

Directorate of Industrial Property

BRANDS

National number and ref: NL22-0042

(to be recalled in all correspondence

-art. R.712-6 of the Intellectual Property Code)

National number of the contested trademark:

1515050 **V/Ref:** EDGE

Case followed by: Stéphane HIDALGO-FRIAZ

Phone : 01.56.65.81.18

TRUMP CARD PILAPLACE

MRS. GUILLERMARD AUDE

ATOUT PI LAPLACE 22 AVENUE ARISTIDE

"VISIUM" BUILDING

94117 ARCUEIL CEDEX

Courbevoie, 15/03/2023

SUBJECT : Proceedings for nullity or revocation - Notification of the decision ruling on nullity (R.716-12 of the Intellectual Property Code) **P.J.**

I have the honour to notify you of the decision established in the light of the annulment procedure referred to above.

This decision, attached hereto, is also accessible and downloadable on the INPI website by means of the dedicated teleservice, according to the modalities indicated on the attached sheet.

I would like to draw your attention to the fact that you have the means of appeal against this decision before the competent Court of Appeal, under the conditions and within the time limits set out in the annex.

I inform you of the names and addresses of the parties to the proceedings:

- **Applicant** : Mobigame - 25-27 rue Titon - 75011 Paris - FRANCE

- **Owner of the disputed** trademark: Edge Games, Inc. - 530 South Lake Avenue, #171 - Pasadena CA 91101 - United States of America

I remind you that all exchanges relating to the nullity or revocation procedure must be carried out in electronic form on the INPI website by means of the dedicated teleservice (section "Access the portal of opposition, nullity and revocation") according to the modalities indicated on the attached form. Please accept the assurance of my distinguished consideration

For the Director-General

of the National Institute of Industrial Property

Stéphane HIDALGO-FRIAZ



Jurist

APPEALS BEFORE THE COURT OF APPEAL AGAINST THE DECISIONS OF THE DIRECTOR GENERAL OF THE INPI
(art. R. 411-19 to R. 411-43 of the Intellectual Property Code)

TIME LIMIT FOR BRINGING PROCEEDINGS

(Art. R. 411-21)

- . The time limit for lodging an appeal with the Court of Appeal is **one month** from the notification of the decision, or, where appropriate, from the date on which the project is equivalent to a decision.
- . This period is **extended** :
 - of one month if the applicant remains in Guadeloupe, French Guiana, Martinique, Réunion, Mayotte, Saint-Barthélemy, in Saint-Martin, Saint-Pierre-et-Miquelon, in French Polynesia, in the Wallis and Futuna Islands, in New York Caledonia and the French Southern and Antarctic Territories ;
 - two months if the applicant remains abroad.

PRESENTATION OF THE ACTION

(art. R. 411-24 to R. 422-30)

- . **The applicant is required to appoint a lawyer** and the appeal is submitted to the competent Court of Appeal **by electronic means**, failing which it will be inadmissible.
- . **The notice of appeal** must contain, on pain of nullity, **the following particulars**:
 1. (a) *If the applicant is a natural person* : surname, first names, profession, domicile, nationality, date and place of birth;
 (b) *If the applicant is a legal person* : its form, name, registered office and the body legally representing it;
 2. Where applicable, the surname, first names and domicile of the person against whom the application is made, or, in the case of a legal person, its name and registered office ;
 3. The unique identification number of the applicant company or any document equivalent to the extract of registration in the Trade and Companies Register for operators located outside France;
 4. The subject matter of the appeal;
 5. The name and address of the holder of the title if the applicant does not have this status;
 6. The appointment of the applicant's lawyer. A **copy of the contested decision** must be attached to the notice of appeal, except in the case of an implied decision rejecting the appeal.
- . **On pain of lapse of the notice of appeal, the applicant has a period of three months from that act to submit his conclusions to the registry. Under the same sanction and within the same period, he must send his conclusions to the INPI (for the attention of the litigation department) by registered letter with acknowledgment of receipt.**

COMPETENT COURTS OF APPEAL

(art. R. 411-19-1 and D 411-19-2)

