



May 24, 2016

Julio Franco

Re: Infringement of SET® trademark and copyrights

Dear Mr. Franco:

I am counsel for Set Enterprises, Inc. ("Set Enterprises") and I am writing to request your assistance in addressing a matter related to your use of copyrighted material for which Set Enterprises is the exclusive license holder.

Marsha Falco is the creator of the award-winning SET game. Cannei, LLC owns the copyright rights in the SET game and has registered the game, cards, box and instructions with the United States Copyright Office, Reg. Nos. TX 2,473,817, TX 3,203,643, TX 8,049,805, TX 3,642,521, TX 3,203,643, VA 1,977,433. In addition, SET is a registered trademark for "downloadable electronic games via wireless devices, electronic game software for cellular telephones; downloadable game software for handheld devices" and "providing information in the field of games via global information networks and providing entertainment services, namely, online computer games." U.S. Reg. Nos. 3,739,955 and 2,203,529. Set Enterprises holds an exclusive license to use and reproduce the copyrighted material and trademark. Set Enterprises has sold and licensed the SET game for sale in the United States and internationally since 1990. The SET game is available both as a traditional card game and as an electronic game. Through its extensive use and promotion of its SET goods and services, Set Enterprises has developed extremely valuable goodwill and an outstanding reputation in its game, design, name and mark and the public has come to recognize and associate the SET game design and mark exclusively with Set Enterprises.

Your game, Slug Set, on the website <http://slugset.pythonanywhere.com/>, and your app located on the iTunes Appstore at <https://itunes.apple.com/us/app/slug-set/id1097010696?mt=8>, (see attached screenshots), infringes the SET copyrights and trademarks. Copyright protection is available for original textual, pictorial, graphic, or sculptural expression contained in games. The law is clear that graphical expressive elements such as the color and style of game pieces, game boards, and game playfields are protectable.¹ Expressive elements related to the game's function or play are copyrightable

¹ *Tetris Holding, LLC v. Xio Interactive, Inc.*, 863 F. Supp. 2d 394, 404 (D.N.J. 2012); see also *Atari Games Corp. v. Oman*, 979 F.2d 242, 245 (D.C. Cir. 1992) (Ginsburg, J.) ("The hallmark of a video game is the expression found in 'the entire effect of the game as it appears and sounds,' its 'sequence of images.'"); *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 617 (7th Cir. 1982) (finding copyright protection extends "to at least a limited extent the particular form in which [a game] is expressed (shapes, sizes, colors, sequences, arrangements, and sounds)").

so long as that expression is capable of being separated from the game rules or game function—leaving other ways of expressing those rules or functions.²

In analyzing the combination of game elements for copyright, the work as a whole may be copyrightable even if the individual pieces are not.³ The overwhelming totality of copying is taken into account and the “total concept and feel” of the work is considered.⁴

Set Enterprises is the exclusive licensee of copyrights in the SET game, cards, box and the game’s instructions. These registrations give Set Enterprises a presumption of valid copyrights.⁵ The classic SET card game includes at least the following expressive card game piece features: shape (ovals, squiggles, diamonds); color (red, purple, green); number of figures (1, 2, 3); and shading (solid, striped outlined). The classic SET game also contains a 12-card playing field arranged as rows of three cards by four cards. You implement substantially similar shapes, colors, numbers of figures, shading, and play field in your implementation of the SET game. Furthermore, the fact that, in the Description section of the iTunes App, you wrote “Play the classic Set card game and find all the sets available on the deck.” demonstrates that you deliberately chose to copy SET’s expressive graphical elements despite literally an unlimited number of dissimilar ways to functionally implement the rules of a SET-type game. This constitutes copyright infringement, particularly when the overwhelming totality of copying is taken into account and the “total concept and feel” of the work is considered.⁶

Copyright damages include either Set Enterprises’ actual damages or statutory damages up to \$150,000 per work for willful infringement.⁷ You may also have to pay the costs and attorneys’ fees Set Enterprises incurs in enforcing its copyrights. *See id.* §505. In addition, you may also be subject to criminal liability for your willful copyright infringement. *See id.* §506.

In addition to infringing on our copyrights, your use of the word “Set” as part of the title of your game and to describe a group of three that are either all the same or all different in each of 3 or 4 individual features infringes on our SET trademarks. It is likely to cause confusion in the minds of

² *Tetris Holding*, 863 F. Supp. 2d at 404 (discussing this rule as result of scenes-a-faire and merger doctrines).

