the record does not

[7] The fact that the various asserted marks are not even visually similar to each other and that the EA and EA DICE marks are prominently displayed on "Mirror's Edge" advertising and packaging further reduces the likelihood of confusion (Opp. 22).

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support plaintiff's claim that purchasers of its various "EDGE"-branded products (to the extent that any exist) would believe that they were associated with EA, EA DICE, or the "Mirror's Edge" franchise.[8]

Yet another failed argument is plaintiff's assertion that the various "EDGE" marks constitute a "family of marks" where confusion can be analyzed based upon a common element shared between them. On this issue, there is no evidence in the record showing that the purchasing public recognizes that the term "edge" in the asserted marks is indicative of a common origin of goods. By contrast, EA has produced evidence that the term "edge" is found in many registered trademarks and product names within the video gaming industry that are *not* owned or licensed by Edge Games (Opp. 20–21). Given this crowded field, the scope of protection (if any) that can be afforded to the asserted marks is limited. Finally, with respect to plaintiff's "EDGE" logo, EA has put forth convincing evidence that the logo itself was first used in commerce by *another* entity, Future Publishing, and that its appearance was recently altered to make it appear more "similar" to EA's "Mirror's Edge" logo (specifically, it was changed from blue to red).

In sum, under the *Sleekcraft* factors, plaintiff has not sufficiently shown that consumers are likely to be confused as to the origin, endorsement, or approval of any of the products at issue in this litigation.[9] For these reasons, Edge Games has failed to establish that it is likely to succeed on the merits.

2. IRREPARABLE HARM

Following the Supreme Court's decision in *Winter*, irreparable harm cannot be presumed — even for trademark actions. Rather, it is the plaintiff's burden to prove that "he is likely to suffer irreparable harm in the absence of preliminary relief." *Winter*, 129 S.Ct. at 374. In the context of preliminary injunctive relief, irreparable harm is established when a plaintiff is

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[8] Reverse confusion occurs when a junior user engages in such extensive promotion of goods under a mark that the market is swamped, resulting in a likelihood that consumers will mistakenly believe the senior user's goods are associated with the junior user. "In a reverse confusion situation, rather than trying to profit from the senior user's mark, the junior user saturates the market and 'overwhelms the senior user.'" 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:10 (2006).

[9] This order is not bound by, and declines to defer to, determinations by the USPTO as to whether the asserted and accused marks are confusingly similar.

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unlikely to be made whole by an award of monetary damages or some other legal remedy at a later date, in the ordinary course of litigation. *See California Pharmacists Ass'n v. Maxwell-Jolly*, 563 F.3d 847, 851–52 (9th Cir. 2009). As explained below, plaintiff has failed to meet this burden.

First, as stated in the prior section, the preliminary injunction record contains compelling evidence that the asserted marks were fraudulently registered and/or have been abandoned by plaintiff. While a jury may ultimately find otherwise, this thunderstorm over the validity of plaintiff's asserted marks tempers the likelihood of irreparable harm. Indeed, without valid and protectable marks, Edge Games cannot suffer *any* harm to its property rights due to EA's continued use of the "Mirror's Edge" name.

Second, given the suspect nature of Dr. Langdell's representations to both the USPTO and the Court concerning plaintiff's current and future sales and business activities, it is an open question whether plaintiff's business activities legitimately extend beyond trolling various gaming-related industries for licensing opportunities. In this connection, plaintiff has not adequately shown that the potential harm to the "EDGE" marks during the interim period between the filing and resolution of this action could not be adequately remedied by legal damages.

Third, and most telling, it is undisputed that Edge Games waited over three years since "Mirror's Edge" was first announced and 21 months since "Mirror's Edge" was first offered for sale to the public before seeking a preliminary injunction. Due to this unreasonable delay, the bulk of the alleged "irreparable harm" to the asserted marks purportedly caused by the "Mirror's Edge" franchise has already been done. Edge Games has not shown why issuing a preliminary injunction *now* would prevent any irreparable harm to its marks beyond the "harm" that has already occurred. The undisputed fact that plaintiff did not timely act to prevent the "Mirror's Edge" franchise from inundating the market is *alone* sufficient to deny the instant motion.

For these reasons, this order finds — based upon the record presented — that Edge Games has *not* demonstrated that it is likely to suffer irreparable harm absent preliminary relief.

United States District Court
For the Northern District of California

3. BALANCING THE EQUITIES AND THE PUBLIC INTEREST

Finally, the two remaining factors weigh heavily against granting the relief sought by plaintiff. *First*, for all the reasons already discussed in this order, Edge Games has *not* established that the balance of equities tips in its favor. All of its representations regarding the validity and use of the asserted marks are infected by evidence of deceit. Moreover, there is scant evidence that Edge Games has invested *any* amount of funds into the development of recent products and services bearing the asserted marks.

By contrast, EA has shown that it has invested millions of dollars into building and promoting the "Mirror's Edge" franchise. It now has millions of customers. While Edge Games could have sought a preliminary injunction prior to (or shortly after) sales of the original "Mirror's Edge" video game began in earnest, it did not. Instead, plaintiff waited 21 months to allow the "Mirror's Edge" franchise to develop and expand. During this delay, EA continued to create and release products carrying the "Mirror's Edge" name, including newly released versions of the video game for the Apple iPad and iPhone. Given this record, allowing Edge Games to obtain a preliminary injunction after allowing EA to invest in and develop the "Mirror's Edge" franchise over such a long period of time would be plainly inequitable and highly prejudicial to defendant. *See E-Systems, Inc. v. Monitek, Inc.,* 720 F.2d 604, 607 (9th Cir. 1983).

Second, Edge Games has not shown that the public interest typically associated with trademark infringement actions — avoiding confusion to consumers — would favor a preliminary injunction. Rather, as stated, plaintiff has not sufficiently established that consumers are likely to be confused or deceived by the products at issue.

* * *

For the foregoing reasons, this order finds that plaintiff has failed to establish that it is likely to succeed on the merits, that it is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in its favor, or that an injunction is in the public interest. As such, a preliminary injunction is not warranted under the factors set forth in *Winter*.

United States District Court
For the Northern District of California

CONCLUSION

Based upon the findings and conclusions set forth herein, plaintiff's motion for a preliminary injunction is **DENIED**.

IT IS SO ORDERED.

Dated: October 1, 2010.

WILLIAM ALSUP
UNITED STATES DISTRICT JUDGE

United States District Court
For the Northern District of California

EXHIBIT 10

Neutral Citation Number: [2011] EWHC 1489 (Ch)

Case No: HC09CO2265

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION

Royal Courts of Justice
Strand, London, WC2A 2LL
13/06/2011

B e f o r e :

MRS JUSTICE PROUDMAN

Between:

FUTURE PUBLISHING LIMITED	**Claimant**
- and -	
(1) THE EDGE INTERACTIVE MEDIA INC **(2) EDGE GAMES INC** **(3) DR TIMOTHY LANGDELL**	**Defendants**

Iain Purvis QC and David Wilkinson (solicitor advocate) (instructed by Stevens & Bolton LLP) for the Claimant
Dr Tim Langdell (the 3rd Defendant) in person for the Defendants
Hearing dates: 7, 8, 9, 10, 13, 14, 15, December 2010, 12 January, 16 February, 2 March 2011 (and further written submissions 9 and 11 March 2011)

HTML VERSION OF JUDGMENT

Crown Copyright ©

Mrs Justice Proudman :

1. These proceedings are brought by Future Publishing Limited for breach of contract, breach of copyright and passing off against two companies registered in the United States, Edge Interactive Media Inc ("EIM") and Edge Games Inc ("Games Inc") and Dr Timothy Langdell, an individual of British origin who now lives in Pasadena USA. I am satisfied that EIM and Games Inc are controlled exclusively by Dr Langdell. A "Jack Phillips" has occasionally put his name to witness statements on behalf of EIM in the past but he is not mentioned at all by Dr Langdell in his evidence and I suspect (without making any findings in this respect) that the claimant is right in saying that he does not exist and is an invention of Dr Langdell. At all events, I find that anything EIM and Games Inc have done has been procured solely through Dr Langdell's intervention. In so far as there is tortious liability on the part of EIM Dr Langdell is liable as joint tortfeasor on the principles set out in **MCA v.**

Charly Records (No 5) [2002] FSR 26.

