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

Proceeding	91232427
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

INTERNATIONAL DAIRY FOODS  
ASSOCIATION,

U.S. DAIRY EXPORT COUNCIL,

ATALANTA CORPORATION, and

INTERCIBUS INC.,

Opposers,

v.

INTERPROFESSION DU GRUYÈRE and  
SYNDICAT INTERPROFESSIONEL DU  
GRUYÈRE,

Applicants.

Opposition No. 91232427

Consolidated with Opposition Nos.  
91232442, 91232446, and 91232448

**OPPOSERS' TRIAL BRIEF – [REDACTED]**

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## INTRODUCTION

Applicants' request is remarkably broad. In their application, they seek registration of a certification mark covering the single word "gruyere," claiming that it identifies a cheese that must be produced in specific regions of Switzerland or France.

That claim is untrue. In the United States gruyere has never meant a cheese with a specific origin. Worse yet, Applicants are at least partially responsible for *making* the claim untrue because they have never controlled the term "gruyere" in the U.S. Indeed, one of them knowingly acquiesced in writing to [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]. Beyond that, Applicants have actively confused the market about the origin of gruyere. For years, one of them proclaimed that gruyere *had to* come from Switzerland—*not France*—but they now join together to say it can be from both places. This evidence shows that Applicants have not controlled use of the term "gruyere" in the U.S. The evidence also shows the widespread use in U.S. publications and by U.S. retailers and U.S. cheese producers of "gruyere" as a generic style of cheese. The Board should reject the application.

## BACKGROUND AND DESCRIPTION OF THE RECORD

This brief addresses most of the specific facts and how they affect the legal issues directly in the Argument section, *infra*. Nonetheless, it is helpful to start with an

overview of the parties, the mark at issue, the opposition history, and the evidence of record. Appendix A hereto includes a detailed list describing the record.

\* \* \*

Applicants are Interprofession du Gruyère (the “Swiss Applicant”) and Syndicat Interprofessionnel du Gruyère (the “French Applicant”). The former is a Swiss organization claiming to be “in charge of the certification rules for the production of [gruyere] in Switzerland.” (TTABVUE #37 at 1 ¶ 1.) The latter is the equivalent French group. (*See, e.g.*, TTABVUE #1 at 1-2, ¶ 1 (Applicants have not submitted a declaration or other testimony from a representative of the French Applicant).)

Together, Applicants seek registration as a certification mark of the generic term GRUYERE in standard characters.<sup>1</sup> (*Id.*) According to their application, this term “certifies that the cheese originates in the Gruyère region of Switzerland and France.” (*Id.* at 2, ¶ 3.) Applicants claim the term was first used to certify origin in Switzerland or France as early as 1982 and used in commerce as early as 1985. (*Id.* at 3, ¶ 4.)

Oppositions were filed by International Dairy Foods Association (“IDFA”), United States Dairy Export Council (“USDEC”), Atalanta Corporation (“Atalanta”), and Intercibus Incorporated (“Intercibus”) (collectively, “Opposers”).<sup>2</sup> (*See generally id.*) The

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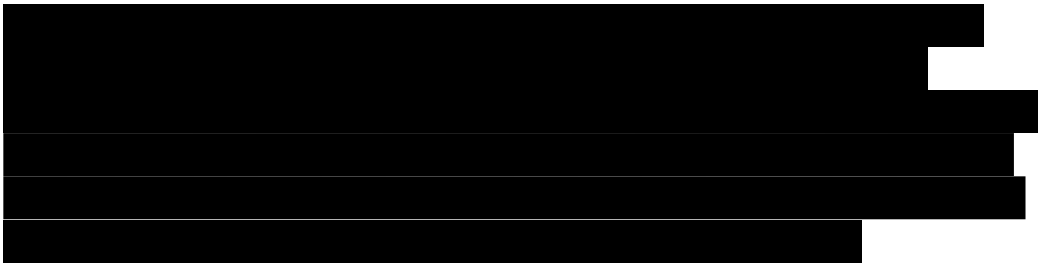
<sup>1</sup> Because a design mark is not at issue, an illustration is not provided here. *See* 37 C.F.R. § 2.126; TBMP § 801.03. However, the Swiss Applicant previously registered a certification mark for a design, Registration No. 4398395, which is discussed later.

<sup>2</sup> Oppositions were also filed by several other parties but they were subsequently withdrawn.

oppositions were consolidated (TTABVUE #4), after which the parties engaged in discovery. Following several extensions (*see, e.g.*, TTABVUE #11-#17), the parties' trial periods began in July of 2018 and the last trial evidence filing was made on November 30, 2018 (*see, e.g.*, TTABVUE #20-#41).<sup>3</sup>

The matter is now before the Board for trial briefing, and Opposers submit this trial brief in support of their opposition. The evidence of record consists of testimony declarations, deposition testimony, and notices of reliance, as detailed in Appendix A.

Opposers submitted three declarations:

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- The declaration of John Umhoefer, Executive Director of the Wisconsin Cheese Makers Association ("WCMA"), is accompanied by two exhibits showing that, *dating back to at least 1995*, U.S. gruyere producers have participated in and even won prizes in the gruyere category of the World Cheese Championship Contest, *without objection from Applicants*. (TTABVUE #20 & #40.)
- The declaration of Shawna Morris, Vice President of Trade Policy for Opposer USDEC, is accompanied by Opposers' Trial Exhibits 1 through 43, showing the widespread use in the U.S. of the term gruyere, without reference to a Swiss or French geographic origin. (TTABVUE #23-#26.)

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<sup>3</sup> Corrected filings were made February 7, 2019, as TTABVUE #40 and #41 to correct confidentiality redactions to the filings at TTABVUE #29 and #30.



In addition to declaration testimony, Opposers submitted trial testimony of Thomas Gellert (TTABVUE #31, accompanied by Opposers' Tr. Exs. #44-#49) and Fermo Jaeckle (TTABVUE #32, accompanied by Opposers' Tr. Exs. #50-#66). Mr. Gellert and Mr. Jaeckle hold management roles with Opposers Atalanta and Intercibus, respectively, and testified to Applicants' failure to control use of the term "gruyere" and to its genericness, based upon their years of experience in the U.S. cheese industry.