- . An appeal against a decision relating to a **trade mark, design or geographical indication** must be brought before the court of appeal with territorial jurisdiction, **to be determined** according to the **place where the person lodging the appeal resides**. The table below indicates, for each of the **ten competent courts of appeal**, the departments concerned:

<i>Competent Court of Appeal</i>	<i>Departments concerned</i>
Aix	2A, 2B, 04, 06, 07, 11, 12, 13, 30, 34, 48, 66, 83, 84
Bordeaux	09, 16, 19, 23, 24, 31, 32, 33, 40, 46, 47, 64, 65, 81, 82, 87

Colmar	67,68
Douai	02, 08, 10, 27, 51, 59, 60, 62, 76, 80
Lyon	01, 03, 05, 15, 26, 38,42, 43, 63, 69, 73, 74
Nancy	21, 25, 39, 52, 54, 55, 57, 70, 71, 88, 90
Paris	18, 36, 37, 41, 45, 58, 75, 77, 89, 91, 93, 94, 974, 975, 976, New Caledonia, French Polynesia, Wallis and Futuna, French Southern and Antarctic Lands
Rennes	14, 17, 22, 29, 35, 44, 49, 50, 53, 56, 61, 72, 79, 85, 86
Versailles	28, 78, 92, 95
Fort-de-France	971, 972, 973

. **When the applicant remains abroad**, the Paris Court of Appeal has jurisdiction. An address for service must be made within the jurisdiction of that court.

OPPOSITION, NULLITY AND DEPLETION PORTAL

All correspondence with the Institute relating to the procedure must be sent **exclusively** in electronic form on the INPI website.

1. How do I go to the opposition, nullity and revocation portal?

You must go to the <https://procedures.inpi.fr/> site, where you must log in:

- if you already have an account, by entering your login details (email address and password you have chosen);
- if you do not have an account, by creating an e-Procedures account.

You will then access the e-Procedures portal. Click in the "BRANDS" section.

You then have access to all trademark proceedings in which you have identified yourself as an applicant, party to proceedings or representative.

If you want to view only nullity or revocation proceedings, click on the "*opposition, nullity, revocation*" tab .

2. Attaching oneself to invalidity or revocation proceedings

2.1. You are the owner of the contested trade mark in invalidity or revocation proceedings

To join in, you must go to the trademark portal as indicated in point 1. above, then click on the "REQUEST OR MODIFY ACCESS" tab and choose "*I am the owner of a contested trademark*". You must then fill in the required fields and submit your application for attachment.

At this stage, you can already send a document, even before the validation of your request for attachment by the lawyer.

2.2. You wish to join as a shareholder in invalidity and revocation proceedings

The parties may be represented by an authorised representative.

To register as a representative in a procedure, you must go to the trademark portal as indicated in section 1. above, then click on the tab "REQUEST OR MODIFY ACCESS" and choose "*I am a new representative*". You must then fill in the required fields and submit your application for attachment.

At this stage, you will already be able to transfer a document, even before the validation of your request for attachment by the lawyer.

3. Consult a file or send a document in invalidity or revocation proceedings

On the opposition, nullity and revocation portal, you have access to all the procedures in which you have identified yourself as a party to the proceedings. All of your current cases are located in the "*Folders under review (including international trademarks designating the France)*" trash.

You can find a folder using the "SEARCH" field. You can also filter folders by "PROCEDURE TYPE".

To send the Institute any document relating to the procedure, you must select the procedure concerned and click on the "ADD DOCUMENTS" button. Once the document is uploaded, you must choose a typing for the document, then click on the "VALIDATE" button. The lawyer in charge of the procedure will then be notified of the receipt of a new document.

If you have any questions, please contact Inpi Direct at +33 (0)1 56 65 89 98.

