

ESTTA Tracking number: **ESTTA796779**

Filing date: **01/23/2017**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Food Distributors, Inc.
Granted to Date of previous extension	01/25/2017
Address	18 Wilshire Drive PO Box 624 Monsey, NY 10952 UNITED STATES
Attorney information	Michael E. Zall Michael E. Zall Law Firm Two Yorkshire Drive Suffern, NY 10901 UNITED STATES Mike@Zall-Law.com Phone:(845) 357-6800

**Applicant Information**

Application No	86759759	Publication date	09/27/2016
Opposition Filing Date	01/23/2017	Opposition Period Ends	01/25/2017
Applicants	Interprofession du Gruyère La Maison du Gruyère 1662 Pringy, SWITZERLAND  Syndicat Interprofessionnel du Gruyère Maison des Agriculteurs 70004 Vesoul, FRANCE		

**Goods/Services Affected by Opposition**

Class A. First Use: 1982/00/00 First Use In Commerce: 1985/00/00 All goods and services in the class are opposed, namely: Cheese
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**Grounds for Opposition**

The mark is generic	Trademark Act Sections 1, 2 and 45
Other	Abandonment 14 U.S.C. Section 1127

Attachments	NoticeOpp.pdf(1116704 bytes )
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Signature	/Michael E. Zall/
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Name	Michael E. Zall
Date	01/23/2017

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

In the matter of Trademark  
Application No. 86759759  
For the mark: **GRUYERE**  
Date of Application: 09/17/2015

Food Distributors, Inc.

**Opposer**

V.

Interprofession du Gruyère  
Syndicat Interprofessionnel du  
Gruyère

**Applicant**

**NOTICE OF OPPOSITION**

Opposer, Food Distributors, Inc. is a corporation duly organized and existing under the laws of the State of New York, having a principal place of business at 18 Wilshire Drive, PO Box 624, Monsey, NY 10952.

Applicant, Interprofession du Gruyère and Syndicat Interprofessionnel du Gruyère, is seeking registration of the mark GRUYERE as a certification mark used by persons authorized by the certifier, to certify that the cheese originates in the Gruyère region of Switzerland or France (specifying the regions).

Opposer believes it will be damaged by the registration of the above-identified mark (hereinafter “Applicant’s Mark”) and opposes the same.

The grounds for the opposition are as follows:

1. Opposer is a provider of a broad range of cheese products, in particular a cheese designated and known generically as *gruyere* cheese, to wholesalers and retailers.
2. Opposer has continuously sold and used the term *gruyere* for many years prior to the filing of Applicants trademark application, and on information and belief, since at least as early as 1995. Attached as **Exhibit A** are photos of Opposer’s products using the term *gruyere*.
3. Opposer has received Cease and Desist letters from Applicant’s attorneys demanding that Opposer cease using the term *gruyere*: “...we ask that you change the descriptions and other text on your website to not refer to cheeses of non-Swiss or French origin as

*GRUYERE* and that you also change the text on your product labels to remove such references...”. See **Exhibits B & C**.

4. Opposer, believes that the term *gruyere* is a generic term and is therefore incapable of functioning as a certification mark for cheese, and in particular the certification identified in Application.
5. Applicant’s mark for *gruyere* if registered will monopolize the generic use of the term *gruyere* and affects the ability for Opposer and others, many of which are opposing the registration of this Application, to use the term generically.
6. Opposer thus requests the Office to refuse registration of this application.

**GENERICNESS UNDER SECTION 14(3), 15 U.S.C. § 1064(3)**

7. The term *gruyere* is the generic name for certain type cheeses, in particular cheeses similar in taste and texture to that identified in the application, among others, and is incapable of functioning as a mark.
8. Numerous third parties, consumers and the media use and understand the term *gruyere* as the generic name for the cheeses identified in Applicant’s application and similar type cheeses.
9. Opposer and others have a competitive and equal right to use the terms *gruyere* as the generic names for such cheeses.
10. If Applicant is allowed to maintain a registration for the generic term *gruyere* they will effectively misappropriate a generic term for their exclusive use, and cause injury and damage to Opposer and others.
11. Accordingly, this Application for the term *gruyere* should be refused under Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3), on the ground that the term *gruyere* is the generic name for the identified cheeses, and is incapable of functioning as a mark.

