

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NOTICE OF OPPOSITION

In the Matter of Application Number: 78/168231
Mark: "Frosty Treats"
Application Filed: September 26, 2002
Application Classes: 35 & 39
Published in the Official Gazette at TM 154
On May 13, 2003


09-05-2003
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

SONY COMPUTER ENTERTAINMENT
AMERICA INC.,

Opposition No.

Opposer,

v.

FROSTY TREATS, INC.,

Applicant.

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

SONY COMPUTER ENTERTAINMENT AMERICA INC. (hereinafter "Opposer"), a Delaware corporation with its principal place of business at 919 East Hillsdale Blvd., Foster City, CA 94404, believes that it will be damaged by the registration of the alleged mark "Frosty Treats" shown in Application No.78/168231 for the identified services in International Classes 35 and 39 whose central focus is the distribution of "frozen foods, ice cream and confections", and Opposer hereby opposes same.

1. Opposer believes that registration is improper for three reasons: (1) “frosty treats” is the generic name for a class of food products which are cold and choice to eat, specifically, the class identified by Applicant in the application as “frozen foods, ice cream and confections”; (2) if “frosty treats” is not generic, it is so highly descriptive of the specific goods identified by Applicant, namely, “frozen foods, ice cream and confections” that Applicant’s proposed proof of acquired distinctiveness is insufficient for registration; (3) Applicant has submitted an improper specimen of use for the services recited in International Class 39.

2. Opposer and its predecessors (hereinafter collectively “Opposer”) have for many years marketed and sold in the United States a wide range of video game and video game hardware products under the world famous PLAYSTATION and PLAYSTATION 2 marks including, but not limited to, the PLAYSTATION and PS ONE video game consoles and the PLAYSTATION 2 computer entertainment system (hereinafter collectively “the PLAYSTATION systems”). Additionally, Opposer has for many years published, marketed and sold in the United States its own video games for the PLAYSTATION systems in the United States under various game marks, and has licensed the right to others to publish, market and sell in the United States their own computer and video games for the PLAYSTATION systems.

3. On November 27, 2001, Opposer published and began to market and sell in interstate commerce in the United States a video game under the trademark TWISTED METAL: SMALL BRAWL which is the subject of U.S. Registration No. 2,753,882, dated August 19, 2003. The video game utilizes generic images of remote-controlled toy cars, red wagons and trucks. The TWISTED METAL: SMALL BRAWL game also includes a fictitious remote-controlled ice cream truck bearing the generic designation “frosty treats”. Opposer uses this generic designation as decoration only for the truck within the game. It does not use this designation as a trademark or service mark. Opposer is not engaged in the same or similar business as Applicant.

4. On September 26, 2002, Applicant filed U.S. Application No. 78/168231 for its alleged mark "Frosty Treats" in International Class 35 for the "wholesale distribution of frozen foods, ice cream and confections" and in International Class 39 for the "leasing of commercial vehicles" for the distribution of the same goods. The application sought registration under Section 2(f) of the U.S. Trademark Act, 15 U.S.C. §1052(f) based on Applicant's declaration of "substantially exclusive" use of its alleged mark for at least the past five years. The Examining Attorney subsequently requested that the words "distributorships featuring" be substituted for "distribution of" in the Class 35 description.

5. As indicated in the TESS database of the USPTO, a relevant excerpt of which is attached hereto as Exhibit A, Application No. 78/168231 was approved for publication on March 20, 2003. On the following day, Applicant and its related companies filed a complaint against Opposer in the Circuit Court of Jackson County Missouri for trademark infringement involving Applicant's alleged mark "Frosty Treats" and other claims. The stamped cover page showing the March 21, 2003 filing date is attached as Exhibit B hereto. In the complaint, Applicant asserted that Opposer's use of the "frosty treats" designation was an infringing use of Applicant's service mark. The state lawsuit was subsequently removed to federal district court in the Kansas City, Missouri where it is currently pending (*Frosty Treats, Inc., et al., v. Sony Computer Entertainment America Inc., et al.*, No. 03-0378-CV-W-SOW, W.D. Mo.). Opposer has denied infringement, denied the existence of a likelihood of confusion and has sought a declaration that Applicant's alleged mark is invalid and unenforceable. Upon information and belief, Applicant's sole reason for filing the subject application was to improperly manufacture a new but non-meritorious federal cause of action for inclusion in the lawsuit. The inclusion of such a cause of action so lacking in merit will drive up the cost and inconvenience of the litigation.

