

IN THE HIGH COURT OF REPUBLIC OF DELURIA

DOLPHIN GAMING ADVENTURES, INC, (*The Claimant*)

v.

DOL-FIN EXCITEMENT, LLC and
DOLLY PAFFIN (*The Defendants*)

IP Lake, J.

The Claimant DOLPHIN GAMING ADVENTURES, Inc., seeks a preliminary injunction restraining the Defendants Dol-Fin Excitement, LLC, and Dolly Paffin individually or together from using, or prosecuting the registration of, the trademark “Dol-Fin Adventures” and Dol-Fin Adventures with DFE logo for a wide variety of goods and services, pending the outcome of these proceedings. For the reasons set forth hereafter, the Court grants the preliminary injunction.

FINDINGS OF FACT

1. The Claimant DOLPHIN GAMING ADVENTURES, Inc. (“DOLGA”) is a Republic of Deluria corporation originally organized as a partnership in 1972 but converted to a limited liability corporation in 1987. Its original purpose was to own and operate The Dolphins Gaming Adventures (“The Dolphins”) on Fifth Avenue in York. Since its inception, The Dolphins has been York’s foremost gaming equipment retailer, selling an extensive selection of gaming controllers, gaming mouse, headsets and related paraphernalia. Located across Pacific Street, The Dolphins has served the gaming community, and grown with it, since its opening. Since 1972, its frontage has expanded from 100 feet and now occupies the entire block from Creed Street to Linking Lane.
2. The second Defendant, Dolly Paffin, is a citizen of the Republic of Deluria and maintains a residence in York, but spends her summers at a gaming institute in the Pine Street with several other prominent gaming stars from the Republic of Deluria. Dolly is the offspring of

Ashley Robin, a famous model, and James Bernard Paffin, a famous gaming champion. Ms. Paffin is a celebrity in her own right. She is a world-class gamer, popular, possesses an exuberant personality, and is known by many as a “Geek,” slang for a person who is an enthusiast and expert in a particular field.

3. The first Defendant, Dol-Fin Excitement, LLC, is a limited liability company organized under the laws of the Republic of Deluria by Ms. Paffin and her family, immediately after the close of the 2010 Warden Gaming Championship, for the purpose of commercializing and exploiting the name, image, and reputation of Ms. Paffin. Ms. Paffin is the majority owner of the LLC; her parents and business manager hold minority stakes in the company.

THE DOLPHINS GAMING SHOP

4. When it opened in a single storefront in 1972, The Dolphins was owned and operated by 19-year-old Daniel Gordon and 24-year-old Fiona Shivers, both avid gamers who foresaw the soon to come boom in the games industry, pooled their savings, earnings, proceeds from pawning certain possessions, and what credit they could get, to bet their foreseeable futures on their shared gaming vision, which turned out to be prescient. Since the store has opened, both its space and inventory have expanded as fast as finances permitted, driven by the exponential growth of gaming.
5. Mr. Gordon and Ms. Shivers also partnered in raising a daughter, Kate Shivers-Gorden, who grew up a gamer, worked in the gaming arena, and acquired an education culminating last year in an MBA from the York College of Technology.
6. While historically DOLGA sold gaming equipment and accessories of the major gaming equipment manufacturers, it has in recent years (after three years of pestering by Kate) begun to contemplate selling its own branded line of gaming controllers, gaming mouse, headsets and paraphernalia. DOLGA engaged the local gaming genius and recent graduate of the York College of Technology to help them design a new gaming controller, and ultimately decided that the name of its new brand would be DOLPHIN BY KATE. Kate and her parents spent months debating the colour scheme and design graphics to be used for the controller, with Kate favouring red, orange and blue.

7. The design featured bold and sharp moves symbolized by red and orange colors, while a blue tone represented focus and clarity, with the mark "DOLPHIN BY KATE" painted on the gaming controller. However, her parents preferred a design showcasing a different and more muted colour combination. Finally, in the hopes of persuading her parents that her proposed graphics were more appealing, Kate had two of the demo gaming controllers painted with the competing designs and placed the graphics on "Choosethedesign" Internet bulletin board seeking input from participants on which design they liked better. After a week of having been posted on the bulletin board, over 5,000 people voted on their favourite design—with the clear winner being Kate's stylised design, with 3,525 votes. With the confidence of the popular vote on which graphics and colour scheme to use, DOLGA went ahead and commissioned the manufacture of its first batch of 1,000 gaming controllers with Kate's stylised colour design [see Exhibit A].

