

ESTTA Tracking number: **ESTTA529359**

Filing date: **03/28/2013**

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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Date	03/28/2013
Attachments	RequestForClarification28Mar2013.pdf (7 pages)(86825 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

<p>EA DIGITAL ILLUSIONS CE AB, a Swedish Corporation; ELECTRONIC ARTS INC., a Delaware corporation, Petitioners,</p> <p>v.</p> <p>EDGE GAMES, INC., a California corporation and FUTURE PUBLISHING LTD a UK corporation</p> <p style="text-align: center;">Co-Registrants/Co-Defendants.</p> <hr style="width: 100%;"/>	<p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p>	<p>CO-REGISTRANT EDGE'S REQUEST FOR CLARIFI- CATION/EXPLANATION OF THE BOARD'S INCONSISTENT, UNEXPLAINED AND SEEMINGLY CLEARLY WRONG DECISIONS.</p> <p>Cancellation No. 92051465</p>
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Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, Virginia 22313-1451

1. Judging by the tenor of the Board's Order of March 8, 2013 (Docket #84), it would seem possible that the Board is about to make decisions – or recommend that the Director make decisions – that will be unjust, unfair and contrary to both legal precedent and law. If so, then this case may become a landmark one, which will go forward to the Court of Appeals and referenced for decades to come as an example of the Board vacillating on its decisions and (should it happen) acting on a Court Order that it knew was void on its face and thus invalid. Should that happen – should this matter need to go forward to the Court of Appeals – EDGE asks that the Board please consider giving some degree of explanation for its sudden unexplained reversals of its decisions, and the unexplained inconsistencies in the Board's decisions, so that the Appeals Court and the parties will not be left speculating why the Board made the decisions that it did.

The Board's Unexplained Reversal of its Prior Decision Regarding Reg. No. 3105816

2. As Co-Registrant Edge Games Inc. ("EDGE") noted in its Reply to the Board's Order, in granting EDGE's motion to reverse the Section 7 Surrender, the Board correctly determined that at the time EDGE filed its surrender it was not the sole owner of this registration. Since EDGE was not the sole owner, the Board correctly ruled that EDGE did not have the right to file a Surrender. The Board wrote in its Order of July 1, 2011 (Docket #42):

*"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.**"* (emphasis added)

3. And as EDGE also noted in recent filings, at no time did Co-Registrant Future Publishing Ltd ("Future") ever grant EDGE express authority or right to Surrender this registration on the joint behalves of the two owners. To the contrary, Future stated in its Intervener Filing (Docket #40) that EDGE did not have either the right or authority to file the Section 7 Surrender (nor, Future said, did EDGE have the right or authority to agree any settlement with Petitioners or agree any stipulated judgment or final order in the District Court case). At no time since Future filed that Intervener Response in March 2011 have Future ever reversed their position on this and specifically granted EDGE the right and authority to file a

Section 7 Surrender, and even were Future to suddenly now (in a self-serving manner) grant this to EDGE it would be too late to make the original Section 7 Surrender valid. Not least because EDGE formally withdrew that Section 7 Surrender when it came to EDGE's attention that EDGE lacked the right or authority to file it given that EDGE was not (and still is not) the sole owner of the registration in question). To be clear, whereas EDGE had no right, standing or authority to file the Section 7 Surrender at the time it did, by contrast EDGE did have the right, standing and authority to file its withdrawal (reversal) of the Surrender at the time it did so and hence the Board should have honored EDGE's withdrawal/reversal.

4. In its March 8, 2013 Order, in a footnote thereto, the Board vacates its prior Order on this motion without providing any explanation whatsoever. EDGE thus respectfully requests that the Board explain why it reversed what was clearly a correct decision so that the parties and the Court of Appeal may gain some insight into the Board's thinking on this should this matter have to go forward to Appeal.

The Board's Unexplained Wrong Denial of EDGE's Motion to Reverse (Withdraw) the Surrender of Reg. No. 3559342 Co-Owned by Future and EDGE

5. Similarly, while the circumstances surrounding Reg. No. 3559342 (and we say Reg. No. 2219837, too, since it should not have been divided while these proceedings were ongoing), were identical to the circumstances of Reg. No. 3105816, it seemed clear that the Board should have granted EDGE's motion to reverse (withdraw) the Surrender of 3559342 just as it originally (and correctly) reversed the Surrender of 3105816. However, without explanation for its decision the Board failed to grant EDGE's motion to reverse (withdraw) the Surrender of 3559342 despite it too being co-owned by Future. Further, and again without any explanation, the Board just reaffirmed this seemingly clearly wrong decision in a footnote to its March 8, 2013 Order, stating that the Board saw no mistake in its prior ruling.

6. With deep respect, both decisions were in error by the Board – 3559342 being co-owned by Future and EDGE at the time EDGE filed the Section 7 Surrender means that EDGE's filing was without authority or right since one owner of a mark cannot surrender it on behalf of two owners without the express permission and authority at the time of filing of the other co-owner (and, frankly, without the other co-owner executing the same Section 7 Surrender at the time of filing). While the Board's recent decision to reverse its previous granting of EDGE's

motion to reverse (withdraw) the surrender of 3105816 means that the Board's decisions are now consistent, they are now – with deep respect – consistently *wrong*. In both cases EDGE lacked the standing to file the Section 7 Surrender of either registration since it lacked either the right or authority to surrender a jointly owned registration. Again, as the Board itself correctly stated when at first it ruled in EDGE's favor:

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."

