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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 Nos. 3,5713,604 and 2,219,837
For the Trademarks THE EDGE and EDGE

EA DIGITAL ILLUSIONS CE AB, a Swedish Corporation; ELECTRONIC ARTS INC., a Delaware corporation,	**CO-DEFENDANT EDGE GAMES INC'S REPLY TO PETITIONERS' OPPOSITION TO EDGE GAMES' MOTION TO REVERSE DIVISION OF REG. NO. 2,219,837 OR TO BRING CHILD REG. NO. 3,713,604 INTO THESE PROCEEDINGS**
Petitioners,	
v.	
EDGE GAMES, INC., a California corporation and Future Publishing Ltd, a UK company	
Co-Defendants.	**Cancellation No. 92051465**

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
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Co-Defendant Edge Games Inc ("Edge") replies to Petitioners' Opposition to Edge's motion to reverse the division of Reg. No. 2,219,837 or to bring Child Reg. No. 3,713,604 into these proceedings as follows:

1. Edge does not dispute that this is Petitioners' cancellation proceedings, but Edge does dispute that it is Petitioners' sole right to determine which registrations are at issue. Just as it was the Board's decision which entities should be a party to these proceedings, similarly it is the Board's decision which registrations are at issue. If, as in this case, Petitioners make allegations against one registration that directly impact another registration, then even though Petitioners have not named that other registration still that registration must be part of the proceedings since it is impacted by the proceedings.

2. In its original petition filed with the Board[1] Petitioners listed Reg. No. 2,219,837 as one of the registrations it was seeking to cancel: and Petitioners described the registration thus (page 19 of the petition, ¶ 33, Doc. No. 1):

Registration No. 2,219,837: EDGE

> *According to the USPTO records, Registration No. 2,219,837 issued January 26, 1999 to The Edge Interactive Media, Inc., for and in connection with "printed matter and publications, namely magazines, newspapers, journals, and columns and sections within such magazines, newspapers, and journals, and pamphlets and booklets, all in the field of business, entertainment, and education, relating to toys, games, computers, computer software, computer games, video games, board games, hand-held games, interactive media, television, interactive music, and video; stationery; posters; exterior packaging for software, namely, cardboard cartons; printed inserts for plastic packaging of software; paper bags; plastic bubble packs for packaging; envelopes; and paper pouches for packaging," in Class 16, claiming first use date and first use in commerce date of May 1984.*

3. Petitioners then go on to state in its petition (Doc. No. 1 at ¶34) that while there were two attempts to partially assign part of this registration from The Edge Interactive Media Inc ("Edge Interactive") to Future Publishing Ltd ("Future"), the most recent assignment activity on the USPTO record is of The Edge Interactive Media Inc assigning the entire interest in the registration (not just that interest owned by Edge Interactive) to Edge Games, Inc. While throwing the assignment into some confusion, this factual statement in the petition does not suggest Petitioners' allegations are restricted to Edge's partial interest or to any parent registration.

4. While Petitioners go on to say that in July 2009 Co-Defendant Future requested division of the registration (¶ 35, Doc. No. 1), at no point do Petitioners state that they are restricting their allegations – or restricting these proceedings – to that part of the registration owed by Edge Games. Petitioners do <u>not</u> define what they mean by "Reg. No. 2,219.837" as only

[1] Indeed, this is the same definition and description of Reg. No. 2,219,837 given in Petitioners' Amended Petition, too.

that part of the original registration owned by Edge. On the contrary, while the fact Future made a request to divide the registration is referenced, Petitioners go on to state that they believe the entire mark has been abandoned and/or the entire mark "was fraudulently obtained, maintained or renewed," once again clearly referring to the entire original registration as defined in Petitioners' paragraph 33 of their petition (see ¶ 36 & ¶ 37 of Doc. No. 1).

