

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: October 7, 2010

Cancellation No. 92051465

EA Digital Illusions CE AB,
Electronic Arts Inc.

v.

EDGE Games, Inc.

Before Bucher, Taylor and Bergsman,
Administrative Trademark Judges.

By the Board:

This proceeding is before the Board for 1) respondent EDGE Games Inc.'s ("respondent," or "EDGE Games") motion (filed March 19, 2010) for reconsideration of the Board's February 22, 2010 decision denying its motion for summary judgment,¹ and 2) respondent's motion (filed June 15, 2010) to suspend this proceeding pursuant to Trademark Rule 2.117(a). The motions have been fully briefed.

Respondent's motion for reconsideration

A request for reconsideration, as provided for in Trademark Rule 2.127(b), allows a party an opportunity to point out any error which the Board may have made in its initial consideration of a matter. Such a motion may not

¹ Respondent's reply brief filed April 30, 2010, thirty days after the date of service of petitioner's motion in opposition, is untimely. See Trademark Rule 2.127(a). Accordingly, petitioner's motion (filed May 18, 2010) to strike respondent's reply brief is hereby granted, and said reply brief has been given no consideration.

properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion. See TBMP § 518 (2d ed. rev. 2004) and authorities cited therein.

Respondent's motion is timely. See Trademark Rule 2.127(b); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000).

Respondent states in its motion that it seeks to "present further argument" and "add further facts and citation of prior TTAB decisions." Because respondent does not point out any error which the Board may have made in its initial consideration of respondent's motion for summary judgment, and because respondent is seeking to introduce new evidence or arguments, respondent's motion for reconsideration is contrary to established practice and it is, therefore, denied.

Even if we considered respondent's motion for reconsideration, it is not well taken. Respondent argues that the doctrine of *stare decisis* requires that the outcomes of 1) a 2008 decision of the United States District Court for the Eastern District of Virginia ("District Court"),² and 2) Cancellation No. 92049162,³ compel that the

² The case is Civil Action No. 03:08CV135-JRS, brought by Velocity Micro, Inc., an entity not a party to this proceeding. The case was dismissed in a brief order referencing a confidential settlement agreement between the parties.

³ In Cancellation No. 92049162, Velocity Micro, Inc., which, as stated, is not a party to this proceeding, petitioned to cancel respondent's Registration No. 3381826 on the grounds of abandonment, fraud, and priority and likelihood of confusion.

Board dismiss the instant petition for cancellation.

Respondent argues that "the exact same issue with the exact same facts had already been fully litigated" in the District Court and in Cancellation No. 92049162.

The Board denied respondent's motion for summary judgment, finding that neither issue preclusion nor claim preclusion bar petitioners' claims herein inasmuch as neither of the petitioners in this proceeding was a party to, or in privity with, the party who brought the District Court case and Cancellation No. 92049162.

As respondent itself acknowledges, the two earlier proceedings on which it bases its argument for application of *stare decisis* were instituted by a third-party plaintiff which is not a party to this proceeding. Moreover, the record simply is not reflective of respondent's assertion that *stare decisis* mandates the dismissal of petitioners' claims herein. Respondent predicates this argument on its assertion that the District Court order - insofar as it states that defendants therein (which include respondent) "are deemed to have defended and succeeded on the merits with respect to the Complaint" - constituted the District Court's ruling on the merits of the third party's abandonment and fraud claims against respondent, based on facts and evidence brought before that tribunal. As petitioners note, neither of the two earlier proceedings were fully litigated; rather, they were "settled and

The proceeding was terminated pursuant to Velocity Micro, Inc.'s

voluntarily dismissed prior to any discovery, dispositive motions, or judicial determinations of the claims on the merits." To the extent that the parties present disparate versions as to the context and manner in which the District Court dispute between respondent and the third party were terminated, the Board must rely in substance on the District Court order, which includes no discussion of evidence pertaining to, or findings of fact with respect to, either of that plaintiff's abandonment or fraud claims against respondent. Indeed, the District Court order's prefatory paragraph states, "the parties have resolved this matter and settled the dispute between them." Furthermore, the present cancellation proceeding has not yet been litigated; thus, respondent cannot assert that the exact same issues with the exact same facts have already been litigated.

