

ESTTA Tracking number: **ESTTA582637**

Filing date: **01/19/2014**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

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| Name | Edge Games Inc | | |
| Entity | Corporation | Citizenship | CA |
| Address | 530 South Lake Avenue, 171 Pasadena, CA 91101 UNITED STATES | | |

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| Correspondence information | Dr Tim Langdell CEO Edge Games Inc 530 South Lake Avenue, 171 Pasadena, CA 91101 UNITED STATES uspto@edgegames.com, tim@edgegames.com Phone:6264494334 |
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Registration Subject to Cancellation

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| Registration No | 4394393 | Registration date | 09/03/2013 |
| International Registration No. | NONE | International Registration Date | NONE |
| Registrant | RAZER (ASIA-PACIFIC) PTE LTD 514 Chai Chee Lane #07-05 SGX SGX | | |

Goods/Services Subject to Cancellation

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| Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: computer tablet; computer keyboards and keypads adapted for use with computer tablet; batteries and power supplies for the aforementioned goods |
| Class 028. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: computer and video game controllers adapted for use with computer tablet |

Grounds for Cancellation

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| Deceptiveness | Trademark Act section 2(a) |
| False suggestion of a connection | Trademark Act section 2(a) |
| The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. | Trademark Act section 14 |
| Priority and likelihood of confusion | Trademark Act section 2(d) |

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| Dilution | Trademark Act section 43(c) |
| Other | <p>This registration infringes on our common law trademark rights dating from at least 1998 for the same mark and the same goods; applicant was well aware of our priority of use and the likelihood of confusion when it applied for the mark in bad faith. Indeed, when applicant applied to register the mark we still owned a live registration for essentially the same mark (hence the PTO should not have permitted it to go forward to publication), and while we no longer currently own those other registrations (3381826, 3105816, 3585463, 3559342, 2219837) it is not because we do not fully possess all our common law rights in all those marks since or about at least 1998 and in most cases since or about 1984. Further, the instant registration is preventing us from registering our own perfectly valid marks EDGE PC and EDGE GAMING PC (85891791,85891810). Last, we also own the application for the mark EDGE GAMES which the instant registration is in direct conflict with (Ser No 85147499), and the trademark office should have cited this earlier application against the instant application preventing it from going forward to publication. We note our application for EDGE GAMES in the same class for the same consumers, predates even the foreign mark application that the instant registration relied upon.</p> |

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| Related Proceedings | Serial #:85147499 Mark:EDGE GAMES Class 009, . Goods and Services: Computer game programs; Computer game software; Computer game software downloadable from a global computer network; Computer game software for use on mobile and cellular phones |
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Marks Cited by Petitioner as Basis for Cancellation

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| U.S. Registration No. | 3381826 | Application Date | 02/05/2006 |
| Registration Date | 02/12/2008 | Foreign Priority Date | NONE |
| Word Mark | GAMER'S EDGE | | |
| Design Mark |  | | |
| Description of | NONE | | |

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| Mark | |
| Goods/Services | Class 009. First use: First Use: 1986/06/01 First Use In Commerce: 1986/06/01 Computers; computer hardware; computer peripherals; computer games software; plug-on computer interface boards; computer accessories, namely, keyboards, mice, player-operated electronic game controllers for computers and electronic video game machines, computer memories, headphones, augmented reality headsets for use with computers and video game machines, virtual reality headsets for use with computers and video game machines, storedisc cases, video display and capture cards, sound cards, audio speakers, web-cameras, carrying cases and bags, all for carrying portable computers or computer accessories; video game software; videogame consoles, namely, video game machines for use with televisions and video monitors; video game accessories, namely, joysticks made for video games, video game interactive control floor pads and mats, and video game interactive remote control units; video game peripherals, namely, external hard drives for computers and video game machines and other storage devices in the nature of plug-in memory devices that attach to the USB port which are commonly known as "flash drives" or "thumb drives" and video adapters in the nature of adapters which convert the video output of the computer or videogame machine to the video input of a monitor or television; set top boxes, cable modems, dsl modems |

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| U.S. Registration No. | 3105816 | Application Date | 01/29/2003 |
| Registration Date | 06/20/2006 | Foreign Priority Date | NONE |
| Word Mark | EDGE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 016. First use: First Use: 1985/01/06 First Use In Commerce: 1985/01/06 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, computer magazines, video gamemagazines, magazines and posters about interactive entertainment; writing instruments, namely, pencils, ball point pens, ink pens | | |

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| U.S. Registration No. | 3585463 | Application Date | 12/14/2007 |
| Registration Date | 03/10/2009 | Foreign Priority Date | NONE |
| Word Mark | EDGEGAMERS | | |
| Design Mark |  | | |
| Description of | NONE | | |

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| Mark | |
| Goods/Services | Class 041. First use: First Use: 2006/07/01 First Use In Commerce: 2006/07/01 Providing organizations for online game administrators, namely, entertainment services in the nature of an online computer gaming club; providing public forums for online game administrators, namely, entertainment services in the nature of an online computer gaming club |

