

The ice cream « The authentic »

Imagine an ice cream with an authentic vanilla flavour, produced on a small scale in a remote little village in Tuscany, and sold almost confidentially by the ice cream manufacturer to his fellow citizens.

Imagine a foreign tourist, captivated by the original flavour of the ice cream which he tasted during an excursion. The tourist, owner of a delicatessen in his own country, then makes a proposition to the ice cream manufacturer to import the ice cream so that his clientele might discover it.

The two associates agree and start looking for a name for their product, which they want to reflect the truly authentic and unequalled nature of the ice cream. No sooner said than done: they decide to call their ice cream « The Authentic »; they then commission a graphic artist to work on creating a sober logo, which highlights the message contained in the name.

They then register their trademark, which successfully passes the grounds for refusal examination.

With the certificate of registration in his pocket, the delicatessen owner starts importing the ice cream. The operation is a great success; his shop is always full of customers.

Until the day when a client tells him of his disappointment: the client bought some ice cream in a shop close to his home, but it wasn't as good as usual. Flabbergasted, the delicatessen owner and the ice cream manufacturer discover that another ice cream manufacturer is selling his products under the name « The Authentic » and not only that, he has also obtained the registration of this trademark but with another logo.

Sure of their rights, the delicatessen owner and the ice cream manufacturer go to law in order to have the registration of their competitor's trademark revoked and to prohibit him from using it. Against all their expectations, the Judge finds against them: the expression. « The Authentic » describes the quality of their product, and as such it must remain freely available to competitors who would also like to indicate the authentic nature of their products. Since the two logos are sufficiently different from each other, the trademarks are not likely to be confused.

The teaching to be drawn from the foregoing is this: the search for a product name has to go beyond the obvious. The field of protection of a trademark depends upon its distinctive force, in other words on its arbitrary nature and originality. A common or descriptive designation cannot be monopolised by a single competitor, even if it forms an integral part of a duly registered trademark.

This is why, when filing a trademark, you must always ensure that the scope of the resulting monopoly actually conforms to your expectations.

We can help you!