Count One: Applicant's Alleged Mark is Generic

6. Through long and extensive use by numerous third parties of “frosty treats” or “frosty treat” (hereinafter collectively “frosty treats”), the relevant purchasing public has come to refer to “frosty treats” as the generic name for a class of food products which are cold and choice to eat, namely, the products described by Applicant as “frozen foods, ice cream and confections.” The use of this generic name is so pervasive it is highly unlikely that Applicant was not aware of such use.

7. Because the relevant public has come to refer to “frosty treats” as the generic name for a class of food products which are cold and choice to eat, and said class also identifies the products identified in the application, namely, “frozen foods, ice cream and confections”, the alleged mark “Frosty Treats” is the generic name for such products and the application should be denied registration on the grounds of genericness.

Count Two: Applicant's Alleged Mark is Merely Descriptive and Lacks Acquired Distinctiveness

8. In the event that the U.S. Patent and Trademark Office somehow were to determine that “frosty treats” is not generic, Opposer submits that the designation is so highly descriptive of the goods identified in the application, namely, “frozen foods, ice cream and confections,” that Applicant’s proposed proof of acquired distinctiveness is insufficient for registration.

9. Applicant’s alleged mark “Frosty Treats” is not “merely” descriptive of a single characteristic of Applicant’s recited goods. Rather, it is “highly” descriptive of both the texture of these products and the reason for consumption of these products. The combination of “frosty” and “treats” describes food products which are cold and choice to eat, namely, Applicant’s “frozen foods, ice cream and confections.” Because the alleged mark is highly descriptive of the goods recited in the application, and these goods

are the central focus of the identified services, substantial proof is required to support a claim of acquired distinctiveness, if such a claim can be made at all.

10. Applicant's evidence of acquired distinctiveness consists solely of the declaration made in the application of "substantially exclusive" use for at least five years. There is no evidence of purchaser recognition of the words "frosty treats" as Applicant's exclusive service mark for the recited services and the goods related thereto. Nor is there any evidence of the amount and types of advertising Applicant has used to generate such recognition. In view of the highly descriptive nature of Applicant's alleged mark, Applicant's proposed proof of acquired distinctiveness should be rejected as insufficient. The application should be denied registration on the grounds that "Frosty Treats" is merely descriptive of Applicant's "frozen foods, ice cream and confections" and lacks acquired distinctiveness.

Count Three: Applicant has Submitted an Improper Specimen of Use for the
Recited Services in International Class 39

11. With regard to the recited services in International Class 39, namely, the "leasing of commercial vehicles" Applicant has failed to submit an adequate specimen in support of such services. According to 37 C.F.R. § 2.56 (b)(2), "(a) service mark specimen must show the mark as actually used in the sale or advertising of the services," in this instance the sale of commercial leasing services to the drivers/lessees or the advertising of such services to the drivers/lessees. As a specimen of use for the recited services in this class, Applicant has submitted a sign bearing the generic designation "frosty treats" as it appears on a vehicle from which Applicant's "frozen foods, ice cream and confections" are distributed to the public.

12. The specimen submitted does not evidence that commercial leasing services are available nor does it provide any information with regard to how the person viewing the specimen might go about leasing a commercial vehicle. Finally, there is no evidence in the record that said sign and said vehicle are displayed in the transaction for

the purchase of commercial leasing services. As a result of this improper submission, Applicant has failed to meet the specimen requirements of 37 C.F.R. § 2.56(b)(2). The application with regard to International Class 39 is void for failure to submit an acceptable specimen, resulting in the abandonment of the application for this class.