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| U.S. Registration No. | 3559342 | Application Date | 03/22/1996 |
| Registration Date | 01/13/2009 | Foreign Priority Date | NONE |

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| Word Mark | THE EDGE |
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| Design Mark | |
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| Description of Mark | NONE |
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| Goods/Services | <p>Class 009. First use: First Use: 1984/06/04 First Use In Commerce: 1984/06/04 Video game peripherals, namely, video game controllers; computers; computer accessories, namely, keyboards, mice; game controllers for computer games; memory cards; headphones; augmented reality headsets for use with computers; virtual reality headsets for use with computers; storage disc cases, namely, compact disc cases and DVD cases; video display and capture cards; audio cards; audio speakers; web-cameras; backpacks, carrying cases and bags all designed for carrying portable computers, computer accessories, and computer peripherals; video game machines for use with televisions and accessories therefore, namely, video game controllers; video game software; computer game software, computer game software for use in location based entertainment centers</p> <p>Class 016. First use: First Use: 1993/04/14 First Use In Commerce: 1993/04/14 Magazines, namely, magazines in the fields of business, entertainment, popular culture and education; Magazines, namely, in the fields of computer games, videogames, board games, hand-held games, interactive media, television, music, video, movie, clothing, fashion, leisure activities and lifestyle; computer and video game magazines, comic books, posters, note paper, note cards, bumper stickers, stickers, pencils, ball point pens, ink pens, stationery; folders</p> <p>Class 021. First use: First Use: 1995/08/12 First Use In Commerce: 1995/08/12 Mugs and cups</p> <p>Class 025. First use: First Use: 1995/08/12 First Use In Commerce: 1995/08/12 T-shirts, sweatshirts, jackets</p> <p>Class 028. First use: First Use: 1995/08/12 First Use In Commerce: 1995/08/12 Toys and playthings, namely, battery operated action toys, bendable toys, collectable toy figures, electronic action toys, electronically operated toy vehicles, fantasy character toys, mechanical action toys, modeled plastic toy figurines, model toy figures, plastic character toys, plush toys, positionable toy figures, toy action figures, toy boxes, toy figures; hand held units for playing games and accessories therefore, namely, carrying cases designed for hand-held units for playing electronic games; stand alone video game machines and accessories therefore, namely, carrying cases and covers designed for stand-alone video game machines</p> |
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| U.S. Registration No. | 2219837 | Application Date | 08/03/1994 |
| Registration Date | 01/26/1999 | Foreign Priority Date | 02/11/1994 |

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| Word Mark | EDGE |
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| Design Mark | |
| Description of Mark | NONE |
| Goods/Services | Class 016. First use: First Use: 1984/05/00 First Use In Commerce: 1984/05/00 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 fields of business, entertainment, and education, relating to toys, games, board games, television, interactive music, and video; stationery; posters; exterior packaging for software, namely, cardboard cartons; printed paperboard inserts for plastic packaging of software; paper bags; plastic bubble packs for packaging; envelopes; and paper pouches for packaging |

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| U.S. Application No. | 85891791 | Application Date | 04/01/2013 |
| Registration Date | NONE | Foreign Priority Date | NONE |

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| Word Mark | EDGE PC |
| Design Mark |  |

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| Description of Mark | NONE |
| Goods/Services | Class 009. First use: First Use: 1998/01/07 First Use In Commerce: 1998/01/07 Computer hardware; Computer hardware and peripheral devices; Computers and computer hardware; Desktop computers; Entertainment system comprising a computer, multiple image display screen, multiple input devices and a printer; Handheld computers; Handheld personal computers; Laptop computers; Netbook computers; Notebook computers; Personal computers; Personal digital assistant computers; Tablet computer |

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| U.S. Application No. | 85891810 | Application Date | 04/01/2013 |
| Registration Date | NONE | Foreign Priority Date | NONE |

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| Word Mark | EDGE GAMING PC |
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| Design Mark | EDGE GAMING PC |
| Description of Mark | NONE |
| Goods/Services | Class 009. First use: First Use: 1998/01/07 First Use In Commerce: 1998/01/07 Computer hardware; Computer hardware and computer peripherals; Computers and computer hardware; Desktop computers; Entertainment system comprising a computer, multiple image display screen, multiple input devices and a printer; Handheld computers; Handheld personal computers; Laptop computers; Netbook computers; Notebook computers; Personal computers; Personal digital assistant computers; Tablet computer |

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| U.S. Application No. | 85147499 | Application Date | 10/07/2010 |
| Registration Date | NONE | Foreign Priority Date | NONE |

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| Word Mark | EDGE GAMES |
| Design Mark | EDGE GAMES |
| Description of Mark | NONE |
| Goods/Services | Class 009. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Computer game programs; Computer game software; Computer game software downloadable from a global computer network; Computer game software for use on mobile and cellular phones |

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| U.S. Application/Registration No. | NONE | Application Date | NONE |
| Registration Date | NONE | | |
| Word Mark | EDGE | | |
| Goods/Services | computer tablet; computer keyboards and keypads adapted for use with computer tablet; game computers; computer game hardware and peripherals; computer and video game controllers; mobile game hardware; peripherals for mobile game hardware (common law rights dating back in most cases to at least as early as 1996) | | |

