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

Proceeding	92051465
Party	Plaintiff EA Digital Illusions CE AB and Electronic Arts Inc.
Correspondence Address	GAVIN L CHARLSTON COOLEY LLP 101 CALIFORNIA STREET, 5TH FLOOR SAN FRANCISCO, CA 94111-5800 UNITED STATES trademarks@cooley.com
Submission	Opposition/Response to Motion
Filer's Name	Vineeta Gajwani
Filer's e-mail	vgajwani@ea.com
Signature	/Vineeta Gajwani/
Date	10/24/2011
Attachments	Petitioner's Opposition to Motion to Reverse Division of Reg No 2219837.pdf (6 pages)(20526 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,

v.

EDGE GAMES, INC., a California corporation and FUTURE PUBLISHING LTD, a UK company,

Co-Defendants.

PETITIONERS' OPPOSITION TO
MOTION TO REVERSE DIVISION OF
REG. NO. OF 2,219,837 OR TO BRING
CHILD REG. NO. 3,713,604 INTO THESE
PROCEEDINGS

Cancellation No. 92051465

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

I. INTRODUCTION

Petitioners EA Digital Illusions CE AB and Electronic Arts Inc. ("Petitioners") hereby oppose defendant Edge Games, Inc.'s ("Edge Games") motion to reverse the division of

Registration No. 2,219,837 or to bring Child Registration No. 3,713,604 into these proceedings.

As discussed in greater detail below, Edge Games' motion should be denied because:

1. This is Petitioners' cancellation proceeding, not Edge Games, and therefore it is Petitioners' sole right to determine which registrations are at issue.

2. Petitioners are only seeking cancellation of Registration No. 2,219,837 ('837 Registration) owned by Edge Games, not Registration No. 3,713,604 ('604 Registration), which was created as a result of a valid partial assignment by Edge Games to Future Publishing.

3. The request to divide the '837 Registration was filed by Future before Petitioners commenced this proceeding. Significantly, Edge Games does *not* dispute that it made a valid assignment to Future, or that a division was warranted. Moreover, Edge Games specifically acknowledged and ratified the prior partial assignment of, and request to divide, the '837 Registration when Edge Games filed its combined Section 8 and 15 declaration. Therefore, the issuance of the '604 Registration by the post-registration division was consistent with the intent of the parties and should not be set aside by the Board.

4. To eliminate any doubt, Petitioners filed an amended petition in this proceeding after the '604 Registration issued, and intentionally elected not to seek cancellation of the '604 Registration.

5. In the subsequent settlement of the District Court litigation, Petitioners and Edge Games expressly agreed that the '837 Registration would be cancelled, not the '604 Registration.

6. Consistent with that Settlement Agreement, the District Court ordered that the '837 Registration must be cancelled, not the '604 Registration.

7. Edge Games filed a voluntary surrender *with prejudice* of the '837 Registration (which it solely owned) as required by the settlement and Judgment; this motion and Edge Games' companion motion to withdraw the surrender of the '837 Registration, violates the settlement agreement with Petitioners and is in contempt of Court's Final Judgment dated October 8, 2010.

II. STATEMENT OF FACTS

On October 15, 2004, Edge Games partially assigned the ‘837 Registration to Future Publishing (“Future”). (Docket No. 1, ¶34)

On October 28, 2005, Edge Games recorded its partial assignment of the ‘837 Registration in the Trademark Office. (Docket No. 1, ¶34)

On July 13, 2009, Future filed a Combined Declaration of Use and Application for Renewal Under Sections 8 and 9 of its partial interest in the ‘837 Registration. (Serial Nos. 74556730 and 75983667, TDR Mail Date July 16, 2009)

On July 31, 2009, Future filed a Request to Divide Registration Under Sections 8 & 9 with respect to its partial interest in the ‘837 Registration. (Serial Nos. 74556730 and 75983667, TDR Mail Date August 3, 2009)

On September 11, 2009, Petitioners filed this proceeding seeking to cancel, among others, the ‘837 Registration. (Id. at ¶¶39-55)

On October 14, 2009, Edge Games filed its Combined Section 8 and 9 Declaration for its portion of the soon-to-be-divided registration and specifically acknowledged the assigned part to Future. (Serial No. 74556730, TDR Mail Date October 19, 2009)

On November 7, 2009, the Trademark Office issued a Notice of Divided Trademark Application, and it was addressed by the Trademark Office to Edge Games. (Serial No. 75983667, TDR Mail Date November 7, 2009)

On December 8, 2009, the Trademark Office issued the ‘604 Registration, acknowledging the partial assignment to Future. (Serial No. 75983667, TDR Mail Date December 8, 2009)

On March 24, 2010, Petitioners filed an Amended Cancellation Petition referencing the prior partial assignment and request to divide the ‘837 Registration, and elected not to seek the cancellation of the ‘604 Registration. (Docket No. 16, ¶¶34-39).