**ABANDONMENT UNDER SECTION 45, 15 U.S.C. § 1127**

12. In the alternative, Applicant has abandoned any rights in the term *gruyere* under Section 45, 15 U.S.C. § 1127 by failing to enforce any such rights against widespread third-party use of the term, and thus the term has lost its significance as an indication of origin, to the extent that it ever had such significance.

**WHEREFORE**, the term *gruyere* is the generic name of the cheeses identified in Applicants application and is incapable of functioning as a mark; Opposer and others must not be precluded

from using that generic term; and Opposer and others are being and will continue to be damaged by the registration of the term *gruyere* through this Application.

**WHEREFORE**, Opposer respectfully requests that the Notice of Opposition be sustained, and that Application No. 86/759759 for the term *gruyere* not be granted.

A filing fee has been submitted electronically.

Respectfully submitted,

**/M ichael E. Z all/**

Dated: January 23, 2017

Michael E. Zall

Attorney for Petitioner

Two Yorkshire Drive

Suffern, NY 10901

Tel.: (845) 357-6800

[Mike@Zall-Law.com](mailto:Mike@Zall-Law.com)

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing Notice of Opposition was served via e-mail and first class mail, postage prepaid, this January 23, 2017, upon Applicant, its Counsel and its Domestic Representative Registrant and its counsel:

*Interprofession du Gruyère*  
*La Maison du Gruyère*  
*Syndicat Interprofessionnel du Gruyère*  
*Maison des Agriculteurs*  
SUSAN UPTON DOUGLASS  
Domestic Representative and Counsel  
Fross Zelnick Lehrman & Zissu P C  
866 United Nations Plz  
New York, NY 10017-1822  
[sdouglass@frosszelnick.com](mailto:sdouglass@frosszelnick.com)

Dated: January 23, 2017

/Michael E. Zall/  
Attorney for Opposer  
Two Yorkshire Drive  
Suffern, NY 10901  
Tel.: (845) 357-6800  
[Mike@Zall-Law.com](mailto:Mike@Zall-Law.com)



## Project details

Date

March 30, 2014

The Good Life Cheese



### OUR CHEESE

- ▶ Natural and Pure
- ▶ Vegetarian
- ▶ Kosher

- ▶ Life & Lacey
- ▶ La Dolce Vita
- ▶ Milk N Honey

### RESOURCES

- ▶ About
- ▶ Contact
- ▶ Distributor Inquiries
- ▶ Cheese Tips
- ▶ Find Us Near You
- ▶ Terms of Use
- ▶ Privacy Policy

•FOODWORKS•

An illustration of a farm scene with a barn, a silo, and a field under a sunburst background.

The Good Life Cheese®

**GRUYERE**

**everybody say Cheese!**®

Natural · Kosher · Vegetarian · Gluten Free



Keep Refrigerated

Manufactured for and Distributed by  
Food Distributors Inc. Monsey, NY 10952

[FoodworksCheese.com](http://FoodworksCheese.com)

Outline  
is Not Print

Item # 61-755



# FROSS ZELNICK LEHRMAN & ZISSU, P.C.

Susan Upton Douglass  
212.813.5995  
sdouglass@fzlj.com

January 12, 2016

## EXHIBIT B

**BY FEDEX AND E-MAIL ([mike@zall-law.com](mailto:mike@zall-law.com))**

Michael E. Zall, Esq.  
Two Yorkshire Drive  
Suffern, New York 10901

Re: Interprofession du Gruyère -- Conflict with Foodworkscheese.com and Food Distributors, Inc. (GRUYERE) (Our Ref.: GRUY USA TC-14/05768 SUD)

Dear Mr. Zall:

We write to you further to the letter we sent to your client, Food Distributors, Inc., dated July 30, 2014, which we enclose for your reference. In this letter, we advised that GRUYÈRE is a recognized appellation of origin that denotes cheese from the Gruyère region, and that our client, Interprofession du Gruyère, owns a federal certification trademark registration for LE GRUYERE SWITZERLAND AOC (U.S. Reg. No. 4,398,395), a copy of which is enclosed.

