

ESTTA Tracking number: **ESTTA1039758**

Filing date: **03/03/2020**

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 has filed a petition to cancel the registration indicated below.

Petitioner Information

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

Correspondence information	Tim Langdell CEO EDGE Games Inc., 530 South Lake Avenue 171 Pasadena, CA 91101 UNITED STATES timlangdell@gmail.com 6268240097
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Registration Subject to Cancellation

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 Singapore 469029 SINGAPORE		

Goods/Services Subject to Cancellation

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, 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 subject to cancellation, namely: computer and video game controllers adapted for use with computer tablet

Grounds for Cancellation


Abandonment	Trademark Act Section 14(3)
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(3)

Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
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Related Proceedings	92064349
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	5934761	Application Date	10/07/2010
Registration Date	12/17/2019	Foreign Priority Date	NONE
Word Mark	EDGE GAMES		
Design Mark	 <p style="text-align: center; font-size: 2em; font-weight: bold;">EDGE GAMES</p>		
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		

U.S. Registration No.	5987060	Application Date	04/01/2013
Registration Date	02/18/2020	Foreign Priority Date	NONE
Word Mark	EDGE PC		
Design Mark	 <p style="text-align: center; font-size: 2em; font-weight: bold;">EDGE PC</p>		
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; Net-book computers; Notebook computers; Personal computers; Personal digital assistant computers; Tablet computer
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U.S. Registration No.	5987061	Application Date	04/01/2013
Registration Date	02/18/2020	Foreign Priority Date	NONE

Word Mark	EDGE GAMING PC
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Design Mark	
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Description of Mark	NONE
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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; Net-book computers; Notebook computers; Personal computers; Personal digital assistant computers; Tablet computer
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Attachments	85147499#TMSN.png(bytes) 85891791#TMSN.png(bytes) 85891810#TMSN.png(bytes) PetitionToCancel4394393.pdf(580461 bytes)
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Signature	/Tim Langdell/
Name	Tim Langdell
Date	03/03/2020

**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 has been, 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 owns three conflicting registrations for essentially the same mark and one of the three registrations directly conflicts and was filed substantially prior to Registrant's filing. This Petition is based on, or related to, these three Petitioner Registrations and not on any other basis previously relied upon in proceedings between the parties. Thus, there should not be any basis for claim preclusion. This Petition also relies on the basis that Registrant has abandoned its use of the mark EDGE in US commerce, a basis not previously relied upon

BASIS 1: PETITIONER'S NEW U.S. REGISTRATIONS

1. Petitioner is the registered owner of the trademark EDGE GAMES in relation to computer games, Registration No. **5934761** which was filed on October 7, 2010 and matured to registration on the US Trademark Register on December 17, 2019. Petitioner is also the registered owner of two other registrations, one for the mark EDGE PC and the other for the mark EDGE GAMING PC, both in IC Class 09 in relation to computer hardware (Registration Nos. **5897060** and **5987061**, both of which matured to the Register on February 18, 2020).

2. By contrast, Registrant's mark was applied for far more recently than Petitioner's mark EDGE GAMES: Petitioner's mark was applied for on 7 October 2010, whereas the date of Registrant's application was October 4, 2012 based on an alleged international registration in Singapore dated April 4, 2012.

3. Petitioner's registration of the mark EDGE GAMES makes no claim to the word GAMES (being merely descriptive of the goods and services Petitioner and Registrant both trade in), and thus is essentially identical to Registrant's mark EDGE.

4. On a *prima face* basis, then, Petitioner has clear substantial priority of filing for its registered rights in the same mark for essentially the same goods. While Registrant's application is fairly generic in its application for computer hardware, it is well known, and easily confirmed

by checking Registrant's US website (www.razerz.com) that Registrant is solely active in the computer game market. Hence Registrant's mark and any use by Registrant of it is in direct conflict – both in the US market and on the USPTO database -- with Petitioner's prior rights in the mark EDGE (GAMES) in relation to computer games, and all related goods such as software and computer hardware.

