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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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Attachments	FurtherResponseToBoardsOrderOf30Mar2012.pdf (11 pages)(78396 bytes)

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

EA DIGITAL ILLUSIONS CE AB, **ELECTRONIC ARTS INC.,** **Petitioners in pro per,** **v.** **EDGE GAMES, INC.** **FUTURE PUBLISHING LTD** **Co-Registrants/Co-Defendants.**	**CO-REGISTRANT EDGE GAMES INC'S FURTHER RESPONSE TO THE BOARD'S ORDER DATED 30 MARCH 2012** **REQUEST BOARD TO ACT ON CONSENT MOTION TO DISMISS INSTANT PROCEEDINGS DATED 11/14/10.** **Cancellation No. 92051465**

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

1. In its March 28, 2012 Order the Board requested that Co-Registrant Edge Games Inc ("EDGE") make certain filings in the District Court and show proof of same to the Board or else the Board would act on the District Court's void final order and cancel five marks at least two, and we say three, of which are owned by **both** EDGE **and** Future Publishing Ltd ("Future"). Our prior response focused on the fact the court's order is void and thus the sole option the Board gave to EDGE to avoid cancellation of the registrations it co-owns with Future was to take action that EDGE cannot take and which the Board could not legally require EDGE to take.

2. While the Board asked that such filings in the District Court be done and proven to the Board within 20-days, we note that the Board did not limit EDGE to 20-days for giving responses to the Board's order. EDGE thus believes that this further response is timely and in any event respectfully requests that in good faith, and in the interest of reaching decisions that are just and equitable in the proceedings, the Board do consider this further response.

A. On November 14, 2010 the parties lodged a Motion On Consent Requesting Dismissal of the Proceedings and thus the proceedings should have been dismissed on the terms agreed by the parties in November 2010.

3. In November 2010 Petitioners and EDGE reached a modified settlement agreement, namely that on the sole condition EDGE filed (note, *filed*, not that it file and be successful) voluntary surrenders of each of the five registrations herein, then Petitioners consented to the dismissal of these proceedings. EDGE met the terms of this consent motion agreement by filing the voluntary surrenders of the five instant registrations which was part of a "Motion on Consent" requesting dismissal of the instant proceedings (see docket #31). Petitioners met the terms of the inter-parties agreement on their part by consenting to the instant proceedings being dismissed (see docket #33, referencing Petitioners agreement to the motion in

#31). And at no time have Petitioners ever asked that agreement to dismiss the proceedings by consent motion be reversed or withdrawn.

4. It is EDGE's belief that because of the unusual turn of events that then followed after November 2010, the Board may have lost sight of the fact that Petitioners consented to the dismissal of these proceedings and nothing that has transpired since November 15, 2010 has reversed Petitioners' agreement to dismiss the instant proceedings, and at no time have Petitioners asked the Board for permission to withdraw or reverse its consent to dismiss these proceedings of November 2010. Consequently, the proceedings should be dismissed as the Board was requested to do at the parties' mutual request embodied in the Motion on Consent of November 14, 2010 – and on the terms, and *only* those terms, agreed between the parties in November 2010.

5. What transpired starting in February 2011 was that Co-Registrant EDGE discovered that the voluntary surrenders that it filed in November 2010 in accord with the agreement to end these proceedings were not valid in some instances because it was not the sole owner of the marks being surrendered. The Board then subsequently agreed that in respect to at least one of the instant registrations (Reg. No. 3105816) EDGE was correct, and it did lack standing to surrender a registration it was not the sole owner of.

