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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.
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Submission	Reply in Support of Motion
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Date	11/22/2009
Attachments	ReplyToOppositionToMotionToDismiss2.pdf (6 pages)(511631 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, a Swedish Corporation; ELECTRONIC ARTS INC., a Delaware corporation,)	
Petitioners,)	REGISTRANT'S REPLY TO PETITIONERS' OPPOSITION TO MOTION TO DISMISS
v.)	
EDGE GAMES, INC., a California corporation)	Cancellation No. 92051465
Registrant.)	
_____)	

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

**REGISTRANT’S REPLY TO PETITIONERS’
OPPOSITION TO MOTION TO DISMISS**

NOW COMES Respondent and Registrant, EDGE Games Inc. (“EGI”), replies to Petitioners’ opposition to Registrant’s motion to dismiss.

INTRODUCTION

Registrant’s motion to dismiss presented several bases on which the existence of prior decisions on essentially the same issues and facts show the issues in this matter have already been decided and its motion should be granted. Petitioners responded that there is no basis for collateral estoppel and thus the motion should be denied. There is, however, basis for collateral estoppel.

PROCEDURAL HISTORY

In the Velocity/Edge proceedings cited in Registrant’s Motion, the Court ruled that no fraud on the Office occurred during the Registration of the marks at issue. In that case, extensive discovery took place that led to a settlement in favor of EGI. Indeed, it was because EGI showed proof of its use of its marks and proof that it did not commit fraud on the USPTO to the satisfaction of both Velocity Micro and the court that gave rise to the settlement. The Court issued an order (Motion, Exhibit B) granting judgment in favor of EGI. Contrary to Petitioner’s allegations, the judgment was on the merits with EGI being deemed to have successfully defended the action. The proceedings were thus fully litigated for the purposes of meeting for the elements of the doctrine of collateral estoppel. For collateral estoppel to be valid, only one party (EGI) needs to be

the same in both cases. A nonparty may be bound by a judgment because she was “adequately represented by someone with the same interests who [wa]s a party” to the suit. *Taylor v. Sturgell*, 128 S.Ct. 2161, 2171 (2008), citing *Richards v. Jefferson County*, 517 U.S. 793, 798 (1996). In *Taylor*, the court held that collateral estoppel may apply even to facts and issues when Petitioner was not a party to the prior action.

ARGUMENT

For collateral estoppel to be evoked the same parties need not be involved in both the prior issue and the current issue; it is sufficient for just one party (EGI) to be common to both issues (*Taylor v. Sturgell*, 128 S.Ct. 2161, 2171 (2008), citing *Richards v. Jefferson County*, 517 U.S. 793, 798 (1996); *Bernhard v. Bank of America* 19 Cal.2d 807, 122 P.2d 892 (1942)). Here, Petitioner raises the question that EGI committed fraud before the Office to acquire the marks Petitioner seeks to cancel. While the Petitioner has changed, the facts and issues in this case are the same or at least substantially the same as in the Velocity Micro/Edge matter. In both cases, it was argued that EGI had abandoned its trademark registrations due to non-use and that EGI had committed fraud on the USPTO in order to obtain its trademark registrations. Contrary to Petitioners’ allegations, the prior issue was litigated fully and as a result of discovery between the parties. Moreover, Petitioner was adequately represented by a party with the same interests who was a party to the prior suit. The order issued reads as follows:

It is hereby ordered that ...

(4) The Complaint of Velocity Micro, Inc. against The Edge Interactive Media, Inc. is dismissed with prejudice; Edge Games, Inc. and The Edge Interactive Media, Inc.

are deemed to have defended and successfully succeeded on the merits with respect to the Complaint

(Final Order 12/16/08; Case Number 3:08-cv-00135-JRS; District Court, Eastern District of Virginia; Judge James R. Spencer; Docket Number 45).

Whereas judgment on all Counts of the counterclaim against Velocity Micro, Inc. was entered pursuant to the settlement agreement between the parties, judgment against Velocity Micro, Inc. in respect to the Complaint was deemed successful as a result of the issues being fully litigated with EGI being deemed to have defended and successfully succeeded on the merits with respect to the Complaint. (Final Order 12/16/08; Case Number 3:08-cv-00135-JRS; District Court, Eastern District of Virginia; Judge James R. Spencer; Docket Number 45).

Petitioners are correct that the Velocity Micro case did not involve all the marks that are the subject of the present cancellation, specifically registrations for EDGE (Reg. No. 2,219,837) and CUTTING EDGE (Reg. no. 2,251,584). However, Petitioners fail to acknowledge that the issues raised regarding these marks are identical to those raised against the other marks that were the subject of the Velocity Micro case. Petitioner fails to allege any new facts or circumstances to show that EGI committed fraud before the Office. Thus, Registrant requests that the Board give deference to the findings of the District Court, Eastern District of Virginia (Richmond) in the Velocity Micro case.

If the Board is not so inclined, in the alternative Registrant requests that its motion to dismiss be granted as to all Registrant's marks that Petitioners seek to cancel other than the two registered marks (Reg. No. 2,219,837 and Reg. no. 2,251,584) which were not subject to the Velocity Micro case order.

SUMMARY

EGI succeeded in defeating a claim of fraud in registering its marks on the merits in Federal Court. EGI also succeeded in defeating a claim of abandonment of its trademarks on the merits in Federal Court. Petitioner's Complaint raises no new allegations or facts that have not already been fully litigated.

While Petitioners were not party to the Velocity Micro case, no facts have been alleged that had anything to do with Petitioners. The facts at issue in fraud before the Office involve interactions between EGI and the Office. The facts at issue in abandonment are those previously presented to the Federal Court and are also not related to Petitioners. If Petitioners have no new facts or allegation, then the decision of the Federal Court should stand and the Board should dismiss this case.

Since the issues have already been adjudged in Federal Court Petitioners should be barred from bringing the same issues again now. For this reason, Registrant's motion to dismiss should be granted.

CONCLUSION

Registrant requests that its motion to dismiss be granted.

Date: November 20, 2009

Respectfully submitted,

By: 

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CERTIFICATE OF SERVICE

I hereby certify that on November 22, 2009, a true and correct copy of REGISTRANT'S REPLY TO PETITIONERS' OPPOSITION TO REGISTRANT'S MOTION TO DISMISS, was filed by Edge Games, Inc., and Certificate of Service was served via e-mail at llewallen@cooley.com and by mailing said copies via Express Mail, Return receipt addressed to:

Cooley Godward Kronish LLP
Attention Linda M. Lewallen
101 California Street, 5th Floor
San Francisco, CA 94111-5800



Tim Langdell