

II. Essay Question

Federal Infringement Claim:

A. Likelihood of Success regarding Mister Softee Script and Figure

Mister Softee has a registered trademark, for which Lanham §32(1) provides the cause of action for infringement that is likely to cause confusion. To determine likelihood of confusion, the Second Circuit uses the eight Polaroid factors. Prior to addressing the factors, it must be noted that confusion must be as to source, sponsorship, affiliation, or approval. Also, as a threshold matter, it should be noted that although Mister Softee has a registered service mark in Mister Softee in block letters, the actual use in commerce has been in the form of the stylized Mister Softee script along with the figure.

1) Strength of the mark is analyzed both in terms of market presence and theoretically. Theoretically, Mister Softee is a relatively strong trademark. Registration is prima facie establishment of the validity and distinctiveness of the mark. (Gallo). Furthermore, the mark is suggestive, not descriptive, since nothing in the words indicates that the product is one of ice cream. The figure, arguably, is more descriptive in nature since it has ice cream on his head. Although the word Softee suggests a soft product, which conceivably includes a soft ice cream, it only does so because the word and the design reinforce the suggestion that the product is one of ice cream. Imagination, thought or perception is required to figure out what the product or service is. Thus it is overall a suggestive mark. As for the market

strength, although the market is not a crowded one and there is no evidence of marketing, the mark is widely distributed, has been in commerce for more than 50 years, which support a finding of a strong mark. Gallo.

2) Degree of similarity between the marks is determined by the appearance, sound and meaning of the marks, as well as the manner in which the marks are used in the market. First, both marks are composite marks. When presented with composite marks, courts may consider whether one part of the mark is dominant. (Marshall Fields) It is not entirely clear whether there is a dominant part here. In Marshall Fields's, Field's was not the dominant term, because Field(s) was a common last name, and Marshall was a widely recognized mark on its own. Neither is true for Mister Softee. Second, they both appear in large font, and are displayed in the same size to the right of the vending window. Yet, there are some obvious differences in their appearance, especially the figure that forms the part of the mark. Although generally words are the dominant part of the mark, considering that children are the target base for the product, it is conceivable that to them the figure is the dominant part. In addition, the two marks use very distinct fonts, which further indicates a lack of similarity. Thus, although an argument regarding the composite nature of the mark as well as the use of the word Softee exists, overall, this prong points to a finding of lack of similarity.

3) The proximity of the products consists of two considerations. The first is the nature of the good. These products are nearly identical: both are ice cream products competing in the same market. Although Mister

Softee has a wider inventory, that fact is unlikely to make a difference since the common dominant article of commerce between the parties is soft ice cream. The second consideration is the channels of commerce. Although the products are not being sold next to each other, they nevertheless appear on same channels as they are both sold on the street. The map of the trucks indicates that the Mister Softee predominantly appears in Mid Town. If Captain Softee sells, for instance, exclusively in Queens, it might argue, albeit unsuccessfully, that the channels of commerce are different.

4) "Bridge the gap: In identical products this factor is not relevant.

5) Evidence of actual confusion. The record does not speak to this issue, and the survey that has been conducted is unlikely to assist since it measured recognition of the mark, which does not bear upon the issue of likelihood of confusion. The proper test is whether confusion is likely when a consumer familiar with one party's mark is confronted with the other party's mark alone. (Gallo). Such a survey may assist us in the future. In addition, actual confusion is not required for a finding of infringement (Gallo).

6) Good faith in adopting the mark. There is generally inference of bad intent where the senior mark holder's trademark is arbitrary and fanciful. Here the mark is suggestive, which means the inference of bad intent will be less straightforward. Knowledge can be imputed to a party given the totality of the circumstances. (Mobil). It is highly unlikely that Captain Softee did not know about Mister Softee as they both work in the same city and Mister Softee is prominent. Although the manner in which Captain Softee came up with the mark may have bearing on his intent, there is a colorable argument

that the intention was to capitalize on Mister Softee's goodwill. A finding of intent is not required to establish likelihood of confusion.

7) Quality of defendant's product or service. Courts generally do not consider this factor.

