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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., and Future Publishing, Ltd.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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

EA DIGITAL ILLUSIONS CE AB, a Swedish Corporation; ELECTRONIC ARTS INC., a Delaware corporation,	)	**OPPOSITION TO MOTION BY DEFENDANT FUTURE PUBLISHING LIMITED FOR CANCELLATION OF REG. NO. 3,105,816**
Petitioners,	)	
v.	)	**AND THE RELATED Cancellation No. 92051465**
EDGE GAMES, INC., a California corporation and Future Publishing Ltd, a UK company Co-Defendants.	)	

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

OPPOSITION TO MOTION BY DEFENDANT FUTURE PUBLISHING LIMITED FOR CANCELLATION OF REG. NO. 3,105,816

Co-Defendant and Co-Registrant Edge Games Inc. opposes Future Publishing Limited's motion for cancellation of the trademark registration number 3,105,816 for the mark EDGE in Class 16. Grounds for opposing the motion are as follows:

1. It is unclear to Co-Defendant Edge Games what standing Co-Defendant Future is relying on in filing the instant Motion for Cancellation of the registered trademark No. 3,105,816. If Future filed their motion as a co-defendant in the ongoing cancellation proceedings

brought by Electronic Arts, then (a) these proceedings are currently stayed pending confirmation by the Board of our notice of Lead Counsel, and (b) now that this registration has had its Section 7 Surrender reversed (withdrawn) the registration is now back in this cancellation proceeding and subject to the rules of all such cancellation proceedings. Those rules, as far as Co-Defendant Edge Games is aware, do not extend to one of the defendants filing a unilateral motion of this kind without the express approval and consent of the other co-defendant, Edge Games. And Edge Games certainly was neither asked its consent for Future to file this motion nor did it give its consent.

2. Further, it is Co-Defendant Edge Games' understanding that the matter Co-Defendant Future seeks to make a motion on has already been ruled on by the Board. The Board granted Edge Games' prior motion to withdraw the Section 7 Surrender and re-establish the cancellation proceedings with this registration now part of the proceedings again, and Future added as a party defendant with substantially the same grounds being argued by Future. In the prior motion regarding the withdrawal (reversal) of the Section 7 Surrender Co-Defendant Edge Games argued that the Board is not obliged to cancel the instant registration because the Stipulated District Court Final Judgment indicated it should cancel it, since the Judgment was clearly invalid due to Edge Games lacking the standing to file the Section 7 Surrender. Edge Games further argued that since Future was not a party to the District Court matter that rendered the Final Court Order invalid, at least as to this one registration (and in our recent motion we argue the Court Order was also rendered invalid, as was our other two Section 7 Surrenders, in respect to two further registrations -- 2,219,837 and 3,559,342 -- in this cancellation proceeding that are also jointly owned with Future Publishing).

3. Similarly, Petitioner Electronic Arts and (at that time) Intervener Future Publishing both argued that Edge Games' motion to withdraw (reverse) the Section 7 Surrender should be denied because the District Court Final Order called for the registration to be cancelled. Thus the same argument, and the same grounds as Future proffer in their latest motion, were already given in opposition to Edge Games' prior motion, and the Board already ruled that the Court Order would not be acted on insofar as this particular registration is concerned.

4. Thus when on July 11, 2011 when the Board ruled that Edge Games lacked authority to voluntarily surrender Registration No. 3,105,816 and granted Edge Games' Motion to Withdraw (Reverse) the Section 7 Surrender, the Board in effect also ruled that it did not agree with Petitioner Electronic Arts or (then) Intervener Future Publishing's argument that despite Edge Games' lack of authority the registration should still be canceled simply because the District Court had ordered it be canceled via stipulation.

5. Co-Defendant Edge Games does not believe that Future Publishing's new position as co-defendant in the instant cancellation proceedings gives it any appreciably different or greater standing to make the same argument again that the Board has already ruled against.

6. If Future Publishing were seeking to file their motion relying on their standing as co-registrants of the registration in question, then again their motion is improper and invalid. As a (co)registrant the kinds of action Future Publishing may take might include seeking to surrender their part of the registration via a mechanism such as a Section 7 Surrender, but (a) the proceedings are stayed at this time in regard to this particular registration and thus no new motions of this kind should be considered, (b) such a motion to surrender its portion of the registration would not be valid anyway since a partial surrender may not be considered or processed by the USPTO while there are ongoing TTAB proceedings relating to the registration in question, (c) clearly insofar as Co-Defendant Edge Games' permission or consent would have been required to make any such filing by Future valid no such permission or consent was sought or gained, and (d) in any event Future did not seek to take an action proper for a co-registration such as attempting a partial surrender, it sought to take an action to entirely cancel the mark which it does not have standing to do either as a co-registrant or as a co-defendant.

7. As Co-Defendant Edge Games has argued in its prior motion and other documents filed in these proceedings, since Future Publishing was a co-owner of Registration No. 3,105,816 at all relevant times and yet was not a party to the District Court Law Suit, therefore the Final Court Order was invalid at least insofar as it sought to cancel this instant registration. Even if the matter had been fully litigated before the District Court – which did not happen -- then the fact Future should have been a party to that action would have still meant that the court lacked standing to make a valid order relating to the instant registration.