5. Petitioners then go on in their petition in ¶ 37 (a), (b) and (c) to clarify that their allegations of fraud include (by the stated scope in using the term "obtained") the original act of registering the mark in August 1994 as well as maintenance and renewal events that occurred in 2004 and early 2009, all before the request to divide the registration was made in July 2009, and well before the registration was actually divided in late 2009. Similarly, Petitioners accusations that the registration has been abandoned by reference to Section 45 of the Lanham Act include almost solely the period when the original registration was not divided. Hence the accusations of non-use in the original petition – that define which registrations are properly part of these proceedings – refer to the entire original undivided registration, not just the part of the registration owned by Edge.

6. Were Petitioners' allegations of non-use of this registration proven – which allegations Edge maintains they won't be – then the result would be the cancellation of the entire original registration. Even if there was found to be a valid division of the registration, then were there a finding on non-use of the registration prior to division then both the parent and the child registrations would be cancelled, not just the parent.

7. Even more clearly, if any of the allegations of fraud, and most notably the allegation of fraud Petitioners make of "obtaining" this registration in 1994, were found to be proven – which Edge maintains they will not be – then naturally the entire original registration would be cancelled. It follows both legally and logically that were the Board to find that the original 1994 filing was fraudulent (or indeed any of the renewals prior to the date of division in late 2009), then the entire registration would be cancelled. Thus even if the division is upheld as valid then a finding of fraud relating to the original filing of the mark or any of its renewals would logically and legally call for both the parent and child registrations to be cancelled.

8. It is patently absurd for Petitioners to assert – as they appear to be doing – that they have the right to cast a form of "immunity" on a child registration while still alleging that the original undivided registration was fraudulently obtained, maintained or renewed. Clearly any accusation that refers to a period before a mark was divided *has to* impact both the parent and child registrations post-division.

9. Further, when Future took over partial ownership of the original registration Future also took on liability and responsibility for all historic and ongoing actions pertaining to the registration. Thus by becoming joint owners of this registration Future became equally liable with Edge in respect to all allegations of at least fraud pertaining the obtaining, maintenance and renewal of the mark – even where such actions predated Future becoming a part-owner, and certainly all accusations relating to 2008 and early 2009 referenced by Petitioners in its petition. Support for this view is found in the USPTO database where the TDR file on the '604 Child Registration has associated with it all of the filings ever done on the original parent registration – the original filing, all maintenance filings and all renewal filings. Thus all the issues Petitioners target at the registration are also targeted at the Child Registration in any event due to the shared/common filing history between a parent and child registration.

10. Petitioners refer to having filed an Amended Petition to Cancel, however these proceedings were suspended immediately after that Amended Petition was filed. As far as Edge is aware, the Board has not yet ruled on whether it will permit the Amended Petition to be considered. It is thus at this point possible that the Amended Petition will be rejected.

11. Further, even if the Amended Petition is accepted into these proceedings, it does not successfully elect to not seek cancellation of the '604 Registration, nor does it compel the Board to exclude the '604 Registration. The section of the Amended Petition defining what Petitioners refer to by "Reg. No. 2,219,837" is substantially the same as the section in the original petition. The Amended version does not define Reg. No. 2,219,837 as being that part of the registration owned by Edge. As with the original petition, the Amended Petition still defines this registration as including all goods and services of the original 1994 application including the goods allegedly assigned to Future (see ¶ 34 of Doc. No. 16). In addition, the Amended Petition still just refers to Future requesting division of the registration in July 2009 and makes no

reference to the registration now being divided and makes no mention of the '604 Child Registration. No where in this section (¶ 34 to ¶ 39) do Petitioners mention their allegations just being in regard to Edge's part of the registration or to excluding the '604 Child Registration from their allegations.

12. In its Claims for Relief in its Amended Petition, Petitioners still allege non-use of this registration and fraud in obtaining, maintaining and renewal of this registration, with no reference at all to not including the '604 Child Registration in these proceedings.