2. EIM and Games Inc have previously been, but are not now, legally represented in the action. Dr Langdell has appeared in person on behalf of all the defendants and I will sometimes refer to him rather than the particular defendant in question.

3. The claimant is a well-known publisher of magazines and it sells approximately 3.6m magazines per month. For present purposes its speciality is computer gaming magazines, in particular the magazine EDGE, which has been distributed in the United Kingdom since 1993. EDGE magazine has a large circulation. Its website is visited by over 400,000 visitors per month. Many jobs in the computer gaming industry are advertised in its pages, it has many corporate subscribers and it has won a number of awards over the years, including Games Magazine of the Year 2008. It is plainly a substantial enterprise engendering a substantial following and substantial respect in the gaming industry.

4. Since its initial launch in 1993 the magazine has been published under the name EDGE and has used a particular and distinctive form of logo. The letters "E" in the logo extend the cross bar on the left hand side (with a corresponding shortening on the right) and there is a sharp scalpel like point at the edge of the extension.

5. In the 1980s and early 1990s Dr Langdell had a business writing games software, under the name Softek and then Edge. He is now well-known, indeed the claimant says notorious, for pursuing third parties using the name Edge for licence fees, failing which he pursues them for damages for trade mark infringement.

6. It is common ground that Dr Langdell and the defendant companies have used three versions of an EDGE logo, all based on a stretched version of the Franklin Gothic or Helvetica fonts. One of these versions is indistinguishable from the logo used by the claimant and was used on the defendants' letter heading in 2008 and 2009 and on EIM's website at various times. A second has a shorter bevelled trapezoid and was used on EIM's website from about 2003-4 until June 2009. A third has a much shorter trapezoid to the left of the vertical stanchion of the "E", amounting to no more than a triangle shape. I only have photocopies which Dr Langdell assures me accentuate the shadow produced by the bevelling. In all three cases, however, the slashed middle bar of the E was retained, as well as the stretching effect of the letters.

7. A number of preliminary issues arise of fact and law with which I intend to deal first.

Action unnecessary

8. Dr Langdell alleges that this present action was unnecessary as the defendants met all the claimant's requests for undertakings before the claim was served. However it seems to me wholly reasonable that the claimant should bring the action. The defendants' solicitors letter of 29th June 2009 says as follows;

> "The EDGE logo has been used by our clients for many years and they will not cease using it because they are entitled to use it."

9. I am unable to find unequivocal undertakings in the correspondence, despite Dr Langdell's assertions that they were given. Further, Dr Langdell continued to contend before me that he

was entitled to continue to use the EDGE logo and that he intended to do so.

Originality

10. Dr Langdell submitted that the claimant can have no copyright in its EDGE logo because it is not original over the Franklin Gothic typeface. I do not accept this submission. The stretching of the font was combined with the distinctive slash and projection on the middle bar of the "E". What is required for artistic originality is the expenditure of more than negligible or trivial effort or relevant skill in the creation of the work: see *Copinger and Skone James on Copyright* 16th Ed at 3-130 and **Ladbroke v. William Hill** [1964] 1 WLR 273 at 287. The claimant's logo is original within this test.

Consensual use

11. Dr Langdell claims that in 2005 he asked for and obtained the consent of Mr Pierce of the claimant to use of the EDGE logo. I accept Mr Pierce's evidence, which was not seriously challenged, that there were no discussions on the subject at any time. I therefore reject the defendants' contention under this head.

12. Dr Langdell accepted in cross-examination that he copied the EDGE logo when he used it in his letter head to write to the claimant. He said this was what he called "an estoppel representation", by which I understood him to mean that he was using it as a deliberate challenge to the claimant to complain about the use. He asserted rather vaguely that this entitled him to a licence by conduct. I do not accept his contention.

1991 invention by Dr Langdell

13. A third preliminary matter is that Dr Langdell asserts that he invented the EDGE logo in 1991. He contends that he did not copy the EDGE logo from any work of the claimant. Indeed he said that, consciously or unconsciously, the claimant copied his invention when the claimant started to use the EDGE logo in 1993.

14. I observe that Mr Williams, the claimant's creative director, gave evidence that he specifically designed the logo for the magazine in the course of his employment. His evidence that he was unaware of the existence of any logo used by Dr Langdell at that time was not seriously challenged in cross-examination.

5.25" floppy disks

15. The most important part of Dr Langdell's case under this head is the question of the floppy disks which he adduced as evidence in support of his case that he had invented the EDGE logo in January 1991.

16. The defendants allege in their pleading that Dr Langdell's invented logo was published and distributed in a single page catalogue and then on a printed flysheet to promote the defendants' products at trade shows and elsewhere. Dr Langdell said in opening that this was known "really clearly" to the claimant at all times and that he had been using the logo continuously for 19 years. When the court asked him what evidence there was of use of the logo in the 1990s Dr Langdell then claimed that there had in fact been what he termed "scarcity of use" at that time.

17. The evidence, and the only evidence, of his creation of the logo, supporting Dr Langdell's own testimony as to the two pages of documents, is that of certain floppy disks. They were first mentioned by Dr Langdell in open correspondence in a letter dated 20th May 2010 and his account of what happened in relation to the disks did not emerge until his seventh witness statement of 29th November 2010.

18. He claims that he saved the catalogue and flysheet on to a 5.25" banana brand floppy disk in 1991, for what reason he cannot now remember. This disk ("disk 1") was sent to the defendants' expert, Mr Steggles of Disklabs, who said not only that it was a genuine 1991 disk but also gave his opinion that the information on it was genuinely created at that time. However when the claimant's expert, Mr Dearsley of Kroll Computers, examined it he pointed out that although disk 1 was an old disk the alleged 1991 content had been created using Windows 95, that is to say, later software. He also said that the content had been deliberately backdated as though it had been created at an earlier date. When the matter was referred back to him, Mr Steggles agreed with Mr Dearsley that the content of disk 1 could not date back to 1991.

19. Dr Langdell then claimed that disk 1 had been sent in error and was a copy he had created in the mid-1990s for some reason he said he was unable to remember. He then produced an involved and absurd story about how he had found two disks in a box in 2009, one of which was a mid-90s back up disk ("disk 2") and the other of which, (disk 1) was used to clone the original. He said he took the two disks to a "repair man" and mixed them up by marking the wrong one. His oral evidence did not tally with his witness statement and his evidence about the boxes in which he allegedly found disk 1 and disk 2 was confused and unpersuasive.

