UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

MISTER SOFTEE, INC.,	:	
Plaintiff,	:	04 Civ. 4011 (JSR) (GWG)
-v.-	:	REPORT AND RECOMMENDATION
MARILYN MARERRO d/b/a, Mister Best and Ice Cream Parlor On Wheels et al.,	:	
Defendants.	:	

GABRIEL W. GORENSTEIN, UNITED STATES MAGISTRATE JUDGE

On May 27, 2004, plaintiff Mister Softee, Inc. ("Mister Softee") filed a complaint against 34 defendants, including Nikolaos Petropolous, raising trademark infringement and related claims. On August 11, 2004, pro se defendant Nikolaos Petropolous filed a motion to dismiss the complaint. (Docket #41). For the reasons stated below, that motion should be denied.

I. BACKGROUND

The allegations of the complaint are assumed to be true for the purposes of this motion.

Mister Softee is a New Jersey corporation that has been operating since 1956. See Complaint, filed May 27, 2004 (Docket #1), ¶¶ 1, 38. Mister Softee franchises Mister Softee mobile ice cream trucks which sell "soft-serve ice cream, hard ice cream, frozen desserts, novelties, stick items, and other products." Id. ¶ 38. Mr. Softee is the owner of United States Trademark numbers: 2,128,918; 0,667,335; and 0,663,456, which are trademarks for Mister Softee and related logos. Id. ¶ 40. Mister Softee also owns the trademark for the "Mister Softee Jingle" played by its mobile trucks at Registration No. 2,218,017. Id. A trademark application is currently pending for the design of the Mister Softee mobile trucks as Serial No. 78,257,992. Id.

Mister Softee asserts that it began using its marks and trade dress in 1956 and the Mister Softee Jingle in 1960. Id.

The Mister Softee trucks are white with a blue trim bordering the bottom of the trucks and blue wheel rims. Complaint, Exhibit A ("Ex. A"). The name "Mister Softee" is written in red cursive letters on the front and sides of each truck. Id.; Complaint, Exhibit B ("Ex. B"). The phrase "the Very Best" is written in red cursive letters on the hood. Ex. B. On the sides, the words "Sundaes," "Shakes," and "Cones" are written in blue block lettering. Ex. A. On the back of the truck, there is a picture of a boy and girl wearing seatbelts and red block lettering reads, "Watch For Our Children Slow!" Complaint, ¶ 42. On the sides of the truck, there is a cartoon logo of a smiling ice cream cone wearing a bow tie, apparently known as "Conehead." Id. ¶¶ 40, 41. Each truck is equipped with a sliding glass window for customer service. Id. ¶ 41. There is a menu at each window titled "Mister Softee Treats" and ads for speciality products such as the "Devil's Delight Conehead" and "Cherry Top Conehead." Id.

Petropolous sells soft-serve ice cream and other frozen desserts using a mobile truck. Id. ¶ 15. Petropolous's "Soft Ice Cream" truck is white with blue trim that borders the bottom of the truck. Id.; Ex. B. The wheel rims are painted blue. Ex. B. The photograph of the truck annexed to the complaint shows the words "Soft Ice Cream" in red script on the front, and the words "Sundaes," "Shakes," and "Cones" in blue block letters on the sides. Id. The back of the truck has the word "SLOW" in red block letters. Id.

Mister Softee asserts two claims against the defendant Petropolous. In Count One, it claims "trademark infringement and unfair competition." Complaint, ¶¶ 47-54. In Count Two, it asserts "trade dress infringement." Id. ¶¶ 55-64.

II. MOTION TO DISMISS

A. Standard Governing Motion to Dismiss

In resolving a motion to dismiss under Fed. R. Civ. P. 12(b)(6), the Court must accept the factual allegations set forth in the complaint as true and draw all reasonable inferences in favor of the plaintiff. See, e.g., Swierkewicz v. Sorema N.A., 534 U.S. 506, 508 n.1 (2002); Scheuer v. Rhodes, 416 U.S. 232, 236 (1974). A complaint need only include a short and plain statement of the claim that gives "the defendant fair notice of what the plaintiff's claim is and the grounds upon which it rests," Swierkewicz, 534 U.S. at 512, and should not be dismissed "unless it appears beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief." Conley v. Gibson, 355 U.S. 41, 45-46 (1957). "At the [Rule] 12(b)(6) stage, '[t]he issue is not whether a plaintiff is likely to prevail ultimately, but whether the claimant is entitled to offer evidence to support the claims. Indeed it may appear on the face of the pleading that a recovery is very remote and unlikely but that is not the test.'" Chance v. Armstrong, 143 F.3d 698, 701 (2d Cir. 1998) (quoting Branham v. Meachum, 77 F.3d 626, 628 (2d Cir. 1996)).