6. As a result of the Board's decision (see docket #42) EDGE's voluntary surrender of Reg. No. 3105816 was reversed. However, the Board then ruled that in respect to this registration the inter-party proceedings were once again before the Board, and the Board brought Future in as a Co-Defendant in these proceedings. With deep respect, this decision by the Board in July 2011 was in error in one key regard: While the Board was correct to add Future as a Co-Defendant in these proceedings (since Future is the co-owner not only of Reg. No. 3105816, but

also Reg. No. 3559342, and potentially Reg. No. 2219837, and hence Future has standing in issues still being resolved as part of the consented dismissal of these proceedings), what the Board overlooked was that on November 14 and 15, 2010 Petitioners and EDGE consented to these proceedings being dismissed. That **Motion on Consent** in which the parties agreed to and requested the Board dismiss these proceedings was never withdrawn or reversed and the inter-party agreement to dismiss these proceedings on terms stated in November 2010 **still stands**.

7. That is, what the Board's decision of July 7, 2011 to reverse EDGE's voluntary surrender of Reg. No. 3105816 should have lead to is the dismissal of these proceedings per consent of Petitioners with this registration (at least) remaining registered. There was no reasonable basis for the Board to overlook Petitioners consent to dismiss these proceedings just because EDGE's motion to withdraw its voluntary surrender of Reg. No. 3105816 had been granted. The dismissal was on condition that EDGE *file* the surrenders, not that EDGE had to be successful by so doing in getting all of its registrations cancelled. When EDGE's motion to reverse its surrender was granted Petitioners did not then seek to reverse their prior consent to dismiss the instant proceedings. Indeed, Petitioners would have no basis to ask that their consent to dismiss these proceedings be reversed, since EDGE adhered *to the letter* of its new agreement with Petitioners to have the instant proceedings dismissed by filing the voluntary surrenders not by invoking the Court Order (which request Petitioners withdrew; docket #33). There was no term of the agreement between Petitioners and EDGE that if any of EDGE's voluntary surrenders were later found to be invalid that thus the inter-party consent motion to dismiss the instant proceedings was to be reversed and the proceedings were instead to continue.

8. With deep respect, once the parties consented by consent motion to dismiss the instant proceedings then these proceedings should have been dismissed. The only outstanding

issues since November 15, 2010 before the Board should have been the status of each of the five instant registrations as at the time of dismissal of the proceedings. Indisputably, at the very least the proceedings should have been dismissed with EDGE's Reg. No. 3105816 still being registered in EDGE's name. EDGE then introduced the entirely valid motion that at the very least at the time of dismissal of these proceedings EDGE's Reg. No. 3559342 should also still be registered in EDGE's name, too.

9. The only question that should currently remain before the Board, arising out of EDGE's subsequent valid and pertinent motions, is the final disposition of EDGE's Reg. No. 2219837 as at the time of dismissal of these proceedings. Rightly, that should be the sole issue still being litigated before the Board prior to dismissal of the proceedings on term agreed between the parties in November 2010 – which differ from the stipulated court order. And in this regard, EDGE's motion for reconsideration of the status of this registration is, with respect, very valid. The registration should not have been divided while the instant proceedings were ongoing. The division of the registration should thus rightly be reversed, and thus Reg. No. 2219837 should be rightly accepted as also co-owned by Future and EDGE. And as a further consequence of this corrective action by the Board, this registration, too, should remain registered to EDGE at the dismissal of these proceedings that the parties jointly motioned the Board to act on.

10. Since the parties consented by motion to dismissal of these proceedings in November 2010, EDGE respectfully believes the Board should not have had its attention diverted to consideration of whether it should be acting on the District Court's (void) Final Order since that became moot when Petitioners and EDGE reached their new consent agreement in November 2010 in regard to the instant proceedings. The recent submissions on this topic should thus have been disregarded, since it had already been agreed by Petitioners and EDGE that the

instant proceedings would be dismissed as of November 14, 2010. There is a firm, irreversible agreement between Petitioners and EDGE of November 2010 that these proceedings be dismissed once EDGE had filed its voluntary surrenders. If, has happened, one or more of those voluntary surrenders were found invalid, then the proceedings should still have been dismissed and all that should have been impacted is the status of EDGE's five registrations as at the date of the dismissal of proceedings.