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|---------------------------------------|---|------------------|------|
| U.S. Application/ Registration No. | NONE | Application Date | NONE |
| Registration Date | NONE | | |
| Word Mark | GAMER'S EDGE | | |
| Goods/Services | game computers; computer game hardware and peripherals; computer and video game controllers; mobile game hardware; peripherals for mobile game hardware (common law rights dating back in most cases to at least as early as 1996) | | |

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| Attachments | 78807446#TMSN.jpeg(bytes) 77352656#TMSN.jpeg(bytes) 85891791#TMSN.jpeg(bytes) 85891810#TMSN.jpeg(bytes) 85147499#TMSN.jpeg(bytes) PetitionToCancelRegNo4394393.pdf(75944 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

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| Signature | /Tim Langdell/ |
| Name | Dr Tim Langdell |
| Date | 01/19/2014 |

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

In the Matter of Registration No. 4,394,393
For the Trademark EDGE
Issued September 3, 2013

| | | |
|------------------------------------|---|-------------------------|
| EDGE GAMES, INC. |) | |
| a California Corporation, |) | |
| |) | Cancellation No. |
| Petitioner |) | |
| |) | |
| v. |) | |
| |) | |
| RAZER (ASIA-PACIFIC) PTE |) | |
| LTD a Singapore Corporation |) | |
| |) | |
| Registrant |) | |
| _____ |) | |

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

PETITION FOR CANCELATION

Edge Games, Inc., a California Corporation having its principal business at 530 South Lake Avenue, 171, Pasadena, CA 91101 (“Petitioner”), believes it is being and/or will be damaged by the continued registration of Registration No. 4,394,393 for the mark EDGE in Classes 09 and 28 (herein the “Subject Registration”), in the United States Patent and Trademark Office (“USPTO”) by Razer (Asia-Pacific) PTE LTD, a Singapore corporation (“Registrant”) and hereby petition to cancel same under Section 14 of the Trademark Act of 1946, 15 U.S.C. § 1064.

As grounds for this Petition, Petitioner alleges the following:

FACTUAL BACKGROUND

Petitioner filed a timely Opposition to this registration, and also filed a timely Letter of Protest that has not yet been acted on.

1. Petitioner filed a timely first request for a 90-day extension of time in which to Oppose on June 25, 2013. That extended Petitioner's time to Oppose to October 16, 2013 and on October 14, 2013 Petitioner then filed a timely Opposition. The TTAB acknowledged the timely receipt of Petitioner's request for extension of time and indicated that when the mark was placed back in a pre-registration, pending status then Petitioner's Opposition would be accepted and the Opposition proceedings would commence forthwith. However, on January 16, 2014 the TTAB suddenly reversed its decision and decided that our request for extension of time was not timely filed because it was filed as paper rather than through ESTTA.

2. In June 2013 Petitioner was not aware of the requirement to use ESTTA, which rule seems unfair given that Petitioner as stated had no access to Internet as at the deadline to file a request for extension of time. Since the extension of time was received at the TTAB in a timely manner, regardless of the method used for its transmission, it does seem grossly unfair that the TTAB reversed its decision to grant the extension. That said, Petitioner would have filed this Petition to Cancel much sooner – in September 2013 – had the TTAB not consistently given Petitioner to believe its Opposition was about to be accepted and the mark about to be returned to pre-registration, pending status.

3. Petitioner also filed a timely Letter of Protest on June 25, 2013, which letter was enclosed with the First Request for 90-Day Extension of Time. Since the request for extension of time was eventually acknowledged to have been timely received (even though via the "wrong" route of paper rather than ESTTA), then it follows that it is inarguable that the Letter of Protest was also timely filed, too. Yet since June 2013, and to the date of filing this Petition, the Commissioner's Office has still not processed and responded to Petitioner's Letter of Protest. Petitioner gave several valid grounds for the instant application not to be permitted to be published, and thus not to be permitted to register. Of all the grounds Petitioner detailed, the most compelling remains the grounds on which the USPTO should have reversed the decision to permit the instant application

is the Petitioner's ownership of the application for the mark EDGE GAMES (Ser. No. 85/147,499) in Class 09 which was filed substantially before Registrant's first filed its Singapore registration, and far before Registrant filed to register the mark in the U.S. based on its Singapore registration.

4. Petitioner's application for the mark EDGE GAMES is clearly in direct conflict with Registrant's mark, and clearly should have been cited against Registrant's mark preventing it from being permitted to go forward to publication. Petitioner's mark EDGE GAMES was applied for on October 7, 2010. By contrast, Registrant's mark was applied for in Singapore on October 18, 2011 (registration granted April 17, 2012) and only filed in the USPTO as recently as October 4, 2012. Consequently, Petitioner's application for the essentially the same mark substantial pre-dates even Registrant's original application overseas, let alone its relatively recent application here in the United States.

