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

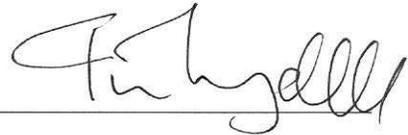
Proceeding	92051465
Party	Defendant EDGE GAMES, INC.
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Submission	Motion to Dismiss - Rule 12(b)
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Date	03/19/2010
Attachments	7158718_Motion for Reconsideration.pdf ( 10 pages )(545482 bytes )



**CERTIFICATE OF SERVICE**

I hereby certify that on March 19, 2010, a true and correct copy of the attached Motion for Reconsideration in respect to the Consolidated Petition for Cancellation No. 92051465 filed by Edge Games, Inc., a California corporation, has been served by mailing said copy on March 19, 2010, via U.S. mail, postage prepaid, addressed to:

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CA 94111-5800



Dr. Tim Langdell  
CEO, Defendant in *pro se*

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

In the Matter of Registration No. 3,559,342  
For the Trademark THE EDGE  
Issued January 13, 2009

In the Matter of Registration No. 3,381,826  
For the Trademark GAMER'S EDGE  
Issued February 12, 2008

In the Matter of Registration No. 3,105,816  
For the Trademark EDGE  
Issued June 20, 2006

In the Matter of Registration No. 2,251,584  
For the Trademark CUTTING EDGE  
Issued June 8, 1999

In the Matter of Registration No. 2,219,837  
For the Trademark EDGE  
Issued January 26, 1999

<b>EA DIGITAL ILLUSIONS CE AB, a Swedish Corporation; ELECTRONIC ARTS INC., a Delaware corporation,</b>	)	<b>MOTION FOR RECONSIDERATION</b>
<b>Petitioners,</b>	)	
<b>v.</b>	)	
<b>EDGE GAMES, INC., a California corporation</b>	)	
<b>Registrant.</b>	)	
_____	)	
	)	
	)	
	)	
	)	
	)	

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

## MOTION FOR RECONSIDERATION

NOW COMES Respondent and Registrant, EDGE Games Inc. (“EGI”), and moves through this motion that the denial of our Motion To Dismiss be reconsidered and upon reconsideration now be granted. Our Motion to Dismiss was filed under Rule 12(B) on the basis primarily of *stare decisis*. However, the Board changed our motion to one of Summary Judgment and construed our motion to be based on *res judicata*, and consequently never considered or ruled on our actual motion based in key part on the fact the exact same issue with the exact same facts had already been fully litigated and been decided in the superior venue of the 2008 Virginia Federal Court only a few months before the petitioners filed the instant petition. Contrary to the Board’s decision on our prior motion, the doctrine of *stare decisis* is valid here and should be recognized and applied by acceptance of the prior decisions. We thus present further argument, acknowledging the grounds may be for summary judgment rather than dismissal for failure to state a claim on which relief can be granted. We add further facts and citation of prior TTAB decisions to support our repeat request that this petition be dismissed. Given the Federal Court decision was relied on to dismiss the prior petition to cancel one of the marks in question, we reassert that prior decision by the TTAB on the same issues and the same facts pertaining to that registration should be taken into account here, too. We also add a challenge to the standing of the parties to bring this petition.

### FACTS

1. Our prior Motion to Dismiss was brought on the basis of the doctrine of *stare decisis*, asking the Board to take into account the prior decisions of the superior venue of the District Court (December 2008 decision) and the Board’s own prior decision

on the previous cancellation action against one of our marks also referenced in the instant petition. The Board construed our motion to be for summary judgment on the basis of *res judicata*. However, we specifically did not file our prior motion on the basis of *res judicata* because that principal requires the same parties to be involved in both matters or that there be privity status established between two parties where they differ. The doctrine of *stare decisis*, in contrast, does not require the same parties be involved but instead requires that the same issue and the same facts were previously fully litigated and that therefore the prior decision(s) should be upheld.