NL 22-0042 / SHF
On 15/03/2023

DECISION

RULING ON AN APPLICATION FOR A DECLARATION OF INVALIDITY

THE DIRECTOR GENERAL OF THE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY,

Having regard to the Madrid Agreement Concerning the International Registration of Marks, as revised on April 14, 1891, the Protocol Relating to that Agreement adopted on June 27, 1989, and the Regulations under April 1, 1996;

Having regard to the Intellectual Property Code in its version resulting from Ordinance No. 2019-1169 of 13 November 2019 and in particular Articles L.411-1, L. 411-4, L. 411-5, L. 711-1 to L.711-3, L. 714-3, L. 716-1, L.716-1-1, L.716-2 to L. 716-2-8, L.716-5, R. 411-17, R.714-1 to R.714-6, R. 716-1 to R.716-13, and R. 718-1 to R. 718-5;

Having regard to the Intellectual Property Code in its version resulting from Law No. 92-597 of 1 July 1992 and in particular Articles L.711-1 to L.711-4, L. 713-2, L.713-3 and L.714-3;

Having regard to the decree of 24 April 2008 amended by the decree of 9 December 2019 relating to the procedural fees collected by the National Institute of Industrial Property;

Having regard to the decree of 4 December 2020 on the distribution of costs incurred during a procedure for opposition to a brand invention or invalidity or revocation of trademark;

Having regard to the amended decision n ° 2020-35 of the Director General of the National Institute of Industrial Property relating to the modalities of the procedure for invalidity or revocation of a trademark.

I.- FACTS AND PROCEDURE

1. On 24 February 2022, the simplified joint-stock company MOBIGAME (the applicant) filed an application for invalidity registered under reference NL 22-0042 against the French part of international registration No 1515050, reproduced below :

EDGE GAMES

This international registration designating the France dated December 26, 2019, of which EDGE GAMES, INC. is the owner (the owner of the contested mark), was published in Gazette 2020/6 of February 20, 2020 and was the subject of a statement of grant of protection published in Gazette 2020/37 of September 24, 2020.

2. The application for a declaration of invalidity was brought against all the goods for which the contested mark is registered, namely :

" Class 09: Computer game programs; computer games; downloadable games from a global computer network; computer games for use on cell phones and mobile phones".

3. The plaintiff invokes a ground relating to the infringement of the well-known mark within the meaning of Article 6bis of the Paris EDGE Convention because of the existence of a likelihood of confusion.
4. A statement of the pleas in law was submitted in support of that application for a declaration of invalidity.
5. The Institute informed the proprietor of the contested mark of the application for a declaration of invalidity and invited him to refer to the electronic file, by simple mail sent to the address indicated when registering the contested international mark.
6. The application for a declaration of invalidity was notified to the proprietor of the contested trade mark at the address indicated at the time of its attachment, by registered letter dated 15 April 2022, received on 20 April 2022. That notification invited him to submit observations in response and to produce any document he considered useful within two months of its receipt.
7. During the investigation phase, the proprietor of the contested mark submitted three sets of observations in response, to which the applicant replied twice within the prescribed period.
8. In accordance with the provisions of Articles R.716-6 and R.716-8 of the Intellectual Property Code, the parties have been informed of the end date of the investigation phase, namely December 21, 2022.

Applicant's claims

9. In its statement of case, the applicant submits that:

- His application is admissible in so far as it is brought before the Institute pursuant to Article L716-2, that it is based on the infringement of a well-known mark within the meaning of Article 6a of the Paris Convention and that it is neither time-barred nor time-barred ;
- The unregistered trademark "EDGE" is known to a large fraction of the relevant public in France to designate video games;
It produces documents for the purpose of justifying the reputation invoked, which will be listed and analysed in point 20;
- There is a likelihood of confusion between the marks at issue 'because of the *visual, phonetic and conceptual similarities between the signs and the identity of the goods concerned*'.

10. In its initial observations, the applicant:

- Disputes the argument of the owner of the challenged trademark that the sign EDGE is not used as a trademark, arguing that copyright protection of the title of a work is not incompatible with trademark protection ;
- Disputes the argument relating to the difference between the signs 'Edge' and 'Edge Extended' on the ground that the term '*Extended*' is *generic and the distinctive character of the sign is based primarily on the term 'EDGE', which is otherwise in a position of attack*' ;
- Responds to the arguments of the proprietor of the contested mark relating to the lack of reputation and produces new documents which will be listed and analysed in paragraph 20;
- Responds to the arguments of the proprietor of the contested mark on the '*alleged prior art of the trade mark 'EDGE GAMES'*'.

