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

Proceeding no.	92081057
Party	Defendant On The Edge Productions Ltd
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Signature	/Julia Anne Matheson/
Date	03/22/2023
Attachments	ON THE EDGE Motion to Suspend 2023.03.22.pdf(643985 bytes )

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

EDGE GAMES, INC.,	)	Cancellation No. 92081057
	)	
Petitioner,	)	Reg. No. 5461153
	)	
v.	)	
	)	
ON THE EDGE PRODUCTIONS LTD.,	)	
	)	
Respondent.	)	

**RESPONDENT’S UNILATERAL MOTION TO SUSPEND**

Respondent unilaterally moves the Board to suspend this cancellation action pending resolution of challenges to multiple of the registrations, applications, and claimed common law rights upon which Petitioner relies for this action. The requested suspension would preserve the resources of the Board and Respondent, a conservation organization.

This cancellation proceeding is a reprise of Petitioner’s campaign to claim broad and exclusive rights in the word EDGE for video games and related goods and services. Petitioner temporarily suspended its prior enforcement activities following a decision issued on October 1, 2010 by the Northern District of California denying its motion for a preliminary injunction against Electronic Arts in a decision summarizing the record evidence of fraud committed by Petitioner’s CEO Dr. Tim Langdell against the U.S. Patent and Trademark Office in obtaining the multiple registrations proffered as evidence of its alleged rights resulting in the cancellation by Court Order of U.S. Reg. 3559342 (THE EDGE); U.S. Reg. 3105816 (EDGE); U.S. Reg. 3381826 (GAMER’S EDGE).

Following the filing of replacement applications, some of which have matured to registration based upon questionable specimens, Petitioner has recently revised its adversarial activity with this Board, filing five new cancellation actions in November 2022 against third party EDGE-formative registrations (e.g., cancellation actions 92080943, 92080972, 92080981, 92081010, and 92081057) and a sixth cancellation action in January 2023 (e.g., Cancellation No. 92081334) using “form pleadings” asserting internally contradictory and inapposite claims which, nevertheless, necessitate response. Following Respondent’s motion in this proceeding, the Board granted the motion on January 26, 2023 (TTAB Dkt #8) and dismissed two of the four cancellation claims asserted by Petitioner in this proceeding.

Multiple of the registrations and applications upon which Petitioner relies in this proceeding are the subject of ongoing challenges for fraud on the PTO currently pending before the Board and ripe for decision (see, e.g., Cancellation No. 92075393 and Opposition No. 91166066). Multiple of the registrations and applications upon which Petitioner relies appear to be refilings made by Petitioner following a court ordered cancellation of its prior registrations for fraud on the PTO. To require Respondent to defend against such rights while active challenges to such rights are ongoing would unnecessarily burden the limited resources of the Board and of the Respondent, a conservation organization with limited resources. Accordingly, Respondent respectfully requests that the Board suspend this proceeding pending resolution of those actions.

## **I. BACKGROUND**

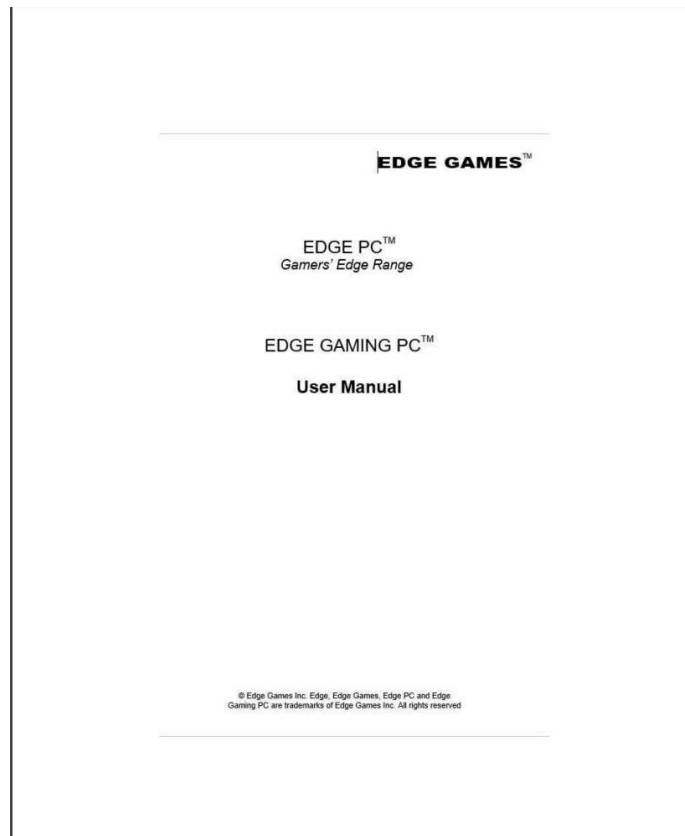
Petitioner relies upon the following marks as the basis for cancellation in this action:

1. U.S. Registration No. 5934761 issued December 17, 2019 for the mark EDGE GAMES covering “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” in Class 9;
  - a. The specimen filed with the USPTO in support of this registration consists of a single undated low-resolution image (see image capture below):



- b. This registration is currently the subject of Cancellation Action No. 92075393 filed October 6, 2020 seeking cancellation of the subject registration on grounds of, *inter alia*, fraud on the USPTO;

2. U.S. Registration No. 5987060 issued February 18, 2020 for the mark EDGE PC covering “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” in Class 9;
  - a. The substitute specimen filed with the USPTO in support of this application consists of a single undated page entitled “User Manual” that, conveniently, displays each of the concurrently applied for marks EDGE GAMES, EDGE PC, and EDGE GAMING PC with no other substantive content indicating the product such “user manual” is alleged to support, the date it was produced, or any other identifying criteria (see image capture below);



3. U.S. Registration No. 5987061 for the mark EDGE GAMING PC covering “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; netbook computers; notebook computers; personal computers; personal digital assistant computers; tablet computer” in Class 9;
  - a. The substitute specimen filed with the USPTO in support of this application consists of a single undated page entitled “User Manual” that, conveniently, displays each of the concurrently applied for marks EDGE GAMES, EDGE PC, and EDGE GAMING PC with no other substantive content indicating the product

such “user manual” is alleged to support, the date it was produced, or any other identifying criteria (see image capture below);

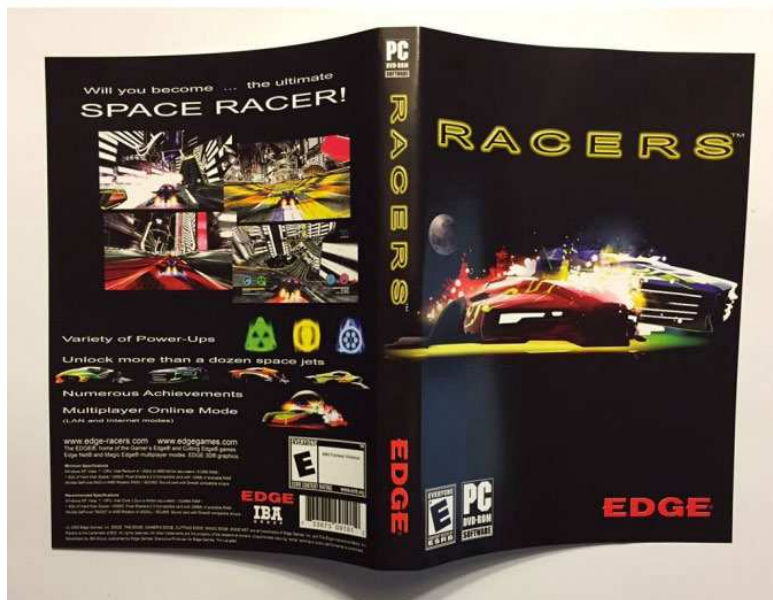


4. U.S. Trademark Application No. 86538581 for the mark EDGE covering “computer application software for mobile phones, namely, software for games; computer game programmes downloadable via the Internet; computer game software; computer game software downloadable from a global computer network; downloadable computer game programs; downloadable computer game software via a global computer network and wireless devices; downloadable electronic publications in the nature of e-zines and

electronically repurposes printed magazine content on the Internet, in the field of mobile on computer and on-console gaming in the field of games software and hardware; handheld personal computers; personal computers; video game software” in Class 9; “cardboard packaging; printed matter, namely, paper signs, books, manuals, curricula, newsletters, informational cards and brochures in the field of computer and video game software and hardware” in Class 16; “non-downloadable electronic publications in the nature of e-zines and electronically repurposed printed magazine content on the Internet, in the field of mobile on-computer and on-console gaming in the field of games software and hardware; providing a web-based system and on-line portal for customers to participate in on-line gaming, operation and coordination of game tournaments, leagues and tours for recreational computer game playing purposes” in Class 41;

a. The specimen filed in support of this application consisted of three images all derived from the same single piece of DVD-Rom packaging which, the USPTO nevertheless accepted in error in support of Class 16 and Class 41 (see images below):







- b. the same Application is the subject of challenge in pending Opposition No. 91166066 which is itself suspended pending final determination in the corresponding Cancellation Action No. 92075393;
- 5. U.S. Trademark Application No. 90686518 for the mark THE EDGE covering “computer game software downloadable from a global computer network; downloadable computer game software for personal computers and home video game consoles; downloadable computer game software for use on mobile and cellular phones; downloadable game software; downloadable computer game instruction manuals; downloadable electronic game software; downloadable interactive game software; downloadable video and computer game programs; recorded computer game software” in Class 9;
  - a. The specimens filed in support of the application consist of page captures from The WayBack Machine;
  - b. Examination of this application is currently suspended based upon prior pending Application Nos. 86491036 and 90226272, both of which are owned by Mobigame, the challenger in each of the Cancellation and Opposition actions described above.