Finally, by notice of reliance, Opposers introduce: a federal regulation (21 C.F.R. § 133.149), prior "gruyere" trademark applications, various publications, and Applicants' discovery responses. (TTABVUE #28, #39-41.) Together, these items show very clearly that "gruyere" does not have any stable origin recognized by U.S. consumers, and—even to the extent it arguably does—Applicants have not exercised reasonable control over use of the term.

By contrast, Applicants' evidence is limited. They have submitted two declarations from affiliated individuals, accompanied by ten trial exhibits. (TTABVUE #36-#37.) Applicants also submitted a Notice of Reliance, primarily offering limited evidence of publications and minimal and ineffective control efforts (TTABVUE #35)—many of which are undermined by Opposers' submissions (*see* TTABVUE #39).

## ARGUMENT

There are two reasons that the application should be denied: (1) Applicants have not controlled use of the term “gruyere” in the U.S., and (2) the term is generic for a style of cheese in the U.S.

### **I. Applicants have not controlled use of “gruyere” in the U.S.**

The evidence of Applicants’ failure to control use of the term “gruyere” in the U.S. is overwhelming. The specific details appear in Section I.B, *infra*, but a quick summary of the failure will help provide context:

- The Swiss Applicant knowingly acquiesced to the U.S. arm of one of its members producing gruyere in the U.S., labeling it as “gruyere,” and selling this U.S.-made gruyere under the label “gruyere” throughout the U.S. The Swiss Applicant condoned these activities in a written document.
- Aside from that blatant failure to control the term in the U.S. (indeed, acquiescence in its uncontrolled use), the Swiss Applicant’s efforts to control the term have been inconsistent, incomplete, and misleading.
- The French Applicant has apparently not done a single thing to control the use of the term “gruyere” in the U.S.

Applicants have not controlled use of the mark, and the application should be denied.

#### **A. *Legal standard for control.***

Where an applicant “does not control, or is not able legitimately to exercise control over, the use” of a mark, that mark cannot be registered as a certification mark.

*See, e.g.*, 15 U.S.C. § 1064(5)(A).

This control requirement has a very important purpose: “to protect the public from being misled.” *Midwest Plastic Fabricators, Inc. v. Underwriters Labs. Inc.*, 906 F.2d

1568, 15 U.S.P.Q.2d 1359, 1362 (Fed. Cir. 1990) (citation omitted). The need to ensure control and protect the public is heightened in the case of certification marks. *Id.* That is because, “the risk of misleading the public may be even greater” for certification marks than other types of marks, “because a certification mark registration sets forth specific representations about the manufacture and characteristics of the goods to which the mark is applied.” *Id.* Accordingly, certification-mark registrants have “an affirmative obligation... to monitor the activities of those who use the mark,” and to ensure that the mark is used only in connection with those things the registrant purports that it represents. *Id.* (citations omitted).

Despite the importance of the control requirement for certification marks, the statutes do not define “control” or specify how much control is required. *Id.*; *see also* 15 U.S.C. § 1064(5)(A). One thing is very clear, however: an applicant must “in fact” maintain control of the proposed certification mark. *Tea Bd. of India v. Republic of Tea, Inc.*, 80 U.S.P.Q.2d 1881, 1888 (T.T.A.B. 2006) (citing *Halo Mgmt., LLC v. Interland, Inc.*, 308 F. Supp. 2d 1019, 76 U.S.P.Q.2d 1199 (N.D. Cal. 2004)). And, while “absolute” control is not required, an applicant’s control efforts must at least be reasonable in light of the particular facts of a case. *Midwest Plastic*, 15 U.S.P.Q.2d at 1363. As the Federal Circuit explained in *Midwest Plastic*:

The “control” requirement of the statute means the mark owner must take reasonable steps, under all the circumstances of the case, to prevent the public from being misled.

**B. *Applicants have acquiesced in writing to a U.S. company producing, marketing, and selling U.S.-made gruyere under the name “gruyere.”***

The Board and commentators have recognized at least one specific circumstance where the control requirement is clearly not satisfied: where “the owner of the mark has, implicitly or explicitly, given permission to others to use the mark without ensuring that their products or services meet the certification mark owner’s standards.” *Swiss Watch Intl., Inc. v. Federation of the Swiss Watch Indus.*, 101 U.S.P.Q.2d 1731, 1739 (T.T.A.B. 2012); *see also* 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 19:92 (5th ed. 2016).

That is the exact circumstance present here. Applicants have condoned the sale of U.S.-made gruyere under the name “gruyere.” And that U.S.-made gruyere clearly does not meet the Applicants’ certification requirements because it is not produced in the designated regions of Switzerland or France.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

This matters because Emmi Roth is producing and selling U.S.-made gruyere with the express acknowledgment of the Swiss Applicant. Specifically, Emmi Roth entered a “Memorandum of Understanding” with the Swiss Applicant, attached to this brief with an English translation as Appendix B, and then Emmi Roth continued selling private-label, U.S.-made gruyere with the knowledge of the Swiss Applicant. (*See, e.g.,*

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<sup>4</sup> Fermo Jaeckle, who owned the predecessor to Emmi Roth and was instrumental in the growth of the U.S. gruyere market, now owns Opposer Intercibus and testified about how he helped grow the Emmi Roth (then known as Roth Kase) market for gruyere from approximately 150,000 pounds in 1991 to more than 2,000,000 pounds in 2009. (*See, e.g.,* TTABVUE #32 at 12-13, 39-40 (Jaeckle Depo. 10:20-11:24, 37:21-38:20).)

TTABVUE #40 at 273-275 (Opposers' Tr. Ex. 146).) By this Memorandum of Understanding, Emmi Roth agreed to support the Swiss Applicant's efforts to register "gruyere" as a certification mark, and both the Swiss Applicant and Emmi Roth agreed to the form of a letter that Emmi Roth would submit to the USPTO. (TTABVUE #40 at 274 ("Point 1"), 275.) Emmi Roth also agreed to stop using the word "gruyere" on cheeses sold *under its own Roth brand*. (*Id.* at 274 ("Point 2").) Here's the catch, though: **Emmi Roth expressly reserved the right to private-label U.S.-made cheeses as "gruyere" for its third-party customers and the Swiss Applicant acknowledged this.** (*Id.* ("Point 2" and accompanying "Remarques").)