11. In his second and final observations, the demandeur reiterates his arguments and completes them by:

- Emphasizing that if the term Edge were to be considered devoid of distinctive character per se, it should be recognized as having a distinctive character acquired through usage;
- Insisting on the absence of a distinctive characteristic of the terms "Extended" and "Demo" ;
- Insisting on the well-known nature of the unregistered mark "EDGE" and producing new documents which will be listed and analysed in point 20;
- Develops its arguments challenging the anteriority of the sign 'Edge Game' of the proprietor of the contested mark and produces documents in that regard.

Claims of the owner of the contested mark

12. In its preliminary observations, the proprietor of the contested mark submits that:

- The signs "Edge" and "Edge Extended" are different so that the elements submitted by the Applicant relating to the sign "EDGE Extended" do not constitute use of the sign "EDGE" ;
- The sign EDGE is not used as a trademark to designate "video games", "*but at most as the title of a work of the mind*";
- The few elements submitted by the applicant "*are clearly insufficient to infer a well-known character of the sign 'EDGE' within the meaning of Article 6bis of the Paris Convention*" on the ground that:
 - The relevant audience is not only composed of "*the specialized public, connoisseur, in search of nostalgia, without leaving the younger generation indifferent*", but "*at least all users of smartphones and mobile devices, regular or occasional consumers of video games on smartphones*";

- The " *information and figures provided by the Applicant do not reflect the alleged notoriety invoked* ";
 - There are inconsistencies between " *revenue and number of downloads* ";
 - The applicant has changed the name of the game several times since 2009;
 - Awards or nominations may not reflect any notoriety among the French public;
 - The applicant does not produce any invoices or accounting documents relating to the sales of the game.
- The EDGE GAMES mark had already been in use in France for several years by the proprietor and his predecessors before the prior art claimed by the applicant, of which the latter was aware.
13. In its second observations, the proprietor of the contested mark reiterates its arguments and responds to the new arguments put forward by the applicant by producing new documents.

In addition, he requests from the Institute "the *payment by MOBIGAME of all the costs of the Account Holder relating to this procedure, in accordance with Article L. 716-1-1 CPI*".

14. In its third and final observations, the proprietor of the contested mark :
- Reiterates its arguments relating to the lack of reputation of the mark invoked and requests the Institute "to *reject the documents and arguments relating to the sales and download figures filed by Mobigame as suspect* ";
 - Reiterates its arguments that "Only the use of the trademark "Edge" by Mobigame must be considered, and not the claimed use of variations of "Edge" ";
 - Maintains that "'EDGE' does not refer to the applicant or its product" on the grounds that 'the trademark 'EDGE', alone or in combination with another word, is used by many companies in the computer and video game industry';
 - Insists on "the *relevance of the UKIPO's decision and the registrations of EDGE Games' trademark in the countries of the European Union*" which "concluded that *EDGE Games, Inc. has priority rights and used the trademarks 'EDGE' and 'EDGE GAMES' for computer games over the period from 1984 to 2019*";
 - Argues that "the *YouTube data [Exhibit 14 applicant] is deliberately misleading and should be ignored*" on the ground that "none of the videos relate to a game simply referred to as 'Edge' and thus none of the data relates specifically to any claimed use of the 'Edge' mark as such" and that "YouTube is accessible to viewers worldwide, and the fact of presenting an image of the website in French does not mean that the viewer data relates to views actually attached to French consumers";
 - Emphasizes the seniority of EDGE Games, Inc. on the two signs "EDGE" and "EDGE GAMES" on the ground:
 - That it is recognised on the territory of the European Union by a decision of the UKIPO before Brexit;
 - That the applicant's statements about the owner of the contested trademark and its CEO are false;
 - That EDGE Games Inc.'s use of the EDGE and EDGE GAMES marks as "trademarks" began in 1984 and ran until 2019.