13. Opposer has a present and future right to use of the “frosty treats” designation as a generic name for food products that are cold and choice to eat in one or more of its video games. Opposer is likely to be damaged by the registration of “Frosty Treats” by Applicant because the registration of this generic term will tend to impair Opposer’s aforesaid right. Furthermore, Opposer has a real interest in this proceeding as its outcome will directly affect the pending litigation with Applicant and therefore Opposer’s ability to use the generic “frosty treats” designation in its video games. In the litigation, Applicant seeks to enjoin sales of Opposer’s existing products because of Opposer’s use in its existing products of the generic “frosty treats” designation. Applicant only seeks registration for use in the pending litigation against Opposer. While Applicant cannot plead and prove infringement in the litigation, the added expense and inconvenience from the addition of a new claim will harm Opposer and Opposer will obviously be harmed if Applicant is able to obtain an injunction against Opposer’s existing products on the basis of a federal registration in the “frosty treats” designation.


14. Applicant’s filing of the aforementioned lawsuit as soon as the subject application was approved for publication reveals its true intent to claim rights far beyond the scope of wholesale distribution and commercial leasing and instead claim exclusivity in the generic name “Frosty Treats” for all uses related to “frozen foods, ice cream and confections”. Not only would the registration of this generic name damage Opposer, it would also be a source of damage and injury to the public and the trade in which Applicant is engaged who use and understand the designation to indicate the generic name of said class of “frozen foods, ice cream and confections” or to merely describe the qualities of said goods, requiring the public and the trade to abandon such generic or

merely descriptive use and substantially modify their marketing, advertising and communications or face additional lawsuits by Applicant, all to the great expense and detriment of the public and the trade.

WHEREFORE, Opposer prays that Application No. 78/168231 for the alleged mark "Frosty Treats" in International classes 35 and 39 be denied and refused registration as being a generic name, or, in the alternative, being merely descriptive and lacking acquired distinctiveness. Moreover, the application with regard to International Class 39 is void for failure to submit an adequate specimen, resulting in the abandonment of the application for this class.

Please recognize as attorneys for Opposer, Riley R. Russell, Vice President, Legal and Business Affairs, Jennifer Y. Liu and James P. Williams, Directors of Legal & Business Affairs and Daniel Herp, Corporate Counsel, Sony Computer Entertainment America Inc., a wholly-owned subsidiary of Sony Computer Entertainment Inc., 919 East Hillsdale Boulevard, Foster City, California, 94404. All are members of the Bar of the State of California. Please address all communications to James P. Williams at Sony Computer Entertainment America Inc. Please deduct the amount of \$600 and any other necessary fees for this two-class opposition from Deposit Account 193196 in the name of Sony Interactive Entertainment Inc.

Dated: Foster City, California
September 4, 2003

By: 
Riley R. Russell
Jennifer Y. Liu
James P. Williams
Daniel Herp

Attorneys for Opposer
Sony Computer Entertainment America Inc.

Thank you for your request. Here are the latest results from the TARR web server.

A

This page was generated by the TARR system on 2003-08-26 19:37:02 ET

Serial Number: 78168231

Registration Number: (NOT AVAILABLE)

Mark (words only): FROSTY TREATS

Current Status: A request for an extension of time to file an opposition has been filed at the Trademark Trial and Appeal Board.