This is the exact situation described in the quote from *Swiss Watches*, above: "the owner of the mark... has, implicitly or explicitly, given permission to others to use the mark without ensuring that their products or services meet the certification mark owner's standards." *Swiss Watch*, 101 U.S.P.Q.2d at 1739; *see also* McCarthy, § 19:92. If anything, the situation in this case is even more egregious than the one *Swiss Watch* described. Here, the Swiss Applicant explicitly acknowledged and condoned Emmi Roth's use of the term *gruyere* "without ensuring" that the products would meet its certification standards; indeed, the Swiss Applicant *actually knew* the products marked by Emmi Roth would not meet its identified standards (and the most important one at that: geographic origin). The Swiss Applicant knew that Emmi Roth's cheese would be produced in the U.S. and still labeled *gruyere*. Yet it still acknowledged and

condoned—indeed, by written documentation—this would occur, resulting in the sale of *millions of pounds* of U.S.-made gruyere in the United States.

The Board should not think that this is some minor failure; Emmi Roth is the dominant producer in the U.S. gruyere market, so the Swiss Applicant’s acquiescence in the continuing and widespread sale of U.S.-made gruyere is even stronger evidence of lack of control. Two things illustrate Emmi Roth’s importance to the U.S. gruyere market and, indeed, to Applicants and their supposed efforts to control use of the term “gruyere” in the U.S.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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<sup>5</sup> Applicants did not specify whether they were using metric tons or U.S. tons. Giving them the benefit of the doubt, we have used the higher number, metric tons (equivalent of approximately 2,204 pounds, whereas a U.S. ton is 2,000 pounds). Obviously, if Applicants’ figures are in U.S. tons, then the ratio of Emmi-Roth gruyere to Swiss- and French-gruyere becomes even more favorable to Opposers’ position.

<sup>6</sup> Total of Roth-branded and private label gruyere.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Second, the Swiss Applicant itself has made Emmi Roth a focal point of its haphazard and insufficient control efforts. In letters sent to producers and sellers of U.S.-made gruyere, the Swiss Applicant repeatedly emphasized Emmi Roth's supposed cessation of the term "gruyere" to describe U.S.-made cheeses.<sup>7</sup> (E.g. TTABVUE #40 at 110-118, 122-144, 148-239 (Opposers' Tr. Exs. 120-121, 123-125, 127-142).)

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<sup>7</sup> This is, of course, misleading. [REDACTED]

Beyond misleading, however, it was also well-known in the cheese marketplace both: (1) that Emmi Roth had stopped labeling only *their own* branded U.S.-made cheese as gruyere, and did so only at the urging of their Swiss parent company; and (2) that, even so, Emmi Roth continued



As a final point, beyond the Swiss Applicant's acquiescence to Emmi Roth's sale of U.S.-made gruyere, there is an even more basic point: neither Applicant has done anything to prevent the largest U.S. producer, Emmi Roth, from selling and labeling U.S.-made gruyere as just that. Emmi Roth does not have any documentation of demands by either the Swiss Applicant or the French Applicant to cease labeling or selling as "gruyere" cheese that was not produced in Switzerland or France. (TTABVUE #21 at 21, Doc. Req. No. 1, Rev. Doc. Req. No. 1, and Responses thereto.)

In circumstances like these—where the mark's purported owner and controller acknowledges in writing that a third-party can freely use the mark on products the owner knows will not satisfy its stated certification standards—the owner is simply not exercising control.<sup>8</sup> *Swiss Watch*, 101 U.S.P.Q.2d at 1739. The application should, therefore, be denied.

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to sell private-labeled gruyere made in the U.S. (See, e.g., TTABVUE #32 at 35-37, 138-139 (Jaeckle Depo. 33:19-35:3 & Ex. 64); TTABVUE #31 at 25, 28 (Gellert Depo. 23:1-24, 26:13-19).)

<sup>8</sup> In many ways, this is similar to a trademark owner granting a "naked license," which will result in a finding of abandonment. See, e.g., *Eva's Bridal Ltd. v. Halanick Enters.*, 639 F.3d 788, 98 U.S.P.Q.2d 1662, 1663 (7th Cir. 2011); *FreecycleSunnyvale v. Freecycle Network*, 626 F.3d 509, 515-516, 97 U.S.P.Q.2d 1127, 1131 (9th Cir. 2010); *Ritchie v. Williams*, 395 F.3d 283, 290, 73 U.S.P.Q.2d 1430, 1435 (6th Cir. 2005); *Haymaker Sports, Inc. v. Turian*, 581 F.2d 257, 261, 198 U.S.P.Q. 610, 613 (CCPA 1978); *Heaton Enters. of Nevada Inc. v. Lang*, 7 U.S.P.Q.2d 1842, 1847 (TTAB 1988). The Swiss Applicant is, in effect, allowing Emmi Roth to use its mark without any control over the quality—an act that is "inherently deceptive," see *Freecycle*, 97 U.S.P.Q.2d at 1131, and should be equally applicable to show lack of control as it is to show abandonment.

**C. Applicants' attempts to control "gruyere" have been inconsistent, incomplete, unsuccessful, and misleading—in a word, unreasonable.**

As their primary evidence of control, Applicants produced a number of letters sent to sellers and producers of U.S.-made gruyere objecting to use of the term "gruyere." However existence of the letters alone is not enough to establish control; instead, Applicant needs to "in fact" control the mark. *Tea Bd. of India*, 80 U.S.P.Q.2d at 1888 (citation omitted). Not only that, the in-fact control must be reasonable. *Midwest Plastic*, 15 U.S.P.Q.2d at 1362.

Even considering the letter campaign on its own (*i.e.* setting aside the damning evidence of Emmi Roth's ongoing, permitted production of gruyere), Applicants have not in fact reasonably controlled the term gruyere. *See id.* This is especially true in light of the control requirement's purpose of preventing the public from being misled, which, in the context of certification marks, is heightened. *See Midwest Plastic*, 15 U.S.P.Q. 2d at 1362. Quite to the contrary of that standard, Applicants' control efforts have been inconsistent, incomplete, unsuccessful, and misleading—in a word, unreasonable.