Finally, in his last observations, the proprietor of the contested mark produces new parts.

II.- DECISION

A- The applicable law

15. In accordance with Article L.714-3 of the Intellectual Property Code, in the version applicable on the day of filing, is declared null and void " *the registration of a trademark that does not comply with the provisions of Articles L. 711-1 to L. 711-4* ".
16. In that regard, Article L. 711-4 of that code provides, inter alia, that 'a sign which may *infringe earlier rights, and in particular: (a) An earlier trade mark registered or well known within the meaning of Article 6a of the Paris Convention for the Protection of Industrial Property*' may not be adopted as a trade mark".

Article 6a (1) of the Paris Union Convention provides that ' (1) *The countries of the Union undertake, either ex officio if the laws of the country so permit, or at the request of the person concerned, to refuse or invalidate registration and to prohibit the use of a trade mark or trade mark which constitutes reproduction, the imitation or translation, liable to create confusion, of a mark which the competent authority of the country of registration or use considers to be well known there as already being the mark of a person entitled to benefit from this Convention and used in respect of identical or similar goods. The same shall apply where the essential part of the mark constitutes the reproduction of such a well-known mark or an imitation liable to create confusion with it* '.

In addition, pursuant to Article 4 I. of the amended decision No. 2020-35 of the Director General of the National Institute of Industrial Property relating to the modalities of the procedure for the invalidity or revocation of a trademark, the applicant provides:

' (c) *if the application for a declaration of invalidity is based on an infringement of a mark which is well known within the meaning of Article 6a of the Paris Convention for the Protection of Industrial Property :*

(...) documents capable of establishing its existence and reputation for the goods and services relied on in support of the application for finality '.

17. The present application for a declaration of invalidity must be assessed in the light of those provisions.

B- Substance

18. In the present case, the invalidity claim on that ground is brought against the following departments of the contested mark : '*Computer game programs; computer games; downloadable games from a global computer network; computer games for use on cell phones and mobile phones*".
19. With regard to those goods, the applicant alleges an infringement of his earlier unregistered mark, relating to the word sign 'EDGE', in that it is well known for video games.
20. In that regard, it produces the following documents :

T his first observations in response:

- **Exhibit 1** : Copy of the contested mark
- **Exhibit 2**: An excerpt from the afjv.com site presenting Mobigame as follows " Mobigame *is an independent studio that develops and publishes Mobigame video gamesfor digital platforms. Mobigame has won many video awards IGF, IMGA, Milthon, etc. thanks to its innovative games: Edge, Crossprix CrossFingers, Truckers Delight, and lately Perfect Cell* »

An extract from the website includes a list of games proposed by the applicant.
The applicant's Facebook, Tweeter and You Tube pages.

- **Exhibit 3:** An excerpt from a site with the words "*International Mobil Gaming Awards Global*", "*Winners and nominees*", "*Excellence in gameplay*" EDGE and the date 2008; an excerpt from the gamesindustry.biz site stating that the mobile version of the mobile game Edge "*winner of this year's International Mobile Gaming Awards Excellence in Gameplay*" dated February 18, 2009; An excerpt from the wikipedia site on "*the milthons of video games*"; An excerpt from a website with the indication "*Independent Games Festival*", relating to the game Edge and including the indication "*Entering 2009*".
- **Exhibit 4:** A "witness statement" by Mr. David Papazian, Managing Director of Mobigame including the statement "*Unregistered sign has been used since the launch of the EDGE game in 2008* ", a table on the "*Sales figures of EDGE games*" and on the "*Downloads of the EDGE game*" and in annexes:
 - DP1: screenshots of the website www.mobigame.net via the Wayback machine tool and covering the years 2008 to 2019.
 - DP2: screenshots of the website www.itune.apple.com via the Wayback machine tool and covering the years 2010 to 2016.
 - DP3, DP4 and DP5: Screenshots from AppFigures – figures on the sale, download of EDGE games in France between 2009 and 2019 as well as user reviews.
 - DP6: a screenshot of the website www.imgawards.com via the Wayback machine tool
 - DP7: a screenshot of the Toucharcade website with the date 2009.
- **Exhibit 5:** Presentation of the EDGE game consisting of an excerpt from the French droid.com site on the game Edge of February 2, 2012; an excerpt from the www.guim.com site about the game Edge; an excerpt from Google Play about the game Edge with comments between 2014 and 2018;
- **Exhibit 6:** Presentation of the game EDGE Extended consistant in an excerpt from the formidapps.com site on the game Edge Extended; an excerpt from the blogosquare.com site relating to the game Edge Extended dated February 2, 2013; an excerpt from Google Play relating to the game Edge Extended with entries between 2015and 2021;
- **Exhibit 7:** Google results on a search for the keywords "EDGE MOBIGAME", "EDGE GAME" and "EDGE GAMES"; - **Exhibit 8:** Excerpt from EdgeGames.com's website.