13. Indeed, Petitioners' statement at ¶ 4 in its Opposition (Docket 61 & 62) would appear to be false: to Edge's belief, **no where in the Amended Petition (Doc. No. 16) is there any reference to the '604 Child Registration,** let alone any reference to Petitioners' not seeking to cancel the '604 Registration or to Petitioners' only seeking to cancel Edge's part of the '837 registration. **No where in the Amended Petition (¶¶ 34-39 of Docket 16) is there any mention of Petitioners specifically electing not to seek cancellation of the '604 Registration.** Indeed, aside from the addition of one paragraph that was not in the original petition, and some new wording and minor added detail to the Claims for Relief, the Amended Petition would appear to be identical to the original save that Petitioners sought to add wording to address the Board's finding in its Denial of Summary Judgment (Doc. No. 14) that the original petition did not adequately allege fraud. And none of this new wording pertains to the '604 Child Registration as Petitioners falsely claim in ¶ 4 of their instant Opposition/Reply Brief. Indeed, since Petitioners raise the issue, had they intended to exclude the '604 Child Registration from these proceedings and only seek to cancel the parent registration (or that part of the original registration owned by Edge) then Petitioners would have said that in their Amended Petition – but they did not.

14. It is simply not true that in the settlement of the District Court litigation Petitioners and Edge expressly agreed that the '837 Registration would be cancelled, not the '604 Child Registration. Indeed, the '604 Child Registration is not mentioned anywhere in either the settlement between Petitioners and Edge or in the District Court Stipulated Judgment. Insofar as Reg. No. 2,219,837 is referenced in either document, it is left undefined as to whether this means

the original undivided registration filed in 1994 that Petitioners were attacking for fraud and non-use, or whether it means the parent registration remaining after division, or both.

15. Edge's voluntary surrender of the '837 Registration was, to the best of Edge's knowledge and belief, invalid for several reasons. First, at the time it was filed Edge believed there was a valid court order requiring Edge to file the surrender on a with prejudice basis. However, Edge subsequently learned that the stipulated court judgment was void on its face since a Necessary Party (Future) was not a party to the proceedings. Similarly, at the time Edge believed there was a valid settlement agreement with Petitioners that also called for Edge to file the surrender, but Edge later learned that the settlement agreement was also invalid since it took failed to include a Necessary Party (Future) whose participation in the settlement was necessary for it to be valid. Further, Edge now believes that the '837 Registration should not have been divided since while the request to divide was made before the instant cancellation proceedings commenced, the division did not take place until some months after they had commenced. And it is Edge's understanding that all post-registration actions on a registration are to be stayed pending the outcome of any cancellations proceedings before the Board.

16. As to Petitioners allegation that Edge is in violation of the settlement agreement or in contempt of the Court's Final Judgment, Edge disagrees. Edge is seeking reversal of the surrender of the '837 Registration and reversal of the division of the '837 Registration (or to bring the '604 registration into these proceedings), because on information and belief Edge understands the settlement agreement and the Court's Final Judgment were both invalid because a Necessary Party (Future) was not a party to either the court proceedings or the settlement. Further, Edge's request to reverse the '837 Registration surrender is also premised on Edge's belief that the registration should not have been divided and is thus still co-owned by both Edge and Future. If the court judgment is not void or invalid, or if Edge did have the authority to surrender, then Edge is not asking for the '837 Registration surrender to be reversed. Since Edge is only asking for reversal of the surrender since it understands the court judgment is void, then logically Edge cannot be in contempt of a void judgment. Similarly, since Edge's actions contrary to the settlement are only on the understanding the settlement is invalid, then logically Edge cannot be in violation of an invalid settlement.

17. To be clear, **as co-owners of several of the trademark registrations in question, Future was an *indispensable party* and *necessary party* to the District Court action: since Future was not a party to that suit, no valid final judgment could lawfully be made. Accordingly, the final judgment issued by the District Court was invalid and void on its face (not merely voidable). Similarly, since Future was also a *necessary party* to any settlement regarding co-owned trademarks, and since it was not a party to the settlement between Petitioners and Edge, consequently the settlement is invalid.** Future agreed with this position in their Intervener Response (Docket 40) and explicitly stated (page 2 of Doc. No. 40) that since Future was not a party to either the civil litigation or these proceedings and was not a party to the settlement agreement that resulted in "the attempted termination of these proceedings," that thus Edge had no right nor the authority to negotiate the surrender of the registrations. Future thus effectively confirmed that the civil proceedings and the settlement were invalid since they should have been a party to both.

