

ESTTA Tracking number: **ESTTA396493**

Filing date: **03/06/2011**

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

Proceeding	92051465
Party	Defendant Edge Games, Inc.
Correspondence Address	TIM LANGDELL EDGE GAMES INC 530 SOUTH LAKE AVENUE, #171 PASADENA, CA 91101 UNITED STATES uspto@edgegames.com
Submission	Other Motions/Papers
Filer's Name	Tim Langdell
Filer's e-mail	uspto@edgegames.com
Signature	/Tim Langdell/
Date	03/06/2011
Attachments	ReplyToPetitionersOppositionToWithdrawal92051465.pdf (13 pages)(319692 bytes)

**REPLY TO PETITIONERS' OPPOSITION
TO REGISTRANT'S MOTION TO WITHDRAW
SECTION 7 SURRENDER.**

1. Registrant presumed in filing its motion that the USPTO record speaks for itself in that it shows clearly that the instant trademark registration is jointly owned by both Edge Games Inc and Future Publishing Limited following a partial assignment of the registration to the latter company in 2004. However, attached as Exhibit A is a copy of the documents on file at the USPTO showing that the assignment did occur in October 2004. There were several attempts to record the assignment in the past in at least 2008 (prior to the current petition filing), with errors in those attempts being finally resolved by or about October 2009. But the timing of the filings and the eventual resolution of the errors in filings to show the correct ownership of the mark does not take away from the core fact that the instant registration was partially assigned in 2004. Thus at the time of the instant petition the registration was already jointly owned by two parties, even if the USPTO database did not accurately reflect that fact at the time.

2. Registrant did not to its knowledge represent during these proceedings that it is the sole owner of this trademark registration, but if Registrant ever did so represent, then it was an honest error and the instant motion is filed in part to correct that error.

3. The Petitioners were aware of the joint ownership of this registration prior to filing the instant petition since they were party to communications with Future Publishing Limited and Registrant that indicated that all such trademark registrations owned by Registrant had been jointly owned with Future Publishing Limited since the 2004 agreement that Future Publishing Limited entered into. Certainly, in the related US

Federal Court Proceedings, Petitioners were well aware of this 2004 agreement since they produced at least one witness statement that summarized this agreement to the court.

4. In any event, any failure by Registrant to draw the fact that this registration is owned jointly with another party to either the TTAB's attention or Petitioners' attention earlier, does not detract from the fact that the registration is not owned solely by Registrant and has not been owned solely by Registrant since at least October 15, 2004. Thus while Registrant was in good faith in its responses in these proceedings, the fact remains that Future Publishing Limited should have been a defendant to this petition insofar as it referred to this registration. Petitioners' assertion that it would have been Registrant's responsibility to bring Future Publishing Limited into these proceedings is not in accord with advice given Registrant by its trademark counsel. Registrant is advised that the onus may have been on the Petitioners to properly research the owner, and once they saw the ownership updated in 2009, to then amend the Petition to include Future Publishing Limited. Or in the alternate, the TTAB should have required that all owners of the registration be served with and be a party to the Petition for it to be valid.

5. Certainly, it is not Registrant's intention to breach any settlement agreement it has with Petitioners. But on the other hand, Registrant cannot contractually agree to surrender a trademark registration that it is not the sole owner of. It may be able to surrender that part of the registration that it owns, but not the entire registration. Insofar as the settlement agreement references surrender of the entire registration, or references the USPTO canceling the entire registration, then there was honest mistake since neither of these actions could be agreed to or ordered without the involvement prior

to the agreement or prior to any order of the co-owner, Future Publishing Limited. To be clear, Registrant seeks a solution, as we are sure Petitioners do too, that does not involve Registrant breaching its contractual obligations under the settlement agreement with Petitioners. We disagree, though, that the reinstatement of the registration to Registrant would breach the agreement since we now know that Registrant was not in a position to agree to surrender a registration it did not solely own.

6. Petitioners' suggestion that they would permit the registration to be reinstated if Future Publishing Limited were to hold it entirely and solely in their name is not an acceptable or legal solution. Future Publishing Limited are prohibited by the 2004 contract they entered into to hold such a trademark registration on their own. Indeed it would be an egregious breach of that 2004 agreement were the registration to be reinstated with Future Publishing Limited as the sole owner of it.

7. In addition, further complicating matters, current disputes that Future Publishing Limited are involved in may result in a change of the partial ownership of this US trademark registration, which is a further key reason the mark could not be reinstated in Future Publishing Limited's sole name. It would have to be at least partly in Registrants name until such time as those other legal disputes are resolved.