2. Despite neither petitioner being involved in either the District Court case nor the prior cancellation action against EGI regarding the mark “GAMER’S EDGE,” the issues and facts were identical in both those other cases to those in the instant petition. While it is unclear whether either petitioner has successfully established standing, the accusations that petitioners brought in their petition – that EGI has abandoned its marks through non-use or committed fraud on the USPTO in gaining its registrations – do not involve either of the petitioner’s at all. Absent the prior decisions, whether the accusations of abandonment and fraud have any merit rest solely on considering the actions of the registrant and do not involve the Board taking into consideration at all the business of the petitioners, any actions or rights of the petitioners, or etc. In other words, an accusation that a registrant has abandoned its marks or has committed fraud is entirely independent of the party bringing the allegations of abandonment and fraud. Petitioners’ accusations are identical to those brought against EGI by Velocity Micro Inc in the District Court case and in the prior cancellation action before the TTAB for EGI’s mark

“GAMER’S EDGE” and the fact the plaintiffs are different does not change the issues or the facts under consideration at all.

3. Petitioners seek to claim standing in this matter by merely stating that EGI owns certain trademark registrations and that petitioners have made use of the mark “MIRROR’S EDGE” but they do not link these two observations. They further falsely state that EGI has made multiple threats to sue petitioners without providing any evidence to support the truth of that assertion. It is thus unclear in what way petitioners are alleging they have an interest in the outcome of this action or would be harmed if EGI’s registrations remained in place.

4. Further, and most noteworthy, petitioner Electronic Arts Inc pointedly failed to mention in the petition that it filed to register the mark “MIRROR’S EDGE” with the USPTO in 2007 (Serial No. 77222986, filed July 5, 2007). They also failed to mention that they expressly abandoned that application on September 8, 2009 three days before filing the instant petition. Further, in the instant petition they represent that EA DICE is the true owner of the mark MIRROR’S EDGE and that EA is merely the licensee, but this is in direct contradiction to the 2007 application which represented EA as the owner of the mark.

### **ARGUMENT**

5. *Stare decisis* is a common law principal requiring judges to apply previous binding decisions of their own court or any higher court. Once a decision (precedent) on a certain set of facts has been made, the courts will apply that decision in cases that subsequently come before it embodying the same set of facts. A precedent that is binding must be followed under this doctrine.

6. The doctrine of *stare decisis* was recognized and applied by the Board in *In re Multivox of America*, 209 U.S.P.Q. 627 (TTAB 1981). The doctrine "rests upon principle that law by which men are governed should be fixed, definite and known, and that, when the law is so declared by court of competent jurisdiction authorized to construe it, such declaration, in absence of palpable mistake or error, is itself evidence of the law until changed by competent authority." *Id* at 630. In ex parte proceedings, *stare decisis* is a "substitute" for the doctrine of *res judicata* "to the extent that the previously decided decision can serve to protect the rights of registrants without constantly subjecting them to the financial and other burdens of opposition proceedings." *Id*

A party seeking to avoid application of the doctrine bears a heavy burden:

**[I]t is incumbent upon the party seeking to avoid the application of this doctrine . . . to persuade the Board that the issue in the instant proceeding is different or that the facts, situation or principles upon which the prior decision was based have changed or that the circumstances that existed at that time have become so exacerbated in the ensuing years that the decision in point has lost in time whatever viability it may have had or that the interplay between the parties since that time has demonstrated a side-by-side tolerance of the parties for one another so that the equities in favor of affording applicant a further opportunity to register its mark are greater than those in favor of precluding possible further litigation and burden on [the Applicant].**

*Id* at 630-31.

7. Even where *res judicata* cannot be applied because of lack of mutuality between the parties between the current and prior cases, the doctrine of *stare decisis* requires that a prior finding that a mark is valid compels a finding of validity in the second action in the absence of a showing that the prior holding was manifestly erroneous. *Pachmayr Gun Works, Inc. v. Olin Mathieson Chemical Corp. Winchester Western Div.*, 502 F.2d 802, 183 U.S.P.Q. 5 (9th Cir. 1974) ("[W]here faced with a prior

