

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Mailed: July 11, 2011

Cancellation No. 92051465

EA Digital Illusions CE AB
and Electronic Arts Inc.

v.

Edge Games, Inc., and
Future Publishing, Ltd.
(joined as party defendant)

Jennifer Krisp, Interlocutory Attorney:

On December 13, 2010, in view of the voluntary surrender with prejudice, of involved Registration Nos. 2219837, 2251584, 3105816, 3381826 and 3559342, filed by respondent Edge Games, Inc., the Board dismissed the petition to cancel, and noted that the registrations would be cancelled pursuant to Trademark Act Section 7(e).

On February 18, 2011, respondent Edge Games, Inc. filed a motion to withdraw (reverse) its surrender of Registration No. 3105816. Papers filed by respondent Edge Games Inc., and petitioners EA Digital Illusions CE AB and Electronic Arts Inc., indicate, inter alia, the following:

1) With respect to Registration No. 3105816, an assignment of an undivided interest to Future Publishing, Ltd. executed on October 15, 2004, was recorded with the Assignment Services

Division of the USPTO on October 21, 2009, after the September 11, 2009 institution of this cancellation proceeding.

2) Respondent Edge Games, Inc. and Future Publishing, Ltd. each own an undivided interest in Registration No. 3105816; therefore, respondent Edge Games, Inc., is not the sole owner of said registration.

3) Future Publishing, Ltd. has not been a party to this cancellation proceeding, is not a party to the civil action in the United States District Court for the Northern District of California, Case CV-10-02614, which occasioned the earlier suspension of this cancellation, and was not a party to the settlement agreement between petitioners and respondent Edge Games, Inc.

Petitioners contest respondent Edge Games, Inc.'s motion to withdraw its surrender of Registration No. 3105816 because Edge Games, Inc. "has failed to introduce any evidence in support its (sic) contentions, such that the motion is legally insufficient" (petitioner's brief, unnumbered p. 2).

Future Publishing, Ltd. filed a paper ("intervener's response") stating, inter alia, that it has not been named as a party to this cancellation, to the civil action, or to the settlement agreement. Future Publishing, Ltd. objects to the surrender of the portion of Registration No. 3105816 that was assigned to it.

Decision

With respect to Registration Nos. 2219837, 2251584, 3381826 and 3559342, the Board's December 13, 2010 order acknowledging respondent Edge Games, Inc.'s surrender thereof, stands. Accordingly, Registration Nos. 2219837, 2251584, 3381826 and 3559342 will be cancelled in due course pursuant to Trademark Act Section 7(e). In regard to said action, the USPTO will continue to send correspondence to respondent Edge Games, Inc. as follows:

Tim Langdell
Edge Games, Inc.
530 South Lake Avenue, #171
Pasadena, CA 91101

With respect to Registration No. 3105816, respondent Edge Games, Inc.'s motion to withdraw its surrender thereof is hereby granted. Inasmuch as respondent Edge Games, Inc. is not the sole owner of record of said registration, the Board cannot give effect to its surrender thereof.¹

Also with respect to Registration No. 3105816, the Board's December 13, 2010 order is vacated. Ownership of the registration by Edge Games, Inc. and Future Publishing, Ltd. stands as presently reflected in the official USPTO registration and assignment records. In this regard, the Board

¹ While the Board notes petitioners' assertion that they do not object to the reinstatement of Registration No. 3105816, "provided that the registration is held solely in the name of Future Publishing Ltd." (petitioners' brief, unnumbered p. 2), and are prepared to cooperate as necessary to achieve that end, the present record provides the Board no basis on which to enter the change in ownership that petitioners contemplate.

notes that when there has been an assignment of a mark that is the subject of, or relied upon in, an inter partes proceeding before the Board, the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board's own initiative. See TBMP § 512.01 (3d ed. 2011). As noted above, respondent Edge Games, Inc. and Future Publishing, Ltd. each appear to own an undivided interest in Registration No. 3105816. Accordingly, Future Publishing Ltd. is hereby joined as a party defendant in this cancellation proceeding.

With respect to Registration No. 3105816, petitioners' operative pleading is the amended petition for cancellation, which was filed on March 24, 2010. After that filing, this proceeding was suspended pending the civil action before the United States District Court for the Northern District of California, Case CV-10-02614. Accordingly, no answer to the amended petition has been filed as of this time.

Inasmuch as Edge Games, Inc. and Future Publishing, Inc. are not presently represented by the same counsel, these two entities are allowed until thirty (30) days from the mailing date of this order in which to either file a paper stating that they will be represented by the same counsel, or appoint lead counsel who will be responsible for coordinating the conduct of respondents' case, and for making and distributing copies of Board correspondence to each respondent or its attorney or

other authorized representative. *Cf.* TBMP § 117.02 (3d ed. 2011). Pending respondents' response, proceedings are otherwise suspended.

In the absence of a filing from the parties notifying the Board of their settlement or disposition of this cancellation as it pertains to Registration No. 3105816, the Board will reset the time to answer, and all subsequent dates, at the appropriate time.