On October 8, 2010, pursuant to a stipulated settlement between Petitioners and Edge Games, the District Court entered a Final Judgment, which provides in pertinent part, “[p]ursuant to Section 37 of the Lanham Act, 15 U.S.C. §1119, the Commissioner of Patents and Trademarks and the Assistance Commissioner for Trademarks are hereby ordered to cancel U.S. U.S. Trademark Registration Nos. 2,219,837; 2,251,584; 3,105,816; 3,559,342; and 3,381,826.” (Docket No. 44, Ex. A; Docket No. 47, Exs. D and E)

On November 12, 2010, Edge Games executed and filed a voluntary surrender *with prejudice* of the ‘837 Registration in furtherance of the settlement agreement and Final Judgment. (Docket No. 31)

III. ARGUMENT

Clearly, Edge Games is not disputing that it made a valid assignment of a partial interest in the ‘837 Registration to Future, or that Future was entitled to perfect the partial assignment and divide the registration accordingly. Rather, Edge Games is raising form over substance by arguing it was the TTAB’s jurisdiction, not the post-registration division, to process the division. That is not a proper basis to reverse the division.

More important, Petitioners do not seek, and have never sought, cancellation of the assigned portion of the subject registration. Indeed, when Petitioners and Edge Games entered into their settlement of the District Court litigation in October 2010, the ‘604 Registration had already been issued to Future and it was omitted from the District Court case. Hence, the Final Judgment entered by the District Court correctly provided for cancellation of the ‘837 Registration, not the ‘604 Registration.

The weakness in Edge Games’ motion is further evidenced by the following undisputed facts. Future filed its request to divide the ‘837 Registration on July 31, 2009, notably several weeks before Petitioners filed this cancellation action. Therefore, Future’s request to divide preceded this action. On October 14, 2009, Edge Games filed its Section 8 and 9 renewal of its

portion of the soon-to-be-divided registration, **and specifically acknowledged the assigned part to Future**. The Notice of Divided Registration issued on November 7, 2009, **and it was sent by the Trademark Office to Edge Games**. The ‘604 Registration acknowledging the partial assignment to Future was issued on December 8, 2009. On March 24, 2010, Petitioners filed an Amended Cancellation Petition referencing the prior partial assignment and request to divide the ‘837 Registration, and specifically elected not to seek the cancellation of the ‘604 Registration. Likewise, in October 2010, when Petitioners and Edge Games settled the federal court litigation, the ‘604 Registration was omitted from the reach of the District Court’s Judgment of cancellation.

This is Petitioners’ cancellation action, not Edge Games’. It is up to Petitioner, not Edge Games, to decide which registrations to contest. Petitioner elected not to contest the ‘604 Registration, and therefore the District Court Judgment requires cancellation of the ‘837 Registration held by Edge Games only. Moreover, Edge Games filed a voluntary surrender of the ‘837 Registration *with prejudice*. There is no question that this surrender was in proper form, as Edge Games was the sole owner of the ‘837 Registration at the time of the surrender. The Board should uphold the surrender, honor the District Court Judgment, cancel the ‘837 Registration as ordered, and deny Edge Games’ motion.

Dated: October 24, 2011

By: /Vineeta Gajwani/
Vineeta Gajwani
Attorney for Petitioners

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 PETITIONERS' OPPOSITION TO MOTION TO REVERSE DIVISION OF REG. NO. OF 2,219,837 OR TO BRING CHILD REG. NO. 3,713,604 INTO THESE PROCEEDINGS was served on the following counsel of record for Applicant, by depositing same in the U.S. Mail, first class postage prepaid, this 24th day of October, 2011:

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

Robert N. Phillips
Reed Smith LLP
101 Second Street
San Francisco, CA 94105