6. U.S. Trademark Application No. 97064385 for the mark EDGE covering “smartphone software design for games; updating of computer games software; designing and developing computer game software and videogame software for the use with computers, video game program systems and computer networks” in Class 42.

- a. The specimen filed in support of this application consists of a single undated screen shot, the subject and providence of which is unclear:



- b. On January 5, 2022, the USPTO issued a 73-page office action rejecting the subject specimen, refusing registration on likelihood of confusion grounds citing Registration Nos. 2920266 (for the mark EDGE owned by Edge Systems, LLC), 4269583 (for the mark EDGE & Design owned by Dominion Energy, Inc.), and 4269587 (for the mark EDGE owned by Dominion Energy, Inc.), and anticipatorily citing Application Nos. 86491036 (for the mark EDGE owned by Mobigame, the challenger in the above mentioned opposition and cancellation actions), 88506022 (for the mark EDGE owned by Edge Group, which application is suspended), and 90226272 (for the mark EDGE also owned by Mobigame) and subsequently suspended further prosecution of the application on June 14, 2022. The subject application remains suspended.

## II. ARGUMENT

Respondent recognizes that the Board seldom grants a motion to suspend an opposition or cancellation proceeding pending the disposition of other oppositions pending against the same application or registration because of concerns around the potential for prejudice to non-consenting parties, in this case, Petitioner. Because the Board and the parties are interested in the prompt disposition of pleaded claims and defenses, separate oppositions against the same application are typically allowed to proceed simultaneously. *See, e.g., Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ 2d 1549 (TTAB 2009); *DataNational Corp. v. BellSouth Corp.*, 18 USPQ2d 1862 (TTAB 1991); *Vaugh Russell Candy Co. v. Cookies in Bloom Inc.*, 47 USPQ 2d, 1635 (TTAB 1998).

The Board's interest in consistency, economy, and the demands of justice may dictate an exception to the regular practice of allowing multiple actions to proceed simultaneously where, as here, the underlying rights upon which the Petitioner relies are the subject of longstanding validity challenges on grounds of fraud on the PTO, and Respondent is a conservation organization with limited resources concerned about the significant costs required to fund a protracted fraud-on-the-PTO claim through to final disposition.

The Board has broad discretion to order suspension of other proceedings pending disposition of one that has proceeded the furthest and is closest to issuance of a Board final decision where that decision may have a bearing on the common claims in other oppositions and/or the veracity of the underlying rights claims. *See* 37 CFR Section 2.117(a) (Trademark Rule 2.117(a)). This is such a case.

In the instant case, multiple of the registrations and applications relied upon by the Petitioner in this cancellation action are the subject of longstanding challenges for fraud on the PTO. Multiple of the registrations and applications upon which Petitioner relies appear to be refilings made by Petitioner following a court ordered cancellation of its prior registrations for fraud on the PTO. Disposition of those rights in the ongoing disputes between Mobigame and Petitioner would have a significant bearing on this proceeding.

To require Respondent, a conservation organization, to defend against such rights while substantive challenges to those same rights are ongoing in longstanding proceedings would unnecessarily burden the limited resources of both the Board and of the Respondent. The validity of Petitioner's cited registrations and applications are highly suspect. To require Respondent to initiate its own counterclaim challenges to Petitioner's cited registrations and applications would impose a significant burden and unnecessarily duplicate existing challenges to those rights currently pending before the Board. And as Respondent's mark registered on May 8, 2018, and could not become incontestable in light of this challenge, a suspension of this proceeding would result in no obvious prejudice to Petitioner.

WHEREFORE, Respondent respectfully requests that the Board suspend this proceeding pending resolution of Cancellation No. 92075393 and Opposition No. 91166066.

Dated: March 22, 2023

Respectfully submitted,

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Attorneys for Respondent On  
the Edge Productions Ltd.

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Respondent's Unilateral Motion to Suspend has been served on March 22, 2023 by emailing a copy to Counsel for Petitioner Tim Langdell at [edgegames@gmail.com](mailto:edgegames@gmail.com).

/s/ Keri D. Click

Keri D. Click, paralegal