Frosty Treats Inc. v. Sony Computer Entertainment America

426 F.3d 1001, 1003-1006 (8th Cir. 2005)

Morris Sheppard Arnold, Circuit Judge

A group of affiliated companies, Frosty Treats, Inc., Frosty Treats of Louisville, Inc., Frosty Treats Wholesale, Inc., and Frosty Treats of Atlanta, Inc., collectively known as "Frosty Treats," sued Sony Computer Entertainment America, Inc., (SCEA) asserting, inter alia, claims under state and federal law for trademark infringement and dilution, and for unfair competition. Frosty Treats premised these claims upon SCEA's depiction of an ice cream truck and clown character in SCEA's Twisted Metal video game series. Frosty Treats contends that because the ice cream truck . . . in the final game, is labeled with its brand identifier, "Frosty Treats," the games create a likelihood of confusion as to Frosty Treats's sponsorship of or affiliation with the games. See 15 U.S.C. § 1125(a). The district court granted SCEA's motion for summary judgment on all of Frosty Treats's claims, and Frosty Treats appeals. We affirm.

Frosty Treats asserts that the district court erred by finding that there were no genuine issues of material fact and holding as a matter of law that the "Frosty Treats" mark was not protectable. . . .

We review a grant of summary judgment de novo, applying the same standards as the district court. . . .

I.

Frosty Treats argues first that the district court erred by holding that its "Frosty Treats" mark is not entitled to trademark protection because it is generic, or, in the alternative, descriptive without secondary meaning. Frosty Treats asserts that the mark is suggestive, or, at worst, descriptive with an acquired secondary meaning, and therefore protectible. We disagree. At best, the "Frosty Treats" mark is descriptive, and there is no basis for concluding that it has acquired secondary meaning.

The stylized words "Frosty Treats" appear toward the rear of the passenger's side of plaintiffs' ice cream vans as pink capital letters with frost on the upper portion of each letter. See Figure 1 (depicting the "Frosty Treats" decal). The decal on which these words appear is approximately nine inches wide by four inches high and is surrounded by decals of the frozen products that the Frosty Treats vans sell. See Figure 2 (depicting a typical Frosty Treats van).

Figure 1.

Figure 2.

To determine whether this mark is protectible, we must first categorize it. "A term for which trademark protection is claimed will fall in one of four categories: (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful." WSM, Inc. v. Hilton, 724 F.2d 1320, 1325 (8th Cir. 1984). A generic mark refers to the common name or nature of an article, and is therefore not entitled to trademark protection. Co–Rect Prods., Inc. v. Marvy! Adver. Photography, Inc., 780 F.2d 1324, 1329 (8th Cir. 1985). A term is descriptive if it conveys an "immediate idea of the ingredients, qualities or characteristics of the goods," Stuart Hall Co., Inc. v. Ampad Corp., 51 F.3d 780, 785–86 (8th Cir. 1995), and is protectible only if shown to have acquired a secondary meaning. Co–Rect Prods., 780 F.2d at 1329. Suggestive marks, which require imagination, thought, and perception to reach a conclusion as to the nature of the goods, and arbitrary or fanciful marks, are entitled to protection regardless of whether they have acquired secondary meaning. See id.

If it is not generic, the phrase "Frosty Treats" is, at best, descriptive. Frosty Treats is in the business of selling frozen desserts out of ice cream trucks. "Frosty Treats" conveys an immediate idea of the qualities and characteristics of the goods that it sells. No imagination, thought, or perception is required to reach a conclusion as to the nature of its goods. To prevail, therefore, Frosty Treats must demonstrate that the mark has acquired a secondary meaning. "Secondary meaning is an association formed in the minds of consumers between the mark and the source or origin of the product." Id. at 1330. To establish secondary meaning, Frosty Treats must show that "Frosty Treats" serves to identify its goods and distinguish them from those of others. Id. Secondary meaning does not require the consumer to identify a source by name but does require that the public recognize the mark and associate it with a single source. Stuart Hall, 51 F.3d at 789; see Heartland Bank v. Heartland Home Fin., Inc., 335 F.3d 810, 818–19 (8th Cir. 2003) (Smith, J., concurring).