Additionally, we noted that authorities in Europe had enacted a directive that requires all use of GRUYÈRE for cheese not being produced in Switzerland according to the strict requirements of our client or – if labeled accordingly – in France be phased out. In accordance with this decision, Emmi Roth USA, a substantial producer and importer of Swiss cheese in the U.S., has ceased all use of the designation Gruyère on its American-produced cheese, as seen in the enclosed letter. The Emmi Roth cheese produced in the U.S. is now sold under the GRAND CRU label.

We then asked your client to change the descriptions and other text on their website to not refer to cheeses of non-Swiss or French origin as GRUYÈRE and that they change the text on product labels to remove such references.

Despite our efforts, we never received a substantive reply from you regarding this letter. However, it appeared that your client had complied with our request to cease use of the GRUYÈRE mark for domestic cheese since we had received no further reports of unauthorized use of the mark. However, on further inspection, we located continued use of the GRUYÈRE designation on your client's website:

<http://www.foodworkscheese.com/our-cheese-lines/the-good-life-cheese/#mg>.

Moreover, our client has reported that cheese using the designation GRUYÈRE sold by Foodworkscheese.com and Food Distributors, Inc. is for sale at the chain of King Kullen grocery stores in Long Island, as seen in the photo below.



Given this report, we must revive this matter. We reiterate our request that your client change the descriptions and other text on their website to not refer to cheeses of non-Swiss or French origin as GRUYÈRE and that they change the text on product labels to remove such references and simply refer to the cheese as "Swiss-style" or some similar designation. We have sent communication to King Kullen notifying them of this ongoing matter, and are providing you with a copy of this letter.

We would appreciate prompt confirmation that your client will comply with proper labeling and will respect our client's trademark and appellation of origin designations, and that they will re-label their cheese and revise the text of their website. Please let us hear from you not later than **January 19, 2016**.

This letter is without prejudice to the rights and remedies of the Interprofession du Gruyère, all of which are expressly reserved.

Very truly yours,

A handwritten signature in blue ink that reads 'Susan Upton Douglass'. The signature is written in a cursive style with a long, sweeping underline.

Susan Upton Douglass

SUD/pab

Encls.

# FROSS ZELNICK LEHRMAN & ZISSU, P.C.

Susan Upton Douglass  
212.813.5995  
sdouglass@fzlz.com

July 30, 2014

**BY EXPRESS MAIL AND E-MAIL**  
**info@FoodworksCheese.com**

Mr. Harold Gottesman  
Food Distributors, Inc.  
100 Red Schoolhouse Road  
Spring Valley, New York 10952

Re: Interprofession du Gruyère -- Conflict with Foodworkscheese.com and Food Distributors, Inc. (GRUYERE) (Our Ref.: GRUY USA TC-14/05768 SUD)

Dear Mr. Gottesman:

We are U.S. trademark counsel to Interprofession du Gruyère, the association of Swiss cheese producers that manufacture genuine GRUYÈRE cheese according to strict requirements. GRUYÈRE is a recognized "appellation of origin" to denote cheese from the Gruyère region of Switzerland. In addition, our client owns a federal certification trademark registration for LE GRUYERE SWITZERLAND AOC (U.S. Reg. No. 4,398,395). A copy of the registration certificate is attached for your reference.