(emphasis added)

7. As with Reg. No. 3105816, Future has never expressly granted EDGE either the right or authority to surrender 3559342, and indeed has clearly stated that it has never granted such right or authority to EDGE to ever act on its behalf. Further, Future has never itself expressly sought to surrender this registration (or the other co-owned registrations), and while it has tried to imply that it does not object to EDGE's surrenders being processed, at the same time Future has never actually granted EDGE the right or authority to do such surrenders. In any case, Future now stating that it does not oppose EDGE surrendering any mark co-owned with Future, or even if Future were to now suddenly stated that it actively supports such surrenders, in either case that change of heart by Future would be too late since (a) it is the status at the time EDGE filed the Surrenders that governs, and (b) EDGE has already long ago filed formal withdrawals of all Section 7 Surrenders that relate to any registration that is co-owned with any other party.

8. Clearly, then, the Board should have granted EDGE's motion to reverse (withdraw) the surrender of 3559342 since that mark was (and still is) co-owned by Future and EDGE lacked either the right or authority to surrender a mark that it did not solely own. EDGE thus respectfully requests that the Board explain or clarify its decision since the Board's decision seems to run completely contrary to law and legal precedent.

The Board's Unexplained Refusal to Reverse the Division of Reg. No. 2219837 that was Divided While The Current Proceedings Were Ongoing, Without Board Approval

9. The Board denied EDGE's motion to reverse the division of Reg. No. 2219837 despite the division taking place after the instant proceedings had commenced, and despite standard USPTO rules prohibiting any post-registration activity or amendments *at all* while a registration

is involved in a matter before the Board. EDGE's research finds this action of permitting the post registration change to this registration unprecedented in the history of the USPTO, and finds it fundamentally wrong since EDGE was never given an opportunity to challenge – as it would have done – such division of the mark before the division was made. EDGE does not agree that the division was correct or lawful, and the undivided status of this mark was central to these Cancellation proceedings. The mark should have remained undivided until all issues pertaining to it had been properly heard by the Board by all the parties.

10. By permitting the division to take place while these proceedings were ongoing the Board has denied EDGE its right to properly dispute all the allegations pertaining to this registration (including Petitioners' claims in the District Court and here that the mark has either been abandoned or was obtained by fraud – it was the original UNdivided registration that was cited by Petitioners in their original petition and that which thus pertains to the question of fraud at the time of registration or renewal and the UNdivided registration that needs to be considered when considering use of the mark in the 5 years prior to late 2009 when these proceedings commenced). It is thus the UNdivided registration that should be part of these proceedings, and the Board wrongly permitted Future to remove what it falsely claims is “its” portion of this registration from the current proceedings (and from the District Court proceedings) so as to avoid Future answering the accusations that Reg. No. 2219837 was either obtained by fraud or fell into disuse in the 5 years prior to late 2009.

11. The Board's decision to not reverse the division of 2219837 is thus clearly in error since now this mark in its UNdivided form (that it was in when the instant proceedings commenced) is not being considered, and Future as co-defendants are wrongly not being required to answer the original accusations made against it by Petitioners regarding use or fraud. Consequently, the Board's decision (and its reaffirmation of its original decision in a footnote to its recent Order) appears clearly in error. EDGE respectfully requests that the Board explain and clarify its decision since it appears contrary to fair play, justice, law and legal precedent. And if the mark should not have been divided then EDGE repeats the same argument it made above regarding Reg. No. 3559342, stating that for the same reasons and on the same grounds, this registration too should not have had EDGE's surrender accepted since EDGE was not the sole owner of this mark at the time the surrender was filed (or should not have appeared to be the sole

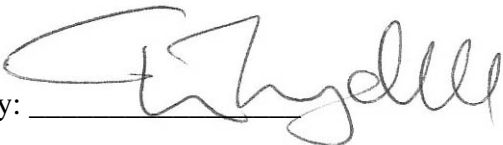
owner, since the mark should not have been divided such that Future's alleged portion (and not EDGE's portion) got divided off and given a different registration number. EDGE argues further that to be fair Future had no more right than EDGE to have its portion granted a new registration number, and had Future's portion (alleged) retained the original Reg. No. 2219837 and had EDGE's portion been given the new registration number, then EDGE's point here about it being wrong to divide the original registration while these proceedings were ongoing would presumably be even clearer to the Board.

Potential Wrong Decision Regarding the Void District Court Order

12. Last, while EDGE sincerely trusts that the Board is not about to act on the void District Court order, or permit/advise the Director to act on the void Court Order, should either the Board or the Director act on the void Order then EDGE respectfully requests that the Board or the Director explain that decision clearly so that the parties and the Court of Appeal will not be left to speculate why a clearly void order was acted on contrary to law, and contrary to numerous Supreme Court and Appeals Court rulings stating that no party that has reasonable basis to believe a court order is void on its face should act on it.

Date: March 28, 2013

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 Co-Defendant Edge Games Inc's Request for Clarification/Explanation of The Board's Decisions was served on the following parties of record, by depositing same in the U.S. Mail, first class postage prepaid, this 28th day of March, 2013:

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