

Bean, Kinney & Korman Wins Appeal For Defendant Imagination Entertainment Limited, et al. Regarding the Marketing and Sale of Popular Dice Game "Left Center Right"

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ARLINGTON, VA—Bean, Kinney & Korman recently won an appeal for client Imagination Entertainment Limited, et al. (Imagination Entertainment Ltd, Imagination Holdings, PTY Ltd and Imagination DVD, Inc.) against competitor George & Company, LLC's claim of federal trademark infringement in the marketing and sale of the popular dice game "LEFT CENTER RIGHT."

A three judge panel of the United States Circuit Court for the Fourth Circuit unanimously affirmed the judgment in Imagination Entertainment's favor against the infringement. The defense was led by Bean Kinney attorneys **William Krebs**, Christopher Glaser and Heidi Meinzer.

Bean Kinney's clients, three interrelated companies constituting an internationally recognized manufacturer and distributor of family-oriented board and DVD games, unveiled a dice game it marketed under the name of "LEFT CENTER RIGHT." The clients' competitor, a manufacturer of a similar game named "LCR," brought suit in the United States District Court for the Eastern District of Virginia seeking to enjoin the clients' marketing activities. As part of its suit, the competitor asserted that it owned rights in both LCR as a federally registered mark and in LEFT CENTER RIGHT due to its prior use of this mark.

Bean Kinney argued on behalf of Imagination Entertainment that, while the competitor owned the name LCR, that mark was not confusingly similar to LEFT CENTER RIGHT and that the competitor did not own any protectable rights in LEFT CENTER RIGHT. The appellate court recognized that the competitor had named its game LCR, it considered LCR to be its trademark, and it had used LCR as the name for its game for the preceding 17 years, but did not use LEFT CENTER RIGHT. In addition, the competitor was not able to establish that its LCR name was confusingly similar to the clients' LEFT CENTER RIGHT name, resulting in the appellate court concluding that LCR was a weak mark and that no meaningful evidence was submitted demonstrating that the public associated this mark with the competitor. Moreover, the Fourth Circuit held that LCR was sufficiently dissimilar in sight, sound and meaning to LEFT CENTER RIGHT so as to conclude that the competitor could not establish confusion among consumers.

The appellate court held that Bean Kinney's clients' competitor did not use LEFT CENTER RIGHT as a trademark and was not entitled to any rights in the phrase. The evidence demonstrated that, at most, it had used the name continuously until 1992 at

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which time it re-branded its game as LCR and abandoned its prior non-abbreviated name. However, the competitor opposed the claim of abandonment and asserted, among other arguments, that its use of the abbreviated LCR was the functional equivalent of its prior elongated name, that the public had come to use the elongated name to identify the game as the competitor's game, and that the competitor verbally used the elongated name with customers.

The Fourth Circuit recognized that LCR and LEFT CENTER RIGHT are not functional equivalents and that trademark law does not allow for the claim of verbal usage to permit a party to accrue rights in a phrase it had never physically affixed to any product. The competitor's reliance on the public's use was similarly misplaced because the public use doctrine recognizes that Americans are prone to shortening words in common use—such as Coke for Coca-Cola or Bud for Budweiser—and that, while trademark rights could accrue to the owner of an elongated mark for the shortened term coined by the public, they cannot accrue to an elongated term coined by the public that was never adopted by the competitor.

William Krebs, shareholder at Bean, Kinney & Korman, represents corporations, partnerships and individuals on a wide variety of disputes. He concentrates on civil litigation, including commercial disputes, intellectual property, fraud, tax, finance, employment and fiduciary obligations.