5. Registrant's mark EDGE is essentially identical to Petitioner's mark EDGE GAMES since Petitioner lays no claim to the word "GAMES" as this is merely descriptive of the type of goods and services that both Petitioner and Registrant are active in selling and marketing. The word "GAMES" can thus be ignored for the purposes of comparing the two marks – indeed, must be ignored when comparing the two. Both Petitioner's and Registrant's marks are in Class 09 for computer games goods thus it is indisputable that there is a likelihood of confusion between the two marks, and since Petitioner has clear priority its Letter of Protest should have been accepted and Registrant's mark should not have been permitted to go forward to publication. Indeed, even now Registrant's mark should be placed back in pre-registration status with Petitioner's 2010 application for EDGE GAMES cited against it. When that decision is made, as in fairness it must be, Petitioner requests its instant petition be automatically withdrawn and its fee paid refunded in full as being in hindsight not necessary

Petitioner's 30-year history of use of the marks "EDGE," "THE EDGE," "GAMER'S EDGE," and a family of EDGE formative marks.

6. Petitioner is the successor in trademark rights to a family of EDGE formative marks, and its predecessors in rights are The Edge Interactive Media, Inc.

(formed 1990) and Softek International Ltd (formed 1983). Petitioner and its predecessors in rights and its licensees have made use of the marks “EDGE” and “THE EDGE” continuously in U.S. interstate commerce since at least as early as June 1986. Further, Petitioner and its predecessor in rights and its licensees has made continuous use in U.S. interstate commerce of the mark “GAMER’S EDGE” since at least as early as 1992 for game software and at least as early as 1998 for game hardware. Petitioner has also used a family of EDGE formative marks since 1986 in interstate U.S. commerce, all in relation to computer and video games software and hardware, including but not limited to “EDGE NET,” “CUTTING EDGE,” EDGE GAMES,” and “EDGE GAMERS”

7. Petitioner is a developer and publisher of game software and both directly and through licensees also manufactures and distributes computer and video game hardware in the U.S. market and has done so since at least as early as 1998 using the marks “EDGE,” “THE EDGE,” and “GAMER’S EDGE.” Revenues in U.S. interstate commerce associated with Petitioner’s and its licensees’ sale of computer game hardware have been in the tens of millions of dollars since or about 1998. Consumers in the United States market have thus come to associate the mark EDGE and the related EDGE formative marks with Petitioner (both directly and through the goodwill accruing to it from its licensees), and have come to expect that software and hardware goods relating to computer and video games bearing these EDGE marks are associated with Petitioner and its licensees and that Petitioner and its licensees are the true source of such EDGE brand goods.

8. In November 2008 Petitioner and Velocity Micro, Inc, a Virginia Corporation (“Velocity”), reached an agreement whereby all right, title interest and goodwill arising from Velocity’s use of the marks EDGE and GAMER’S EDGE for computer game hardware would be under license from Petitioner, with all goodwill accruing to Petitioner not Velocity, retroactive to Velocity’s first use of the marks EDGE and GAMER’S EDGE in 1998. In entering in to this license agreement with Petitioner, Velocity affirmed that as of November 2008 its revenues from sales of game computers in United States commerce bearing the marks EDGE and/or GAMER’S EDGE had already exceeded \$12 million.

9. Since 2008 Velocity has continued to sell game computers under the brand name EDGE throughout the United States, such sales and marketing having been continuous at all times since or about 1998. Such game computers have been exceptionally well reviewed and been given various awards for quality and value for money. Moreover, Petitioner's licensee Velocity has sold such EDGE game computers through essentially the exact same channels of U.S. trade as Registrant has ever sold its EDGE game tablet, except that Velocity has to-date sold its game computers through a far greater network over a considerably longer time (decades), including not only direct sales to the public from its website, but also, Petitioner believes, historically through such major retail outlets as BestBuy, Fry's, Costco, Walmart, Amazon, and many others. Moreover, Velocity has been active in producing and selling tablet computers, too, such as its range of tablet computers launched in or about July 2010.

10. It is the intention of Petitioner, either directly or through its licensees, to launch a game tablet using the brand name EDGE, which Petitioner has every right to do given it and its licensees' consistent use of the brand EDGE for gaming computers since at least 1998. Yet when Petitioner and/or its licensees launch such a product there will be even more confusion than already exists in the U.S. marketplace due to the existence of Registrant's gaming tablet also named EDGE, based on the instant registration. Yet, Registrant has ignored Petitioner's Cease and Desist Demand, and refuses to take its EDGE gaming tablet off the market, or rename it, and one presumes this is primarily because the USPTO has wrongly permitted Registrant's mark EDGE to mature to the U.S. trademark register, falsely giving Registrant to believe the USPTO itself approves of Registrant's infringing and passing off activity.