20. He sought to explain the backdating of the images on disk 1 by saying that he wanted to create a clone as close as possible to the original. However he was wholly unable to explain to the Court's satisfaction why he should wish to create a clone at all rather than a simple back-up copy. It was not until October 2010, according to his account, that he found disk 3, the alleged original 1991 disk, although I found his evidence confusing under this head; it is possible that disk 2 and disk 3 were supposed to be one and the same.

21. At any rate, by October 2010 Dr Langdell had seen Mr Dearsley's report setting out the reasons why the information on disk 1 could not have been produced on the disk in 1991. Mr Dearsley's view was that it would be possible to create a disk which did not show these software anomalies once the maker was armed with the Report's explanation of what was wrong with the previous version. Dr Langdell said that he was technically incompetent to do such a thing but I do not accept his evidence that he did not either do it himself or procure someone else to do it.

22. In May 2010 Dr Langdell had claimed that the relevant disk was too delicate to be moved to the UK, despite the fact that he says that he shipped it twice across the Atlantic in the early part of that year. He was ordered to provide inspection by Order of the Master on 19th August 2010 which resulted in the examination by the experts.

23. Dr Langdell then produced a long and tortuous explanation of the emails he had sent to Mr Steggles, which were disclosed only a week before trial. The emails were presented to the court in a sequence which gave the impression that an email received from Mr Steggles on 3rd October 2010 was in response to an email from Dr Langdell ("the suspect Steggles

email") which in fact had never been received by Mr Steggles. The suspect Steggles email mentioned no fewer than 5 times that a clone had been made. The email actually received by Mr Steggles (and to which his own email was a response) made no reference to the creation of a clone. Moreover the format of the suspect Steggles email is suspicious in itself and I have no doubt not merely that it was not received but that it was never in fact sent. The overwhelming inference is that the suspect Steggles email was concocted as support for Dr Langdell's story that he had created a cloned disk.

24. Dr Langdell's story is incredible. The truth is a prosaic one, namely that Dr Langdell concocted disk 1 in support of his claim that he had invented the EDGE logo in 1991. When this was exposed by the claimant's expert he constructed an elaborate explanation and created disk 3, having learned from the Report how to avoid the mistakes he made the first time.

25. There is however a further and very important aspect of the matter. In his closing submissions, Mr Purvis QC pointed out that in all the correspondence about disclosure there had never been a suggestion prior to May 2010 that the evidence relied on by the defendants was contained in disk rather than paper form.

26. The claimant had expressed willingness to let the court read the without prejudice correspondence passing between the parties but Dr Langdell, as was his right, refused to waive the privilege attaching to it.

27. In his closing written submissions, however, Dr Langdell made the serious allegation against the claimant and its solicitors that they were deliberately misleading the court. He asserted that they knew very well that the disks had been referred to in without prejudice correspondence.

28. Mr Purvis took me to the relevant authorities and I held that this allegation resulted in a waiver by the defendants of their right to keep the without prejudice correspondence from the court. Mr Purvis then produced a clip of what the claimant said was the entire without prejudice correspondence for the relevant period. None of the letters in that clip mentioned the existence of a disk. In response, Dr Langdell subsequently produced a hard copy of two emails allegedly written by him to Mr Millar of the claimant (respectively dated October 2nd 2009 and February 23rd 2010) which he alleged had been deliberately and dishonestly excluded from the string of correspondence and which do indeed refer to the disk on which he relies.

29. I was in some difficulty as the matter of the without prejudice correspondence had arisen entirely in the course of closing submissions. No evidence had been formally given and there had been no cross-examination. However the correspondence and the counter allegations could not simply be ignored. Not only was the claimant's allegedly dishonest behaviour now part of Dr Langdell's case but, if the emails were genuine, they would support Dr Langdell's substantive case about the genuineness of the disk.

30. By this stage Dr Langdell had returned to Pasadena and arranging a mini-trial on the issue of the emails would be no easy task and would add substantially to the costs of the proceedings. Neither side wished me to do so.

31. I have decided that I should apply some common sense to this issue. I cannot let the case run

on indefinitely in circumstances where the evidence (properly and fully tested in cross-examination) is overwhelming that the disks were concocted.

32. In deciding not to reopen the matter I have taken into account the following. The claimant has, pursuant to its continuing disclosure obligations, carried out a full search of its IT systems for the emails. No trace has been found. Dr Langdell has at no stage said that he has conducted a similar exercise and at no stage has he offered to let the claimant's experts examine any of his digital material.

33. Secondly, although Dr Langdell was aware of the claimant's allegation in mid-January, the two emails were not produced to the claimant until the hearing of 2nd March 2011, giving the claimant no opportunity to test them forensically, to seek permission to adduce evidence about them or to cross-examine Dr Langdell as to their authenticity. The emails had never been referred to before and, in common with other emails which Dr Langdell alleges were sent but not received, were not produced until the very last moment. It is hard to escape the inference that (in common with the suspect Steggles email and the email to Randall Copland referred to below) the intention was to try and reduce the scope for investigation by the claimant. It is also hard to escape the inference that crucial emails, said to have been sent by Dr Langdell but not received (for example an email sent to Jo Clayton of the claimant, together with an alleged "read receipt") were never in fact sent at all.

34. Thirdly, Dr Langdell claimed (as with the email to Randall Copland) that the email of 2nd October 2009 was a "stand-alone place-holder" reply and not part of a thread. However he was unable to explain why it was headed "Original Message". The email of 23rd February 2010 is also headed "Original Message" and again no thread has been disclosed.

35. Fourthly, a subsequent email to the claimant (dated 18th December 2010) from Dr Langdell says in terms that he had not responded to the claimant's without prejudice email timed at 1.18 am on 2nd October 2009. The alleged email of 11.34 am of 2nd October 2009 is therefore inconsistent with this assertion.

36. Lastly, the format of these emails differs from the thread disclosed by the claimant and its solicitors and resembles that of the suspect Steggles email and the Copland email, both of which were extensively dealt with in evidence.

37. I accept that it would be wrong to make positive findings of forgery of the two alleged without prejudice emails without proper evidence formally adduced. I cannot and should not make any findings of fact about them. The above factors are merely the circumstances against which I have decided that it would not be in accordance with the overriding objective to re-open the issue of whether the disks are genuine. In all those circumstances I propose to attach no weight to the two alleged without prejudice emails on the basis of a new allegation made by Dr Langdell.

38. I now turn to the claims made by the claimant in the action.

Contract

39. In October 1993 Dr Langdell issued proceedings against the claimant for passing off, alleging that he had unregistered rights in the mark EDGE. On 11th February 1994 Dr

Langdell applied to register the trade mark EDGE in the class 16 (printed matter) category in respect of various items including gaming magazines. The action was stayed pending payment by Dr Langdell of security for costs but was then settled by an agreement dated 4th December 1996 ("the 1996 Agreement"). By that date, the claimant as well as EIM had applied to register the name EDGE in the class 16 (printed matter) category.