We see from your website <http://www.foodworkscheese.com> that your company, Food Distributors Inc., sells a variety of types of cheese, including cheese identified as "GRUYERE" as seen in the photo below:



You should be aware that the authorities in Europe recently enacted a directive that requires that all use of GRUYÈRE for cheese not being produced in Switzerland according to the strict requirements of our client or – if labeled accordingly – in France be phased out. Thus, the term GRUYÈRE should only refer to cheese from the Gruyère region of Switzerland. Further, Emmi Roth USA, a substantial producer and importer of Swiss cheese in the U.S., has acted in accordance with this decision and has ceased all use of the designation Gruyère on its American-produced cheese.

Inasmuch as your company undoubtedly values fine cheeses as well as correct information about the cheeses you sell, we ask that you change the descriptions and other text on your website to not refer to cheeses of non-Swiss or French origin as "GRUYÈRE" and that you also change the text on your product labels to remove such references and simply refer to the cheese as "Swiss-style" or some similar designation.

We would appreciate your prompt confirmation that your company will comply with proper labeling and will respect our client's trademark and appellation of origin designations, and that you will re-label your cheese and revise the text of your website. Please let us hear from you not later than **August 15, 2014**.

This letter is without prejudice to the rights and remedies of the Interprofession du Gruyère, all of which are expressly reserved.

Very truly yours,



Susan Upton Douglass

SUD/eem  
Enclosure

United States of America  
United States Patent and Trademark Office

**LE GRUYÈRE**  
**SWITZERLAND** 

**Reg. No. 4,398,395**

**Registered Sep. 10, 2013**

INTERPROFESSION DU GRUYÈRE (SWITZERLAND REGISTERED ASSOCIATION)  
LA MAISON DU GRUYÈRE, CASE POSTALE 12  
1662 PRINGY, SWITZERLAND

**CERTIFICATION MARK**

FOR: CHEESE, IN CLASS A (U.S. CL. A).

**PRINCIPAL REGISTER**

FIRST USE 0-0-2001; IN COMMERCE 0-0-2001.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SWITZERLAND" AND "AOC", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF THE TERM "LE GRUYÈRE SWITZERLAND" IN A STYLIZED FONT, THE TERM "SWITZERLAND" APPEARS WITHIN A SOLID BAR DIRECTLY UNDER "LE GRUYÈRE". TO THE RIGHT APPEARS A STYLIZED SQUARE CONTAINING THE LETTERS "AOC" AND A STYLIZED SWISS CROSS.

THE ENGLISH TRANSLATION OF "LE" IN THE MARK IS "THE".

THE CERTIFICATION MARK, AS USED BY PERSONS AUTHORIZED BY THE CERTIFIER, CERTIFIES THAT THE CHEESE ORIGINATES IN THE GRUYÈRE REGION OF SWITZERLAND INCLUDING THE CANTONS OF FRIBOURG, VAUD, NEUCHÂTEL, JURA, AND THE DISTRICTS OF COURTELARY, LA NEUVEVILLE, MOUTIER, AND THE COMMUNES OF FERRENBALM, GUGGISBERG, MÜHLEBERG, MÜNCHENWILER, RÜSCHEGG AND WAHLERN OF THE CANTON OF BERN.



SER. NO. 85-118,515, FILED 8-30-2010.

KAREN M. STRYZ, EXAMINING ATTORNEY

  
Acting Director of the United States Patent and Trademark Office

**Re: US Trademark Application Serial Nos. 85/091,899 for LE GRUYERE in Class A and 85/118,515 for LE GRUYERE SWITZERLAND and Design in Class A**

For the Attention of the U.S. Patent and Trademark Office:

It has come to our attention that the trademark applications indicated above have been submitted to the United States Patent and Trademark Office (USPTO) and subsequently rejected by the Examining Attorney. As part of the basis of rejection we understand that our company's use of the term "Gruyère" in connection with our GRAND CRU brand cheese, has been cited as one item of evidence that the word "gruyère" is generic in the United States for a type of cheese, and not a designation of origin for cheese produced in Switzerland, as has recently been recognized throughout Europe.