5. While Petitioner's two other US registrations (for EDGE PC and EDGE GAMING PC) post-date Registrant's mark's filing and registration dates, it is pertinent that Registrant did not oppose either of Petitioner's newer marks. This failure to oppose Petitioner's applications is despite the fact that Petitioner's marks are also for the mark EDGE and specifically for computer hardware, and in particular computer game hardware. This goes to the simple fact that the mark EDGE does truly belong to Petitioner, for software and hardware pertaining to games, and that Registrant deliberately took advantage of Petitioner's over 25-year history of using the mark EDGE in US commerce in respect to computer game related products and services. By not opposing Petitioner's new marks Registrant tacitly acknowledged that Petitioner is the true owner of the mark EDGE for all such goods.

Good faith attempts were made to stop Registrant's registration in 2013

4. 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.

5. 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.

6. 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. In telephonic conversation with the Commissioner’s Office Petitioner is informed that the office located the Letter of Protest in or about December 2014 but by that time the instant mark had already matured to registration and thus, although it was USPTO clerical error, by this time it was too late to process the Letter of Protest. The Commissioner’s Office also informed Petitioner that Petitioner’s Letter of Protest was approved and had it been processed in a timely manner in or about June or July 2013 as it should have been, then Registrant’s application would have been placed back in pre-publication status, suspended, with all Petitioner’s EDGE registrations and then pending EDGE applications cited against it.

7. It is Petitioner's position that the USPTO should not have permitted Registrant's application to go forward to publication given Petitioner's earlier filed mark EDGE GAMES which filing pre-dated that of Registrant's by some two years. Registrant's mark should not have been permitted to move forward to publication until Petitioner's mark EDGE GAMES had been fully processed, and when Petitioner's mark matured to the Register in December 2019, Registrant's pending application should have been given a Notice of final refusal.

8. After the clerical errors in 2013 that prevented Petitioner's Letter of Protest being timely acted on (to place Registrant's application back in pre-publication, pending status), and which caused Petitioner's Opposition not to be considered, Petitioner was then forced to wait until its mark EDGE GAMES matured to the Register before it could file the instant Petition based on that registration. Since Petitioner's mark was filed around 2 years prior to Registrant's filing of its application (or 18 months before the foreign application it was based on), Petitioner is well within its rights to file the instant application. However, registration of Petitioner's mark EDGE GAMES (filed October 7, 2010) was held up for just over ten years due to circumstances beyond Petitioner's control.

9. The primary delay in the EDGE GAMES mark maturing to the Register was the need for Petitioner to first dispose of an earlier application made by a French company (Mobigame) for the mark EDGE, by way of a timely filed opposition to that application. Petitioner had two main bases for that opposition: First, Petitioner's substantial 30-year use of the mark EDGE in US commerce that predated any use by the French company, and second, Petitioner's potential (disputed) ownership of an earlier EDGE registration from the 1990s. Since if Petitioner had prevailed on either of its bases for opposition it would have successfully caused the French application to be rejected, Petitioner asked that the USPTO initially consider the

Opposition initially just based on the evidence of prior use and goodwill and only go on to consider the basis of the earlier registration should the first basis of Opposition fail.

10. However, the French company insisted that the Opposition be suspended pending the outcome of the dispute possible earlier registration. If the French company had not insisted on that suspension, or if the USPTO had granted Petitioner's request to deal with the priority of use and prior goodwill first, then Petitioner's mark EDGE GAMES would have matured to the Register by or about 2014 or 2015. As it was, the French company failed to renew its underlying French registration upon which the US application had been based, and hence the French application was abandoned before the Opposition could conclude. To expedite being able to address other issues, including the instant Petition, Petitioner opted to end that Opposition as moot given the French application had abandoned. But this is the reason why Petitioner has been forced to wait some additional five or six years before being in a position to file the instant Petition based on the EDGE GAMES registration

Petitioner has an over 30-year history of use of the mark "EDGE" and a family of EDGE formative marks in US commerce that form the basis of the EDGE GAMES registration.

11. Petitioner wishes to make clear that while it is basing this Petition on its three registrations (particularly the earliest one, filed 2010), and not basing the Petition on prior use or goodwill, nonetheless Petitioner believes it is pertinent to give an overview of the historic use and substantial accumulated common law goodwill. It is this 30-years or prior use and accumulated common law goodwill that formed the basis for the three registrations Petitioner is relying on here, even if the Petition itself is not relying on said priority of use or goodwill *per se*.

12. Not only has Petitioner over 30 years of use in US commerce of the mark EDGE in relation to computer games, but in the years prior to Registrant's first use, Petitioner had sales of EDGE products in the US itself and via its licensees of over \$10million with not less than

\$1million for each year in the 5-10 years prior to the Registrant's application being filed.