***First, Applicants' control efforts have been inconsistent.*** Applicants, themselves, have not defined gruyere in the way they would like to now in the present application.

For years, the Swiss Applicant claimed that gruyere could be produced only in Switzerland and nowhere else, *not even France*. (*E.g.* TTABVUE #40 at 83-96, 99-115, 119-126, 145-147, 158-161, 181-184, 227-235, 240-242 (Opposers' Tr. Exs. 115, 117-120, 122-123, 126, 129, 134, 141, 143).) In fact, in one letter, the Swiss Applicant demanded that a

website be changed “to not refer to cheeses of Austrian, *French* or American origin as ‘GRUYERE’ ... .” (TTABVUE #40 at 101 (Opposers’ Tr. Ex. 117) (emphasis added).) The Swiss Applicant even took this position in a prior registration proceeding,<sup>9</sup> claiming that gruyere is “an appellation of origin for a cheese that *originates in the Gruyère region of Switzerland.*” (TTABVUE #28 at 37 (Tr. Ex. 68) (emphasis added).)

The Swiss Applicant has drastically changed positions in the present application: it now claims that “gruyere” certifies a cheese made in Switzerland *or France*. Perhaps Applicants will argue that, from 1982 through the Swiss Applicant’s February 2016 letters,<sup>10</sup> “gruyere” meant a cheese made only in Switzerland, but that beginning at some point thereafter the meaning changed to mean a cheese from *either* country. That is a remarkably short time for a term to reliably “certify regional or other origin,” as a certification mark is supposed to signify.<sup>11</sup> 15 U.S.C. § 1127.

On the other hand, if Applicants do not claim the meaning changed, then the Swiss Applicant’s control efforts have been dishonest and intended to purposefully

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<sup>9</sup> This prior proceeding resulted in issuance of the “LE GRUYÈRE SWITZERLAND AOC” design certification mark, Reg. No. 4396395, displayed on Page 27 at footnote 14, *infra*.

<sup>10</sup> When, for the last time in the record, it referred to gruyere as a cheese only from Switzerland.

<sup>11</sup> This is particularly concerning given that a certification mark is meant to give a consumer the right to “assume that [the certified] product or service meets whatever standards of... quality [that] have been set up and advertised by the certifier.” MCCARTHY § 4:8. Here, applicants are primarily interested in having the gruyere mark certify one single thing—geographic origin—yet have not even consistently adhered to what they now claim the standard means. Where the certifiers, themselves, are not consistently applying the standard, certainly a consumer cannot rely on the certification.

confuse the market—simply another species of failure to control. As *Midwest Plastic* made clear, “[t]he ‘control’ requirement of the statute means the mark owner must take reasonable steps, under all the circumstances of the case, to prevent the public from being misled.” 15 U.S.P.Q.2d at 1362. It is far from “reasonable” for the Swiss Applicant to actively mislead and confuse the market by claiming gruyere can come from only one country when, apparently according to Applicants now, it can actually come from two. Perhaps in ten more years Austrian gruyere will also become acceptable to Applicants?

Where an owner is itself distorting the definition of its own mark, misleading the public all the while, it should not be able to claim “control.” *See id.*

***Second, Applicants’ control efforts have been incomplete.*** It is not possible to catalog everything that Applicants have failed to do in their control efforts—the list would be very long. Nonetheless, we can highlight a few of the more egregious failures.

*Applicants have done nothing to challenge, change, or clarify an obvious hurdle to their registration: a U.S. federal regulation, 21 C.F.R. § 133.149, that defines gruyere cheese without reference to origin.* The Code of Federal Regulations, specifically 21 C.F.R. § 133.149, provides a description of gruyere cheese that does not specify any geographic origin. (TTABVUE #28 at 18 (Opposers’ Tr. Ex. 67); *see also* TTABVUE #32 at 33-34 (Jaekle Depo. 31:22-32:18).) Applicants, however, have done nothing to have that definition modified or amended—they have not even objected to it in any way. (*E.g.* TTABVUE #40 at 24 (Opposers’ Tr. Ex. 109, Interrogatory No. 24 & Response thereto), 39-40

(Opposers' Tr. Ex. 110, Interrogatory No. 24 & Response thereto), 57-59 (Opposers' Tr. Ex. 111, Requests for Production Nos. 28-31 & Responses thereto).) And, as a formal regulation promulgated by the Food and Drug Administration, 21 C.F.R. § 133.149 has the force of law. *See Batterton v. Marshall*, 648 F.2d 694, 701-02 (D.C. Cir. 1980). Seeing as Applicants have done nothing to combat that legal definition, their control efforts should be found distinctly lacking.<sup>12</sup>

*Applicants did not object to the World Championship Cheese Contest's acceptance of non-French, non-Swiss cheeses in the gruyere category. From at least 1995 through 2018, gruyere cheeses from the United States, Australia, South Africa, and Denmark all competed in the "gruyere" category of the World Championship Cheese Contest; some even took awards in the category. (TTABVUE #20 at 17-48 (Umhoefer Decl., Ex. B); TTABVUE #28 at 244-253 (Opposers' Tr. Exs. 74-78).) During that time, Applicants did not object to the acceptance of these non-Swiss, non-French cheeses by WCMA, the organization in charge (TTABVUE #20 at 6 (Umhoefer Decl. ¶ 4)), despite Applicants'*

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<sup>12</sup> Here, we have little doubt that the Applicants will try to confuse matters. They will likely argue that, under *Pom Wonderful LLC v. The Coca-Cola Company*, 134 S. Ct. 2228 (2014), the FDA standards are not binding on the Board with respect to this certification mark application. They will also point to another cheese, Roquefort, that is subject to FDA standards without a specific designated origin while also enjoying certification-mark protection. *Neither point has any bearing on the import of this evidence as it goes to Applicants' control efforts.* Regardless of whether it is theoretically possible for a certification mark to apply more stringently than the FDA standard of identity covering an identical term, it does not change Applicants' failure to try to amend, revise, or clarify the FDA standard of identity. The point here is not the effect of the standard of identity; the point is Applicants' repeated failure to do anything about the definition of "gruyere" under U.S. law.

awareness of and participation by its members in the competition (TTABVUE #40 at 97-98 (Opposers' Tr. Ex. 116 (advertisement produced by Applicants showing "LE GRUYÉRE SWITZERLAND AOP" mark with a statement that a member's cheese was named the world cheese champion in 2008))).

