

# Trademark Review

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## Owner of “WOULD YOU RATHER...?” Wins \$8.3 Million

In a case that started in 2006, a jury unanimously ruled that the phrase “Would You Rather...?” is protectable as a trademark for board games and books. The jury further found that Zobmondo infringed the owner’s rights by using the same phrase for the same types of goods and awarded the owner \$5.1 million in damages and \$3.5 million in punitive damages. Both companies use the phrase in connection with games that pose humorous or undesirable choices to the player of the game. The district court originally ruled on summary judgment that the phrase was merely descriptive and lacked secondary meaning, and thus, not entitled to trademark protection. The Ninth Circuit reversed that ruling, and found there were questions of fact, including the need for comprehensive consumer surveys.

*Spin Master Ltd. v. Zobmondo Entertainment LLC*, Case nos. 2:06-cv-03459 and 2:07-cv-00571 (D.C. C.D.Cal. Nov. 7, 2012)

## PC ON A STICK Is Not Merely Descriptive

Lockheed Martin filed to register the mark PC ON A STICK for computer storage devices such as flash drives. The Patent and Trademark Office rejected the application finding the mark merely descriptive. The Trademark Trial and Appeal Board reversed, finding that the consumer must go through a multi-stage reasoning process to appreciate that the “STICK” does not contain a “PC,” but rather the data and software content of a PC. Thus, the Board concluded “the mark suggests the function and purpose of the goods, but it does not do so ‘forthwith and with immediacy.’”

*In re Lockheed Martin Corporation*, Serial No. 85073741 (TTAB, November 15, 2012)

## Sonoma Wine Producer Wins Geographically Limited Injunction

The maker of wines sold under the label “Stark Wine” obtained a preliminary injunction enjoining the use of STARK RAVING on wines in Sonoma County. The court found that the plaintiff’s Stark Wine had obtained a reputation in Sonoma County where the wine is produced, but was not well known outside of Sonoma County. The court refused to grant injunctive relief beyond the limited geographic scope where the plaintiff’s wines were known.

*Christian Stark et al. v. Diageo Chateau & Estate Wines Co.*, Case no. 4:12-cv-04385 (D.C. N.D.Cal. Nov. 5, 2012)

### In This Issue

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- Sonoma Wine Producer Wins Geographically Limited Injunction
- Brand Owners Awarded Favorable Damages Awards in Counterfeiting Cases



## **Brand Owners Awarded Favorable Damages Awards in Counterfeiting Cases**

In one case, Cartier was awarded \$30 million against a watch manufacturer, and in an unrelated case Tory Burch obtained a \$2 million award against counterfeiters of its fashion goods. In both instances, the defendants failed to appear. The courts in each case also issued injunctions against further sales. Although the brand owners may never collect the damages awarded, these awards can help in deterring other counterfeiters.

*Richemont North America Inc., et al. v. Linda Lin Huang, et al.*, Case no. 12-cv-4443 (D.C. S.D.N.Y. Nov. 19, 2012) and *Tory Burch LLC v. Does 1 – 100*, Case no. 1:12-cv-07163 (D.C. N.D.Ill. Nov. 2, 2012)

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