40. The thrust of the 1996 Agreement was that EIM would keep its registered mark and would be given the claimant's trade mark application in return for a royalty-free licence for the claimant to use the mark EDGE in relation to EDGE magazine in any form, electronic, on-line or otherwise. The claimant paid EIM the sum of £20,000. All rights and goodwill arising out of the mark EDGE were to vest in EIM. EIM was prohibited from publishing or licensing anyone else to publish a magazine substantially similar to EDGE magazine under the name EDGE or any colourably similar mark. EIM was prohibited from claiming any association or connection with EDGE magazine or with the claimant, save that in response to an unsolicited request EIM could confirm that it had licensed the mark EDGE to the claimant in relation to EDGE magazine.

41. The claimant's case is that thereafter, as EDGE magazine's success grew, Dr Langdell's behaviour became increasingly burdensome. The claimant wanted to abrogate the licensing agreement and buy all necessary trade marks from the defendants.

42. Agreement was reached in 2004, both with EIM and with Dr Langdell. The result was a Concurrent Trading Agreement ("CTA") with EIM and a Deed with Dr Langdell. Each was paid a substantial sum of money in consideration of entering into the deeds, $250,000 to EIM and $25,000 to Dr Langdell, although the total sum was paid into Dr Langdell's bank account.

43. I should say at this juncture that Dr Langdell relied before me on Recital F to the 1996 Agreement, saying (although this was not pleaded) that it barred the claimant from bringing these present proceedings against EIM. Recital F provided (the emphasis is mine),

> "EIM Softek and Future wish to settle the Proceedings and all actual <u>and potential</u> disputes between them relating to the publication by Future of EDGE Magazine upon the terms hereinafter appearing."

This contention is misconceived as it ignores the fact that the 1996 Agreement was expressly (see Recital 4 of the CTA) terminated and replaced by the CTA.

44. The primary effect of the CTA was to assign to the claimant those parts of the trade marks owned by EIM which included the word EDGE and which covered EDGE magazine. Because Class 16 includes not only magazines but also other printed matter such as posters, booklets and instruction manuals the agreements provided that EIM would assign to the claimant that part of each mark in Part 16 which covered:

> "Printed matter and publications, namely magazines, newspapers, journals, columns and sections within such magazines, newspapers and journals, all in the field of business, entertainment and educations relating to computers, computer software, computer games, video games, hand-held games and other interactive media."

The Register of Trade Marks was duly amended accordingly, with a suffix "A" for EIM's marks and a suffix "B" for the claimant's marks.

45. The assignment included all rights in the agreed part of the trade marks,

> "including all goodwill attaching to the use of the Agreed Part of the Trademarks in class 16 and all rights of action, powers and benefits arising from ownership of the Agreed Part...."

"Trademarks" was defined as including not only the registered marks but also "all unregistered trademark rights of EIM in those marks."

46. Under clause 2.1.2 of the CTA, EIM granted the claimant certain licensed rights, making it clear that EIM could not object to claimant using the mark EDGE in relation to electronic publications. By Clause 2.9, the claimant undertook not to use the mark EDGE outside the publication of computer games magazines, their associated marketing and promotion and the uses covered by clause 2.1.2.

47. Importantly, both agreements provided as follows:

CTA clause 2.4:

> "EIM further undertakes that it shall not use or permit the use by any other person of any Trade marks in a way which is or could reasonably be confusing with Future's use of the same in accordance with this Agreement and Deed."

The Deed clause 2.1.6:

> "Not [to] use or permit the use by any other person of any of the Trademarks in a way which is or could reasonably be confusing with Future's use of the same in accordance with the [CTA]."

48. I will also cite the provisions of clause 6.9 of the CTA as Dr Langdell set great store by them, saying that the claimant never fulfilled its obligations under the last part of the sub-clause:

> "....The Parties acknowledge that specifically in respect to the trademark and brand "EDGE" in the computer and video games sectors, they will both be actively promoting, building and enforcing rights in the brand to the Parties' mutual benefit, and that the Parties will share a common aim to use their reasonable endeavours to grow and enhance the EDGE brand in the computer and video game industry and promote worldwide consumer recognition of the EDGE brand as one associated with innovative quality goods and services. While not committing either Party to take any specific action after Completion, the Parties agree in good faith to use their reasonable endeavours to identify ways in which they may work together to jointly promote and enhance the EDGE brand in the worldwide computer and video game markets."

49. I am not sure of the relevance of clause 6.9 to the case. Dr Langdell's counterclaim has been

struck out. He seeks to use the provision (and the claimant's alleged shortcomings, which in any event the claimant denies) as some sort of defence to the claim, justifying his use of the EDGE logo and his claims to be responsible for the magazine. However while clause 6.9 recognises that both parties will be, and should in good faith be, promoting the EDGE brand, it does not provide any mandate for making claims to the business of the other party or for causing confusion between the undertakings of the two parties. Dr Langdell's assertion that his use of the EDGE logo was merely "a good faith effort to comply with paragraph 6.9" is misplaced.

Breaches of the CTA and of the Deed

Confusing use of the EDGE logo

50. I have no doubt that the defendants deliberately adopted a logo which is an obvious replica of the claimant's EDGE mark. I was taken to many examples and I mention only the following. The version on the home page of EIM's website in June 2010. A version used in July 2010 on EIM's page on the Café press website. A version used on a letterhead in 2008 and 2009. (Dr Langdell accepted in cross-examination that the logo adopted on his letterhead for the purposes of a letter to the claimant's solicitors was a deliberate copy.) A version used on the homepage of EIM's website between 2003/4 and June 2009. A version used on EIM's game Mythora. Versions used on the game Bobby Bearing.

51. I accept the claimant's submission that all such uses are confusing or could reasonably be confused with the claimants' EDGE logo within the meaning of CTA clause 2.4. This is so whether the test to be applied is the "defective recollection" test appropriate to passing off, or a straight comparison of the marks side by side: see generally **British Telecommunications plc v One in a Million Ltd** [1999] FSR 1 at 23.

52. Dr Langdell admitted in cross-examination that he adopted the EDGE logo on his website in June 2009 in order to create a connection in the mind of the public with the claimant. He said he believed he had the right to do so but that was on the basis of his assertion, which I have already rejected, that he himself devised the EDGE logo in 1991. The logo was adopted to indicate Dr Langdell's entire business including his own games business and I reject his claim that he only used it on his webpage to promote the claimant's magazine.

53. There is also some hearsay evidence of confusion to be found in blog comments on the Internet. Dr Langdell shrugged this off saying that this evidence could have been written by the claimant. This seems to me inherently unlikely but I ascribe less weight to such evidence as the origin is unknown and there is no possibility of analysing its trustworthiness.

Deceptive statements

54. I also accept the claimant's submission that various statements made by Dr Langdell, combined with his use of the EDGE logo, are designed to confuse visitors to his website. For example, in his letter to Apple of 31st March 2009 Dr Langdell stated that "EDGE is extremely well known for its other game products and services such as EDGE magazine." Dr Langdell operated a domain name using the title "EDGE Magazine", claiming that the magazine was published under licence from EDGE Games. The EDGE games website stated that the magazine was "published by our trading partner, Future Publishing". Dr Langdell's personal website stated that "the EDGE brand is now known for many game related products

and services, notably the UK top selling games magazine EDGE". His biography on the International Games Developers Association ("IGDA") website stated that EDGE games "spawned such well-known EDGE branded ventures as EDGE magazine."

