

## I. Likelihood of Confusion, “LOC”, against El Cheapo

A claim of LOC between two marks may be used by a senior mark holder to bar registration of the junior mark, or in an infringement action under Lanham §32 for registered marks and §43 for unregistered marks. Mister Softee’s, “Mister” trademarks in Mister Softee logo for “Ice Cream Trucks”, Mister Softee in Block Letters for “Retail Mobile Vending Services”, and Mister Softee Truck Trade Dress are registered and therefore Lanham §32 provides the cause of action for infringement. Mister is clearly the senior mark holder (*Bluebell*) and since the marks are registered they are valid under §7(d). Mister can also seek to protect its unregistered trade dress in the menu under §43. Courts have interpreted registered and un-registered marks to have the same LOC analysis. LOC requires that an appreciable number of ordinary prudent consumers are likely to be misled or confused into believing that the junior user’s product or service either originated with the senior user, or had some connection such as sponsorship, affiliation, or endorsement to the senior user. To determine LOC, courts have developed a few multi-factor tests: 2<sup>nd</sup> circuit (*Polaroid*), 9<sup>th</sup> (*Sleeckcraft*), 8<sup>th</sup> (*squirtco*); I will use the *Polaroid* factors.

First, it’s necessary to consider whether the products will be compared in their pre or post sale condition. The products will be compared pre-sale since the two products are probably identical post-sale and consumers will likely be confused at the point of purchase. (*Musingwear*)

### 1) Strength of Mister’s Marks:

Strength of the mark has two components: theoretical strength and market strength. The logo of Mister’s “ice cream trucks” and the service mark for “retail mobile vending services” are not theoretically strong. Mister immediately conveys knowledge of the ingredient of soft serve ice cream and if Mister was created by a man who sold soft serve ice cream then it would be merely descriptive requiring proof of secondary meaning. Captain may argue the truck itself is functional (*Traffix*), but this does not bar the nonfunctional, ornamental product features of the truck including the logo imprinted on the truck from registration. The trade dress of the truck is considered product packaging since the product itself is the ice cream cones and service; but the packaging seems to be descriptive since its comprised of ice cream products. (*TwoPesos*) At most the colors are suggestive as the blue and white suggest ice, cold and refreshing. Nevertheless, the TM’s are distinctive due to their strong secondary meaning (*IKC*) under the *Gimix* factors: the cone head has been used for 50 years and the trade dress for 40 years, 67% of Manhattan and 59% of residents in other borrows instantly recognize the trucks as Mister, and the volume of sales are significant. Additionally, Mister TM’s have not become generic since other vendors

exist in the market including Good Humor. Mister's strength in the ice cream truck market is substantial; its in 15 states and is now the largest franchiser of soft ice cream in the US and has significant operations internationally. If Captain can prove that there are extensive 3<sup>rd</sup> party uses, this may weaken its market strength.

2) Similarity

The second factor is the similarity of the marks as judged by their sight, sound and meaning. Each mark must be considered as it is encountered in the marketplace. The word mark Captain Softee is confusingly similar to Mister Softee for retail vending services and its logo. As to sound, the two marks share the dominant word, "softee" rendering the marks auditorally similar. As to meaning, both marks convey the same idea and stimulate the same mental reaction since both imply that a person is serving ice cream. Visually, there are differences between the fonts of the logos, but Mister has a registration for Block letters for retail mobile vending services. Additionally, similarities weigh more heavily than differences. Also, the color of the font is similar since both contain red.

Visually, the trade dresses of the trucks are remarkably similar. Both are white with a big blue stripe on the bottom. As in *Qualitex*, the colors of the Mister truck have acquired strong secondary meaning. Captain may try to claim the blue and white colors for an ice cream truck trade dress are aesthetically functional since they satisfy, "the noble instinct for giving the right touch of beauty to common and necessary things." Arguably, blue and white represent ice and something that's cool and refreshing, but unlike butter which is always yellow, if an ice cream truck company chose other colors it would not put them at a significant non-reputation related advantage. Both trucks display an ice cream sundae in the left side of the window with menus underneath the window. The total look and feel of these trade dress are the same.

Mister has probably acquired common law rights in its menu design since it consistently used the same menu design since the 1960's. Captain's menu is exactly the same despite a few minor differences. Captain may try to argue that the menu is functional and cannot have TM rights (*Triffax*) regardless of the existence of alternative designs. However the colors and placement of pictures of ice cream Sundays, cones and shakes with the word mark in the center are ornamental aspects of the menu and not essential to the use or purpose of a menu.