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).

13. Petitioner and its predecessors in rights and its licensees have made use of the marks "EDGE," "EDGE GAMES" and "THE EDGE" continuously in U.S. interstate commerce since at least as early as June 1984. Further, Petitioner and its predecessors 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 computers. Petitioner has also used a family of EDGE formative marks since 1984 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" and "EDGE GAMERS."

14. 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.

15. 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 into 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.

16. From 2008 Velocity continued to sell game computers under the brand name EDGE throughout the United States until at least October 2012, such sales and marketing having been continuous at all times since or about 1998. Such game computers were exceptionally well reviewed and been given various awards for quality and value for money. Moreover, Petitioner’s licensee Velocity 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, Frys, 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.

17. 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. Indeed, Petitioner has game computers on sale using its brand EDGE, thus expanding the range of goods to include computer tablets, too, is a natural extension of Petitioner's US business plans. Yet, Registrant has ignored Petitioner's Cease and Desist Demand, and one presumes this is primarily because the USPTO 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 compared to that of Petitioner

18. According to USPTO records, Registrant over Petitioner's extensive protest was 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

19. It is noted that while Registrant sought registration for tablet computers in general, in fact in the U.S. market Registrant is known solely for computer game hardware and sold its "EDGE" brand tablets solely as gaming tablets, thus in direct

infringement and competition with Petitioner's long-established historic rights. Comparing these statements of goods and services with registered EDGE marks owned by Petitioner we see the following:

EDGE GAMES (Reg. No. 5934761)

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)

EDGE PC (Reg. No. 5987060)

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.***

(emphasis added)

EDGE GAMING PC (Reg. No. 5987061)

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.***

(emphasis added)

20. 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, involving the same consumers (U.S. customers who play computer games) and the same channels of trade. Petitioner's use of the mark EDGE in relation to computer games has been continuous at all times since 1984 to the current day, by its own sales and marketing activity and that of its licensees and predecessors in rights.

No dilution prior to Registrant's registration and use in US market

21. Petitioner and its predecessors in rights had been vigilant over more than two decades 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 was the only registrant 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.

22. 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.

Registrant Acted in Bad Faith

23. 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. However, what Registrant completely overlooked, or doggedly refused to consider, is that despite the 2013 cancelations Petitioner's then pending mark was filed in 2010. Thus, in 2013 when the parties were corresponding, it was clear that when Petitioner's mark EDGE GAMES matured to the US Register it would mean that Petitioner would have held registered rights at all times since the early 1990s with no gap in coverage (the new '761 registration being effective as of the 2010 filing date and the cancelations not coming into effect until 2013).

24. Petitioner responded to Registrant making clear that the cancellation 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 cancellations. 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 then 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 (which of course they then did in 2019 and 2020). 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.

25. 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.

BASIS 2: REGISTRANT HAS ABANDONED REGISTRATION/USE OF THE MARK

25. To Petitioner's best knowledge and belief, Registrant cease sale of their "EDGE" branded goods (specifically a PC gaming tablet computer) in or about 2015. Certainly, by 2016 there are comments on the Internet about how Registrant's EDGE branded product had not been on sale for some considerable time, with the implication being over one year (i.e. by 2015).

26. Researching the website www.archive.org (the “Wayback Machine”), which keeps a “snapshot” of websites at certain historical dates, Petitioner finds that Registrant appears to have stopped sale of its “EDGE” branded products by 2 March 2015. As of this date, the EDGE branded PC tablet computer is not mentioned as an item for sale on Registrant’s website (at that time www.razerzone.com).

27. The evidence clearly appears to show that Registrant thus ceased use of the mark EDGE, and thus ceased use in U.S. Inter-State commerce of the U.S. registration it wrongfully acquired for the mark EDGE, over 5 years ago.

28. Review of the documents in the USPTO database pertaining to Registrant’s mark reveals that on 3 September 2018 the Trademark Office sent a Courtesy E-Reminder to Registrant of its obligations regarding a Section 71 (6-year) filing. In this Reminder, the USPTO informed Registrant: “[...] *the holder/owner of the registration must file a Declaration of Use and/or Excusable Nonuse under §71 of the Trademark Act anytime between now and Sep 3, 2019. For an additional fee, the holder/owner may file the declaration within the six-month grace period that ends on Mar 3, 2020*” (emphasis added).