55. The primary defence advanced by Dr Langdell at trial was that the statements are true. Some (but not all) of them may well be literally true, but that does not prevent them from being misleading and in my judgment they are. My one doubt was about the phrase "trading partners", since in a letter Mr Millar himself described the claimant and the defendants in these very terms. However even leaving this one phrase on one side there is enough material amply to justify my finding that the defendants' statements on websites controlled by them claim, explicitly or otherwise, a relationship between EIM and the claimant which does not exist and which comprises a confusing use of the trade mark EDGE in breach of the CTA.

56. I should add that Dr Langdell denies any responsibility for the contents of his biography on the IGDA website. However he was a director of IGDA when complaint was first made, and no positive defence was pleaded to this effect at a time when the point could have been investigated with IGDA.

Clauses 2.3 and 4.2

57. The claimant pursued two allegations of breach in relation to US registered trade marks. It is notable that although the distinction between denial and non-admission was carefully explained to Dr Langdell by the Court during the course of the hearing, the defence advanced no positive case but merely pleaded non-admissions. Dr Langdell claims to have assigned these trademarks to the claimant in compliance with the CTA and during the course of the trial produce extracts from the US Patent Office Website which records the existence of a corrective assignment on its assignment page. He contends that the claimant's claim in these respects is yet more evidence of its bad faith in its dealings with him.

58. It not clear exactly what did happen with these assignments as EIM had already assigned the marks to EDGE Games. However that may be, the claimant (without making any admissions) does not now pursue these claims since in proceedings in the USA the US Court has now revoked EDGE Games' ownership portion of the relevant trade marks. I therefore say no more about this aspect of the case.

Fundamental breach

59. The final contractual issue is whether the breaches of the CTA and the Deed by EIM and Dr Langdell are such as to constitute fundamental breach and, if so, whether the claimant has accepted the repudiation. This is an important issue since the claimant is restricted by the CTA from using the mark EDGE for any purpose other than the publication of computer games magazines and certain ancillary uses.

60. The test for fundamental breach, approved by Lord Wilberforce in **Federal Commerce v. Molena Alpha** [1979] AC 757 at 778-9 is that expounded by Buckley LJ in **Decro-Wall v. Practitioners in Marketing** [1971] 1 WLR 361 at 380:

> "....the.... breach must be such as to deprive the injured party of a substantial part of the benefit to which he is entitled under the contract....Will the consequences of the breach be such that it would be unfair to the injured party to hold him to

the contract and leave him to his remedy in damages".

61. Further, as Lord Wright said in **Ross T Smyth v. T D Bailey** [1940] 3 All ER 60 at 72,

> "I do not say that it is necessary to show that the party alleged to have repudiated should have an actual intention not to fulfil the contract. He may intend in fact to fulfil it, but may be determined to do so only in a manner substantially inconsistent with his obligations and not in any other way."

62. However, although the mere fact that a breach is deliberate will not of itself make it a fundamental breach, deliberateness is a relevant factor. As Lord Wilberforce recognised in **Suisse Atlantique Societé d'Armement SA v. NV Ritterdamsche Kolen Centrale** [1967] 1 AC 361 at 435,

> "a deliberate breach may give rise to a right for the innocent party to refuse further performance because it indicates the other party's attitude towards further performance.'"

63. In deciding that the defendants' breaches were fundamental, I take into account the following matters. First, the breaches are of critically important terms of the CTA and the Deed. They are breaches of the terms regulating the ongoing obligations of the parties. Clause 2.4 of the CTA balances the restrictions on the claimant's use of the EDGE logo in areas in which EIM had no interest by protecting the claimant's independent goodwill in the area allocated to it. As Scrutton LJ said in **Gibaud v. Great Eastern Rly** [1921] 2 KB 426 at 435,

> "If you undertake to do a thing in a certain way, or to keep a thing in a certain place, with certain condition protecting it, and have broken the contract by not doing the thing contracted for, or not keeping the article in the place where you have contracted to keep it, you cannot rely on the conditions which were only intended to protect you if you carried out the contract in the way in which you had contracted to do it."

I agree with the claimant that EIM cannot continue to claim the benefit of the CTA while at the same time refusing to comply with its own obligations not to damage the claimant's goodwill. Where, as here, the parties have agreed terms which are to apply to both sides, the defendants' continuing refusal to comply with their side of the bargain is inconsistent with a right to insist on the contract continuing in force. Dr Langdell on behalf of the defendants has made it quite clear before and during this trial that they intend to continue to use their versions of the EDGE logo.

64. Secondly, the defendants' breaches were deliberately calculated to cause confusion. Thirdly, that confusion has necessarily caused substantial damage to the claimant's reputation.

65. There was a great deal of evidence before the court of Dr Langdell's increasing notoriety in the gaming industry. Dr Langdell submitted that his reputation was unjustified and had been orchestrated by the claimant. As to the former, it does not matter for present purposes whether the generally held view about Dr Langdell is justified or not. What matters is that connection with him harms the claimant. As to the latter point, I find it unlikely that all of the very considerable amount of internet condemnation of Dr Langdell has been posted by

the claimant. In any event, there was other evidence of notoriety. For example, evidence from some of the claimant's witnesses (in particular Mr Binns and Mr Douglas) which was not seriously challenged. The fact that Dr Langdell pre-empted a petition to remove him from the Board of IGDA by resigning, followed by his expulsion from IGDA on ethical grounds. The fact that serious findings have been made against him and his companies in two sets of litigation in the US. Dr Langdell protested that those findings were made in interim proceedings only, but it is plain that the US court took a robust view of his conduct which will deleteriously affect the claimant's reputation if it is thought that the two businesses are connected.

66. In principle, therefore it is my view that the defendants' breaches of the CTA and the Deed were fundamental breaches within the test propounded by Lord Wilberforce.

67. Termination of a contract by acceptance of repudiation can be effected notwithstanding the prior acquisition of rights unconditionally acquired. Accordingly the assignment to the claimant of goodwill and registered trade mark rights in the name EDGE and the payments to EIM and Dr Langdell of consideration under the agreements do not prevent termination. Each side is entitled to retain those benefits: see *Chitty on Contracts* (30th Edition) at 24-051 and cases therein cited.

68. The only outstanding question is whether the claimant can be said to have unequivocally affirmed the CTA in such a manner as to debar it from terminating it through acceptance of fundamental breach. I have in mind that in August 2009 the claimant brought these proceedings for breach only. The claimant only purported to accept the defendants' repudiatory breaches by amendment to its pleading on 19th August 2010.

69. However this was a case in which the breaches were persisted in by the defendants. In those circumstances the fact that the claimant continued to press for performance should not preclude it from treating itself as discharged from its obligations under the contract. The claimant is not discharging on account of the original repudiation and trying to go back on an election to affirm. It is instead treating the contract as being at an end on account of the continuing repudiation reflected in the other party's behaviour: see *Chitty* (above) at 24-004 and cases therein cited.

70. I therefore find that the claimant has accepted the defendants' repudiatory breaches and validly terminated the CTA.

Passing off claims

71. I have found that Dr Langdell has tried to appropriate for his own business the goodwill associated with EDGE Magazine by statements leading the public to believe that EIM is responsible for EDGE Magazine or that EIM's games are in some way approved or authorised by EDGE Magazine. It follows that all the pleaded breaches of the CTA committed within the jurisdiction of the court also comprise acts of passing off as representations likely to lead to confusion.

72. The court will assume damage where the goodwill associated with the product is being used and eroded by the actions of the defendant: see **Blazer v. Yardley** [1992] FSR 501 at 509-10, **BT v. One in a Million** at 23 and **Irvine v. Talksport** [2002] FSR 60.