3) Proximity of Goods and Services and 4) Bridge the Gap

For this factor, courts consider the content, channels of commerce and marketing channels. Here, the products are clearly proximate since they are offering the same product, soft serve ice cream, and service in the same channel of commerce (retail trucks). Also, since the products and services are the same, the likelihood that Mister will bridge the gap is irrelevant.

5) Actual Confusion

If evidence of actual confusion exists, it will often be the best evidence of LOC. However evidence of actual confusion is not necessary to establish LOC. (*Gallo*) If a survey is well constructed, survey evidence can be especially persuasive of actual confusion. This can also be shown through misdirected inquiries (*IKC*). Here, there is no evidence here of actual confusion and a survey has not been conducted by Mister yet.

6) Intent

From the popularity of Mister, it is certain that Captain knew of Mister when adopting their marks. Courts have held that a rebuttable presumption of bad faith may be warranted when the junior user's mark is identical or close to another mark that is already well known and had acquired secondary meaning at the time the junior adopted it. In the 2<sup>nd</sup> circuit, a finding of bad faith creates a rebuttable legal presumption that the actors intended to confuse. Here, Mister is a registered well-known mark and had acquired strong secondary meaning; hence bad faith may be presumed.

7) Quality of Captain's products and services

The issue for this factor is whether the senior users reputation is jeopardized by virtue of the fact that the junior user is of inferior quality. (*Banfi*) Courts have interpreted this factor to be the least meaningful and there is no evidence of the quality of Captain's products.

8) Consumer Sophistication

In general, more sophisticated consumers are presumed to be less easily confused than those who are less sophisticated. The consumers of ice cream are generally children who are less sophisticated than adults. Inexpensive soft serve ice cream tends to be an impulse purchase for which most consumers wont exercise much care. Confusion is more likely where the products are relatively inexpensive, impulse products (*Gallo*).

In conclusion, Mister has a strong claim for infringement against El Cheapo since analysis of the *Polaroid* factors weigh heavily in favor of LOC.

**Initial Interest Confusion**

Mister may also establish Initial Interest Confusion. Many consumers of Mister might be confused initially by Captain, believing that the confusing marks in question were Mister's, arrive at the truck and realize it was Captain, but not really care about the source of the ice cream and buy it anyway. Under *Mobile*, a LOC may be found in this instance where the defendant gains its

credibility with the consumer during the initial phases of the deal. Captain is playing off the “good will” of Mister and therefore this is worth pursuing as a claim.

## **II) Dilution**

Mister may also bring a dilution claim under state or federal law if LOC is not found. Dilution is broadly defined as the whittling away of a TM value. Under Lanham §43(c), an owner of a “Famous Mark” that is distinctive is entitled to an injunction against any person who, at any time after the owner becomes famous, commences use of a mark or TN in commerce that is likely to cause dilution by blurring or tarnishment. This act requires that defendant’s use be a commercial use “in commerce”; here this is satisfied because El Cheapo is selling providing services to interstate travelers from NJ and Connecticut due to the nature of NYC and its warehouse is in NJ. §43(c)(1) also requires that the plaintiff’s mark is famous. As proved by the consumer survey in 06, Mister is famous because it is widely recognized by the consuming public in the US as a designation of the goods or services throughout 15 states.

If Mister is not considered famous, Mister can also bring a claim in State court for blurring or tarnishment. Tarnishment requires a finding that the plaintiff’s mark will suffer negative associations through defendant’s use. (*Hormel*). If Captain’s ice cream is inferior or is offensive then there may be a tarnishment issue. Blurring occurs when another’s use of a mark creates the possibility that the mark will lose its ability to serve as a unique identifier of the plaintiff’s product. Blurring involves a loss of distinctiveness of Mister Softee’s marks. Here, the record suggests that the companies are competitors in NY, but there is no evidence of loss of distinctiveness. The claim should be brought regardless because most state laws and the Lanham Act merely require a likelihood of dilution.

## **III Other Defenses**

Captain may argue descriptive fair use since Softee is a descriptive word for soft serve. However, Captain’s use does not point away from Mister’s TM’s since the TM’s are used to represent the same type of product and service. Captain may assert a first amendment defense since giving Mister exclusive use of the words Mister Softee and its trade dress prohibits Captain from conveying its message. (*SanFran*) This argument will probably fail since Mister Softee is not a phrase that is rich in meaning and Captain had other ways of conveying its message. For example, Good humor has a distinct word mark and logo from Mister. Finally, Captain does not seem to be a parody on Mister therefore nominative FU probably won’t work either.

Word count: 1799 words