8) The sophistication of the consumer. Inexpensive ice cream tends to be an impulse purchase for which most consumers will not exercise much care. This makes the force of the trademark more powerful (and confusion between similar marks more likely) as consumers are likely to rely heavily on brand recognition. Alternatively, consumers who care a great deal about their ice cream may think that Captain Softee is affiliated with Mister Softee. The respective customer, be it a child or a parent, is unlikely to invest too much time or energy to the purchase. Thus the likelihood of confusion is very high.

In conclusion, although certain factors weigh against it, Mister Softee has a strong argument for infringement.

B. Likelihood of Success regarding the Registered Trade Dress

A threshold matter is whether the trade dress is a design trade dress or a packaging trade dress. The Supreme Court has held that product design is incapable of being inherently distinctive. (Samara). A packaging design dress could be inherently distinctive if its predominant purpose of encasing the product in a distinctive packaging is to identify the source of the product. Although the trade dress may have some ancillary purposes, one being attracting people to the product, the main purpose of the ice cream truck is product association. Two Pesos is similar. There the décor was found to be

a packaging for the product, Mexican food. The product being encased here are the milk based ice cream products. Captain Softee may argue that the trade dress is not the design but is part of the product of ice cream itself. That argument may have some sway with regard to Two Pesos, where the act of consuming the product occurred within the premise to which the design was attributed to, but here the purchase of the ice cream ends the relationship of the truck with the sale and the purchaser may simply leave the area and consume it elsewhere in no relation to the trade dress.

In the alternative, there is a strong argument that the trade dress has acquired secondary meaning. (Qualitex) The product has been in commerce both nationally and internationally for a long time. In addition, there is a survey that supports the conclusion that it is a well-recognized trademark.

Overall Mister Softee has a stronger argument regarding the trade dress under the application of Polaroid factors than it did with the trademark. Where the above analysis differs, it does so to the benefit of Mister Softee.

The similarity between the dresses is striking: the location of the mark, the color scheme, apparently identical bowl of ice cream to the left of the window. Captain Softee might argue aesthetic functionality of white to go with ice cream, but in today's variegated milk product market, it is hard to see why any particular color should give any party an aesthetic non-reputation-related advantage.

The sixth factor, intent, is also easier to impute in the trade dress infringement claim. An almost identical copying of an arbitrary and fanciful trade dress, which this dress is, is evidence of bad faith.

Overall, the factors weigh in favor of finding infringement.

C. Unregistered Menu

The menu is not a registered trade dress, but it can still receive trademark protection under **§43(a)** provided that it has been used in commerce, is distinctive, and non-functional. (Traffix) Use in commerce is easily met. Whether consumers associate the menu with Mister Softee is not clear on this record, since the cited survey speaks only to the trade dress of the truck. Furthermore, Captain has a colorable argument that the menu is generic, since it is fairly common to, not only ice cream trucks and stands, but in general street vending businesses. Finally, the menu is “essential to the use or purpose” of the ice cream truck, and therefore unlikely to pass the functionality threshold either.

Dilution:

Since Federal dilution does not require a finding of likelihood of confusion, even if the above claims fail, Mister Softee can argue dilution. Lanham §43(c)(1) requires that the mark be use in commerce, is famous, and the diluting activity occurs after the mark has become famous. These factors have been met as well since Mister Softee has been in commerce since 1956, with a substantial geographic reach and is well-recognized, and Captain Softee has only recently started the dilution.

Once these prerequisites are established, the argument for blurring under 43(c)(2)(B) can be made, as the factors for blurring mimic those of likelihood of confusion. Tarnishment argument, however, is likely to fail.

As for state dilution, the case for dilution via blurring is stronger since it does not require a finding of “famous” mark, just distinctiveness, nor does it insist on actual dilution. (Deere) A case for blurring can be made, but tarnishment argument is unlikely to succeed.

Initial Interest Confusion:

Initial interest confusion occurs when a consumer is initially deceived by a product, believing it to come from a different source, but ultimately buys it anyway. (Mobil) It is likely that a consumer might confuse Captain Softee’s for Mister Softee’s, walk towards it, get his wallet out, and essentially prepare to purchase ice cream, only to realize that it was not the expected Mister truck. Yet, having prepared to make the purchase, he might be just as happy to buy from Captain. The initial interest confusion is more likely to succeed with respect to the trade dress than the actual mark, because there is a stronger similarity between the trade dresses than the marks.

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