B. Trademark and Trade Dress Infringement

A trademark is "any word, name, symbol, or device, or any combination thereof [used or intended to be used] to identify and distinguish [a producer's] goods . . . from those manufactured or sold by others and to indicate the source of the goods . . . ." 15 U.S.C. § 1127. "Trade dress" refers to the "design and appearance of the product together with all the elements making up the overall image that serves to identify the product presented to the consumer." Fun-Damental Too, Ltd. v. Gemmy Indus. Corp., 111 F.3d 993, 999 (2d Cir. 1997). This includes

"the total image of a product and may include features such as size, shape, color or color combinations, texture, [or] graphics." Bristol-Meyers Squibb Co. v. McNeill-P.P.C., Inc., 973 F.2d 1033, 1043 (2d Cir. 1992).

The Lanham Act protects trademarks from infringement. See generally 15 U.S.C. § 1114. This section creates liability for the unauthorized use in commerce of "any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1114(1)(a). Thus, to prevail on a trademark infringement claim, a claimant must show that "it has a valid mark entitled to protection and that the defendant's use of it is likely to cause confusion." Gruner + Jahr USA Publishing v. Meredith Corp., 991 F.2d 1072, 1075 (2d Cir. 1993).

For a trade dress claim, a plaintiff must prove "(1) that the mark is distinctive as to the source of the good, and (2) that there is a likelihood of confusion between its good and the defendant's." Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 115 (2d Cir. 2001). In addition, "the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional." 15 U.S.C. § 1125(a)(3).

Here, Mister Softee has sufficiently pled its infringement claims. It has asserted that it owns certain trademarks infringed by the defendant. Complaint, ¶¶ 40, 45, 48. It has also made clear that the nature of its trade dress -- consisting in large part of matters painted on the surface of its trucks -- are both distinctive and non-functional. See id. ¶ 41. With respect to both the trademark and trade dress elements, it has asserted that there is a likelihood that the markings on defendant's truck will cause confusion. See id. ¶¶ 50, 59. Because Mister Softee has adequately

pled the elements of its trademark and trade dress infringement claims, the defendant's motion to dismiss must be denied.

C. Unfair Competition

Plaintiff also asserts a claim of "unfair competition," id. at 18, presumably based on its allegation that its trademark has been "diluted." Id. ¶ 51.

The Lanham Act provides for injunctive relief if a person's commercial use of another's mark "causes dilution of the distinctive quality of the mark." 15 U.S.C. § 1125(c). For a successful trademark dilution claim, "(1) the senior mark must be famous; (2) it must be distinctive; (3) the junior use must be a commercial use in commerce; (4) it must be after the senior use has become famous; and (5) it must cause dilution of the distinctive quality of the senior mark." Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 215 (2d Cir. 1999). The statute provides a list of factors for determining whether a mark is famous, including: "the degree of inherent or acquired distinctiveness of the mark," "the duration and extent of use of the mark in connection with the goods or services with which the mark is used," and "the geographical extent of the trading area in which the mark is used." 15 U.S.C. § 1125(c).

Mister Softee has adequately pled the elements of a dilution claim. First, the Complaint adequately alleges that Mister Softee's marks and trade dress are famous based on its contention that they have been "continuously used and advertised . . . throughout the region." Complaint, ¶ 40. The marks and trade dress are described in such a way that it is clear they are distinctive. Id. ¶ 41. Defendant's use is alleged to be commercial, id. ¶ 15, and by implication to have occurred after Mister Softee's use became famous. See id. ¶ 60. Finally, Mister Softee has pled

that its mark has been diluted. Id. ¶ 61. Accordingly, the motion to dismiss must be denied as to the dilution claim as well.

Conclusion

For the foregoing reasons, Petropoulos's motion to dismiss should be denied.

PROCEDURE FOR FILING OBJECTIONS TO THIS REPORT AND RECOMMENDATION

Pursuant to 28 U.S.C. § 636(b)(1) and Rule 72(b) of the Federal Rules of Civil Procedure, the parties have ten (10) days from service of this Report and Recommendation to serve and file any objections. See also Fed. R. Civ. P. 6(a), (e). Such objections (and any responses to objections) shall be filed with the Clerk of the Court, with copies sent to the Hon. Jed S. Rakoff, 500 Pearl Street, New York, New York 10007, and to the undersigned at 40 Centre Street, New York, New York 10007. Any request for an extension of time to file objections must be directed to Judge Rakoff. If a party fails to file timely objections, that party will not be permitted to raise any objections to this Report and Recommendation on appeal. See Thomas v. Arn, 474 U.S. 140 (1985).

Dated: October 21, 2004
New York, New York

GABRIEL W. GORENSTEIN
United States Magistrate Judge

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