

## ARTICLES

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### THE BATTLE TO KEEP THE "MISTER SOFTEE" BRAND FROM MELTING AWAY

#### AUTHORS

Stefan J. Kirchanski, Ph.D.  
Miguel A. Lopez, Ph.D.

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The sight of a Mister Softee ice cream truck is a reminder that summer is here, and its jingle draws children to run and grab a cone to enjoy. Mister Softee trucks are sprinkled around 15 states, with over 600 trucks operated by franchisees. Although the trucks move slowly enough for a child to catch up, this number of mobile franchises can be difficult for a franchisor to monitor.

In a recent attempt to police its brand, Mister Softee took aim against a former franchisee that began operating "Master Softee" and "Soft King" trucks. The underlying case, *Mister Softee, Inc. v. Tsirkos*, accused Dimitrios Tsirkos of trademark infringement and breach of the Franchise Agreement with Mister Softee. Tsirkos was authorized to operate sixteen Mister Softee trucks around Queens and the Bronx, but allegedly breached the Franchise Agreement by failing to make royalty payments and park the trucks in a designated depot. After ending his franchise relationship with Mister Softee, Tsirkos continued to operate ice cream trucks labeled "Master Softee" and "Soft King" in the same areas he operated Mister Softee trucks, in violation of the Franchise Agreement's non-compete provisions, according to the complaint.

In its June 5, 2014 decision, the court for the Southern District of New York granted Mister Softee's request for preliminary injunction, finding the names and designs of Tsirkos's trucks confusingly similar to Mister Softee's. The injunction prohibits Tsirkos from operating trucks with designs and names confusingly similar to Mister Softee's trademarks – including the "Mister Softee" name, cone figure, jingle, and truck design – and operating trucks within a five mile radius of Tsirkos's prior Mister Softee territories.

The proverbial cherry on top came when Tsirkos continued to operate "Master Softee" trucks in Manhattan, violating the injunction. The court found that Mister Softee demonstrated Tsirkos violated the order by providing photographic evidence of "Master Softee" trucks operating around Manhattan starting just two days after the injunction was granted. Information also came to light that at least two other individuals owned and operated "Master Softee" trucks, proving that this is not the end of the road for Mister Softee's battle.

The "Master Softee" case garnered a great deal of media attention, some of which noted Mister Softee's strict enforcement of its Franchise Agreements and protection of its trademarks and trade dress. This is not the first time a Mister Softee franchisee has gone off course – earlier this month the District Court of New Jersey granted a similar injunction against Reza Amanollahi who was allegedly operating similarly infringing trucks (although there was dispute over the actual ownership of the trucks). These recent decisions follow prior cases in which Mister Softee filed trademark infringement suits against other ice cream truck operations, though not franchisees, for using markings confusingly similar to those registered by Mister Softee.

Although monitoring 600 trucks for compliance is not always a treat, Mister Softee's consumer base may be favorable when a court evaluates its trademark infringement claims. As noted by the *Tsirkos* court, the designs on trucks are meant to be seen from a distance, allowing a court to review the similarity of the marks or designs at issue with less scrutiny. Additionally, Mister Softee's consumers are (mostly) children, deemed as "unsophisticated consumers."

So while it may be a lofty task for Mister Softee to police its moving franchises, certain factors have favored Mister Softee and allowed it to succeed on trademark infringement claims, keeping the brand from melting away.