

ESTTA Tracking number: **ESTTA961604**

Filing date: **03/20/2019**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Paul Reiche III
Granted to Date of previous extension	03/20/2019
Address	2553 Laguna Vista Drive Novato, CA 94945 UNITED STATES

Attorney information	Stephen C Steinberg Bartko Zankel Bunzel & Miller One Embarcadero Ctr., Ste. 800 San Francisco, CA 94111 UNITED STATES ssteinberg@bzbm.com, tingroff@bzbm.com, mark@palmerlex.com, smc-tigue@bzbm.com 4152914523
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**Applicant Information**

Application No	88016354	Publication date	11/20/2018
Opposition Filing Date	03/20/2019	Opposition Period Ends	03/20/2019
Applicant	Stardock Systems, Inc. 15090 Beck Road Plymouth, MI 48170 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Computer game programs; Computer game software; Video game programs; Video gamesoftware
Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Entertainment services, namely, providing on-line computer game software and video games; Providing information on-linereleting to multimedia entertainment software production services; Providing information on-line relating to computer games and video games

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)

Failure to function as a mark	Trademark Act Sections 1, 2 and 45
Applicant not rightful owner of mark for identified goods or services	Trademark Act Section 1
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)
Deceptiveness	Trademark Act Section 2(a)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
Other	Application made in bad faith and to harass, misuse of application process

### Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	FWIFFO		
Goods/Services	Computer game programs; Computer game software; Video game programs; Video game software; Online computer game software and video games		

Related Proceedings	Stardock Systems, Inc. v. Reiche, et al., Case No. 17-cv-07025-SBA, U.S. District Court, Northern District of California TTAB Proceeding Nos. 91242194, 91243698, 91244069, 91246027, and 91246028
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Attachments	2019.3.20 FWIFFO Notice of Opposition.pdf(170905 bytes )
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Signature	/Stephen C Steinberg/
Name	Stephen C Steinberg
Date	03/20/2019

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

In the Matter of:  
Application Serial No.: 88/016,354  
Mark: FWIFFO  
Published in the Official Gazette: November 20, 2018

Paul Reiche III,  
  
                    Opposer,  
  
          v.  
  
Stardock Systems, Inc.,  
  
                    Applicant.

Opposition No.  
Application Serial No.: 88/016,354

**NOTICE OF OPPOSITION**

Paul Reiche III (“**Reiche**”), an individual residing at 2553 Laguna Vista Drive, Novato CA 94945, believing that he would be damaged by Applicants’ registration, hereby opposes registration of the mark shown in Application Serial No. 88/016,354 for the mark FWIFFO filed on June 26, 2018, under the Trademark Act of 1946, in the name of Stardock Systems, Inc., a Michigan corporation, located and doing business at 15090 Beck Road, Plymouth, Michigan 48170 (hereinafter “**Applicant**”), published for opposition in the *Official Gazette* of November 20, 2018 (the “**Opposed Mark**”).

The grounds for Opposition are as follows:

1. A civil action is filed and pending in United States District Court for the Northern District of California, *Stardock Systems, Inc. v. Reiche, et al.*, Case No. 17-cv-07025-SBA, that will have a bearing on the instant proceeding (“**Civil Action**”). On July 16, 2018, Reiche filed an Amended Counterclaim and on October 15, 2018, Reiche filed a Second Amended

Counterclaim against Applicant for declaratory judgment re: trademark rights, including with respect to the Opposed Mark. Moreover, on July 16, 2018 Applicant filed a Second Amended Complaint and on October 15, 2018 Applicant filed a Third Amended Complaint against Reiche for unfair competition and false designation of origin and trademark infringement against Reiche, including with respect to the Opposed Mark.

2. Upon information and belief, Applicants filed, under Trademark Act § 1(b) claiming intent to use in U.S. commerce, U.S. Trademark Application No. 88/016,354 for the mark FWIFFO for use with “Computer game programs; Computer game software; Video game programs; Video game software” and “Entertainment services, namely, providing on-line computer game software and video games; Providing information on-line relating to multimedia entertainment software production services; Providing information on-line relating to computer games and video games” (the “**Opposed Application**”).

3. Between 1988 and 1992, Reiche originally created, authored, developed and released for distribution in U.S. commerce two (2) computer software games called “Star Control”, also known as “Star Control I” and “Star Control II”, also called “Star Control II: The Ur-Quan Masters” and at times just “The Ur-Quan Masters.” (collectively the “**Original Star Control Games**”).