In its second comments in response:

- **Case documents n°9 :** figures relating to downloads of the game "EDGE" and its variations and the revenue generated between July 2008 and July 2022;
- **Exhibit 10 :** Download figures for Mobigame's main games
- **Exhibit 11 :** Apple TV ranking "EDGE" as the 18th most downloaded paid game in France, July 25, 2022
- **Exhibit 12 :** Excerpt from <https://apps.apple.com> site about comments for the game "EDGE" via the App Store and including comments between 2015 and 2021

In his third and final comments in response:

- **Exhibit 13:** Excerpt from the www.jeuxvideo.com site for a search for the use of the term "Extended" in video games
- **Exhibit 14:** Screenshot of Mobigame's YouTube channel of videos between 10 and 13 years old
- **Exhibit 15 :** S-is-theyregenerate-10-years-ago-this-month <https://www.gamesindustry.biz/the-thing-about-troll> website article dated October 1, 2020
- **Exhibit 16 :** Decision of the United States Districts Court - Edge Games, Inc. v. Electronic Arts, Inc., Decision No. C10-02614 WHA, October 1, 2010
- **Exhibit 17:** <https://www.escapistmagazine.com/mobigame-langdell-legalbattle-just-getting-started/> dated October 7, 2010

- **Exhibit 18** : Site article <https://www.gamesindustry.biz/court-rules-in-favour-of-eaover-trolling-langdell> dated October 5, 2010
- **Exhibit 19** : Site article <https://kotaku.com/after-four-years-an-industry-scourgeloses-his-edge-476590339> dated April 20, 2013
- **Exhibit 20**: Decision of the Royal Courts of Justice Future Publishing Limited v. The Edge Interactive Media Inc., Edge Games Inc. and Timothy Langdell, Decision No. 2011 EWHC 1489 dated June 13, 2011
- **Exhibit 21** : Site article <https://www.rockpapershotgun.com/tim-langdell-loses-infuture-edge-trial> dated June 16, 2011
- **Exhibit 22** : Site article <https://www.escapistmagazine.com/u-k-judge-crushes-timlangdell/> dated June 17, 2011
- **Exhibit 23** : Data relating to the registration and use of the domain name <mythora.com>

1. The existence, scope and reputation of the earlier mark relied on

21. It is common ground that a mark is regarded as well known when it is known to a large proportion of the French public concerned, throughout the territory or a substantial part of it.

The criteria to be taken into consideration include its age, the extent and intensity of its use or the importance of the advertising support it receives or the market share held by the applicant.

(a) As a preliminary point, on the request to exclude certain documents submitted by the applicant

22. In his last observations, the proprietor of the contested mark asks the Institute to reject the documents and arguments relating to the sales and download figures filed by Mobigame as suspicious on the ground that "it is very likely that the Applicant has added up all the sales figures of other products in the report. which they called 'Edge', which makes it impossible to accurately assess their use of the 'Edge' trademark alone in French commerce."
23. However, apart from the fact that the 'suspect' nature of the documents produced is not corroborated by concrete evidence and is based on mere assumptions, these mere assertions can in no way in themselves make it possible to exclude the presumed documents from the proceedings, but require an analysis of the merits.
24. Thus, the applicant's request for the inadmissibility of certain documents is rejected.