In summary, respondent has not pointed to any error the Board made in ruling on its motion for summary judgment. The Board maintains that the February 22, 2010 decision is correct and supported by the record.

In view of the foregoing, EDGE Games' motion for reconsideration is denied.⁴

Respondent's motion to suspend

Respondent seeks suspension of this proceeding under Trademark Rule 2.117(a), pending final disposition of a

withdrawal of its petition.

⁴ To the extent that respondent seeks to "add a challenge to the standing of the parties to bring this petition" in its motion for reconsideration, said request is inappropriate, and is hereby denied.

civil action which respondent filed on June 15, 2010 in the United States District Court for the Northern District of California ("District Court of California case") against Electronic Arts Inc., one of the petitioners herein. Respondent included a copy of the complaint filed therein.⁵

Flowing from the Board's inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon motion, or upon stipulation of the parties approved by the Board. See Trademark Rule 2.117(a); TBMP § 510.01 (2d ed. rev. 2004). When both a motion to suspend and a potentially dispositive motion are pending before the Board, the potentially dispositive motion may be decided before the question of suspension is considered, regardless of the order in which the motions were filed. See Trademark Rule 2.117(b).

Furthermore, to the extent that a civil action in a federal district court involves an issue or issues in common with those in the proceeding before the Board, the decision of the district court is often binding upon the Board, while the decision of the Board is rarely binding upon the district court. See *Goya Foods Inc. v. Tropicana Products Inc.*, 846

⁵ Said civil action is captioned *Edge Games, Inc. v. Electronic Arts Inc.*, CV10-02614BZ.

The Board has considered respondent's second-filed reply brief, which bears a corrected date of service of July 14, 2010.

The Board notes petitioners' motion, filed in Opposition No. 91193736, to consolidate Cancellation No. 92051465 and Opposition No. 91193736. Inasmuch as different dispositive motions have been filed in the two proceedings, the Board defers consideration

F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F.Supp. 563, 2 USPQ2d 1208 (D.Minn. 1986). Moreover, it is incumbent on the Board to give deference to the determinations of a federal court, including any remedy entered therein, and to consider the terms of any injunction entered. See *DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1950 (TTAB 2008). Because an injunction or similar remedy may permanently prohibit a party from using the mark or marks at issue, it is a legal impossibility for an enjoined party to obtain a registration. See *Id.* In a similar manner, such a ruling and remedy, if imposed on a plaintiff, may, at a minimum, bear on a plaintiff's standing, assertion of damage, or rights in a mark.

The District Court of California case involves, inter alia, respondent's claim that petitioners' use of the mark MIRROR'S EDGE is an infringing use, and petitioners plead common law use of said mark in their petition to cancel herein. Accordingly, the Board concludes that the outcome of that case may have a bearing on this proceeding.

In view thereof, suspension is appropriate. Respondent's motion for suspension is granted. This proceeding is hereby suspended pending the outcome of the referenced District Court of California case.⁶

of the issue of consolidation, which is discretionary with the Board. See TBMP § 511 (2d ed. rev. 2004).

⁶ A proceeding is considered to have been finally determined when a decision on the merits of the case (i.e. a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom or all appeals filed therefrom have been decided. See TBMP § 510.02(b) (2d ed. rev. 2004).

Within twenty (20) days after the final determination of the pending civil action, the parties shall so notify the Board and call this case up for any appropriate action.

At such time as the Board resumes proceedings herein, it will reset dates, as appropriate, including respondent's time to answer petitioner's amended petition to cancel filed March 24, 2010, which is now the operative pleading in this proceeding.⁷ See Trademark Rule 2.115; TBMP § 507.01 (2d ed. rev. 2004).

During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

⁷ As the Board indicated in its February 22, 2010 order, petitioner's request for Board participation in the parties' discovery conference, as well as respondent's response thereto, are noted. In the event that the Board resumes proceedings, the Board will set forth a revised schedule, and will direct the parties to contact the assigned interlocutory attorney to schedule the discovery conference, as appropriate (see Order of the Board, February 22, 2010, fn. 13).