29. Consequently, Registrant failed to file the required Section 71 form either by the deadline (3 September 2019) or by the end of the grace period (3 March 2020). Accordingly, Registrant’s Registration No. 4,394,393 should be cancelled as abandoned under the appropriate USPTO rule the provisions of the TMEP.

FIRST CLAIM FOR RELIEF

Priority of Rights

30. Petitioner repeats each and every statement set forth in paragraphs 1 through 29 as if fully set forth herein.

31. The priority claimed here is based on the 2010 filing date of the EDGE GAMES registration. Petitioner's use of the marks EDGE and EDGE GAMES prior to 2010 that formed the actual-use basis of its 2010 filing are thus pertinent. 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.

32. 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, such rights are reflected in Petitioner's earlier EDGE registrations (voluntarily cancelled as part of a commercial compromise in 2013) and as long ago as 2003 declared in the newer three registrations (it is unclear to Petitioner why the 2003 date was put in its applications since Petitioner had use in US commerce substantially pre-dating 2003. Petitioner suspects this was a typing error. That said, use dates from at least 2003 which more than meets the requirements needed to be established in this Petition).

SECOND CLAIM FOR RELIEF

Dilution (including Section 43(c))

33. Petitioner repeats and re-states each and every statement set forth in

paragraphs 1 through 32 as if fully set forth herein.

34. As summarized above, Petitioner has been diligent over the several 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.

35. 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. Certainly, it is one of the better know marks in the entire history of the US computer game industry. Hence Petitioner argues for dilution under Section 43(c).

THIRD CLAIM FOR RELIEF

Likelihood of Confusion

36. Petitioner repeats and re-states each and every statement set forth in paragraphs 1 through 35 as if fully set forth herein.

37. The confusion argued here is between Petitioner's registered marks and that of Registrant. There can be no reasonable dispute that there is a likelihood of confusion between

Registrant's use of the mark EDGE for game computers (aka "computer tablets") and Petitioner's use of the mark EDGE GAMES for computer games (being the products that are played on game computers and computer tablets), and both EDGE PC and EDGE GAMING PC (specifically for computers and tablet computers). Just as the mark EDGE GAMES is essentially the same as the mark EDGE (because Petitioner lays no claim to the word GAMES), similarly the marks EDGE PC and EDGE GAMES PC are essentially the same as the mark EDGE since PC and GAMES PC are merely the goods Petitioner and Registrant trade in.

38. There is no reasonable counter to this argument of likelihood of confusion, since the mark is essentially identical, and the use is in real terms identical, the channels of trade are the same or are those used by the consumers who buy computer game services and goods. If proper and fair process had been followed, Registrant's 2012 application would not have been permitted to move forward to publication let alone to registration, because Petitioner's earlier application for EDGE GAMES would have been cited against it.

FOURTH CLAIM FOR RELIEF

Bad Faith/Fraud

39. Petitioner repeats and re-states each and every statement set forth in paragraphs 1 through 38 as if fully set forth herein.

40. Bad faith in this instance is multiplied many times by the retroactive realization that while Registrant was fighting Petitioner in 2015/16 to resist all attempts to cancel its EDGE mark, at the very same time Registrant had abandoned use of its mark. 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.

41. 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.

42. Thus when Registrant applied to register the mark EDGE for the instant registration it deliberately made fraudulent representations to the USPTO that it, Registrant, was the true owner of the mark EDGE for such goods and services when Registrant knew well that Petitioner was the true owner and the source that consumers associate with the mark EDGE for such goods and services as is evidenced by Petitioner's two EDGE registrations for the same or directly related goods and services pertaining to computer games and game computers.

FIFTH CLAIM FOR RELIEF

Abandonment

43. Petitioner repeats and re-states each and every statement set forth in paragraphs 1 through 42 as if fully set forth herein.

44. Petitioner has presented two bases for a ruling of abandonment: first through non-use by Registrant for a period of over 5 years (and certainly over 3 years), and second by virtue of the failure of Registrant to timely file its Section 71 filing. Petitioner thus calls for Registrant's instant mark to be cancelled as abandoned.

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

Date: March 3, 2020

Respectfully submitted,
EDGE GAMES, INC.
In *Pro Se*

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