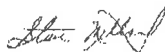
We are writing to offer our support for the registration in Class A of the marks LE GRUYERE and LE GRUYERE SWITZERLAND and Design, submitted by the Interprofession du Gruyère (IPG) of Switzerland.

Emmi Roth USA, Inc. ("ERUSA", formerly known as "Roth Käse USA, Ltd.") is since 2009 an indirect wholly-owned subsidiary of Emmi International Limited, a Swiss corporation and member of the Emmi Group of companies. Prior to its acquisition by Emmi, in 1991 ERUSA began producing an award-winning cheese made from pasteurized milk in Wisconsin, including our GRAND CRU brand cheese.

We recognize that the LE GRUYERE mark denotes cheese produced in the Gruyère region of Switzerland, and thus our position, in support of our fellow cheese makers in Switzerland, is that their cheese should receive proper recognition in the United States market for its distinctive geographic origins. We have committed as from May 1, 2013 to renounce the addition of "Gruyère" to ERUSA brand cheeses produced locally in the United States.

We trust that our position is clear and that this letter will assist in allowing the LE GRUYERE marks to be registered in the USPTO as certification marks.

Very truly yours,



Steve Millard  
CEO and President  
Emmi Roth USA  
100 Dutch Hill Road  
Orangeburg, NY 10989

# FROSS ZELNICK LEHRMAN & ZISSU, P.C.

Susan Upton Douglass  
212.813.5995  
sdouglass@fzlz.com

January 12, 2016

## **BY FEDEX**

Brian C. Cullen and J. Donald Kennedy  
Chief Executive Officers  
King Kullen Grocery Co., Inc.  
185 Central Ave  
Bethpage, NY 11714

Re: Interprofession du Gruyère - Conflict with King Kullen Grocery Co., Inc. (GRUYÈRE) (Our Ref.: GRUY USA TC-15/10385 SUD)

Dear Mr. Cullen and Mr. Kennedy:

We are U.S. trademark counsel to Interprofession du Gruyère, the association of Swiss cheese producers that manufacture genuine GRUYÈRE cheese according to strict requirements. GRUYÈRE is a recognized "appellation of origin" to denote cheese from the Gruyère region of Switzerland. In addition, our client owns a federal certification trademark registration for LE GRUYERE SWITZERLAND AOC (U.S. Reg. No. 4,398,395). A copy of the registration certificate is enclosed for your reference.

You should be aware that the authorities in Europe enacted a directive that requires that all use of GRUYÈRE for cheese not being produced in Switzerland according to the strict requirements of our client or – if labeled accordingly – in France be phased out. Thus, the term GRUYÈRE should only refer to cheese from the Gruyère region. Further, Emmi Roth USA, a substantial producer and importer of Swiss cheese in the U.S., has acted in accordance with this decision and has ceased all use of the designation Gruyère on its American-produced cheese, as seen in the enclosed letter. The Emmi Roth cheese produced in the U.S. is now sold under the GRAND CRU label.

Our client has informed us that your company sells in your stores cheese labelled “GRUYERE” from Food Distributors, Inc., as seen in the photo below:





We understand that this cheese has been supplied to Food Distributors, Inc. We have contacted this company as well, requiring them to change the descriptions and other text on their labels and website to not refer to cheeses that do not come from the Gruyère region as GRUYÈRE. Consumers who purchase this cheese would expect that they are purchasing genuine GRUYÈRE cheese from your store, and not a domestic cheese that has a different taste and texture. Indeed, it is deceptive to consumers to refer to this domestic cheese as GRUYÈRE.

Inasmuch as your company undoubtedly values fine cheeses as well as correct information about the cheeses you sell, we ask that you discontinue selling cheese labeled as GRUYERE from Food Distributors, Inc. We would appreciate your prompt confirmation that your company will comply with proper labeling and will respect our client's trademark and appellation of origin designations. Please let us hear from you not later than **January 26, 2016**.