Registrant's use of the mark EDGE and its use in U.S. commerce

11. According to USPTO records, Registrant has been permitted registration of the instant mark **EDGE** (Reg. No. 4,394,393) for the following goods and services in Classes 09 and 28:

Class 09: computer tablet; computer keyboards and keypads adapted for use with computer tablet; batteries and power supplies for the aforementioned goods

Class 28: computer and video game controllers adapted for use with computer tablet

It is noted that while Registrant sought registration for tablet computers in general, in actual fact in the U.S. market Registrant is known solely for computer game hardware and sells its “EDGE” brand tablets solely as gaming tablets, thus in direct infringement and competition with Petitioner’s rights. Comparing these statements of goods and services with those for EDGE marks owned by Petitioner we see the following:

THE EDGE (Reg. no. 3,559,342)

*Class 09: Video game peripherals, namely, **video game controllers; computers; computer accessories, namely, keyboards, mice; game controllers for computer games; memory cards; headphones; augmented reality headsets for use with computers; virtual reality headsets for use with computers; storage disc cases, namely, compact disc cases and DVD cases; video display and capture cards; audio cards; audio speakers; web-cameras; backpacks, carrying cases and bags all designed for carrying portable computers, **computer accessories, and computer peripherals**; video game machines for use with televisions and accessories therefore, namely, video game controllers; video game software; computer game software, computer game software for use in location based entertainment centers. FIRST USE: 19840604. FIRST USE IN COMMERCE: **19840604*****

*Class 28: Toys and playthings, namely, battery operated action toys, bendable toys, collectable toy figures, electronic action toys, electronically operated toy vehicles , fantasy character toys, mechanical action toys, modeled plastic toy figurines, model toy figures, plastic character toys, plush toys, positionable toy figures, toy action figures, toy boxes, toy figures; **hand held units for playing games and accessories therefore, namely, carrying cases designed for hand-held units for playing electronic games; stand alone video game machines and accessories therefore, namely, carrying cases and covers designed for stand-alone video game machines. FIRST USE: 19950812. FIRST USE IN COMMERCE: **19950812*****

EDGE PC (Ser. No. 85/891,791)

*Class 09: Computer hardware; **Computer hardware and peripheral devices**; Computers and computer hardware; Desktop computers; Entertainment system comprising a computer, multiple image display screen, multiple input devices and a printer; **Handheld computers**; Handheld personal computers; Laptop computers; Netbook computers; Notebook computers; Personal computers; Personal digital assistant computers; **Tablet computer**. FIRST USE: 19980107. **FIRST USE IN COMMERCE: 19980107***

EDGE GAMING PC (Ser. No. 85/891,810)

*Class 09: Computer hardware; **Computer hardware and computer peripherals**; Computers and computer hardware; Desktop computers; Entertainment system comprising a computer, multiple image display screen, multiple input devices and a printer; **Handheld computers**; Handheld personal computers; Laptop computers; Netbook computers; Notebook computers; Personal computers; Personal digital assistant computers; **Tablet computer**. FIRST USE: 19980107. **FIRST USE IN COMMERCE: 19980107***

EDGE GAMES (Ser. No. 85/147,499)

*Class 09: Computer game programs; **Computer game software**; Computer game software downloadable from a global computer network; **Computer game software for use on mobile and cellular phones**.*

(emphases added)

12. As can be seen, Petitioner's goods and services associated with its EDGE marks are almost exactly the same as those that the USPTO permitted registration to Registrant for. In particular, Petitioner's applications for EDGE PC and EDGE GAMING PC (based in sizable part on the extensive and continuous use of the mark EDGE by Velocity since 1998), are for the exact same goods (game computers, tablet computers, and peripherals associated therewith). Moreover, Petitioner's application for the mark

EDGE GAMES (which has substantial priority over Registrant's mark, filings or claims to use), is for the same kind of goods – namely computer games and games for all kinds of computers including, by definition, tablet PCs – and the same consumers and the same channels of trade sell both Petitioner's games as well as gaming PCs and gaming tablets (and accessories/peripherals) as Registrant is using the mark for and has gained wrongly registration for. There is not only a likelihood of confusion (which is the minimum bar Petitioner needs to show), but in this instance a *certainty* of confusion given the identical nature of the mark and the goods and the channels of U.S. trade (direct Internet sales, sales via retailers, etc).

Petitioner's other priority rights arising out of other licensees' use

13. Petitioner has other licensees for the mark EDGE in U.S. commerce, including Future Publishing which publishes a computer game magazine named "EDGE." While Petitioner sold the very limited class 16 rights in the mark EDGE solely and specifically only for the rights to use the mark in association with a printed (paper) magazine, Petitioner retained all rights to the mark EDGE for the balance of class 16 and for all other classes including 09, 28 and 41 for electronic publication of the "EDGE" magazine on, for instance, the Internet or on handheld devices such as tablet computers.

14. Petitioner's predecessor in rights entered into the agreement with Future originally in 1996, with retroactive effect from 1993, with all Future's use of the mark EDGE for any reason having its goodwill vest in Petitioner's predecessor, not Future. From 2004, with the revised license agreement, all use by Future for the printed magazine has its goodwill vest in Future, but for all other use by Future (including class 09, 28 and 41 use) that was all agreed to still vest in Petitioner's predecessor in rights, not in Future. Consequently, all right, title, interest and goodwill arising from Future Publishing's use of the mark EDGE in U.S. commerce in relation to electronic publication of the game magazine EDGE vests in Petitioner and its predecessor in rights.