18. Neither the Board, nor the Commissioner For Trademarks, is obliged to comply with a District Court Order that is clearly invalid. Indeed, the Board should not comply with a void judgment. The District Court Judgment sought to bind and/or impact a third party (a non-party) – Future Publishing Ltd – in an action to which Future was not a party. It is axiomatic that any Judgment or Court Order that seeks to bind and/or impact a third party who was not a party to the action (a "non-party") is invalid and thus *void ab initio* (see Potenz Corp. v. Petrozzini, 170, Ill, App, 3d 617, 525 N.E. 2d 173, 175 (1988). Where a court seeks to make an order that would bind a non-party then all that is required to determine the order is void is to inspect the record of the case and determine that the party the court sought to bind and/or impact (here Future) was not a party to the case. That being determined then the order (judgment) is automatically deemed *void ab initio*.

19. It is a common misconception even among attorneys that only a judge can declare an order or judgment void, but this is not the law. If a court acts beyond its authority – here seeking to bind and/or impact an entity that was not a party to the law suit – then the judgment in question and all orders arising from the judgment are automatically void. As the U.S. Supreme court stated "Courts are constituted by authority and they cannot go beyond that power delegated to them. If they act beyond that authority, and certainly in contravention of it, their judgments

and orders are regarded as nullities. They are not voidable, but are simply void, and this is even prior to reversal"[emphasis added] (Vallely v. Northern Fire and Marine Ins. Co., 254 U.S. 348, 41 S. Ct. 116 (1920). See also Old Wayne Mut. I. Assoc. v. McDonough, 204 U.S. 8, 27 S. Ct. 236 (1907); Williamson v. Berry, 8 How. 495, 540, 12 L.Ed, 1170, 1189, (1850); Rose v. Himely, 4 Cranch 241, 269, 2 L.Ed. 608, 617 (1808).

20. That is, any judgment or order that seeks, even just in part, to bind and/or impact a person or entity that was not a party to the court action is invalid in its entirety. It is not merely "voidable" (in the sense of being *subject* to *being* voided by a judge upon a motion to vacate or similar or upon appeal), such judgments and such orders are automatically void. Indeed, case law (see above) states that such judgments and orders by virtue of being void, rather than voidable, may not be appealed and may not have motions in respect to them filed for them to be vacated or modified. The judgment or order in question being *void ab initio* in a real sense does not exist, and thus cannot be modified, vacated or appealed.

21. But to be clear, though, the '604 Child Registration **was** effectively part of the District Court Action even though it was not specifically named in the Court's Final Judgment. All references to Reg. No. 2,219,837 in the court action did not clarify whether the registration reference was to the original undivided registration, the parent registration (post division) or to both. But by clear implication because Petitioners specifically alleged in the court action that there had been fraud committed in the *procurement*, maintaining and renewal of "2,219,837" then by definition legally these allegations were also being made against the '604 Child Registration, too. Indeed, it was partly because any jury decision at trial relating to fraud regarding the parent registration would have automatically impacted the child registration consequently meant Future was a Necessary and Indispensable Party to the court action.

22. Contrary to what Petitioners allege in their Opposition, Edge does dispute the assignment to Future and does dispute Future's right to divide the original registration into parent and child in the manner that they did. **If Edge had abandoned this registration prior to the partial assignment to Future – which Edge denies – then the assignment to Future would be invalid, and consequently any division would be invalid, too**. Similarly, **if Edge committed fraud in obtaining, maintaining or renewing the registration – which Edge denies – prior to**

the partial assignment to Future, then once again the assignment would be invalid, and any division would be invalid. Since all these allegations against Edge are part of Petitioners original and amended petition to cancel, it follows that the outcome of these instant proceedings will determine if there was a valid assignment to Future and whether a division should have occurred. It is precisely because the proceedings before the Board can impact any and all post-registration actions that usually no post-registration action is taken after Board proceedings have commenced – even if the request to take such action occurred prior to commencement of proceedings.