*Applicant did not object to the use of "gruyere" by the vast majority of U.S. producers and sellers. Use of the term "gruyere" is remarkably widespread, with more than 100 sellers and producers of U.S.-made gruyere identified in the record. (See, e.g., TTABVUE #24 at 50-51, 57-63 (Opposers' Tr. Exs. 18 (identifying 108 grocers selling Boar's Head U.S.-made gruyere, alone), 20-22); TTABVUE #25 at 303-335 (Opposers' Tr. Exs. 37-40).) Opposers have identified only approximately 40 recipients of Applicants' control efforts in all of their productions, which Applicants have represented as being exhaustive of all such efforts. (See, e.g., TTABVUE #40 at 56-57 (Opposers' Tr. Ex. 111, Requests for Production Nos. 24-27 & Responses thereto).) Moreover, those efforts did not start in earnest until 2012—meaning that the term "gruyere" spent 20 years after its purported date of first use in the U.S. without being the subject of any control efforts by Applicants. (Id.)*

*Third, Applicants' control efforts have been unsuccessful.* At the very least, Applicants have either abandoned or had rejected entirely their limited control efforts with the following businesses (in alphabetical order):

- Boar's Head (TTABVUE #39 at 10 (Opposers' Tr. Ex. 162) (still selling));

- Dairyfood USA, Inc. (TTABVUE #40 at 114 (Opposers' Tr. Ex. 120) (not resolved));
- Finlandia (TTABVUE #40 at 149 (Opposers' Tr. Ex. 126) (not resolved));
- Food Innovations (TTABVUE #39 at 21 (Opposers' Tr. Ex. 165) (still selling));
- Foodworks/Food Distributors, Inc. (TTABVUE #40 at 158 (Opposers' Tr. Ex. 128) (not resolved));
- Frank Brunckhorst (TTABVUE #40 at 162 (Opposers' Tr. Ex. 129) (not resolved));
- Intersource, Inc. (TTABVUE #40 at 166 (Opposers' Tr. Ex. 130) (not resolved));
- Keystone Farm, LLC (TTABVUE #40 at 170 (Opposers' Tr. Ex. 131) (not resolved));
- Mandi Foods, Inc. (TTABVUE #40 at 179 (Opposers' Tr. Ex. 133); TTABVUE #39 at 13 (Opposers' Tr. Ex. 163) (still selling));
- Ralph's Supermarkets (TTABVUE #39 at 7 (Opposers' Tr. Ex. 161) (still selling));
- Red Apple (TTABVUE #40 at 111 (Opposers' Tr. Ex. 119); TTABVUE #39 at 16 (Opposers' Tr. Ex. 164) (still selling));
- Trader Joe's Company (TTABVUE #40 at 220 (Opposers' Tr. Ex. 140) (not resolved)).

Indeed, even in the most up-to-date summary of Applicants' control efforts, there are still many contacted parties who continue to sell non-Swiss, non-French gruyere. (*See generally* TTABVUE #39.) Obviously some recipients of demand letters from Applicants gave into the demand rather than fight, but given the many U.S. businesses still using

the term “gruyere” with U.S.-made cheese, the control efforts on the whole have been unsuccessful.

*Fourth, Applicants’ control efforts rely on misleading information.* As already described, in many of the attempted control letters produced by Applicants, the Swiss Applicant claimed that Emmi Roth stopped using the designation “gruyere” on its U.S.-made cheese. (E.g. TTABVUE #40 at 110-118, 122-144, 148-239 (Opposers’ Tr. Exs. 120-121, 123-125, 127-142).) This is simply false. [REDACTED]

[REDACTED]

[REDACTED]

Perhaps Applicants will argue that they meant only that Emmi Roth stopped using the designation “gruyere” on its own Roth-branded products. If that is, in fact, what they meant to convey, then the letters could arguably be characterized as at least technically truthful. However, any reader would almost certainly come away with the distinct—and false—impression that Emmi Roth stopped labeling as “gruyere” all its U.S.-made cheese, as for instance the following examples strongly suggest:

Just as Emmi Roth USA, the largest U.S. importer of Swiss cheese, has phased out all use of the GRUYERE mark on cheese that does not originate in the Gruyère region, we ask that Acme

(TTABVUE #40 at 118 (Opposers’ Tr. Ex. 121).)

In answer to your first request, I had assumed that you were familiar with the first point raised in my letter – that Emmi Roth USA, the largest producer and importer of Swiss cheese in the US, had agreed to cease use of the designation Gruyere on its American-produced cheese by May 1, 2013 – because you had so carefully reviewed the USPTO file. A copy of the letter from the CEO and President of Emmi Roth confirming this step is attached.



(TTABVUE #40 at 123 (Opposers' Tr. Ex. 123).)

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, as seen in the attached letter. The Emmi Roth cheese produced in the U.S. is now sold under the GRAND CRU label.

(TTABVUE #40 at 128 (Opposers' Tr. Ex. 124).)

*Midwest Plastic* made perfectly clear that the control requirement serves the important purpose of “protect[ing] the public from being misled.” 15 U.S.P.Q.2d at 1362. Accordingly, there is an affirmative obligation on mark owners to “take reasonable steps... to prevent the public from being misled.” *Id.* Applicants simply cannot satisfy that requirement, here, where instead of trying to prevent the public from being misled, *they are actively trying to mislead it*, by encouraging producers and sellers to take unnecessary action on the basis of—generously—half-truths.

*Fifth, the French Applicant has not done a single thing to control the mark.* If the Board looks through all of the control efforts, it will notice a striking absence: not a single one of them came from the French Applicant. Instead, the Swiss Applicant appears to be the only active party—and, remember that the Swiss Applicant, for many years, claimed that gruyere could only come from Switzerland, *not* France.