15. While the contract between Future and Petitioner's predecessor in rights was eventually terminated, that termination did not impact Future's license from Petitioner's predecessor in rights since the license was styled as "perpetual" and

“irrevocable” and was fully paid for by Future in 2004, in perpetuity. Thus, as the license was styled as perpetual it naturally survived termination of the agreement: the only significant impact that the termination of the agreement had, then, was to theoretically free Future from its previous contractual constraints to never use the mark EDGE (or apply to register the mark EDGE) for any goods or services other than strictly printed magazines in class 16. But in real terms that makes no difference, since if Future were to use the mark EDGE for game goods or services other than the printed magazine (or the electronic publication under license from Petitioner via its predecessor in rights), then Future would be infringing Petitioner’s trademark rights and passing off on Petitioner. Consequently, the termination of the 2004 agreement had no significant effect at all, certainly none on Petitioner’s and its predecessor in rights’ ownership of all goodwill arising from Future’s use of the mark EDGE in U.S. commerce in classes such as 09, 28 and 41.

16. Under license from Petitioner’s predecessor in rights, Future Publishing has made extensive use of the mark EDGE in U.S. commerce for electronic publication of its magazine EDGE and has to the best of Petitioner’s knowledge and belief operated an Internet website for such purposes since at least 2001, and has been active in the electronic publication of its EDGE magazine in the U.S. since or about at least 2009 on handheld devices such as tablet PCs. Future Publishing’s use is far from token, with reputedly millions of U.S. consumers accessing such electronic content per month since at least 2001, and certainly since 2009, thus substantially previous to any first use or even expression of intention to use by Registrant.

17. While Petitioner’s trademarks EDGE for printed matter were subsequently cancelled, they stand as pertinent reference to Petitioner’s rights since the cancelations were not connected to any underlying fraud on the PTO or abandonment, and indeed were on the strict condition that Petitioner was affirming its common law rights to having used the marks at all times in U.S. commerce:

EDGE (Reg. No. 2219837 – note this achieved incontestability)

*Class 16: 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 fields of business, **entertainment**, and education, relating to toys, games, board games, television, interactive music, and video; stationery; posters; exterior **packaging for software**, namely, cardboard cartons; printed paperboard inserts for plastic packaging of software; paper bags; plastic bubble packs for packaging; envelopes; and paper pouches for packaging. FIRST USE: 19840500. FIRST USE IN COMMERCE: 19840500*

EDGE (Reg. No. 3105816)

*Class 16: 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, **computer magazines, video game magazines, magazines and posters about interactive entertainment**; writing instruments, namely, pencils, ball point pens, ink pens.*

(emphases added)

It is thus beyond dispute that Petitioner, through its predecessors and licensees such as Future Publishing, have made further extensive use of the mark EDGE in U.S. commerce since at least 1984, all for goods and services related to computer and video games.

No dilution prior to Registrant's registration and actions

18. Petitioner and its predecessors in rights had been vigilant over the past two decades or more in preventing dilution of the brand EDGE both in U.S. commerce and on the USPTO Trademarks Register. Until Registrant was wrongly granted the instant registration for the mark EDGE, Petitioner and those it had specifically consented (e.g. Future Publishing solely for the narrow part of class 16 rights), were the only registrants on the USPTO Trademarks Register for the mark EDGE in relation to game software or

hardware related goods. Similarly, for the same period, Petitioner and its predecessor in rights had also successfully prevented, along with the assistance of and at the insistence of its licensees, others from using the mark EDGE for games or game related goods in U.S commerce.

19. Petitioner has maintained a lack of dilution on the U.S. Trademarks Register, with the sole exception of the instant registration which it was noted above Petitioner believed it had timely Opposed so as to prevent the mark maturing to registration. And, indeed, in respect to which, as also noted above, Petitioner filed a timely Letter of Protest that should, fairly and rightly, have been sufficient to prevent the instant mark from maturing to publication, let alone maturing to registration. In respect to which diligent anti-dilution activity, Petitioner recently succeeded in preventing the registration of the mark EDGE for computer games (application by Mobigame; Ser. No. 79/067,304) which Opposition action by Petitioner was terminated in Petitioner's favor. Aside from Registrant's wrongful registration, then, there are no other registrations on the U.S. Trademarks Register for the mark EDGE for computer games or related products that are not either owned by Petitioner, owned by Future Publishing (with special permission of Petitioner and its predecessors), or which are not also challenged by Petitioner as part of its diligent policing and anti-dilution activities.

Cancelation of Petitioner's earlier U.S. Marks should not be misunderstood as Petitioner having lost any core rights in its EDGE marks or as suggesting Petitioner ever committed fraud on the PTO in gaining its registrations, or that Petitioner ever abandoned any of its marks through non-use.