73. Further, as I have already found, association with Dr Langdell is likely to cause serious damage to the claimant and EDGE Magazine.

Infringement of copyright

74. I have already said that I accept Mr Williams's evidence that he created the EDGE Logo for the claimant and that it has artistic originality. Dr Langdell's case in copyright was put squarely on the basis that he invented the EDGE Logo in 1991. I have rejected that claim. Accordingly use by the defendants of all three versions of the EDGE logo are in my judgment copies infringing the claimant's copyright.

75. There were infringing acts within the jurisdiction of this court. Merchandise bearing the EDGE logo was advertised on the Café Press website and sold in the UK pursuant to an order from the claimant. This is an issue of copies of the work to the public within s. 16 (1) (b) of the Copyright Designs and Patents Act 1988. In addition Dr Langdell has continued to threaten to infringe copyright through use of the EDGE logo. An injunction is thus in my judgment justified and appropriate.

De-registration through non-use

76. The claimant contends that all of EIM's registered trade marks in the UK are invalid for non-use under s. 46 (1) (b) of the Trade Marks Act 1994, namely:

> "that such use has been suspended for an uninterrupted period of five years and there are no proper reasons for non-use".

The burden of proof lies on the proprietor to show that his marks have been used: s.100 of the Act.

77. Use for the purposes of s. 46 must be genuine use. In **La Mer Technology Inc v. Laboratoires Goemar SA** [2004] Case C-259/02, BAILII: [2004] EUECJ C-259/02 at [21]-[22], the European Court of Justice explained that use as follows,

> "....use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive, even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to be justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.
>
> The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case-by-case assessment which is for the national court to carry out. The characteristics of those products or services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical products or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account."

78. This action was started in 2009 but until the end of November 2009 the only evidence produced by Dr Langdell in support of trade mark use in the UK was by way of assertion in his witness statements. He says there that his annual turnover in the UK has never fallen below £100,000 and that he has consistently sold the game "Bobby Bearing" and other games for mobile phones and personal computers throughout the relevant period.

79. A number of points arise. First, there is no suggestion that these games have been advertised or promoted for sale in the UK in the relevant period. The only evidence of anyone finding and purchasing them in the UK is evidence of "trap" orders placed by the claimant for the purposes of the proceedings. Indeed when such orders were placed EIM did not even deliver the games. The only outlets through which any of the games could be purchased are Dr Langdell's websites which redirect to amazon.com and another website. On both websites the games are priced in dollars. Amazon shows no instance of feedback from any buyers. There is therefore nothing to show that the marks "preserve or create market share for the goods or services protected by the mark". The mere placing of the mark on the defendants' websites is not genuine use in the absence of active promotion of the website since it is insufficient to establish a market for the goods.

80. Secondly, Dr Langdell seeks to rely on the claimant's use of the mark. He cannot do this for the simple reason that he has no registered marks in relation to computer gaming magazines. They belong to the claimant alone.

81. Thirdly, Dr Langdell seeks to rely on sales of goods by others whom he claims are licensees of EIM. One matter relied upon is 20th Century Fox's movie "The EDGE". I would need cogent supporting evidence to convince me that this company is EIM's licensee and no such evidence has been forthcoming. In any event it is doubtful whether the name of the movie fulfils the function of a trade mark in indicating the origin of goods. Another supposed licensee is Datel, which who sells a Wii game controller called "the Edge" in the US and over the internet. Again there is no evidence in support of trade mark use in the UK. A third supposed licensee is NIS which sells a Playstation 3 game called "Cross Edge". Again there is no corroborative evidence and the relevance of this product is dubious in any event since "Cross Edge" is not one of the registered marks.

82. The defence, drafted at a time when the defendants were legally represented, did not give particulars of use. On 7th October and again on 22nd October 2010 the claimant served a request for further information asking for particulars of all uses relied on in relation to each mark including turnover figures and requesting support from accounts. The request was sent by recorded delivery to Dr Langdell's address for service in Regent Street and also to Dr Langdell's email address. No response was received and Dr Langdell claims he did not receive any such request. By contrast, the documents in Dr Langdell's list on disclosure which might relate to use were not actually provided with the covering letter purporting to enclose them. They were still not provided despite a letter from the claimant's solicitors of 19th October 2010 informing him of the omissions.

83. Just before the trial Dr Langdell served a supplemental list of documents. They include alleged sales figures in the UK for a number of the defendants' games. However no underlying records were produced and it was plainly too late to investigate the position in any event. No evidence of payments has ever been offered even though it is claimed that all payments were made through Paypal. No person who is said to have purchased a game has given evidence. It is not explained how sales could have been achieved in the absence of

marketing or distributorship. I observe that although the games are offered on Amazon at $24.99 each the sale price on the document is less than $10. No explanation has been given as to why Dr Langdell has disclosed only one order ID from Amazon, although he alleges that he sold 471 copies of the game "Racers".

84. Another document shows sales of Bobby Bearing by a Polish company, Artegence. No evidence is tendered as to how such sales could have been effected in the UK. In any event, the sales shown are inconsistent with the contract that the defendant had with Artegence, which was in evidence. The contract does not require breakdown of sales by country, it requires payment of 30% gross revenue less sales tax and commission and there is no reference in the sales document to the exchange to dollars. The sales document does not in any event identify the number of units alleged to have been sold.

85. One of the documents disclosed by Dr Langdell shortly before trial was an EIM invoice and shipping notice dated 26th November 2010 addressed to Creative Distribution Ltd, a video game distributor in Croydon, for 50 copies of the Racers game. Dr Langdell offered no reason at all for not having disclosed documentation about this sale as soon as it was available. The invoice was a very recent one, bearing the date of only some 10 days before trial. However, under cross-examination, Dr Langdell was unable to recall the name of the person to whom he had dealt at Creative Distribution, whether the communication was by telephone or email, when the transaction had occurred, how Creative Distribution is said to have seen the game or what were the terms and conditions of sale. The invoice is in these circumstances insufficient proof of the sale it purports to record.

86. Importantly, Dr Langdell sought to rely on sales in the UK by his licensee Velocity Micro Inc. Apparently in response to the claimant's Part 18 request on 7th October 2010 Dr Langdell emailed the claimant's solicitors on 30th November 2010 with two emails, comprising an exchange with Randall Copland of Velocity Micro. Dr Langdell claims that he had sent hard copies of these documents to the claimant's solicitors twice by post but they were not received.

87. The first email was an alleged email from Dr Langdell to Mr Copland timed at 10.26 am on 11th June 2010, requesting UK sales figures for Velocity Micro's "Edge" and "Gamer's Edge" products for the years 2006-9. The second email is the alleged response timed at 6.34 am on 14 June 2010, saying simply,

> "The figure is way over $1m for each year".

88. The claimant contacted Mr Copland and he made a witness statement dated 3rd December 2010 attaching his correspondence with Dr Langdell. He said that the emails disclosed were not in the form sent and received. He attached the true copies of the emails he sent and received, explains how the disclosed emails appear to have been altered and confirms that the actual UK sales figures for the years in question were nil. Dr Langdell did not disclose the email dated 11th June that he had actually sent, nor did he disclose the email from Randall Copland in unredacted form which he actually received. His explanation for these omissions was totally unconvincing.