(b) Use as a trade mark

25. In its observations in reply, the proprietor of the contested mark submits that the sign EDGE is not used as a trade mark to designate 'video games', *'but at most as the title of a work of the mind'*.

It observes in that regard that *'in the present case, only the name of the publisher and developer of the video game 'EDGE', namely 'MOBIGAME', can act as a guarantee of origin of the video games at issue (MOBIGAME Exhibits Nos 2, 3, 4, 5, 6 and 7), the sign relied on as 'EDGE' merely designating the multimedia work that is the mobile game concerned and giving no information to the consumer with regard to its commercial origin'*. It concludes that *" the sign 'EDGE' does not have an identifying function and does not act as a trade sign indicating the commercial origin of goods"*.

26. The plaintiff disputes these arguments, arguing that *'although the sign 'EDGE' does indeed designate the multimedia work that is the mobile video game concerned, it has been largely associated with its developer and publisher, Mobigame, thus making it possible to fulfil the criterion of distinctiveness imposed by the Intellectual Property Code and to distinguish the applicant's products from those of other natural or legal persons'*.
27. In that regard, it should be noted that it is apparent from Decision T-435/05 of the General Court of the EU of 30 June 2009, relied on by the parties, that *'the same sign may be protected as a work of the original mind by copyright and as an indication of commercial origin by trademark law'* but also that the title of a work *'cannot benefit automatically from from recognized protection to indicators of commercial origin, because only signs that develop the characteristic functions of trademarks can benefit from this protection'*.
28. It follows that although the title of an intellectual work may be protected under both copyright and trademark law, this dual protection is not automatic and must be demonstrated.
29. In the present case, it is therefore necessary to determine whether the term EDGE, relied on by the applicant as having a reputation, is used as a trade mark.
30. In that regard, it is apparent from the documents produced that the applicant develops and publishes video games, including the game entitled 'Edge', 'Edge Extended' and 'Edge Demo'.

However, it must be noted that that video game is clearly identified by its title – both on download platforms and in specialised magazines and sites – which, independently of its potential protection by copyright, makes it possible to identify the commercial origin of the product for which the reputation of the earlier trade mark is claimed.

In that regard, although the name MOBIGAME is capable of identifying the publisher/developer of the video game, the term EDGE, for its part, allows consumers of the goods in question to distinguish the EDGE video game from those which have another origin.

31. **Thus, the term EDGE is indeed used as a trade mark contrary to what the owner of the contested mark maintains.**

c) Reputation for the EDGE trade mark

About the relevant audience

32. The applicant considers that the products are aimed at ***'a specialised public, connoisseur, in search of nostalgia, without leaving the younger generation indifferent'***.
33. The owner of the contested mark refers to a relevant public consisting of *"at least all users of smartphones and mobile devices, regular or occasional consumers of video games on smartphones"*.
34. It is apparent from the documents produced that the goods claimed to be famous consist of video games downloadable on online platforms such as 'Windows Phone Store', 'Google Play' or 'App Store' and on online download sites and intended to be played on mobile devices such as smartphones and tablets.
35. Thus, the relevant audience is the general French public casual or regular video game players, accessible on digital platforms.

Analysis of notoriety

36. The applicant shall produce the documents referred to in point 20 to which reference should be made.
37. It should be noted in the first place that the documents produced must relate to the period prior to the registration of the contested mark, that is to say, before 26 December 2019, so that the information contained in Exhibit No 11, dated 25 July 2022, cannot be taken into account in the assessment of the reputation of the sign EDGE.
38. In addition, it appears from all the documents produced that most of the documents relate only to the description of the game (Exhibits n°2, 5 and 6), the prizes awarded in the years 2008 and 2009 (Exhibits n°2 and 3), or Youtube videos dated more than 10 years and whose number of views does not make it possible to determine the relevant territory, **so that those factors are not sufficient to characterise the reputation of the earlier mark.**
39. In addition, the applicant invokes the following figures from the certificate produced by the Managing Director of Mobigame:

YEAR	TERRITORY	SALES IN DOLLARS
		(US\$)
2009	France	36,339.53
2010	France	16,035.35
2011	France	15,273.38
2012	France	12,027.64
2013	France	6,768.56
2014	France	4,151.92
2015	France	1,948.71
2016	France	947.89
2017	France	589.86
2018	France	555.82
2019	France	398.89

YEAR	TERRITORY	TOTAL NUMBER OF DOWNLOADS
2009	France	131,832
2010	France	15,141
2011	France	128,558
2012	France	78,972
2013	France	169,815
2014	France	27,141
2015	France	28,895
2016	France	13,683
2017	France	8,578
2018	France	6,872
2019	France	3,098
Total (2009 – December 31, 2019)	France	612,585

In support of this certificate, he produces a document entitled "Appfigures" from which the following figures emerge:



40. However, while it appears from these documents that the EDGE game was somewhat successful when it was released in 2009, the number of downloads and turnover have steadily declined since that date. In this regard, it should be noted that the five years preceding the registration of the contested mark, it generated between USD 1 948.71 in 2015 and USD 398.89 in 2019 for the French trademark.
41. Similarly, it is apparent from the information contained in Exhibit 10 (consisting of figures relating to downloads of Mobigame's main games) that the EDGE game and its variations **represent only 0.9% of the projects offered by the applicant himself**, so that taken from the overall market for video games intended for the relevant public previously defined, The number of downloads cannot make it possible to characterise intensive use of the earlier mark, despite the duration of its exploitation which began in 2008 and 2009.
42. **Thus, it must be held that the reputation of the EDGE sign has not been demonstrated by the applicant.**

2. The existence of a likelihood of confusion

43. In view of the lack of demonstration of the reputation of the earlier mark within the meaning of Article 6a of the Paris Convention, there is no need to rule on the existence of a likelihood of confusion.
44. **Consequently, the ground for invalidity of the contested mark based on the existence of a likelihood of confusion with the well-known mark EDGE is rejected.**

C- Apportionment of costs

45. Article L.716-1-1 of the Intellectual Property Code provides that: " At the request of the *winning party*, the *Director General of the National Institute of Industrial Property* shall charge the *losing party* all or part of the costs incurred by the other party within the limit of a scale fixed by order of the Minister responsible for industrial property".

46. The decree of 4 December 2020, provides in its article 2.II. that "*Within the meaning of Article L. 716-1-1, the following shall be considered as a winning party: ...*
b) *The proprietor of the contested trade mark whose registration has not been altered by the decision of invalidity or revocation*" (...)
c) *the applicant when his application is granted in respect of all the goods or services initially referred to in his application for invalidity or revocation*".
Finally, it specifies in Article 2.III that "*For the application of Article L. 716-1-1, the maximum amounts of the costs charged to the parties shall be determined in accordance with the schedule in the annex*".
47. The proprietor of the contested trade mark requested '*MOBIGAME charging all the costs of the proprietor relating to the present proceedings, in accordance with Article L. 716-1-1 CPI*'.
48. He must be regarded as a successful party if the application for a declaration of invalidity is rejected in respect of all the goods and services challenged by the applicant, so that the registration of the mark in question is not altered.
49. In addition, the investigation procedure gave rise to exchanges between the parties. The proprietor of the contested mark, represented by a representative, submitted three sets of observations in response to the applicant's application for a declaration of invalidity, which falls within the category of small and medium-sized enterprises.
50. In the light of those considerations specific to the present proceedings, the sum of EUR 550 should be charged to the applicant (losing party to the present proceedings), corresponding to part of the costs incurred by the proprietor of the contested trade mark in respect of the written part (EUR 300) and in respect of representation costs (EUR 250).

FOR THESE REASONS

DECIDES

Article 1: The application for nullity NL22-0042 is rejected.

Article 2 : The sum of 550 euros is charged to the simplified joint stock company MOBIGAME for the costs incurred.



Stéphane HIDALGO FRIAZ
Jurist



Christine LESAUVAGE Head
of Cancellation Unit