4. The name FWIFFO was first created and introduced by Reiche to identify a distinct alien character in Star Control II.

5. After their initial release, the Original Star Control Games quickly acquired a cult status among computer game enthusiasts, and ultimately grew to be regarded as some of the all-time classic and best computer games in history. Star Control and Star Control II: The Ur-Quan Masters were both successful in terms of sales and received substantial critical acclaim around

the time of their release and in subsequent years. For example, in 1996, Computer Gaming World ranked Star Control II: The Ur-Quan Masters as the 29th best game of all time, and Star Control as the 127th best game of all time. More recently, in 2005, IGN named Star Control II: The Ur-Quan Masters the 17th best game of all time. Reviewers praised the graphics, dialogue, and quality of the gameplay, among other things. A few years ago, Star Control II: The Ur-Quan Masters emerged as the consistent favorite in a crowd-sourced list of the best PC games of all time: <https://kotaku.com/the-game-that-won-our-classic-pc-games-list-if-it-ha-1349952997>.

6. In 1988, Reiche initially licensed the Original Star Control Games to be published by a company called Accolade, Inc. (“**Accolade**”) pursuant to a written license agreement and subsequent addenda thereto (the “**1988 License Agreement**”). The 1988 License Agreement stated that Reiche would own the copyrights and all other proprietary rights in the Original Star Control Games, while Accolade would own any trademarks that it adopted and used in marketing the Original Star Control Games. On information and belief, the only trademark adopted and used by Accolade was the name “Star Control.”

7. In April 1996, Accolade filed U.S. Trademark Registration No. 2,046,036 for the mark STAR CONTROL for computer game software, and manuals supplied as a unit therewith (the “**1996 Star Control Registration**”). On information and belief, Accolade never filed to register nor otherwise claimed any rights to any other trademark(s) related to the Original Star Control Games.

8. The April 1, 1998 Addendum No. 3 to the 1988 License Agreement between Accolade and Reiche made clear that his rights included the “characters [and] names” and the “names (of starships and aliens races) [and] characters” in the Original Star Control Games.

9. On information and belief, on or around April 1, 1999, Accolade was acquired by Infogames, Inc. (“**Infogames**”) and in or around May 2003, Infogames was renamed as Atari, Inc. (“**Atari**”).

10. By 2001, all licenses granted by Reiche to Accolade and its successors or assigns with respect to the Original Star Control Games under the 1988 License Agreement had expired or were terminated and all previously granted rights reverted to Reiche, including, without limitations all copyrights to publish or make derivative works from the games.

11. Also by 2001, Accolade and its successors or assigns had abandoned all use of the registered STAR CONTROL mark, and any other common law marks that may have been used or associated with the Original Star Control Games from time to time. Further, those abandoned marks remained unused in commerce by Accolade or any of its successors or assigns for more than a decade until at least 2011.

12. Since at least 2001, Reiche has held the copyright and other rights to publish and make derivative works from the Original Star Control Games, including but not limited to, all marks and other intellectual property rights otherwise not adopted and used by the Accolade in the original marketing and publishing of the games and the names/titles, sub- names/titles, characters (e.g., aliens), alien race names, characters names, planet names, spaceship names and spaceship designs.

13. On August 1, 2002, having previously regained all rights to publish and control the Original Star Control Games, Reiche released online to the public an open source edition of the Star Control II: The Ur-Quan Masters game that was distributed free to use in a non-commercial context (the “**Open Source Project**”), which reinvigorated interest in the game and introduced it to a new generation of gamers. Having been unable to reach an agreement with

Accolade to acquire or use the 1996 Star Control Registration, Reiche re-released the Open Source Project under the title “The Ur-Quan Masters” with Accolade’s knowledge and without any objection.

14. On November 25, 2002, Accolade attempted to assign U.S. Trademark Registration No. 2,046,036 for STAR CONTROL to Infogames, and on March 17, 2003, Infogames filed with the United States Patent and Trademark Office (“USPTO”) a Declaration of Use and Incontestability attaching a picture of the Star Control II packaging from 1994 as the Specimen of Use. On information and belief, this was a fraudulent statement to the USPTO because Accolade had not sold any Star Control game, including the pictured version of Star Control II, since at least 2000 and perhaps even earlier, as evidenced by the lack of royalty payments to Reiche.

15. On September 18, 2007, Atari filed with the USPTO a Declaration of Use in Commerce and Application for Renewal of Registration for the STAR CONTROL mark. On information and belief, this was a fraudulent statement to the USPTO because Atari was not using the STAR CONTROL mark in interstate commerce at that time, nor had it done so since at least 2000 and perhaps even earlier. Further, on information and belief, Atari did not use the STAR CONTROL mark through at least early 2011.

16. On January 2, 2012 (with an effective date of April 1, 2011), Reiche entered into the Digital Distribution Agreement with GOG Limited (“**Reiche-GOG Agreement**”) to provide GOG with a non-exclusive license to distribute the Original Star Control Games.