89. Having been served with Mr Copland's statement on the following working day Dr Langdell wrote to the claimant's solicitors saying that he had never alleged that Mr Copland's 14th

June email was in response to his 11th June email. In cross-examination he insisted that he sent the email to Mr Copland. His explanation was that,

> "....we have been let down by Velocity Micro, who said they were selling to the UK."

90. He elaborated on the Velocity Micro position by saying that he found Mr Copland's statement that he sold nothing in the UK market "surprising" as he had done some test purchases from Velocity Micro system during the years in question and had them shipped to his UK office. Again, however, there was no evidence whatsoever of this.

91. Instead, crucially, the claimant called Dr Langdell's bluff and offered to tender Mr Copland for cross-examination on his witness statement. The court explained to Dr Langdell that if he did not accept Mr Copland's evidence he would be well-advised to cross-examine him or else the court would be likely to accept his evidence as unchallenged. Dr Langdell then made the deliberate and informed choice not to take up the offer to explore his case with Mr Copland in cross-examination.

92. In all the above circumstances there is no cogent evidence that the defendants have had any presence in the UK market during the relevant period. I reject the sales figures contended for by Dr Langdell.

93. I would add that Dr Langdell contended that the claimant's allegations of passing off were inconsistent with their claims that he had not used his registered mark. However representations can still be made on websites directed into the UK in the absence of the conduct of a genuine business under that mark: see **Euromarket Designs Inc v. Peters** [2001] FSR 20.

Conclusion

94. The claimant therefore succeeds in establishing all claims pursued at trial.

EXHIBIT 11

The Blog of the IGDA Board of Directors

Tim Langdell removed from IGDA Membership

The Board of Directors today voted to remove Tim Langdell from IGDA membership pursuant to our bylaws Article III. Section 6 (b) which states that any member may be removed from membership if the member has demonstrated a lack of integrity or unethical behavior, as determined by the Board of Directors.

Brian Robbins
Chair, IGDA Board of Directors

This entry was posted on Wednesday, October 13th, 2010 at 23:02 and is filed under Uncategorized. You can follow any responses to this entry through the RSS 2.0 feed. Both comments and pings are currently closed.

« Previous Post (http://igdaboard.wordpress.com/2010/08/19/new-igda-board-officers/) Next Post » (http://igdaboard.wordpress.com/2011/01/27/kaos-studios-and-quality-of-life-in-the-game-industry-2/)

One Response to *Tim Langdell removed from IGDA Membership*

Former Edge Trademark Owner Langdell Booted From IGDA | Ajoder.net says:
17 October 2010 at 11:44
[...] board chairman Brian Robbins posted a brief note (via GamesIndustry.biz) this week stating, "The Board of Directors today voted to remove Tim [...]

The Contempt Theme.
Blog at WordPress.com.

Follow

Follow "International Game Developers Association Board"

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EXHIBIT 12

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

July 14, 2006

Leo Stoller
7115 W. North Avenue #272
Oak Park, Illinois 60302

Dear Mr. Stoller:

By order dated March 28, 2006, you were informed that the United States Patent and Trademark Office (USPTO) was considering imposing sanctions against you under 37 C.F.R. §10.18(c),[1] and you were allowed thirty days in which to show cause why sanctions should not be imposed. On April 26, 2006, after an extension of time to respond was granted, you filed your response to the order to show cause.

BACKGROUND

Summary of the March 28, 2006 show cause order

The show cause order noted that you and entities you control filed more than 1100 requests for extension of time to file notices of opposition between November 2005 and March 2006. The order noted, further, that the sheer number of such filings by one person is unprecedented and raises serious questions about whether the filings were undertaken for an improper purpose in violation of 37 C.F.R. § 10.18(b)(2), such as for harassment or unnecessary delay of the targeted applications.

The show cause order made reference to the numerous sanctions imposed on you, over many years, in past TTAB proceedings as evidence of your pattern of misconduct and abuse of the TTAB's

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[1] The authority to impose sanctions under 37 C.F.R. §10.18(c) has been delegated to the Chief Administrative Trademark Judge from the General Counsel under authority delegated to him by the Under Secretary of Commerce and Director of the United States Patent and Trademark Office.

that supports a claim that you may be damaged by registration of the mark.

Finally, you were informed that the sanctions being considered included terminating or vacating any extension of time to oppose found to have been filed in violation of the applicable rules, restriction of your right to appear before the USPTO on your own behalf or as an officer, director, or partner of any entity you control, and/or restriction of your right to request extensions of time to oppose on behalf of yourself or any entity you control.

Summary of Response

Your four-page response, to which you attached many pages of exhibits, consists of quotations from the show cause order, citation to certain cases to which you were a party and in which no sanctions were imposed on you, coupled with a request that the USPTO not impose any sanctions based on your past practices before the TTAB and other tribunals, and general comments concerning your basis for filing the numerous requests for extensions of time to oppose, without mention of any particular request.

References to Other Proceedings

In asking that the USPTO not sanction you for your past conduct in TTAB cases and the cases in other tribunals, you point out that the Executive Committee for the federal judicial district of the Northern District of Illinois issued you a citation on December 15, 2005, allowing you time to show cause why "reasonable and necessary restraints" should not be imposed upon you in view of your activities in the lawsuits brought by you or your wholly-owned companies, before the Court. The Executive Committee quoted Judge Coar in *Central Mfg. Co. v. Brett,*[3] 78 USPQ2d 1662, 1664 (N.D. Ill. 2005) as follows:

> Indeed, as several judges (including this one) have previously noted, Stoller appears to be running an industry that produces often spurious, vexatious, and harassing federal litigation … Plaintiff and one or more of his corporate entities have been involved in at least 49 cases

[3] The Executive Committee referenced the case as: Case No. 04 C 3049, *Stealth Ind. Inc. v. George Brett & Brett.*

investigate the facts, obtain documentation, and to enable the potential opposer to consider its position with regard to potential opposition of an application." You did not provide information regarding any specific steps you have taken with regard to any application for which you have obtained an extension of time to conduct such an investigation.

With respect to the requirement that you support your claim of damage, you state that, through entities which you control, you "hold rights to over 100 Federal Trademark Registrations" and hold "Common Law rights to several thousand trademarks and slogans which can be found at www.rentamark.com." You submitted, as exhibits, excerpts from the referenced website, including a "list of emarks" to which you claim rights. You state that, for each extension filed, you relied on common law rights to a trademark that was, in your opinion, confusingly similar to the applicant's mark.[6]

In requesting that you not be sanctioned, you ask that the USPTO merely give you "… some direction to keep Leo Stoller on a proper course…."

Activities Since Issuance of the Show Cause Order

Since the date of the show cause order, you have filed requests for extension of time to oppose against more than 400 additional applications, bringing the total since November 2005 to over 1800, as compared to only six you filed in the five-month period between June and October 2005. In particular, USPTO records show that during the past year you have filed requests for extension of time to oppose as follows:

June 2005	**1**
September 2005	**3**
October 2005	**2**
November 2005	**47**
December 2005	**238**

[6] "For each of the extensions that Leo Stoller filed, Leo Stoller held Common Law rights to a trademark that was in Leo Stoller's opinion, confusingly similar to the *potential opposer's* mark." (Emphasis added.) It is assumed that your reference to "potential opposer's mark" was intended, rather, as a reference to the marks against which you filed the extension requests.

