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"Would You Rather...?" Litigation Update

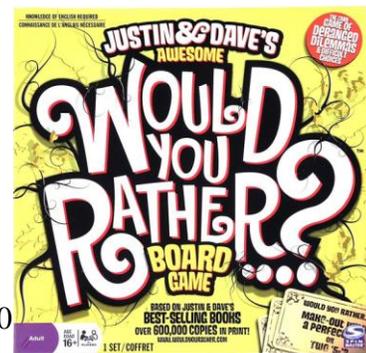
Posted on March 4, 2011 by [Dan Kelly](#)

Last May, I [reported](#) on a [Ninth Circuit Court of Appeals](#) decision opining on the descriptiveness of the ["Would You Rather...?" trademark registration](#). Subsequent to the Ninth Circuit's decision, the case returned to the [United States District Court for the Central District of California](#) and is now styled *Spin Master, Ltd. v. Zobmondo Entertainment, LLC*. (Falls Media was the named party in the Ninth Circuit case, and evidently the predecessor to Spin Master.)

By way of brief recap, [Spin Master](#) owns U.S. Trademark Registration No. 2970830 for the mark WOULD YOU RATHER...? for use in connection with books and games, among other things. They sued (rather, their predecessor sued) [Zobmondo](#) for trademark infringement, and Zobmondo counterclaimed to cancel Spin Master's registration based upon fraud on the Trademark Office. (If I recall correctly, Zobmondo actually sued first for declaratory judgment, but Spin Master is currently identified as the plaintiff, and is the natural plaintiff in any event.)

Spin Master's predecessors, David Gomberg and Justin Heimberg, the developers of the Would You Rather...? game (and books), filed an intent-to-use trademark application for WOULD YOU RATHER...? in July 1997, and the registration did not issue until July 2005. Along the way, Zobmondo made [a failed attempt to oppose the application](#), and Gomberg and Heimberg ultimately used all five available extensions of time to file a statement of use to support the registration, the last four of which required "good cause." The essence of Zobmondo's effort to cancel the registration boils down to an argument that Gomberg and Heimberg essentially strung along the Trademark Office while squatting on the trademark, and only put the mark to use in connection with games at the very last moment.

The district court issued [an opinion](#) last week granting summary judgment for Spin Master against Zobmondo's cancellation counterclaim. While Gomberg and Heimberg were not a model of efficiency in getting their product to market, the court found that they also did not embark on a course to commit fraud in procuring their trademark registration. The court cited [In re Bose](#) liberally, with the key proposition being "subjective intent to deceive, however difficult it may be to prove, is an indispensable element in the [fraud] analysis."



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I would encourage trademark types to read the opinion, as it describes a not-too-uncommon fact pattern of a trademark applicant encountering a bumpy road in charting a path to market, and how this creates risk for the resulting registration to be attacked down the road. While the applicant here landed on its feet (so far), the facts were sufficient to allow the adverse party to take the issue to judgment. Better to have a prosecution history that doesn't invite a cancellation in the first place.



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