\* \* \*

In the final analysis, Applicants simply have not reasonably controlled use of the term “gruyere” in the U.S. They have knowingly acquiesced to the term being used to

identify products that could not be certified under Applicants' identified standards. They have been inconsistent in defining the applicable certification standards and, just as bad, misled many of the targets of their limited control efforts. Their control efforts, meanwhile, have been incomplete and—in the subset of the subset of U.S. gruyere sellers and producers that they have actually contacted—only partially successful.<sup>13</sup> And the French Applicant sat idly by, doing nothing as its co-applicant—for years—represented that gruyere *could not* be made in France. This is not reasonable control.

## II. “Gruyere” is a generic term.

“A generic term, by definition, identifies a type of product, not the source of the product.” *In re Steelbuilding.com*, 415 F.3d 1293, 75 U.S.P.Q.2d 1420, 1421 (Fed. Cir. 2005) (citing *In re Gould Paper Corp.*, 834 F.2d 1017, 5 U.S.P.Q.2d 1110 (Fed. Cir. 1987)). The Ninth Circuit, for instance, uses a “‘who-are-you/what-are-you’ test” to determine whether a mark is generic; “A mark answers the buyer's question[.]... ‘Where do you come from?’... But the generic name of the product answers the question ‘What are you?’” *Advertise.com, Inc. v. AOL Advert., Inc.*, 616 F.3d 974, 96 U.S.P.Q.2d 1310, 1315 (9th Cir. 2010) (internal quotation omitted). Accordingly, where a mark does not indicate the regional origin of a good, the mark is generic and cannot be registered as a certification mark. *See Tea Bd. of India*, 80 U.S.P.Q.2d at 1888.

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<sup>13</sup> Those limited successes, in turn, were likely due at least in part to Applicants' misleading representations.

To the U.S. consumer, “gruyere” indicates, generically, a type of cheese.

Although there is a Gruyère region that straddles the border of Switzerland and France, and some gruyere cheese is produced there, not all gruyere cheese sold in the U.S. is produced there. (See, e.g., Tables at Pages 10-11, *supra* (together showing that probably far more than half of the gruyere cheese sold in the U.S. is domestically-produced).)

In other words, “gruyere” does not answer “Where do you come from?” — rather, it answers “What are you?” See *Advertise.com*, 96 U.S.P.Q.2d at 1313. For evidence of this, the Board need not look further than the regulation defining gruyere, 21 C.F.R. § 133.149, which *does not specify where* gruyere cheese must originate. By contrast, the regulation *does specify what* gruyere is—a cheese that: “contains small holes or eyes”; “has a mild flavor”; has a “minimum milkfat content [of] 45 percent,” and a “maximum moisture content [of] 39 percent”; and “is at least 90 days old.” 21 C.F.R. § 133.149(a)(1). The regulation even goes so far as to describe: the process by which gruyere must be prepared, *id. sub. (a)(3)*; ingredients that can be used in it, *id. sub. (b)*; and how the cheese can be described on labels, *id. subs. (c-d)*.

The fact that “gruyere” answers “what” (*not “where”*) is further supported by the same evidence that shows Applicants’ failure to control the term, specifically:

- [REDACTED]

- Applicants have not been consistent in their own definitions of gruyere, with the Swiss Applicant claiming for years that it could come from Switzerland *and nowhere else* (e.g. TTABVUE #40 at 83-96, 99-115, 119-126, 145-147, 158-161, 181-184, 227-235, 240-242 (Opposers’ Tr. Exs. 115, 117-120, 122-123, 126, 129, 134, 141, 143)); and
- Non-Swiss, non-French gruyere has routinely competed in the gruyere category at the World Championship Cheese Contest (*see generally* TTABVUE #20 at 16-48), and Applicants did not object to its inclusion there (TTABVUE #20 at 6 (Umhoefer Decl. ¶ 4); TTABVUE #40 at 97-98 (Opposers’ Tr. Ex. 116)). Indeed, one of the Swiss Applicant’s members even touted its winning entry in advertising. (TTABVUE #40 at at 97-98 (Opposers’ Tr. Ex. 116)).

These facts, too, either individually or taken together, establish that gruyere is a generic term that describes a type of cheese that can be made anywhere. Indeed, it has been made in the U.S. for years, not to mention multiple other countries including Austria, Germany, Hungary, Australia, Argentina, and Uruguay. (TTABVUE #32 at 12-13, 17-18, 23 (Jaeckle Depo. at 10:20-11:24, 15:23-16:3, 21:11-18); TTABVUE #31 at 14-18 (Gellert Depo. 12:16-25, 13:7-23, 14:9-23, 15:25-16:9).)

In addition, many publications either define “gruyere” without reference to origin or provide potential origins other than France and Switzerland. These include:

Source & Description	Record Citation
Chili U.S. Gruyere Cheese Baked Cups	TTABVUE #24 at 15 (Opposers’ Tr. Ex. 5); TTABVUE #28 at 255 (Opposers’ Tr. Ex. 79)
Recipes from www.usapeecme.org website in Mandarin	TTABVUE #24 at 21 (Opposers’ Tr. Ex. 8); TTABVUE #28 at 257 (Opposers’ Tr. Ex. 80)