³ *Atari Games Corp.*, 888 F. 2d at 883 (“None of the individual elements of the Reader's Digest cover — ordinary lines, typefaces, and colors — qualifies for copyright protection. But the distinctive arrangement and layout of those elements is entitled to protection as a graphic work.... Reader's Digest has combined and arranged common forms to create a unique graphic design and layout. This design is entitled to protection under the Copyright Act as a graphic work.”); *see also Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 388 (5th Cir. 1984) (component parts “neither original to the plaintiff nor copyrightable” may, in combination, create a “separate entity [that] is both original and copyrightable”); *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109 (9th Cir. 1970) (greeting cards held to be copyrightable although textual matter standing alone was not copyrightable; “all elements of each card, including text, art work, and association between art work and text, [must] be considered as a whole”).

⁴ *See Tetris Holding*, 863 F. Supp. 2d at 409-10 (finding copyright infringement by unauthorized iPhone app using game pieces with substantially similar shapes, bright colors and shading, rectangular playing field, and movement of game pieces as in classic Tetris game). “If one has to squint to find distinctions only at a granular level, then the works are likely to be substantially similar.” *Id.* at 410.

⁵ *Apple Computer, Inc. v. Formula Int’l Inc.*, 725 F. 2d 521, 523 (9th Cir. 1984).

⁶ *See Tetris Holding*, 863 F. Supp. 2d at 409-10 (finding copyright infringement by unauthorized iPhone app using game pieces with substantially similar shapes, bright colors and shading, rectangular playing field, and movement of game pieces as in classic Tetris game). “If one has to squint to find distinctions only at a granular level, then the works are likely to be substantially similar.” *Id.* at 410.

⁷ 17 U.S.C. §504.

consumers as to the source or origin of the app. The Lanham Act prohibits an entity from using a trademark that is likely to cause confusion as to the source of goods or services.⁸ The purpose of this law is to ensure that trademark owners benefit from the goodwill they have acquired in their intellectual property and to ensure that consumers can distinguish between competing producers of goods and services.⁹ Through its extensive use and promotion of the term SET to describe our game and a group of three that are either all the same or all different in each of 3 or 4 individual features within a matching-type game, Set Enterprises has developed extremely valuable good will in the term as it is used in your app and on your website. It is evident from the 'How to play' section on your webpage wherein you have copied—verbatim—the 'How to play' section from our website page at <http://www.setgame.com/set>, that you are aware of our game. Use of our trademarked term to describe essentially the exact same thing we use it to describe, in a game that is essentially just like the game we use the trademarked term as the title of, in a class in which we have it protected and on goods for which we have it protected, infringes on our trademark. In fact, it is clear to me that you used our trademarked term in an effort to capitalize on the goodwill we have earned. Your use of the famous SET mark constitutes trademark infringement, false association and dilution and your continued use will cause Set Enterprises irreparable injury.

Accordingly, I must demand that you immediately cease the display and distribution of the infringing app and remove the infringing material on the webpage located at <http://slugset.pythonanywhere.com/>. I hope this matter can be resolved amicably, without resorting to legal proceedings. However, in light of the irreparable injury caused by your infringement, I must ask for your response to the foregoing no later than **five (5) days** from your receipt of this email/letter. Please contact me via email at bpopp@setgame.com or via post at Set Enterprises, Inc., 16537 E. Laser Drive, Suite 10, Fountain Hills, AZ 85268. I appreciate your cooperation in this matter and look forward to hearing from you.