17. On information and belief, in 2013 Atari filed for bankruptcy, and according to Applicant, under a purported Purchase Agreement dated July 18, 2013, Atari allegedly transferred to Applicant the 1996 Trademark Registration for the previously abandoned STAR

CONTROL mark. However, Atari did not purport to own, sell, or license, nor did it own or have the right to sell or license, any rights to the Original Star Control Games, the 1988 License Agreement having terminated or expired over a decade earlier. Nor did Atari purport to own, sell, or license, nor did it own or have the right to sell or license, any rights to other marks, such as FWIFFO.

18. Notwithstanding the foregoing, in the Civil Action, Applicant alleges that, among other things: a) Accolade and then Atari owned the rights to the mark FWIFFO; b) Atari sold such rights to Stardock in 2013; c) Stardock has used the FWIFFO mark in U.S. commerce since 2013 by offering for sale and selling the Original Star Control Games; d) the FWIFFO mark has obtained valuable fame, reputation, and goodwill as a result of the success of the Original Star Control Games; and e) Reiche's use of the name FWIFFO in the Open Source Project constitutes trademark infringement.

19. If Stardock is correct that use of the name FWIFFO to identify a distinct alien character in Star Control II: The Ur-Quan Masters and then in the Open Source Project constitutes use of the mark in commerce, then the FWIFFO mark was abandoned by Accolade or Atari after 2000 and has been used continuously by Reiche since at least 2002.

20. Regardless, the name FWIFFO has become recognized by the consuming public as a designation of origin or as being directly associated with Reiche, the Original Star Control Games, The Ur-Quan Masters game, and the Open Source Project.

21. Over the past 30 years, consumers have come to identify FWIFFO and The Ur-Quan Masters game with Reiche as one of the two creators and designers (along with his business partner Fred Ford) of the Original Star Control Games and with their unique storylines,



modes, ships, and alien characters. The Ur-Quan Masters and the Original Star Control Games have individually acquired valuable fame, reputation, and goodwill among the purchasing public.

22. Since Reiche's open source release of The Ur-Quan Masters in 2002, various other marks associated with that game have been in use in U.S. commerce by Reiche alongside the FWIFFO Mark. The rights and collective goodwill established from such use and associated with such marks have inured to the benefit of Reiche.

23. The FWIFFO Mark has obtained valuable fame, reputation and goodwill due to Reiche's long-standing use of the mark in U.S. commerce and its association with Reiche, the Open Source Project and the highly successful Original Star Control Games.

24. For over 25 years since its original release, Reiche hoped to return to the Star Control universe to continue The Ur-Quan Masters story.

25. In October 2017, Reiche announced his intention to begin development on a new computer software game called "Ghosts of the Precursors" as a direct and true sequel to Reiche's original story embodied in the Original Star Control Games, and particularly in The Ur-Quan Masters adventure, including FWIFFO.

26. In October 2017, Reiche and Ford learned that Stardock had begun selling the Original Star Control Games, including The Ur-Quan Masters with the FWIFFO alien character, through Steam, a digital distribution platform, to market and promote the release of Applicant's new game then in development, without Reiche's permission and in violation of Reiche's copyrights.

27. In addition, besides the instant application, between October 2017 and July 2018 Applicant filed nearly two dozen applications to register U.S. trademarks in bad faith, under fraudulent circumstances, and to harass or otherwise injure Reiche, including the following:

<b>U.S. TRADEMARK APPLICATION NUMBER</b>	<b>MARK</b>	<b>FILE DATE</b>
87662697	SUPER MELEE	10/27/2017
87720654	THE UR-QUAN MASTERS	12/14/2017
87810480	ORZ	2/26/2018
87810484	UR-QUAN	2/26/2018
87810486	SYREEN	2/26/2018
87810492	SPATHI	2/26/2018
87810495	ANDROSYNTH	2/26/2018
87810499	CHENJESU	2/26/2018
87810502	ILWRATH	2/26/2018
87810516	PKUNK	2/26/2018
87810518	ARILOU	2/26/2018
87810526	VUX	2/26/2018
87810528	MELNORME	2/26/2018
87825741	YE HAT	3/8/2018
87877907	TAALO	4/16/2018
87877969	DNYARRI	4/16/2018
88016293	CRIMSON CORPORATION	6/26/2018
88016354	FWIFFO	6/26/2018
88033532	CHMMR	7/11/2018
88033544	DRUUGE	7/11/2018

28. Since at least 2002, the above marks have been used by Reiche and represent alien character names, functional identifiers, or other unique creative elements in the Original Star Control Games. To the extent that Applicant contends that Accolade's prior use of these names in or association of these names with the Original Star Control Games at any time prior to 2001 constituted use in commerce, such use, if any, was abandoned by Accolade, and its successors and assigns. Further, all other rights to the above stated terms either always remained with Reiche or reverted to Reiche upon expiration or termination of the 1988 License

Agreement. The above stated names and terms have been used continuously by Reiche in connection with offering The Ur-Quan Masters game to the consuming public since 2002.