<b>Source &amp; Description</b>	<b>Record Citation</b>
U.S. Specialty Cheeses: An Introduction to the Heritage, Quality & Trends, U.S. Dairy Export Council, describing "Gruyère Surchoix" as a semi-soft specialty cheese made in the United States	TTABVUE #24 at 27 ( <i>Opposers' Tr. Ex. 9</i> )
Cheese Market News, noting that while gruyere originated in Switzerland and France, Germany and Austria also have a tradition of producing it and is now being produced in Wisconsin	TTABVUE #24 at 32-33 ( <i>Opposers' Tr. Ex. 10</i> )
August 2005 USDA Food Standards and Labeling Policy Book	TTABVUE #24 at 65 ( <i>Opposers' Tr. Ex. 23</i> ); TTABVUE #28 at 272 ( <i>Opposers' Tr. Ex. 83</i> )
Peterson Specialty Cheese Catalog	TTABVUE #24 at 253 ( <i>Opposers' Tr. Ex. 24</i> ); TTABVUE #28 at 460 ( <i>Opposers' Tr. Ex. 84</i> )
Definition of gruyere from collinsdictionary.com	TTABVUE #25 at 182 ( <i>Opposers' Tr. Ex. 30</i> ); TTABVUE #28 at 553 ( <i>Opposers' Tr. Ex. 85</i> )
Definition of gruyere from merriam-webster.com	TTABVUE #25 at 189 ( <i>Opposers' Tr. Ex. 31</i> ); TTABVUE #28 at 559 ( <i>Opposers' Tr. Ex. 86</i> )
Definition of gruyere from oxforddictionaries.com	TTABVUE #25 at 200 ( <i>Opposers' Tr. Ex. 32</i> ); TTABVUE #28 at 570 ( <i>Opposers' Tr. Ex. 87</i> )
Definition of gruyere from thefreedictionary.com	TTABVUE #25 at 207 ( <i>Opposers' Tr. Ex. 33</i> ); TTABVUE #28 at 577 ( <i>Opposers' Tr. Ex. 88</i> )
Evidence of the term gruyere being used at restaurants in the United States	TTABVUE #25 at 211 ( <i>Opposers' Tr. Ex. 34</i> ); TTABVUE #28 at 581 ( <i>Opposers' Tr. Ex. 89</i> )
Recipes using gruyere printed in U.S. newspapers and various publications	TTABVUE #25 at 264 ( <i>Opposers' Tr. Ex. 35</i> ); TTABVUE #28 at 634 ( <i>Opposers' Tr. Ex. 90</i> )
Websites containing various Wisconsin gruyere cheeses for purchase	TTABVUE #25 at 341 ( <i>Opposers' Tr. Ex. 42</i> ); TTABVUE #28 at 678 ( <i>Opposers' Tr. Ex. 93</i> )

<b>Source &amp; Description</b>	<b>Record Citation</b>
U.S. Dairy Export Council informational brochure, U.S. Specialty Cheeses, An Introduction to the Heritage, Quality & Trends	TTABVUE #28 at 259 ( <i>Opposers' Tr. Ex. 81</i> )
May 25, 2007 Cheese Market News article regarding Gruyere	TTABVUE #28 at 268 ( <i>Opposers' Tr. Ex. 82</i> )

There is an equally large number of non-Swiss, non-French gruyere products that are either currently on the market or have been, including:

<b>Product/ Producer or Distributor</b>	<b>Origin</b>	<b>Record Citation</b>
Process gruyere style product/ Dairy Farmers of America	America	TTABVUE #24 at 7 ( <i>Opposers' Tr. Ex. 1</i> )
Gruyere Surchoix/ Roth Kase USA	Wisconsin	TTABVUE #24 at 9, 11, 13 ( <i>Opposers' Tr. Exs. 2-4</i> ); TTABVUE #28 at 251, 253 ( <i>Opposers' Tr. Exs. 77-78</i> )
Blanc Grue Gruyere Cheese/ Boar's Head	Wisconsin	TTABVUE #24 at 17, 19, 42, 44 ( <i>Opposers' Tr. Exs. 6-7; 14-15</i> ); TTABVUE # 28 at 799 ( <i>Opposers' Tr. Ex. 99</i> ); TTABVUE #32 at 146 ( <i>Jaeckle Depo Ex. 66</i> ); TTABVUE #39 at 7, 10 ( <i>Opposers' Tr. Ex. 161-162</i> )
Hickory Smoked Gruyere/ Boar's Head	Wisconsin	TTABVUE #24 at 36, 38, 40 ( <i>Opposers' Tr. Exs. 11-13</i> ); TTABVUE #39 at 7 ( <i>Opposers' Tr. Ex. 161</i> )
Smoked Gruyere/ Red Apple	Wisconsin	TTABVUE #24 at 60 ( <i>Opposers' Tr. Ex. 21</i> ); TTABVUE #39 at 16 ( <i>Opposers' Tr. Ex. 164</i> )
Apple Smoked Cheese Kosher Gruyere/ Red Apple	Wisconsin	TTABVUE #39 at 13 ( <i>Opposers' Tr. Ex. 163</i> )
Gruyere/ Boone Creek Creamery	Kentucky	TTABVUE #24 at 344 ( <i>Opposers' Tr. Ex. 25</i> )

<b>Product/ Producer or Distributor</b>	<b>Origin</b>	<b>Record Citation</b>
Danish Gruyere	Denmark	TTABVUE #28 at 245 ( <i>Opposers' Tr. Ex. 74</i> )
Everton Gruyere/ Jacobs and Brichford	Indiana	TTABVUE #28 at 249 ( <i>Opposers' Tr. Ex. 76</i> )
South African Gruyere/ Klein River Cheese	South Africa	TTABVUE #20 at 44; TTABVUE #28 at 249, 253 ( <i>Opposers' Tr. Exs. 76, 78</i> )
Saxony Alpine Style Gruyere/ Saxon Cheese	Wisconsin	TTABVUE #28 at 249 ( <i>Opposers' Tr. Ex. 76</i> )
Gruyere Reserve/ Emmi Roth USA	Wisconsin	TTABVUE #20 at 48; TTABVUE #28 at 251 ( <i>Opposers' Tr. Ex. 77</i> )
Gruyere Extra Aged/ Emmi Roth USA	Wisconsin	TTABVUE #20 at 48; TTABVUE #28 at 251 ( <i>Opposers' Tr. Ex. 77</i> )
Fortsonia Alpine Style Gruyere/ Nature's Harmony	Georgia	TTABVUE #20 at 48; TTABVUE #28 at 251 ( <i>Opposers' Tr. Ex. 77</i> )
Gruyere/ Fromagerie de Courgenay for Emmi Roth Kase	New York	TTABVUE #20 at 38; TTABVUE #28 at 253 ( <i>Opposers' Tr. Ex. 78</i> )
Gruyere Grand Tradition/ Fromalp for DCI Cheese	Wisconsin	TTABVUE #20 at 38; TTABVUE #28 at 253 ( <i>Opposers' Tr. Ex. 78</i> )
Austrian Smoked Gruyere	Austria	TTABVUE #28 at 802 ( <i>Opposers' Tr. Ex. 100</i> ); TTABVUE #32 at 94 ( <i>Jaeckle Depo Ex. 53</i> )
German Gruyere	Germany	TTABVUE #28 at 760 ( <i>Opposers' Tr. Ex. 95</i> ); TTABVUE # 31 at 63 ( <i>Gellert Depo Ex. 47</i> )
Austrian Gruyere	Austria	TTABVUE #28 at 840 ( <i>Opposers' Tr. Ex. 108</i> ); TTABVUE #32 at 68-92, 99-117 ( <i>Jaeckle Depo Ex. 51-52, 54-57</i> ); TTABVUE #39 at 21 ( <i>Opposers' Tr. Ex. 165</i> )
Wisconsin Gruyere	Wisconsin	TTABVUE #28 at 829