20. It should be noted that Petitioner only assented to the cancelation of its five existing EDGE marks, including those that had achieved *incontestability*, because it was forced to due to a purely commercial decision that had nothing to do with Petitioner's trademark rights, and was not connected with Petitioner either admitting to having committed fraud on the PTO in obtaining its registrations (nor was Petitioner found guilty of any such fraud), nor connected with Petitioner admitting it had abandoned any of its marks (nor was Petitioner found by any court or judicial body to have abandoned its marks). Indeed, the December 2008 Federal Court ruling in the Velocity Micro vs. Edge Games Inc case resulted in Petitioner being affirmed by the court not to

have committed fraud on the USPTO in obtaining any of its registrations, and affirming that Petitioner had never abandoned any of its marks and that all of Petitioner's U.S. registrations were completely valid.

Registrant Acting in Bad Faith

21. In early April 2013 immediately upon Petitioner becoming aware that Registrant intended to launch a gaming tablet computer named "EDGE," Petitioner wrote to Registrant informing it that use of the mark EDGE would infringe on Petitioner's rights accrued over many decades from its own, its predecessors in rights' and its licensees' use of the mark EDGE in U.S. interstate commerce and would also constitute passing off in Petitioner's extensive good will in the trademark EDGE. At first a Senior IP Executive for Registrant replied stating they wished to be cooperative, but asked for further time to research the issue. Then subsequently attorneys for Registrant responded essentially admitting that Registrant was fully aware of Petitioner's mark EDGE and its extensive goodwill accrued over many years through both its own and its licensees' use, but that Registrant was going ahead regardless with the use of the mark EDGE simply because it had noted that Petitioner's U.S. registrations had been cancelled effective April 17, 2013.

22. Petitioner responded to Registrant making clear that the cancelation of Petitioner's marks should not be confused with Petitioner having lost any core right (i.e. its common law rights) since Petitioner had expressly retained all such rights as part of the commercial agreement that lead to the cancelations. Petitioner also reminded Registrant of the extensive use in U.S. commerce by Petitioner's licensee Velocity of the same mark for essentially the same goods since at least 1998, and further that Petitioner had a number of pending U.S. trademark applications (EDGE GAMES, EDGE PC, EDGE GAMING PC) that Petitioning fully expected to mature to the U.S. Trademark Register in due course. In its further response, Registrant appeared to accept the dangers of persisting in the use of the mark EDGE and its USPTO application, and implied it would revert to Petitioner in due course, but instead Registrant simply went forward with use of Petitioner's mark EDGE regardless, and consciously and deliberately chose to entirely ignore all of Petitioner's claims to prior and conflicting rights.

23. Subsequently, not only did Registrant fail to cease its infringing and passing off behavior having been duly warned by Petitioner's Cease and Desist Notice, but worse, Registrant actively pursued its application to register Petitioner's mark EDGE in its name when rightfully it should have withdrawn its application for the mark EDGE from the USPTO substantially prior to that mark being advertised in June 2013. There is not no doubt that Registrant was fully familiar with Petitioner's extremely well known mark EDGE for games software and hardware at the time it chose the mark EDGE to use in U.S. commerce, and at the time that it decided to apply for the instance trademark registration. Accordingly, there can also be no doubt that Registrant acted in bad faith both when it adopted the instant mark in U.S. commerce and when it filed the instant application.

FIRST CLAIM FOR RELIEF
Priority of Rights

24. Petitioner repeats and realleges each and every allegation set forth in paragraphs 1 through 23 as if fully set forth herein.

25. There is no evidence that Petitioner is aware of that Registrant even considered use of the mark EDGE in U.S. commerce prior to 2011, and certainly as far as Petitioner can see its application in October 2012 makes no mention of Registrant ever having use the mark at all – neither in Singapore nor in U.S. commerce – despite the application being made under basis 66A. By contrast, Petitioner and its predecessors in rights have priority of use of the mark EDGE for the exact same goods (gaming computers) dating back to at least 1998, and for gaming goods and services in general in U.S. commerce dating back as far as 1984.

26. Indeed, while now cancelled, Petitioner held several EDGE registrations for game software and hardware, including gaming computers, for many years – since the 1990s, with registrations having achieved incontestability. While Petitioner is aware that these registrations were cancelled because Petitioner was forced to agree to same for purely commercial reasons (unrelated to trademark rights), the fact of these historic EDGE registrations by Petitioner stands as proof of the long standing prior rights of Petitioner that substantially predate any that might be claimed by Registrant.

SECOND CLAIM FOR RELIEF
Dilution (including Section 43(c))

27. Petitioner repeats and realleges each and every allegation set forth in paragraphs 1 through 26 as if fully set forth herein.

28. As summarized above, Petitioners have been diligent over the past decades in ensuring a lack of dilution in U.S. commerce and on the USPTO Trademark Register for the mark EDGE in relation to computer games and related goods and services. Petitioner and its predecessors in rights, have achieved an absence of dilution (prior to the instant Registration being wrongly granted) by various means, including: successfully challenging rival EDGE marks for games before the TTAB over the past 20 years; arriving at amicable agreements with rival companies to either cease using the mark EDGE, renamed their product or service to a different non-infringing mark, or by coming to an amicable agreement with other parties that they become a licensee of Petitioner, with all goodwill, right, title and interest arising out of that other party's use of the mark EDGE for game related goods since first use inuring in Petitioner rather than the other party.