Trademark Rule 2.102 provides, in relevant part, for the filing of requests to extend the time to oppose as follows:

> **(a)** Any person who believes that … it would be damaged by the registration of a mark on the Principal Register may file … a written request … to extend the time for filing an opposition. … Electronic signatures pursuant to § 2.193(c)(1)(iii) are required for electronically filed extension requests.
>
> **(c)** …. Requests to extend the time for filing an opposition must be filed as follows:
>
> > (1) A person may file a first request for either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.

Trademark Rule 2.193(c)(2) provides in relevant part as follows:

> The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter.

Patent and Trademark Office Rule 10.18 provides as follows:

> (b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-
>
> > (2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that- (i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office; (ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal

denied,[9] your filing of more than 1100 requests for extension of time to oppose within the few months preceding the date of the show cause order suggested a serious violation of your responsibilities as a party before the USPTO. The show cause order thus required you to demonstrate more than what might have been required in the ordinary case to support a single request for extension of time. In particular, you were required to demonstrate that the extension requests were not filed for improper purposes but, instead, were based on cognizable rights you may have arising under the Trademark Act.

Addressing directly the issue of your belief that you will be damaged, you indicate that you own over 100 federal registrations for trademarks and that you have common law rights in several thousand trademarks and slogans, referring to your website and attaching pages from your website to your response. Your submissions do not substantiate your rights in any of the claimed marks, let alone support a colorable claim of damage. For example, you did not submit copies of the registration certificates of the registered trademarks you claim to own. Nor did you even clearly identify your registered trademarks and the goods and services for which they are registered.

In support of your claim of damage to your purported common law trademarks, you provided a listing of your claimed trademarks, running to almost 150 pages (50 terms listed on each page). The listing was derived from your website and includes nothing more than the listing of the marks themselves. You submitted no evidence of products or services bearing these alleged marks, no evidence that you have sold any products or services under these marks, and no evidence of your advertising of goods or services with these marks.

At your website, you offer to "RENT-A-FAMOUS slogan" and offer "Famous Trademarks for Rent On-Line." Your website states that you "control over 10,000 famous trademarks…." Nonetheless, the exhibits from your website do not demonstrate your offering for sale any goods or services, other than the "rental" of the marks themselves, nor do the website exhibits demonstrate the use of any of the asserted terms as trademarks. These excerpts from your website, rather than evidencing support of any purported claim for damage, reinforce the conclusion that you are holding up thousands of applications in an attempt to coerce applicants

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[9] *But see*, TBMP § 210, 211 (2d ed. rev. 2004)(regarding requests by applicants that the TTAB reconsider granted requests for extensions of time to oppose or deny subsequent requests).

need not be extensive and the TTAB's examination of extension requests is usually cursory, Trademark Rule 2.102 and Patent and Trademark Rule 10.18 require that all requests for extension of time be based on a good faith belief that the potential opposer would be damaged by the potential registration.

The show cause order invited you to demonstrate that your filing of each of the extraordinary number of requests for extension of time to oppose was not improper. ("Any such showing should include evidence that supports a claim that you may be damaged by the registration of each of the marks for which an extension of time to oppose has been filed.") While extensions of time to investigate potential claims are common, the potential opposer must still hold some reasonable belief that it would be damaged by registration of the mark in question. Notwithstanding the opportunity offered to you to demonstrate such a belief, you have declined to make any such showing.

Any impropriety with respect to the letters you have sent to applicants against whose applications you have filed requests to extend time to oppose is not now under review. Nonetheless, the manner in which you request "consent" for prospective further requests to extend time to oppose, such consent being necessary under Trademark Rule 2.102(c)(3), is indicative of your motivation in filing the requests to extend time to oppose that are now under scrutiny. Specifically, your intimation that the individual applicant's consent is presumed if you do not receive an objection is in contradiction of your actual knowledge that any such consent must be explicit. *See Central Manufacturing, Inc. v. Third Millennium Technology, Inc.*, 61 USPQ2d 1210 (TTAB 2001) (misrepresenting that applicant has "agreed" to the third and fourth requests to extend time to oppose). Thus, your contact letters, providing misinformation as to the requirements for the final extension request permitted under Trademark Rule 2.102(c)(3), support the finding that the extension requests at issue here were filed for improper purposes, specifically "…to obtain additional time to harass applicant, to obtain unwarranted extensions of the opposition period, and to waste resources of applicant and the Board." *Id.* at 1216.

In view thereof, it is determined that you have not made a showing that you have a colorable claim of damage justifying the extension requests filed during the period in question and have failed to establish good cause for filing such requests. It is determined, further, that you filed the extension requests for improper purposes, namely, to harass the applicants to pay you to

Wright & A. Miller, 5A Fed. Prac. & Pro. Civ.3d § 1336.1 (2006) (appropriate to consider prior behavior in other cases when exercising a court's inherent authority); Fed. R. Civ. P. 11, Advisory Committee's Note (1993) (same consideration appropriate under Rule 11). While the USPTO has considered findings made by other tribunals, the pattern of activities in the TTAB alone justify the sanctions imposed below.

The following sanctions are, therefore, hereby imposed:

Grant of Extension Requests Vacated

The approval of each request for extension of time to oppose that you have filed since November 2005 is hereby vacated.[12]

Two-Year Prohibition On Filing Extension Requests

You are hereby prohibited for a period of TWO YEARS from the date of this order from filing, on your own behalf or as an officer, director, or partner of any entity you control, any request for extension of time to oppose under Trademark Rule 2.102. This two-year prohibition applies whether or not you are represented by an attorney.

Requirement Of Attorney Representation For Any Future Extension Requests

You are PERMANENTLY prohibited from appearing before the USPTO on your own behalf or as an officer, director, or partner of any

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[11] In contrast to the two cited orders of the Northern District of Illinois in which the Executive Committee and the Court declined to impose sanctions, that court has chastised and sanctioned you numerous times. *See, e.g., S Industries, Inc. v. JL Audio, Inc.*, 29 F. Supp.2d 878 (N.D. Ill. 1998) ("This has not been a good year for Plaintiff in the Northern District of Illinois, but, then again, Plaintiff has not been a good litigant."), referencing several other cases before the Court that had been decided against you. *See also Central Mfg. Co. v. Pure Fishing, Inc.*, 2005 WL 3090998 (N.D. Ill. 2005) (and cases cited therein), in which the court imposed the sanction of dismissing plaintiff's claim and granting defendant's counterclaims to cancel registrations you own and for declaratory and injunctive relief. (The *Pure Fishing* case is suspended pending resolution of your petition in bankruptcy.)

[12] Extension requests granted more than 90 days ago have now expired. This sanction is, thus, moot with respect to such requests. But, if you have filed a notice of opposition against any of the involved marks, such notice of opposition is rendered untimely by this sanction, and any such opposition shall be dismissed.

extension requests or to require that you be represented by an attorney with respect to any future Board matter, not just requests for extensions of time to oppose. At this time, the USPTO has restricted the sanctions imposed herein to those closely related to your recent misconduct and, it believes, the minimum necessary to prevent such misconduct in the future. Nonetheless, the question of broader sanctions will be revisited if you commit further improprieties in proceedings before the TTAB.

So ordered.

/signed/

J. David Sams
Chief Administrative Trademark Judge
Trademark Trial and Appeal Board
United States Patent and Trademark Office