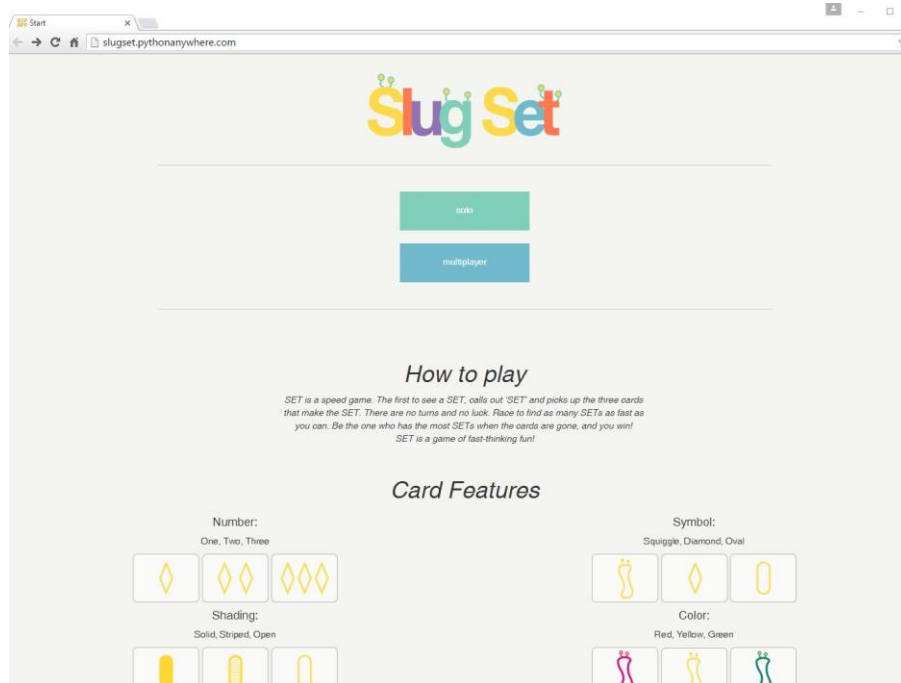
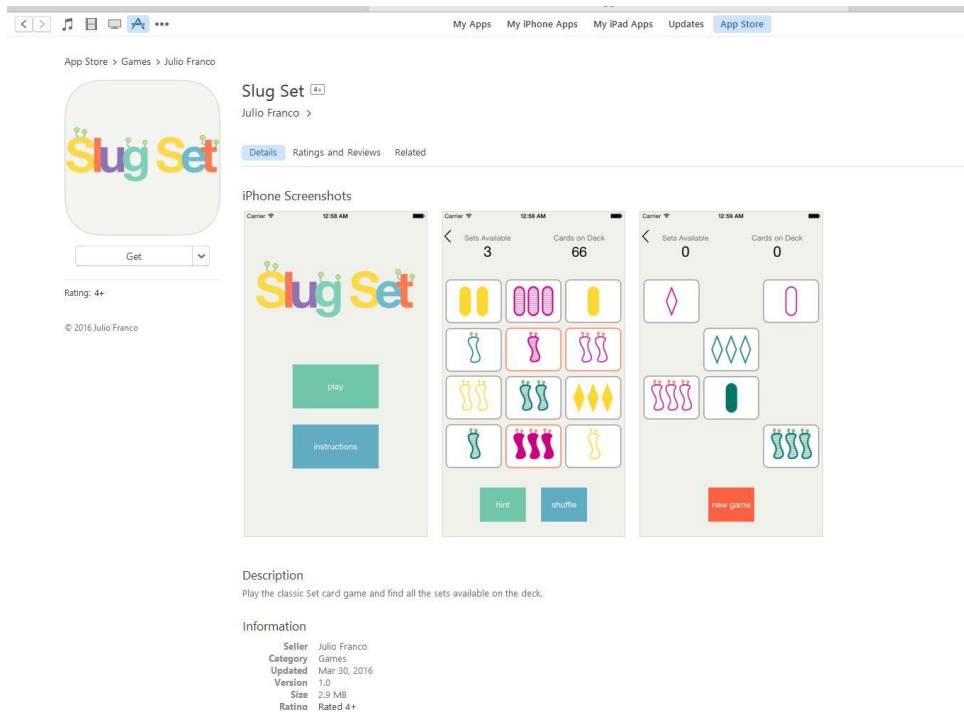
Sincerely,



Bree Popp
Vice President & Counsel

⁸ See 15 USC §1125(a)(1)(A).


⁹ *Park 'n Fly v. Dollar Park & Fly*, 469 US 189, 198 (1985).




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Card Features


Number:
One, Two, Three




Symbol:
Squiggle, Diamond, Oval



Shading:
Solid, Striped, Open



Color:
Red, Yellow, Green




What is a set

To make a set you need to pick three cards and for **each** feature they all have to agree, or they all disagree.

- They all have the same number, or they have three different numbers.
- They all have the same symbol, or they have three different symbols.
- They all have the same shading, or they have three different shadings.
- They all have the same color, or they have three different colors.

Examples of sets



Julio Franco
Work in progress