11. That is, the inter-party agreement reached between Petitioners and EDGE in November 2010 superseded any prior agreement or settlement between the parties, including anything contained in the stipulated judgment (even though it was void). The new consent agreement between the parties embodied in the November 14, 2010 motion thus became the sole motion before the Board that should have impacted ending of these proceedings (only by dismissal, on consent). Consequently, since Petitioners and EDGE agreed on Consent Motion in November 2010 to dismiss these proceedings; the proceedings thus should have been dismissed on the terms that the parties agreed to as stated in the Motion on Consent of November 14, 2010.

B. The March 30, 2012 Board order does not ask Future to appeal or seek any relief of the Court's (void) Final Order that ordered registrations Future co-owns be cancelled. Thus the Board implicitly suggests that Future, despite being co-owner of at least two, we say three, of the registrations in question, has no standing to appeal or seek relief of the (void) order. The Board's own March 30 order thus reveals the Court's Final Order is clearly invalid; that the Court's Order *must* be void.

12. The Board's March 30, 2012 order does not ask Co-Defendant (Co-Owner) Future to seek relief from the District Court's final order, by any method including a motion filed with the District Court or by Appeal. While the Board does not state why the Board only asked one of the two defendants, one of the two *owners*, to seek such relief from the District Court, perhaps the Board saw no point in suggesting Future file any motion with the District Court to seek relief from the order, or appeal against the order, since Future has elsewhere stated that it

does not disagree with the order. However, that is not the point – the crucial point is that **even if** Future disagreed with the District Court's Final Order, Future has no standing to either seek relief from the order by filing any motion or to file an appeal against the Final Order.

13. It is thus of vital importance, we believe perhaps overlooked by the Board, that the Board would clearly have no right to suggest to the co-owner of these marks in danger of being canceled that it seek relief from the court order. The Board could not ask Future to seek such relief from the Final Order, even though the final order directly impacts trademark registrations Future is co-owner of, because to seek relief from the order or to appeal the order Future would have had to be a party to the court action. That is, to get relief or to appeal Future would have needed to be named in the Final Order and thus named as a party in the proceedings – and of course it was not.

14. Consequently, the very fact that the Board could not ask Future to seek relief from the Final Order, despite Future being co-owner of the marks impacted by the order to cancel them, proves that the court's order is clearly invalid – clearly void. Thus all the Board has to do to test whether the District Court's Final Order is void or not, is to consider whether Future has standing to either seek relief from the Final Order by filing a motion with the District Court, or whether it could get relief by way of appealing the Final Order. And clearly Future cannot take either of those actions since to take either action Future needed to be named in the Order and had to be a party to the court action. Thus it is inherent in the fact the Board did not – and *could not* -- suggest Future seek relief from the order that the Board must surely be able to deduce that the order clearly is indeed void, is indeed invalid.

15. The same principal that lead the Board to correctly rule that EDGE's motion to withdraw the voluntary surrender of Reg. No. 3105816 is exactly the principal that the Board

should invoke in looking at the Court Order and at where Future now standS on its right (or lack thereof) to challenge or seek relief from the court order. The Board acknowledged (docket #42, July 11, 2011) that EDGE on its own lacked standing to voluntarily surrender a mark that it was not sole owner of. It is in essence the same legal basis and the same principal that identifies EDGE could not be the sole party to a law suit that ordered the cancellation of any registration that EDGE was not sole owner of. It is also in essence the same legal basis and the same principal that identifies EDGE was the only one of the two owners that the Board could have possibly suggest file for relief in the District Court since the Board knows that Future has no standing to file such appeal or for such relief. Consequently, the March 30, 2012 order was wrong since what it asked goes directly against the principal that the Board previously, correctly, invoked and stood behind when the parallel issue of EDGE's right to unilaterally surrender a jointly owned registration was considered.