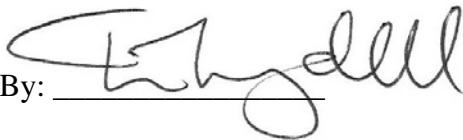
8. Registrant is informed by the USPTO division dealing with the dividing of trademark registrations and the processing of section 7 surrenders that the USPTO cannot divide a trademark registration when it is not currently live in the USPTO system, nor can it divide a registration while a TTAB proceeding is ongoing prior to a final decision being rendered on it by the TTAB. Indeed, if there is a way to divide the registration and then partially surrender it prior to the closing of the instant TTAB proceedings, it would

not be a solution since as we indicated above, due to the other disputes yet to be resolved, the ownership of this registration may change and the owners need to remain jointly Registrant and Future Publishing Limited until said other disputes are concluded.

9. Consequently, Registrant believes its current motion to reinstate this registration (withdraw/reverse the section 7 surrender), conclude the instant cancellation proceedings, and then leave Petitioner and Registrant to resolve this complex issue between them in accord with the settlement the parties reached, is the only viable solution to this issue. Registrant thus repeats the request in its motion.

Date: March 6, 2011

Respectfully submitted,

By: 

Dr. Tim Langdell, CEO
EDGE Games, Inc.
Registrant in *Pro Se*
530 South Lake Avenue, 171
Pasadena, CA 91101
Telephone: 626 449 4334
Facsimile: 626 844 4334
Email: ttab@edgegames.com

EXHIBIT A

TO: TIM LANGDELL COMPANY: 530 SOUTH LAKE AVENUE #171

C 10/24/09

11-02-2009

Electronic Version v1.1
Stylesheet Version v1.1

103579411

SUBMISSION TYPE:		CORRECTIVE ASSIGNMENT	
NATURE OF CONVEYANCE:		Corrective Assignment to correct the Undivided interest only should have been conveyed previously recorded on Reel 003769 Frame 0309. Assignor(s) hereby confirms the Assignment was of undivided interest remaining after prior partial assignment to Future Publishing.	
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
The Edge interactive Media, Inc		02/21/2008	CORPORATION: CALIFORNIA
RECEIVING PARTY DATA			
Name:	EDGE Games, inc.		
Street Address:	530 S Lake Ave #171		
City:	Pasadena		
State/Country:	CALIFORNIA		
Postal Code:	91101		
Entity Type:	CORPORATION: CALIFORNIA		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Registration Number:	3105816	EDGE	
CORRESPONDENCE DATA			
Fax Number:	(626)844-4334		
<i>Correspondence will be sent via US Mail when the fax attempt is unsuccessful.</i>			
Email:	uspto@edgegames.com		
Correspondent Name:	Tim Langdell		
Address Line 1:	530 South Lake Avenue #171		
Address Line 4:	Pasadena, CALIFORNIA 91101		
ATTORNEY DOCKET NUMBER:	CLARIFICATION OF ASSIGNMENT		
NAME OF SUBMITTER:	Tim Langdell		
Signature:	/Tim Langdell/		

OP 540.00 3105816

TRADEMARK
REEL: 004089 FRAME: 0688

TO: TIM LANGDELL COMPANY: 530 SOUTH LAKE AVENUE H171

Date:	10/21/2009
<p>Total Attachments: 4 source=Assignments#page1.tif source=ClarificationPartialAssignEDGE8208607#page1.tif source=ClarificationPartialAssignEDGE8208607#page2.tif source=ClarificationPartialAssignEDGE8208607#page3.tif</p>	

TRADEMARK

REEL: 004089 FRAME: 0689

TRADEMARK ASSIGNMENT

Electronic Version v1.1
Stylesheet Version v1.1

SUBMISSION TYPE: NEW ASSIGNMENT

NATURE OF CONVEYANCE: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

CONVEYING PARTY DATA

Name	Formerly	Execution Date	Entity Type
The Edge Interactive Media, Inc		02/21/2008	CORPORATION:

RECEIVING PARTY DATA

Name: EDGE Games, Inc.
 Street Address: 530 South Lake Avenue
 Internal Address: #171
 City: Pasadena
 State/Country: CALIFORNIA
 Postal Code: 91101
 Entity Type: CORPORATION:

PROPERTY NUMBERS Total: 7

Property Type	Number	Word Mark
Registration Number:	3381826	GAMER'S EDGE
Serial Number:	78807479	EDGE
Registration Number:	3105816	EDGE
Serial Number:	75077113	THE EDGE
Serial Number:	75029400	EDGE
Registration Number:	1853705	EDGE
Registration Number:	2251584	CUTTING EDGE

CORRESPONDENCE DATA

file://C:\Documents and Settings\Tim Langdein\Local Settings\Temporary Internet Files\10/22/2009
 TRADEMARK

REEL: 004089 FRAME: 0690

Fax Number: (626)844-4334
Correspondence will be sent via US Mail when the fax attempt is unsuccessful.
Phone: 6264494334
Email: USPTO@EDGEGAMES.COM
Correspondent Name: Tim Langdell
Address Line 1: 530 South Lake Avenue
Address Line 2: #171
Address Line 4: Pasadena, CALIFORNIA 91101

NAME OF SUBMITTER: TIM LANGDELL

Signature: /Tim Langdell/

Date: 04/30/2008 ←

Total Attachments: 1
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RECEIPT INFORMATION

→ ETAS ID: TM113820
Receipt Date: 04/30/2008 ←
Fee Amount: \$190

CLARIFICATION OF ASSIGNMENT OF TRADEMARK

This document references the assignment agreement entered into 21st of February, 2008 between The Edge Interactive Media, Inc., of 530 S. Lake Avenue, Suite 171, City of Pasadena, State of California, herein referred to as "Assignor", and EDGE Games, Inc., of 530 S Lake Avenue, Suite 171, City of Pasadena, State of California, herein referred to as "Assignee".


That Assignor assigned to Assignee all right title and interest, as well as all goodwill arising from use of the mark and the business symbolized by said mark, in the trademark EDGE in Class 16, registration number 3105816.

However, prior to this assignment a partial assignment of certain goods in this trademark should have been filed (but said filing was not filed at the time it was meant to be in 2004), assigning a certain part of the goods to Future Publishing Ltd. A copy of that Assignment is attached as Exhibit A. Consequently, the list of goods assigned to Assignee by the February 21, 2008 Assignment in respect to the mark EDGE registration number 3105816 was the undivided interest in the original mark still retained by Assignor following the prior assignment to Future Publishing Ltd, namely:

"printed matter, namely, comic books, comic book reference guide books, books featuring stories in illustrated forms, graphic novels, comic strips, picture postcards, comic postcards, printed postcards, novelty stickers, decals, bumper stickers, note cards, note paper, stationery folders, posters about interactive entertainment; writing instruments, namely pencils, ball point pens, ink pens."

Date

2/21/08


Dr. Tim Langdell, CEO
Assignor

TRADEMARK
REEL: 004089 FRAME: 0692

EXHIBIT A

TRADEMARK
REEL: 004089 FRAME: 0693

PARTIAL ASSIGNMENT OF TRADEMARK

WHEREAS, The Edge Interactive Media, Inc., a California corporation having its correspondence address of 530 South Lake Avenue, #171, Pasadena, California ("Assignor") has adopted, owns, and used the trademark EDGE in connection with various goods and services listed in Assignor's Trademark Application Serial No. 78208607;

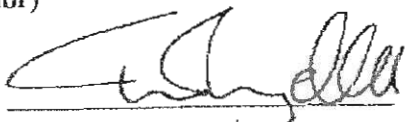
AND WHEREAS, Future Publishing Ltd., a company incorporated and existing under the laws of the United Kingdom, having a place of business at Beauford Court, 20 Monmouth Street, Bath BA 1 2BW, England (hereinafter the "Assignee") desires to acquire any and all rights, title and interest in and to the herein specified part of the EDGE trademark (hereinafter the "Partially Assigned Trademark"), only for the following goods (hereinafter the "Assigned Class 16 Goods"):

Mark	Application Number	Assigned Class 16 Goods
EDGE	Ser. No. 78/208,607	computer magazines, video game magazines, magazines about interactive entertainment

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Assignor does hereby sell, assign, and transfer to the said Assignee, its successors and assigns, all rights, title, and interest in and to the Partially Assigned Trademark for the Assigned Class 16 Goods, in the United States, together with the goodwill of the Assignor's business connected with the use of and symbolized by the Partially Assigned Trademark for the Assigned Class 16 Goods.

IN WITNESS WHEREOF, the said Assignor has hereunto executed this instrument this 15th day of October, 2004.

The Edge Interactive Media, Inc.
(Assignor)

Signed: 
Name: TOM LANGDELL
Title: CEO

Date: 10/15/04