8. DOLGA is the owner of the following Republic of Deluria Trademark Registrations, all of which are valid and subsisting, according to official records:
 - a. Mark: Dolphin Gaming Adventures
Services: Retail store services in the field of gaming equipment, in International Class 35.
Disclaimer of "Gaming"
Application Date: June 1, 1991
Claimed Date of First Use: January 31, 1972
Reg. Date: July 5, 1993
Renewed: June 3, 2003
Reg. No: 5000001

 - b. Mark: DOLPHIN BY KATE
Goods: Games, gaming controllers in International Class 28. Application Date: September 19, 2011
Claimed Date of First Use: Proposed to be used
Reg. Date: October 15, 2012
Reg. No: 5802644

DOLLY PAFFIN and DOL-FIN EXCITEMENT

9. Ms. Paffin was raised in the spotlight—both her mother and father have been famous public and tabloid figures since before she was born. Dolly took to gaming at age 5. She is an enormously popular celebrity in her own right, largely because she is articulate, and always seems to be happy and carefree. Since she was a child touting a breakfast cereal that tasted great and was less filling, Dolly has been in the public eye. She managed to get through her teenage years without any known incidents of alcohol abuse, drug use, shoplifting, or romance more lurid than holding hands with boys, all while making a more than small fortune endorsing a wide variety of products and services, many intended for consumers far older than she. Perhaps the most notable was the ready-to-eat breakfast bar intended for senior citizens, which she endorsed with the youthfully sincere admonition, “It is never too late to start eating healthy!”.
10. Ms. Paffin is also an accomplished racer. In her early teens, she appeared in racing commercials, showcasing her fearless skills behind the wheel of motor racing cars, always pushing the limits and staying ahead of the curve. Many advertising professionals attributed the success of her commercials to the fact that besides being great at Gaming, Dolly’s love for the racing is infectious. At the prestigious Warden Gaming Championship in 2010, she emerged victorious, claiming the coveted gold medal as the top gamer. Her fearless and daring approach to the game earned her the top spot, showcasing her exceptional skills and unyielding competitive spirit.
11. On April 4, 2010, Ms. Paffin and her management team organized Dol-Fin Excitement (“DFE”) to “commercialize the Dolly Paffin name and reputation.” Specific plans to exploit Ms. Paffin’s celebrity, if there were any such plans, remain a closely guarded secret.
12. The following dates are important. The Court has carefully reviewed all the evidence, and concludes that the following chronology is supported by the overwhelming weight of evidence:

DFE

- April 12, 2010: DFE filed two trademark applications to register the words “Dol-Fin Adventures” and a logo incorporating the letters DFE along with “Dol-Fin Adventures” as shown on DFE’s Gaming Controller [see Exhibit B] for a wide range of goods in Classes 9, 16, 25, 28, and 35. As of the application date, DFE’s

specifications in several classes included – eyewear, product development and design, product sourcing, and product marketing/business plans, games, posters and sweaters and shirts, and gaming controllers for game consoles, and retail shops for gaming equipment. DFE would later amend its specifications during prosecution of the applications. During the year following the application date, there were one-page “study papers” listing the pros and cons of launching certain products. Listed as strongly desirable products to be launched as soon as possible were magazines. Headwear, eyewear, and books were listed as “optional.” The other goods were not mentioned.

- The “Dol-Fin Adventures” word mark was registered on September 20, 2012, for eyewear, gaming software in Class 9; posters and magazines in Class 16; and games, controllers for game consoles in Class 28. The remaining goods/services were divided into separate applications for its logo and word mark and are still pending.
- The affidavits filed by DFE in this application shows evidence of its use of the “Dol-Fin Adventures” word mark and Dol-Fin Adventures along with DFE logo mark since April 10, 2010, for the following goods:
 - i. eyewear, gaming software in Class 9;
 - ii. posters and magazines in Class 16; and
 - iii. clothing, sweaters and shirts in Class 25.

DOLGA

- September 13, 2011: Ms. Kate Shivers-Gordon announced, via press release, that starting the following day, she would devote all her time and energies to developing a new, cutting-edge DOLPHIN BY KATE gaming controller. Her goal was to achieve the world’s most responsive gaming controller for gaming championships.
- December 12, 2011: Ms. Shivers-Gordon completed consultations with game builders, gamers, and commenced testing on several prototype gaming controllers she had designed and built.
- February 13, 2012: Ms. Shivers-Gordon fixed the final design for the first model DOLPHIN BY KATE gaming controller. The first prototype gaming controller were built by April 1, 2012. On that day, DOLGA began advertising and soliciting orders from gaming companies for delivery commencing April 2, 2012. The gaming controllers were sold solely through DOLGA and its website and it is planned that

selected other gaming arenas may sell DOLPHIN BY KATE in 2014. The retail price for a DOLPHIN BY KATE gaming controllers, custom-designed but mass-produced, is \$2,150, and has shattered all previous price records for gaming controllers.