29. The Opposed Mark is confusingly similar to or associated with Reiche's common law FWIFFO mark given that the Opposed Mark is identical.

30. The Opposed Mark is confusingly similar to Reiche's common law FWIFFO mark given the public association established between FWIFFO, Reiche, the Ur-Quan Masters game, and the Open Source Project over the years.

31. The goods and services in the Opposed Application are highly related to, if not the same as, the goods and services associated with the Original Star Control Games and the Open Source Project.

32. Applicant's registration of the Opposed Mark will create a likelihood of confusion, mistake and/or deception among consumers, within the meaning of Trademark Act § 2(d), 15 U.S.C. § 1052(d), all to the detriment Reiche.

33. Upon information and belief, Reiche avers that members of the relevant consuming public are likely to be confused, mistaken, or deceived as to the origin, sponsorship, or approval of Applicant's goods and services to be marketed and offered under the Opposed Mark and misled into believing that such goods and services emanate from or are in some way associated with Reiche or the Original Star Control Games.

34. Because the Opposed Mark is confusingly similar to Reiche's common law FWIFFO Mark and the goods and services listed in the Opposed Application are related to and, in some cases the same as the associated goods and services provided by Reiche (i.e. the Original Star Control Games and the Open Source Project), consumers would likely believe that the Opposed Mark is associated with Reiche, the Original Star Control Games, or both.

35. The Opposed Mark falsely suggests to consumers a connection with Reiche and the Original Star Control Games. Applicant's registration of the Opposed Mark will therefore falsely suggest a connection with Reiche or the Original Star Control Games or both within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), to the detriment of Reiche.

36. Applicant has no bona fide intent to use of the Opposed Mark in commerce to support its intent to use based application for its registration under Trademark Act §1(b), 15 U.S.C. § 1051(a).

37. As set forth in greater detail above, even assuming arguendo that a previously unregistered mark identical to the Opposed Mark was used in commerce by Applicant's predecessors in interest, such a mark has long since been abandoned due to nonuse with intent not to resume use, due to nonuse for more than three consecutive years, or due to that course of conduct having caused the mark to lose significance as an indication of source.

38. Applicant has used the Opposed Mark and applied for registration to misrepresent or mislead as to the source or origin of its goods or services, including without limitation, by bundling its goods and services for sale along with Reiche's Original Star Control Games without license or authorization.

39. The Opposed Mark is not in lawful use in commerce by Applicant and cannot lawfully be used by Applicant for the provision of the identified goods and/or services under federal law, including, without limitation, under copyright and unfair competition law.

40. The Opposed Mark was filed in bad faith or under fraudulent circumstances.

41. Alternatively, the abandoned FWIFFO mark has become a well-known or famous mark and Applicant is not the original user of the mark.

42. Consumers have come to identify and associate the Opposed Mark with Reiche and the Original Star Control Games over time, and particularly with The Ur-Quan Masters game.

43. When parties to a case pending before the Trademark Trial and Appeal Board (“TTAB”) are engaged in a civil action that may have a bearing on the case, the TTAB may suspend the proceeding until termination of the civil action. 37 C.F.R. § 2.117(a); TBMP § 510.02(a). The TTAB has explained that “while a decision by the District Court would be binding upon the Patent Office, a decision by the Trademark Trial and Appeal Board would only be advisory in respect to the disposition of the case pending in the District Court. Accordingly, and notwithstanding the fact that the Patent Office proceeding was the first to be filed, it is deemed to be the better policy to suspend proceedings herein until the civil suit has been finally concluded.” *Tokaido v. Honda Associates Inc.*, 179 USPQ 861, 862 (TTAB 1973).

44. The Civil Action currently pending in the Northern District of California involves (at least in part) essentially the same issues raised in the instant proceeding. The determination of these issues by the District Court will likely affect the issues involved in this proceeding.

WHEREFORE, Reiche believes and avers that he is being and will continue to be damaged by registration of the Opposed Mark as aforesaid, and requests that said Application Serial No. 88/016,354 for the mark FWIFFO be rejected, that no registration be issued thereon to Applicants, and that this Opposition be sustained in favor of Reiche for the foregoing reasons. Reiche also respectfully requests suspension of this proceeding pending final determination of the Civil Action.

Reiche has appointed Stephen C. Steinberg and Mark S. Palmer, members of a U.S. Bar in good standing, to prosecute this Opposition and to transact all business in and before the

United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

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Dated: March 20, 2019

Respectfully submitted,

BARTKO ZANKEL BUNZEL & MILLER

By: /Stephen C. Steinberg/

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Counsel for Opposer Paul Reiche III

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION was served on Applicants' attorney of record as listed with the U.S. Patent and Trademark Office this 20th Day of March 20, 2019, by sending the same via email to:

David L. May  
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