The record, when viewed in favor of Frosty Treats, demonstrates that SCEA is entitled to judgment as a matter of law on this issue. Frosty Treats has failed to put forth more than a scintilla of evidence that the public recognizes its "Frosty Treats" mark and associates it with a single source. Frosty Treats claims that its survey evidence demonstrates that the term "Frosty Treats" has acquired secondary meaning, but, if anything, it indicates the opposite. In the survey, respondents were shown images of the Frosty Treats ice cream van and asked, "Are you familiar with or have you ever seen or heard of this before?" Forty-seven percent responded affirmatively. They were then asked what they knew about the van. The respondents most frequently mentioned that it sold ice cream. Only one percent of the respondents in the survey mentioned Frosty Treats by name. There is no indication in the record that the survey respondents (apart from the one percent) were familiar with the vans because of the small nine-by-four-inch "Frosty Treats"

decal on the rear portion of the side of the van, the only place where the phrase "Frosty Treats" appears on the vehicle. This decal, moreover, is surrounded by numerous other decals comprising the van's menu board. See Figure 2. Frosty Treats's survey provides no basis to conclude that the respondents associated the van with a single source as opposed to simply a generic ice cream truck.

Although direct evidence such as consumer testimony or surveys are most probative of secondary meaning, it can also be proven by circumstantial evidence. See Heartland Bank, 335 F.3d at 819–20 (Smith, J., concurring). Circumstantial evidence such as the exclusivity, length and manner of use of the mark; the amount and manner of advertising; the amount of sales and number of customers; the plaintiff's established place in the market; and the existence of intentional copying could also establish secondary meaning. See id. (citing 2 J. Thomas McCarthy, McCarthy on Trademarks & Unfair Competition §§ 15:30, 15:60, 15:61, 15.66, 15.70 (4th ed. 1999)). But the circumstantial evidence that Frosty Treats offered to establish secondary meaning also fails to raise a genuine issue of material fact.

We recognize that the application of some of these criteria to the facts of this case may militate in favor of a finding of secondary meaning in the mind of a reasonable juror. For instance, there is evidence that Frosty Treats has used the term in a continuous and substantially exclusive manner since 1991. Cf. Stuart Hall, 51 F.3d at 789–90. Furthermore, the record reflects that Frosty Treats, although a relatively small company, is nevertheless one of the largest ice cream truck street vendors in the nation.

On the other hand, there is no evidence that SCEA intentionally copied the term. Most significantly, the record does not contain sufficient evidence for a juror to conclude that Frosty Treats engages in advertising or publication of the "Frosty Treats" mark to an extent that would be effective in having the public recognize it and equate it with a single source. See Co–Rect Prods., 780 F.2d at 1330; Heartland Bank, 335 F.3d at 820 (Smith, J., concurring). In fact, Frosty Treats does not even prominently display the "Frosty Treats" mark on its street-vending vans, which according to its brief is the primary way that it advertises the phrase. As mentioned earlier, the phrase appears on the vans as a nine-by-four-inch decal that is surrounded by numerous other decals of frozen desserts.

Furthermore, SCEA submitted indirect evidence that the term "Frosty Treats" has not acquired secondary meaning. SCEA's expert conducted a survey of 204 children and 200 adults who had purchased ice cream from an ice cream truck in Frosty Treats's largest markets. When asked to volunteer the names of any ice cream trucks that they had purchased ice cream from, not one recalled the name "Frosty Treats." The evidence as a whole simply does not provide a sufficient basis for concluding that the phrase "Frosty Treats" has acquired a secondary meaning. Accordingly, it is not protectible under trademark law.

{The court went on to find, inter alia, that there was no likelihood of confusion as to the source or sponsorship of SCEA's video game.}