23. Further, Edge disputes the division of the registration in any event. By dividing the original registration Future have created a new registration that falsely (fraudulently) claims Future's first use of the mark for the goods and services in question was May 1984. However, it is widely acknowledged that Future's first use of the mark Edge was on a magazine it launched in 1993. This problem was avoided so long as the registration remained co-owned by Future and Edge and was not divided. Further, in filing its request for division on or about July 31, 2009, Future failed to include a copy of the assignment document with their request. The USPTO was thus provided with no proof that the assignment was as Future alleged it to be and that the goods in the original registration were rightly to be divided up as Future claimed. The post-registration section processed the division taking Future at their word which they should not have done. Furthermore, Edge was an interested party in the division and yet was neither copied with the request for division nor given the opportunity to protest or oppose it. For all these reasons, too, the division was improper, should not have occurred and should be reversed.

24. Petitioners' reference to the fact Edge filed its voluntary surrender on a *with prejudice* basis does not mean Edge gave up its right to reverse the surrender. After it had filed the surrender Edge discovered the full extent of the fraud by Petitioners on the district court and on Edge in obtaining both the stipulated judgment and the settlement. Further, Edge discovered procedural issues and the fact that the judgment and settlement were invalid after it file the voluntary surrender. Under these circumstances Edge has every right to reverse a surrender (indeed was obliged to reverse it if it lacked the authority to file it), and cannot and should not be prevented from doing so because it was originally filed on a *with prejudice* basis.

25. Edge notes again that **Future laid claim to being the sole owner of Registration 2,219,837 (by implication, both the Parent and Child Registrations)**.[2] As bizarre as this claim might be, the fact is Future have made this claim to the USPTO and it is part of the record the Board will need to consider – frankly, even if Future now seek to deny it or claim the statement was made in error. Since Future have laid claim to owning the entirety of registration 2,219,379, clearly it calls into question whether Edge had the authority to file the voluntary surrender, agree to the stipulated judgment or to enter into the settlement with Petitioners. At the very least, this claim by Future formally puts in dispute who owns the Parent Registration, and thus calls into doubt whether Edge had standing to file the voluntary surrender. Further, Future's claim to own the entirety of 2,219,837, where their definition of being the sole owner clearly includes both the parent and child registrations, means that both the parent and child registrations must be part of these proceedings.

26. **Last, but far from least, Edge notes Future (which is most impacted by the Motion) did not oppose this Motion and thus presumably agrees with it.** The Board should thus reverse the division of Reg. No. 2,219,837 or in the alternate should bring Reg. No. 3,713, 604 into these proceedings.

Date: October 28, 2011

Respectfully submitted,

By: _____

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[2] See Section II of Future's Response to Office Action dated 27 June 2011, both in regard to their application for the mark EDGE Serial No. 85153958 and for EDGE Serial No. 85153981. In this section Future make a specific claim to being the sole owner of Reg. 2,219, 837 – both the parent and child portions. See: http://tdr.uspto.gov/jsp/DocumentViewPage.jsp?85153981/ROA20110627171523/Response%20to%20Office%20Action/7/27-Jun-2011/sn/false#p=3 (go to page 3).

Certificate of Service

In accordance with the Trademark Rules of Practice, as amended, it is hereby certified that a true copy of the foregoing Edge Games' Reply to Petitioners' Opposition To Edge Game's Motion to Reverse Division of 2,219,837 or Bring 3,713,604 into These Proceedings Filed by Petitioners was served on the following Co-Defendant and counsel of record for the Petitioners, by depositing same in the U.S. Mail, first class postage prepaid, this 28th day of October, 2011:

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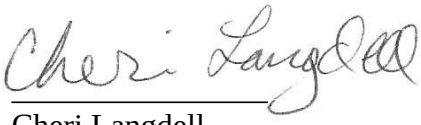

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