16. Last on this point, EDGE notes again that in its Intervener's filing (docket #40) Future itself made clear that neither the settlement agreement between EDGE and Petitioners, nor the District Court Final Order, could be valid since for either to be valid then Future would have had to be a party to the settlement and to the court action that gave rise to the final order. Thus it should not be overlooked that the co-defendant is also on record as essentially agreeing with EDGE that the Court Order and Settlement Agreement were both invalid – both void on their face – since Future was not a party to either. This is not a position that only EDGE is holding, then, not an argument that only EDGE has made. Future clearly agrees with EDGE on this crucial, central point.

17. To remind the Board, at page 3 of docket #40, Future clearly stated:

"*Future further objects to Petitioners' Opposition to Motion to Withdraw (Reverse) Section 7 Surrender of Reg. No. 3,105,816, insofar as Future was not a named party to the civil litigation and these proceedings, and was not included in the settlement agreement that resulted in the attempted termination of these proceedings. As a result, Registrant (EDGE) had neither the right nor the authority to negotiate the surrender of Future's interest in the Subject Registration*."

What Future is clearly stating here – as EDGE has also stated repeatedly -- is that both the court proceedings (and thus the Court's Final Order) and the settlement agreement between Petitioners and EDGE were invalid on their face (without needing a court order or motion to confirm invalidity) since Future was clearly not a party to either.

Conclusion.

18. In conclusion, the parties to this proceeding agreed in a consent motion in November 2010 that the instant proceedings were to be dismissed upon EDGE filing voluntary surrenders of the five registrations in question. That agreement between Petitioners and EDGE, and the consent motion's request to the Board to dismiss the proceedings, was not premised or conditioned on EDGE being successful in its motions to surrender each of the registrations. EDGE merely had to be on record as filing the surrenders and having attempted to surrender the registrations even if it failed to be permitted to do so. EDGE's position is that it failed – or should have failed due to lack of authority -- on at least two of the motions to surrender, and we say three, because it lacked authority to surrender the marks as it was not the sole owner of either mark. EDGE submits that the third mark should also be on record as co-owned by Future and EDGE and hence the surrender of it, too, should have failed (the withdrawal/reversal should have

been granted). These proceedings, then, should be dismissed with at the very least two of EDGE's registrations remaining registered in its name (not canceled). Further, the very fact that Future clearly could not be asked to seek relief from the District Court Final Order proves that the order must be void, must be invalid, since for it to be valid all parties impacted by the order must be named in the order, must be a party to the proceedings, and must have standing to appeal or seek relief of the order. Thus the District Court order is very obviously invalid and clearly void on its face. Since the Final Order is invalid and void *on its face* – that is, it is void based on facts that can be easily confirmed by checking the public record and noting Future was not a party – there is no lawful, reasonable or just basis for requiring EDGE to seek a court order confirming the Final Order to be void. The Board should accept the Final Order as void on its face. In any event, the fact the Final Order of the District Court is void should be moot to the Board since in these proceedings the parties agreed to dismiss the proceedings through a consent motion. Thus the Board should honor the parties' November 2010 consent motion and the proceedings should be dismissed leaving at the very least two, and we say three, of EDGE's five registrations still live and still registered to EDGE (Reg. Nos. 2219837, 3559342 and 3105816).

Date: April 20, 2012

Respectfully submitted,

By: ________________

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Certificate of Service

In accordance with Rule 2.105(a) of the Trademark Rules of Practice, as amended, it is hereby certified that a true copy of the foregoing CO-REGISTRANT EDGE GAMES INC'S FURTHER RESPONSE TO BOARD'S ORDER DATED 30 MARCH 2012 AND REQUEST BOARD TO ACT ON CONSENT MOTION TO DISMISS INSTANT PROCEEDINGS DATED 11/14/10 in these proceedings was served on the following parties of record, by depositing same in the U.S. Mail, first class postage prepaid, this 20th day of April, 2012:

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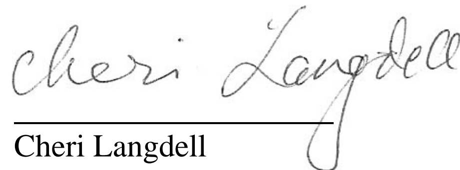

Cheri Langdell