8. However, as Edge Games has previously argued, in this case the issues – and in particular the issues relating to whether Registration No. 3,105,816 was valid or had been abandoned, etc -- were *not* fully litigated on their merits by the District Court and the Final Order was not arrived at as a result of the issues and facts being fully litigated in relation to this trademark registration. While it may be the case that in general the District Court is the higher court and the Board might usually be obliged to accept an Order of the District Court as Co-Defendant Future sought to submit, the Board is not obliged to act on or be bound by any District Court Order that is based on a stipulated outcome resulting from a settlement between the parties where the issues were not fully litigated before the Court. In this case, not only did the District Court not fully litigate the issues pertaining to this registration and its validity, etc, but the matter did not even get as far as discovery, let alone anywhere close to full litigation before a jury, or a final jury verdict. And as is a matter of public record, the District Court matter in question was to be a jury trial.

9. It is well established that where a District Court Final Order is a stipulated order arising out of the parties having settled then the USPTO and the Board are not obliged to act on said Order and are not obligated to follow the Final Judgment or Order. Co-Defendant Future's reference to *The Other Telephone Co. v. Connecticut Nat'l Telephone Co.*, 181 U.S.P.Q. 779, 781-82 (Comm'r of Patents 1974) stating that 'Court adjudications are "binding" on TTAB, whereas TTAB decisions are not binding on District Courts" does not pertain where a District Court adjudication is the result of a stipulated outcome resulting from a settlement between the parties and where the issues in question were never fully litigated on their merits.

10. The fact Co-Defendant Future had a right to be a party to both the District Court action and the Electronic Arts Settlement, and yet was not, means that the District Court Final Order and the Settlement are both *invalid*, at least insofar as they relate at all to the instant Registration No. 3,105,816 (and Edge Games would argue also both invalid in respect to Registration Nos. 2,219,837 and 3,559,342 , too) . Co-Defendant Future's new standing as a defendant party in the instant cancellation proceedings does not provide Future with a valid basis to merely "waive any objection arising from the fact that [Future] was not a named party to the District Court action or the Settlement Agreement" as Future seeks to argue. Future's waiver does not alter the validity of either the Stipulated District Court Order, or the Settlement – it is

the fact Future should have been a party to both the court action and the settlement, and yet was not, that renders both invalid as to this registration, and no mere 'waiver' of rights by Future can now render either the court order or the settlement valid as to this registration's cancellation (or, indeed, in respect to the other two registrations also co-owned by Future and Edge Games).

11. Indeed, the idea that a waiver at this late date by Future could cause the Board to be obligated to act on the Stipulated Court Order is illogical and we submit has no foundation in Board policy or US trademark law. What rendered the Stipulated Court Order, the Settlement and the Section 7 Surrender all invalid was the fact that Edge Games executed all relevant documents pertaining to these *as if* it was the sole owner of this registration 3,105,816. What was lacking in each case was Co-Defendant Future being a party to the Court action, the settlement negotiations and the Board Cancellation proceedings and the lack of Future's signature *at the relevant times* in question on each relevant document in question. No waiver now by Future can change the fact that it was the co-owner of record of this registration 3,105,816 at all relevant times relating to the Stipulated Court Order, the Settlement and the Section 7 Surrender, thus no waiver by Future can alter the validity of any of these documents or actions.

12. For Registration No. 3,105,816 to be validly cancelled would involve Co-Registrant (Co-Defendant) Future Publishing filing a document at this time that specifically states it opts to cancel or surrender its portion of the instant registration. However, no 'waiver' by Future now can stand in any sense as a retroactive formal execution of any document in the past by Future that would amount to a surrender or cancellation of its portion of registration 3,105,816. Further, the filing of any such document would not permit Co-Registrant Future to cancel or surrender its ownership of its portion of the registration at this time: no such document can be considered by the USPTO while the Board proceedings are ongoing. Moreover, it is probable that for any such filing by Future to be valid, Future would first have to file a request to divide the instant registration into two separate registrations and then file a Section 7 Surrender of that new registration formed from its part of the instant registration. No such actions to divide the instant registration, or otherwise modify the instant registration, can be done while the Board proceedings are ongoing. Further, Future has not gained Co-Registrant's consent or permission to file any document that would stand as a joint surrender of the registration, and Future does not have the standing on its own to file any document requesting cancellation of the *entire*

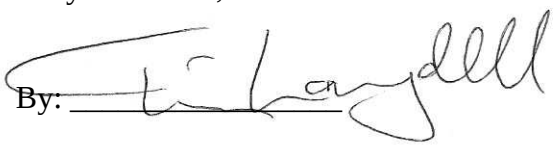
registration (just as Edge Games lacked authority to file the Section 7 Surrender on its own, as the Board has already ruled).

In summary, Co-Defendant/Co-Registrant Future Publishing's Motion For Cancellation of the Mark Registration No. 3,105,816 pursuant to the Stipulated District Court Final Judgment should be denied. By virtue of being a stipulated judgment where the facts and issues were not fully litigated on their merits (indeed it was a jury trial and there was no discovery, let alone a trial), the Stipulated District Court Judgment was not valid insofar as it relates to Registration No. 3,105,816 and the TTAB is not obligated to act on the Court Judgment under such circumstances. Further, Co-Defendant lacks any standing at this time to unilaterally file any document that would cause the instant registration to be cancelled *in its entirety*. Now that the instant cancellation proceedings are once again about to recommence, and since the instant registration is once again subject to the instant cancellation proceedings, in regard to this registration the Board should only be considering documents filed jointly on behalf of both defendants regarding this registration, and not considering any documents or motions of this nature filed by just one defendant in respect to the instant registration.

For all the above reasons, Co-Defendant Future's Motion should be denied.

Date: August 9, 2011

Respectfully submitted,

By: 

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