This letter is without prejudice to the rights and remedies of the Interprofession du Gruyère, all of which are expressly reserved.

Very truly yours,

Susan Upton Douglass

SUD/pab  
Encl.



# FROSS ZELNICK LEHRMAN & ZISSU, P.C.

Susan Upton Douglass  
212.813.5995  
sdouglass@fzllz.com

July 30, 2014

## EXHIBIT C

**BY EXPRESS MAIL AND E-MAIL**  
**info@FoodworksCheese.com**

Mr. Harold Gottesman  
Food Distributors, Inc.  
100 Red Schoolhouse Road  
Spring Valley, New York 10952

Re: Interprofession du Gruyère -- Conflict with Foodworkscheese.com and Food Distributors, Inc. (GRUYERE) (Our Ref.: GRUY USA TC-14/05768 SUD)

Dear Mr. Gottesman:

We are U.S. trademark counsel to Interprofession du Gruyère, the association of Swiss cheese producers that manufacture genuine GRUYÈRE cheese according to strict requirements. GRUYÈRE is a recognized "appellation of origin" to denote cheese from the Gruyère region of Switzerland. In addition, our client owns a federal certification trademark registration for LE GRUYERE SWITZERLAND AOC (U.S. Reg. No. 4,398,395). A copy of the registration certificate is attached for your reference.

We see from your website <http://www.foodworkscheese.com> that your company, Food Distributors Inc., sells a variety of types of cheese, including cheese identified as "GRUYERE" as seen in the photo below:



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We would appreciate your prompt confirmation that your company will comply with proper labeling and will respect our client's trademark and appellation of origin designations, and that you will re-label your cheese and revise the text of your website. Please let us hear from you not later than **August 15, 2014**.

This letter is without prejudice to the rights and remedies of the Interprofession du Gruyère, all of which are expressly reserved.

Very truly yours,



Susan Upton Douglass

SUD/eem  
Enclosure

United States of America  
United States Patent and Trademark Office

LE GRUYÈRE

SWITZERLAND



**Reg. No. 4,398,395**

**Registered Sep. 10, 2013**

**CERTIFICATION MARK**

**PRINCIPAL REGISTER**

INTERPROFESSION DU GRUYÈRE (SWITZERLAND REGISTERED ASSOCIATION)  
LA MAISON DU GRUYÈRE, CASE POSTALE 12  
1662 PRINGY, SWITZERLAND

FOR: CHEESE, IN CLASS A (U.S. CL. A).

FIRST USE 0-0-2001; IN COMMERCE 0-0-2001.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SWITZERLAND" AND "AOC"  
, APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF THE TERM "LE GRUYÈRE SWITZERLAND" IN A STYLIZED  
FONT. THE TERM "SWITZERLAND" APPEARS WITHIN A SOLID BAR DIRECTLY UNDER  
"LE GRUYÈRE". TO THE RIGHT APPEARS A STYLIZED SQUARE CONTAINING THE  
LETTERS "AOC" AND A STYLIZED SWISS CROSS.

THE ENGLISH TRANSLATION OF "LE" IN THE MARK IS "THE".

THE CERTIFICATION MARK, AS USED BY PERSONS AUTHORIZED BY THE CERTIFIER,  
CERTIFIES THAT THE CHEESE ORIGINATES IN THE GRUYÈRE REGION OF SWITZER-  
LAND INCLUDING THE CANTONS OF FRIBOURG, VAUD, NEUCHÂTEL, JURA, AND  
THE DISTRICTS OF COURTELARY, LA NEUVEVILLE, MOUTIER, AND THE COMMUNES  
OF FERENBÂLM, GUGGISBERG, MÜHLEBERG, MÜNCHENWILER, RÜSCHEGG AND  
WAHLERN OF THE CANTON OF BERN.

SER. NO. 85-118,515, FILED 8-30-2010.

KAREN M. STRYZ, EXAMINING ATTORNEY



*Karen M. Stryz*  
Acting Director of the United States Patent and Trademark Office