Date of Status: 2003-06-05

Filing Date: 2002-09-26

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: LAW OFFICE 116

Attorney Assigned:
CARROLL DORITT Employee Location

Current Location: 657 -Pre-Publication Final Review

Date In Location: 2003-07-08

CURRENT APPLICANT(S)/OWNER(S)

1. Frosty Treats, Inc.

Address:
Frosty Treats, Inc.
620 East Linwood Boulevard
Kansas City, MO 641091718
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Missouri
Phone Number: 816-931-9969

GOODS AND/OR SERVICES

wholesale distributorships featuring frozen foods, ice cream, and confections
International Class: 035
First Use Date: 1991-03-00
First Use in Commerce Date: 1991-03-00

Basis: 1(a)

Leasing of commercial vehicles

International Class: 039

First Use Date: 1991-03-00

First Use in Commerce Date: 1991-03-00

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-06-05 - Extension of time to oppose - Filed

2003-05-13 - Published for opposition

2003-04-23 - Notice of publication

2003-03-20 - Approved for Pub - Principal Register (Initial exam)

2003-03-06 - Examiners amendment e-mailed

2003-03-05 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

David R. Barnard (Attorney of record)

David R. Barnard

LATHROP & GAGE L.C.

2345 Grand Boulevard, Suite 2300

Kansas City MO 64108-2618

Phone Number: 816-292-2000

Fax Number: 816-292-2001

IN THE CIRCUIT COURT OF JACKSON COUNTY, MISSOURI
AT INDEPENDENCE, MISSOURI

B

FROSTY TREATS, INC., FROSTY
TREATS OF LOUISVILLE, INC.,
FROSTY TREATS WHOLESALE,
INC. AND FROSTY TREATS OF
ATLANTA, INC.,

Plaintiffs,

v.

SONY COMPUTER
ENTERTAINMENT AMERICA, INC.,
SONY CORPORATION, AND
GEORGE GOEHRING, CAROL
GOEHRING AND SCOTT GOEHRING
D/B/A GAME X CHANGE,

Defendants.

03CV207329

BDS

Case No. _____

Division _____ **DIVISION
17**

Service Instructions:

Sony Computer Entertainment
America, Inc., Registered Agent
in California is: Corporation Service
Company, 2730 Gateway Oaks Drive,
Suite 100, Sacramento, CA 95833

George Goehring
2010 Wayhaven Drive
West Plains, MO 65775

Carol Goehring
2010 Wayhaven Drive
West Plains, MO 65775

Scott B. Goehring
4409 Noland Road, Apt. C
Independence, MO 64055

PETITION

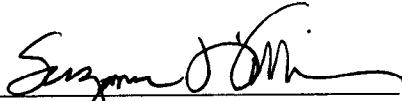
Plaintiffs Frosty Treats, Inc., Frosty Treats of Louisville, Inc., Frosty Treats Wholesale,
Inc. and Frosty Treats of Atlanta, Inc. (collectively, "Plaintiffs" or "Frosty Treats") state the

[Handwritten signature and notes]

Certificate of Mailing by "Express Mail"

"Express Mail" mailing label number EL052151726 US

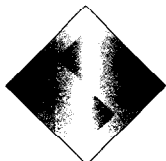
I hereby certify that this Notice of Opposition is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on September 4, 2003.



Suzanne Williams
Sony Computer Entertainment America
919 East Hillsdale Boulevard
Foster City, CA 94404

TTAB

SONY



COMPUTER ENTERTAINMENT

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919 East Hillsdale Blvd., 2nd Floor
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650 655 8000
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VIA EXPRESS MAIL
#EL052151726 US



09-05-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

September 4, 2003

BOX TTAB FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

RE: Notice Of Opposition To The Registration Of Application
No. 78/168,231 for "FROSTY TREATS"

Dear Sir/Madam:

Enclosed please find the original and two copies of the Notice of Opposition to the registration of Application No. 78/168,231 for "Frosty Treats" which is being filed by Opposer Sony Computer Entertainment America Inc. Also enclosed is a return postcard.

Please have \$600.00 and/or any other necessary fees deducted from Deposit Account #19-3196 in the name of Sony Interactive Entertainment Inc.

Please feel free to contact me directly at (650) 655-8137 if you need any further information concerning this mark.

Very truly yours,

James P. Williams
Director, Legal & Business Affairs
Sony Computer Entertainment America Inc.
Enclosure

US 507 10 01 1726 00

09-05-2003