ruling of this Court holding a substantially identical trademark valid, it was error to disregard the *stare decisis* effect of that ruling absent a strong showing that it was 'palpably erroneous' in fact or law"); *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 227 U.S.P.Q. 598, 82 A.L.R. Fed. 97 (9th Cir. 1985). See also, *Marchak v. Sheppard*, 666 F. Supp. 590, 3 U.S.P.Q.2d 1829, 1835 (S.D.N.Y. 1987) stating, "[T]he *stare decisis* effect of a prior finding of validity of a trademark may be overcome if defendant 'present[s] persuasive new evidence' of invalidity and demonstrate[s] that there is a 'material distinction' between the cases," quoting from *Illinois Tool Works, Inc. v. Foster Grant Co.*, 547 F.2d 1300, 192 U.S.P.Q. 365 (7th Cir. 1976), cert denied, 431 U.S. 929, 53 L. Ed. 2d 243, 97 S. Ct. 2631, 194 U.S.P.Q. 576 (1977).

8. Here, we have a District Court decision in favor of EGI as well as a prior TTAB decision (Cancellation No. 92049162) dismissing the prior cancellation action filed against EGI, with both decisions concerning the same registered marks that are the subject of the current cancellation proceeding. The facts and the issues are identical. Although we lack mutuality between the parties from the prior Federal case or the prior cancellation action and the current cancellation action, the Board should recognize the prior decision(s) as precedent under *stare decisis* rather than *res judicata* or *collateral estoppel*.

9. The prior District Court case and the prior cancellation action before the TTAB established, after the facts were considered and the issues fully litigated, that EGI had not abandoned any of its registered trademarks nor had EGI committed fraud on the USPTO in gaining any of its registrations. Once the District Court determined that there was sufficient evidence that EGI had not abandoned any of its registered marks, it

logically follows that no evidence the petitioners can now bring to the current proceeding can reverse that decision. It is irrelevant what facts were before the District Court lead to the decision that EGI had not abandoned its trademarks or committed fraud, and it is only relevant that at the least sufficient such evidence was presented to achieve the court's effective certification that all of EGI's registrations are valid. Unless, that is, petitioners can show clearly why the prior decisions were "palpably erroneous' in fact or law" (*Transgo Inc. Id.*).

10. It is questionable whether either petitioner has standing to bring this petition in that they have both failed to show clearly that they both have a "real interest" in the outcome of this matter and a reasonable basis for belief of damage. If petitioners truly believed that either one of them would suffer harm as a result of EGI's registrations remaining on the USPTO register, then why did EA abandon its 2007 application rather than continue with it and assign ownership of the application to EA DICE? The express abandonment clearly stood as EA's acceptance of EGI's superior rights in its marks EDGE, THE EDGE and its family of EDGE formative marks, which in turn means that the express abandonment stood as a clear admission that petitioners do not believe they will be harmed if EGI's registrations remain, and waived their right to allege harm. At the very least, the express abandonment is at direct odds with any claim petitioners might now seek to make that they would be harmed by EGI's registrations remaining in place.

11. It is clearly in question whether at least one of the petitioners has standing since EA would appear to have been playing a shell game with the USPTO as to who it wishes to claim the owner of that mark is, and who they claim the licensee is, in order to devise a way to possibly falsely represent that both petitioners have standing.

## CONCLUSION

12. The principal of *stare decisis* does pertain in this matter and unless petitioners can show clearly how the facts, situation or principals have changed since the prior decisions in favor of EGI ruling its trademarks to be valid (not abandoned) and it to have not committed fraud on the USPTO, then the doctrine should rightly be evoked and this petition should be dismissed.

13. This cancellation proceeding should be dismissed because the issues and alleged facts raised by EA have already been decided by a Federal Court on the exact same grounds and of the exact same marks. Since the Federal Court has already ruled in favor of EGI on the merits in the Virginia Court case, the TTAB should not allow petitioners to disturb that ruling on the same issues involving the same facts.

14. In addition, and/or in the alternative, EGI requests that the TTAB uphold its prior decision on the merits in Cancellation Proceeding No. 92049162 in respect to the GAMER'S EDGE mark.

15. The petitioners have failed to adequately show they have standing to bring the instant petition.

Date: March 19, 2010

Respectfully submitted,

By: 

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