29. Indeed, Petitioner recently won its Opposition to the registration of the mark EDGE for computer games as detailed above, which aside from Registrant's instant application/registration stood as the only attempt to register the mark EDGE that threatened dilution of the mark on the Register when Petitioner had maintained through great effort an absence of such dilution for the past 20 or more years.

30. More specifically, by gaining the instant registration Registrant has not only caused dilution on the U.S. Trademarks Register that did not exist before, but is also preventing Petitioner from being able to register its own EDGE marks (EDGE PC and EDGE GAMING PC) for the same goods as Registrant now wrongly owns registration of (gaming tablet computers, game computers, and related peripherals). While Registrant's registration of the mark EDGE cannot be cited against Petitioner (and thus has not been) in its application for the essentially identical mark EDGE GAMES, when this mark matures to the U.S. Register (which rightly it will), then there will be not only dilution of

the mark on the register for the first time, but also two essentially identical marks registered for the same or nearly the same goods.

31. Moreover, Petitioner's mark is *so* well known in the game industry through it and its licensees' use that it has arguably become a famous mark. Hence Petitioner argues for dilution under Section 43(c), too.

THIRD CLAIM FOR RELIEF
Likelihood of Confusion

32. Petitioner repeats and realleges each and every allegation set forth in paragraphs 1 through 31 as if fully set forth herein.

33. It is abundantly clear from the above summaries that Petitioner and its licensees have extensive use of the mark EDGE for computer games and computer game related goods (including specifically game computers and thus game computing tablets) stretching back at the very least to 1998, and in most cases rights in U.S. commerce stretching back many decades to at least 1984. Use by Petitioner's license Velocity since 1998 of the exact mark EDGE for the exact same goods (game computers and accessories/peripherals), with sales of such game related hardware in the tens of millions of dollars by Petitioner and its licensee, alone suffices to prove beyond all reasonable doubt that there is a likelihood of confusion were Registrant to be permitted to keep the instant registration and use the mark EDGE for such goods in U.S. commerce.

34. There is no reasonable counter to this argument of likelihood of confusion, since the mark is identical, and the use is in real terms identical. Petitioner's Licensee Velocity's use of the mark EDGE has been specifically for the same kind of hardware in class 09 since at least 1998 (gaming computers), and Velocity are also known for producing tablet computers, too. A likelihood of confusion is beyond dispute, so far beyond dispute we say that it is really the certainty of confusion not the mere likelihood thereof that is in question here.

FOURTH CLAIM FOR RELIEF

Bad Faith

35. Petitioner repeats and realleges each and every allegation set forth in paragraphs 1 through 34 as if fully set forth herein.

36. It is abundantly clear that Registrant was fully aware of Petitioner's long established rights in the mark EDGE for computer games and game related goods and services since substantially before Registrant first decided to adopt the mark EDGE for its use, or even contemplate filing to register the mark EDGE in either Singapore or the United States. Indeed, so high profile was the dispute between Petitioner and such companies as Electronic Arts, Inc and Future Publishing, since at least 2009, that no active member of the game industry – which Registrant certainly is – could have missed knowing intimately about the long established and extensive rights in the mark EDGE owned by Petitioner. Moreover, in its response to Petitioner when Petitioner sent Registrant a Cease and Desist Demand prior to Registrant's mark being approved for publication, Registrant responded indicating it was fully aware of Petitioner's various disputes and thus of Petitioner's well documented claim to rights in the mark EDGE for computer game related goods stretching back over several decades in U.S. commerce.

37. There can be no doubt then that Registrant acted in bad faith when it knowingly adopted the mark EDGE for its gaming tablet computers and related accessories and peripherals, and when Registrant intentionally applied to register the mark EDGE in its name for such goods knowing that Petitioner is the true and rightful sole owner of the mark EDGE for such goods in the U.S, market. At the very least, Registrant was fully aware that its adoption of the mark EDGE would cause dilution in the U.S. market, and registration would cause dilution on the U.S. Register.

38. More specifically, by gaining the instant registration Registrant has not only caused dilution on the U.S. Trademarks Register that did not exist before, but is also preventing Petitioner from being able to register its own EDGE marks (EDGE PC and EDGE GAMING PC) for the same goods as Registrant now wrongly owns registration of (gaming tablet computers, game computers, and related peripherals). While Registrant's

registration of the mark EDGE cannot be cited against Petitioner (and thus has not been) in its application for the essentially identical mark EDGE GAMES, when this mark matures to the U.S. Register (which rightly it will), then there will be not only dilution of the mark on the register for the first time, but also two essentially identical marks registered for the same or nearly the same goods.

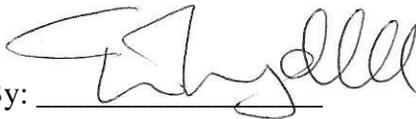
39. Petitioner is and will continue to be harmed by the continued registration of the mark shown in the Subject Registration.

WHEREFORE, Petitioner prays that Registration No. 4,394,393 be cancelled and that this Petition for Cancellation be sustained in Petitioner's favor.

Date: January 17, 2014

Respectfully submitted,

EDGE GAMES, INC.
In Pro Se/Pro Per

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