- April 16, 2012: The DOLPHIN BY KATE gaming controller was launched at a block party outside the Dolphins store at Fifth Avenue in York. Kate herself arrived during the height of festivities. The event attracted national media coverage and a large number of gaming celebrities, including an uninvited Dolly Paffin.
- April 20, 2012: Dolly Paffin, holding torch aloft, led a procession of gamers to the Geek Gaming Terrace commemorating the launch of "Dol-Fin Adventures" gaming controller. The gaming controller had a blue and red colour scheme which made the gaming controller visually very attractive. The controller's bold blue and red hues created a captivating aesthetic, adding to its appeal. The event also attracted local celebrities and national media attention. Kate Shivers-Gordon was invited, but did not attend.
- May 3, 2012: The May issue of RaceEra magazine featured a ten-page photo gallery of the two events under the title "Kate & Dolly Team Launch Their Line of Personalized Gaming Controllers." Three issues later, small corrections of the words "Team" to "Teams" and "Line" to "Lines" was printed, along with certain other corrections to articles in other issues, beneath the magazine's masthead on the page behind the contents page.
- May 15, 2012: "Dol-Fin Adventures" Gaming Controllers began shipping to gaming stores.
- May 31, 2012: DOLGA filed a writ of summons against Dolly Paffin and Dol-Fin Excitement LLC, and applied for a preliminary injunction to be issued against them forbidding the sale or offering for sale of "Dol-Fin Adventures/ Dol-Fin Adventures with DFE logo " Gaming Controllers in commerce. This is the decision on the preliminary injunction.

13. Gaming is often deemed as a fun and millennial activity, yet it first emerged as early as the 1960s. What began as simple games like noughts and crosses or tic-tac-toe has evolved dramatically, leading to the sophisticated gaming equipment, diverse platforms, and immersive experiences we see today.

14. Given the multiple ways gaming can be conducted - be it physically or virtually - it is interesting that people, young and old, are captivated with online gaming. What is truly captivating about gaming is the interactive and immersive experience it offers, especially through the use of gaming controllers that amplify the passion and excitement of gamers. Whether playing action, sports, or other genres, these tools heighten the engagement and enjoyment across the gaming spectrum.
15. The primary piece of equipment for gaming is indeed the gaming controllers that are widely used all over the world.
16. Whilst there are other modes of gaming which do not require gaming controllers namely computer-based gaming and others, it is worthwhile that statistically, one uses gaming controllers frequently in enjoying their gaming experience even if the games played are computer-based games. This shows that gaming controllers function as a catalyst that creates a more engaging gaming experience and session for the users.
17. Gaming controllers are sold primarily through gaming-oriented stores and are marketed predominantly in gaming media (magazines, newsletters, and TV). They are also sold online or on e-commerce platforms which are easy to find, making them accessible for gamers to discover and purchase them.
18. As far as can be discovered, Kate's name had never before appeared in conjunction with Dolly's. In the month following the launches of DOLPHIN BY KATE gaming controllers and "Dol-Fin Adventures" gaming controllers, it is documented that both names appeared in the same newspaper articles, magazine stories, and social media video segments at least two hundred and nineteen times.
19. Ms. Paffin deposed on affidavit that when she decided to apply to register "Dol-Fin Adventures" for gaming controllers, she was aware of the DOLPHIN gaming shop, having met them socially from time to time. However, she was not sure if she knew at the time that Kate was connected to DOLPHIN. She claimed that the whole idea behind the "Dol-Fin Adventures/ Dol-Fin Adventure with DFE logo" mark was to promote her name and enhance her reputation. She acknowledged that DOLPHIN had done a fine job promoting The DOLPHIN BY KATE brand, and that Kate's name seemed to have struck a responsive chord in the gaming community—something Ms. Paffin admitted she would be able to

achieve in the gaming world. She stated that she only knew more about DOLPHIN and the gaming world after being sued by them.

20. In the latter part of 2012 , there were reports—perhaps no more than rumors—that the Consumer Watchdog Commission had product safety concerns regarding the "Dol-Fin Adventures" gaming controllers. Whatever issues there may have been were quickly resolved, but by early June, DOLGA reportedly noticed an unusually large number of incidents of customers for DOLPHIN BY Kate gaming controllers questioning the safety of the controller due to claims of Carpal Tunnel Syndrome.

THE COURT'S FINDINGS

21. Section 100 of the Republic of Deluria Trade Marks Act (DTMA) states as follows (insofar as it is relevant to this claim):

(2) A person infringes a registered trade mark if he or she uses in the course of trade a sign where because

(a) the sign is identical with the trademark and is used in relation to goods or services similar to those for which the trademark is registered; or

(b) the sign is similar to the trademark and is used in relation to goods or services identical with or similar to those for which the trademark is registered,

(c) the sign is identical to the trademark and is used in relation to goods and services identical with those for which the trademark is registered,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trademark.

