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

| | |
|---|---|
| Proceeding | 91212834 |
| Party | Defendant<br>Mobigame |
| Correspondence Address | PATRICK J CONCANNON<br>NUTTER MCLENNEN & FISH<br>155 SEAPORT BLVD<br>BOSTON, MA 02210-2698<br>UNITED STATES<br>Primary Email: docket@nutter.com, pconcannon@nutter.com<br>617-439-2177 |
| Submission | Request for Reconsideration of Final Board Decision |
| Filer's Name | David Papazian |
| Filer's email | david@mobigame.net |
| Signature | /David Papazian/ |
| Date | 08/06/2020 |
| Attachments | Combined Motion for Relief from Final Judgment and for Sanctions in t he Form of Judgment Against Opposer - 06953267 SIGNED.pdf(178679 bytes )<br>Electronic Arts Decision - 06953268.pdf(6020171 bytes ) |

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of U.S. Service Mark Application Ser. No. 79/067,304
Published in the *Official Gazette* on June 4, 2013

| | | |
|---|---|---|
| Edge Games, Inc. | ) | |
| | ) | |
| Opposer | ) | |
| | ) | |
| v. | ) | Opposition No. 91212834 |
| | ) | |
| MOBIGAME | ) | |
| | ) | |
| Applicant | ) | |

Combined Motion for Relief from Final Judgment and for Sanctions in the Form of Judgment Against Opposer

1. MOBIGAME, applicant for Appl. No. 79/067,304, hereby requests that the USPTO review the record in Opposition No. 91212834, re-open those proceedings, revive Appl. No. 79/067,304, and sanction opposer Edge Games, Inc. in the form of denial of Opposition No. 91212834.

2. MOBIGAME has been harmed by the USPTO's not doing its job as a credible trademark registry, but instead protecting a dangerous trademark troll. MOBIGAME convincingly proved through multiple submissions that Edge Games, Inc.'s principal Tim Langdell engaged in fraudulent behavior before the USPTO and courts. He doctored specimens to register his trademarks. He lied before the USPTO, and he delayed the proceedings to play the clock against his opponents and run up defense costs by filing frivolous motions to dismiss and other groundless motions. On January 25, 2017 MOBIGAME filed with the USPTO a copy of Judge Alsup's "Order Denying Motion for Preliminary Injunction" about court proceedings that Tim Langdell and Edge Games, Inc. brought against Electronic Arts, which proves that MOBIGAME's claims about Edge Games' bad faith and bogus trademark usage and rights claims were accurate. See Exhibit A. The business practices of Tim Langdell and Edge Games were referred to as trolling by the US District Court after it was found that there was no evidence of commercial use of the asserted marks but that there instead was evidence that Langdell had submitted doctored specimens and had fraudulently obtained and/or maintained many of his registrations.

3. After receiving that proof of serious fraud on courts and the USPTO, the USPTO should have dismissed immediately Opposition No. 91212834. MOBIGAME alerted the USPTO that Tim Langdell was a trademark troll many times, and supported those claims with proof that can be found within the opposition record. But the USPTO ignored our evidence at every turn.

4. The USPTO asked us to stop corresponding directly, requiring that we hire legal counsel in the US to address this matter for us. And no one alerted us that our International Registration was going to expire. We never received any paper, email, fax or phone call from the USPTO. Although we communicated by email with the USPTO in the past, and it knew our email address, they did not send anything. Our US attorney did not alert us about the renewal deadline for International Registration either, until the TTAB dismissed the opposition after the International Registration had expired.

5. Because of Tim Langdell's practices, our game EDGE was removed from the Apple App Store in 2009 because Apple said our trademark was not registered yet, and not enforceable. The lost sales are quite hard to estimate exactly, but if we just interpolate the data, it's more than $500,000.

6. If the USPTO does not reinstate our trademark immediately, the consequence could be terrible. Edge Game's trademark is registered, so he can start again his extortion business as described by the US District Court in its judgement. So not only did the USPTO enable trademark troll Tim Langdell's and Edge Games' activities against us in this opposition procedure, but by letting our trademark expire it also helped Tim Langdell to resume his trolling activities.

7. We have been fighting trademark troll Tim Langdell for 10 years. At any time during Edge Game's groundless opposition, the USPTO might have sanctioned him, but it never did so. Instead the USPTO asked us to stop MOBIGAME's direct communications with the USPTO. The USPTO played into trademark troll Tim Langdell's hands by tolerating and eventually granting his groundless opposition.

8. Many companies have been extorted by Tim Langdell and Edge Games during this time, and this is only because the USPTO let him register his trademarks with doctored, fake specimens and based upon his lies about his nonexistent business activity. However, the USPTO had all the proof to stop him, and it knew all along that Tim Langdell was perpetrating a serious fraud. Yet the USPTO did nothing. Now Tim Langdell and Edge Games are totally free to start again.

9. The USPTO has cast a willfully blind eye on Tim Langdell's behavior to the point that it almost has been complicit with him in enabling abusive registration and extortion. If the rules had been applied properly, all this would have been avoided.

10. For all of the above reasons, MOBIGAME asks the USPTO to reconsider its position and reinstate MOBIGAME's Appl. No. 79/067,304. If the USPTO reinstates our trademark as we request, no third party credibly can claim to be prejudiced.

MOBIGAME respectfully urges the USPTO to reconsider the matter and reverse the obviously unjust opposition outcome.

Sincerely,

MOBIGAME

By _____

David Papazian

Director

Date: 30 july 2020

**Exhibit A**

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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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):

EDGE®

**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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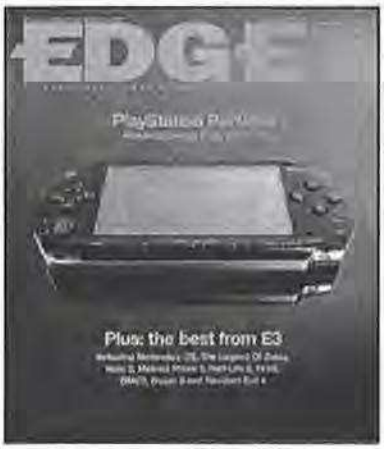
number written clearly on it" (*id.* at Exh. L).[2] According to a declaration submitted by the publisher of Edge Magazine, however, the magazine cover submitted to the USPTO by Dr. Langdell was *not* a genuine copy of any magazine cover that had ever been published (Binns Decl. ¶ 13, Exh. C). *It was 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.



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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:



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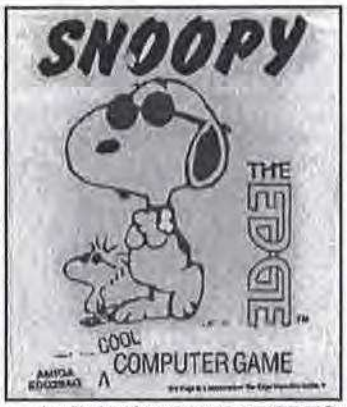



**As Submitted to the USPTO**

**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**

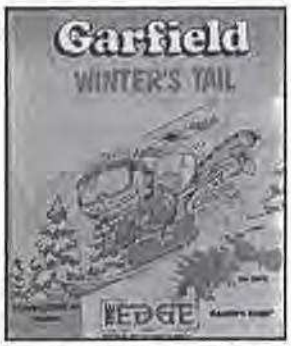
**Actual Comic Book**

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"

[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.



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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).

* * *

[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.



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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.



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### 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*.



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## 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

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