(3) For the purposes of this section, a person uses a sign if, in particular, he or she—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;

(c) imports or exports goods under the sign; or

(d) uses the sign on business papers or in advertising.

22. Section 101 of the DTMA states as follows:

A registered trademark is not infringed by the use in the course of trade of an earlier right.

For this purpose, an “earlier right” means a registered or unregistered trademark or other sign continuously used in relation to goods or services by a person, or its predecessor in title, from a date prior to whichever is the earlier of—

(a) the use of the first-mentioned trademark in relation to those goods or services by the proprietor, or its predecessor in title; or

(b) the registration of the first-mentioned trademark with respect to those goods or services in the name of the proprietor, or its predecessor in title.

23. When evaluating whether there is a likelihood of confusion on the part of the public for the purposes of the assessment under Section 100(2), a court must take into account all the circumstances of the case. In this case, the Court considers that the following factors are particularly relevant:

- (i) The Claimant’s marks are “Dolphin Gaming Adventures” and “DOLPHIN BY KATE”.
- (ii) The Defendant’s marks are “Dol-Fin Adventures” and Dol-Fin Adventures with DFE logo.
- (iii) The mark of the Defendants that the Claimant challenges is “Dol-Fin Adventures” which is confusingly similar to “DOLPHIN BY KATE” and “Dolphin Gaming Adventures”. “DOL-FIN” is phonetically indistinguishable from “DOLPHIN”. The omission of the word “Gaming” from the Defendant’s mark does not mitigate the likelihood of confusion; in fact, it exacerbates the potential harm by broadening the scope of similarity. While “DOLPHIN BY KATE” and “Dol-Fin Adventures” may appear slightly less confusing, the difference is insufficient to avoid confusion. It could still mislead consumers into thinking “Dol-Fin Adventures” is an extension of Kate’s gaming controller brand, further increasing the likelihood of confusion.
- (iv) The products involved under both the marks are identical i.e. gaming controllers.
- (v) There is persuasive evidence of actual confusion. RaceEra, the foremost magazine in its field, obviously believed that Kate’s and Dolly’s enterprises were connected, and so informed its 14 million readers and online followers.

24. The Court also finds that, despite her protestations, Dolly intended to piggyback on the success of the Claimant's "DOLPHIN BY KATE" mark. Indeed, she has admitted to intending to imitate "DOLPHIN BY KATE" mark's success.

25. The Court holds that "Dol-Fin Adventures" when used for gaming controllers is likely to cause confusion with "DOLPHIN BY KATE" for gaming controllers and "Dolphin Gaming Adventures".

26. Because there is a likelihood of confusion, priority thus becomes an issue. In such situations, the prior mark prevails. There is no doubt that "Dolphin Gaming Adventures" for retail store services in the field of gaming equipment predates "Dol-Fin Adventures" for gaming controllers. The Claimant also rests its case on "DOLPHIN BY KATE" mark, arguing that it is the conjunction of: (i) BLUE and RED colours; (ii) phonetically equivalent DOL-FIN in place of DOLPHIN; and (iii) addition of ADVENTURES in place of KATE suggests another one of KATE's "adventurous" games and gaming controllers. This is what makes the marks so similar as to be likely to confuse.

27. Section 72 of the DTMA states as follows:

The registration of a trademark for goods and/or services with respect to which the trademark is registered shall take effect from (and including) the filing date with respect to the application for registration, save that where a right of priority for the registration of the trademark is claimed by the applicant, the registration shall be deemed to take effect from (and including) the claimed priority filing date.

28. The filing date for DOLPHIN BY KATE is September 19, 2011. The filing date for "Dol-Fin Adventures" is April 12, 2010. Notwithstanding Dolly's apparent April 12, 2010 prior date, because the Court finds that DOLGA began to use its DOLPHIN GAMING ADVENTURES mark well before that date, and because the Court finds that the goods (namely gaming controllers) and services are identical, DOLGA has established that it has an earlier right pursuant to the above applicable provisions of the DTMA.

29. DOLGA faces immediate reputational harm as Dolly's persona becomes associated with

“DOLPHIN BY KATE”, whose reputation will then no longer be entirely within DOLGA’s own control. In short, the Claimant is losing control of its reputation, and the only way that can be corrected pending fuller trial on the merits is to enjoin further use of “Dol-Fin Adventures” for gaming controllers or related activities.

30. By reason of the aforesaid circumstances, this Court hereby orders that the Defendants cease all use of “DOL-FIN ADVENTURES/ DOL-FIN ADVENTURES with DFE logo” either by itself or in conjunction with other wording (specifically “Dolly Paffin,” or any confusingly similar designation) as a trademark, brand name, or any other designation for any article for, or connected with, any gaming equipment, including gaming controllers, or games, or any services related thereto.

Exhibit A: Dolphin by Kate

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Exhibit B: DOL-FIN ADVENTURES