Product/ Producer or Distributor	Origin	Record Citation
		<i>(Opposers' Tr. Ex. 105); TTABVUE #32 at 104 - 129 (Jaekle Depo Exs. 56-61)</i>
Piave DOP Mezzano Gruyere	Italy	TTABVUE #28 at 837 <i>(Opposers' Tr. Ex. 107); TTABVUE #32 at 111 (Jaekle Depo Ex. 56)</i>
Graviera	Greece	TTABVUE #28 at 837 <i>(Opposers' Tr. Ex. 107)</i>
Grand Cru Gruyere	Wisconsin	TTABVUE #28 at 824 <i>(Opposers' Tr. Ex. 104); TTABVUE #32 at 132 (Jaekle Depo Ex. 62)</i>

To further confuse things, at least making clear that gruyere has never consistently been known to U.S. consumers as coming from Switzerland or France, the Board can also look to prior applications and registrations for marks including the word "gruyere." In Registration No. 4,398,395, the Swiss Applicant represented that gruyere must be produced in Switzerland and nowhere else.<sup>14</sup> (TTABVUE #28 at 37 (Opposers'

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<sup>14</sup> It is worthwhile to point out here that Opposers do not object to Applicants' registration and use of a design mark similar to the one the Swiss Applicant already registered to certify that a product originates from its members. That mark, reproduced below, makes perfectly clear that the labeled cheese comes from Switzerland. Applicants, however, are trying to reach much further here, seeking registration of the single word "gruyere," alone, as a certification mark, despite their own failure to control the mark and its genericness. Reg. No. 4,398,395:





Tr. Ex. 68).) In Application No. 85/091,899, the Swiss Applicant abandoned its attempt to register the mark “LE GRUYERE” after a finding that the mark was merely descriptive and generic; in pursuing this, the Swiss Applicant also represented that gruyere must be produced in Switzerland and nowhere else. (TTABVUE #28 at 135, 139-143, 146-150 (Opposers’ Tr. Ex. 69).)<sup>15</sup> Registration No. 1,026,885 identifies gruyere as a type of cheese “produced in France.” (TTABVUE #28 at 217 (Opposers’ Tr. Ex. 70) ; see also TTABVUE #28 at 222-243 (Tr. Exs. 71-73) (prior registrations requiring disclaimer of “gruyere”).) European regulations, themselves, cannot seem to resolve this question; the European Union issued regulations specifying that gruyere is made in France, while Switzerland issued its own to specify a Swiss origin. (Compare TTABVUE #28 at 246 (Opposers’ Tr. Ex. 96) with TTABVUE #28 at 251-252 (Opposers’ Tr. Ex. 97).)<sup>16</sup>

<sup>15</sup> This application was denied because the Examiner determined that “‘gruyere’ is a type or class of firm cheese made of cow’s milk with a rich, nutty flavor” —in other words, that “gruyere” is generic for a style of cheese. In support, the Examiner pointed to: (1) definitions from Merriam-Webster, the website Epicurious, Oxford Dictionaries, Collins Dictionary, and the American Heritage Dictionary; and (2) multiple U.S. producers of gruyere.

<sup>16</sup> These regulations further support the conclusion that gruyere is a generic style of cheese from anywhere, but with generally-consistent characteristics. The regulations differ between each other in their descriptions of gruyere, as shown in the table below. In other words, even in Europe “gruyere” does not have a consistent definition.

	<b>EU Regulations</b> (TTABVUE #28 at 244-245 (Opposers’ Tr. Ex. 96).)	<b>Swiss Regulations</b> (TTABVUE #28 at 252-253 (Opposers’ Tr. Ex. 97).)
Color	Golden yellow to brown	“uniformly brownish”
Holes	Pea- to cherry-sized	“desirable, but not indispensable”
Fat Content	47% and 52%	49% to 53%
Dry Content	No less than 62%	No specific minimum
Maturation Period	At least 120 days	5 months (appx. 150 days)

Taken together, all of these sources make one thing clear: in the U.S. the term “gruyere” does not now and has never meant a cheese that must specifically originate from particular regions of Switzerland or France. There is no consistency among the many sources on that supposed requirement. Some say it must be French alone. Others, including the Swiss Applicant, have said Swiss. Yet others have offered even more potential origins, and yet more do not identify any specific origin at all. This being the case, “gruyere” does not answer the question of source, “Where are you from?” See, e.g., *In re Steelbuilding.com*, 75 U.S.P.Q.2d at 1421; *Advertise.com*, 96 U.S.P.Q.2d at 1313. Instead, it simply describes the *type* of cheese, one that can be produced anywhere—including in the U.S. Cf. *In Re Cooperativa Produttori Latte E Fontina Valle D’acosta*, 230 U.S.P.Q. 131, 133 (TTAB Mar. 19, 1986) (finding that “fontina is the [generic] name of a type of cheese,” and therefore requiring a disclaimer).<sup>17</sup> (See also TTABVUE #32 at 22 (Jaeckle Depo. 20:14-16).)

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<sup>17</sup> Applicants may point to the lack of survey evidence in this case on the issue of genericness. If so, the *Fontina* case amply demonstrates that survey evidence is not required for a genericness finding. In fact, in that case, the Board explicitly chastised the parties for not including better evidence regarding the nature of the term fontina in the record. *Id.* Notably, however, the things the Board said would have helped it to understand the term—“evidence relating to use of the term in trade publications and in newspapers and magazines... and evidence of uses of this term in the marketplace by other cheese producers”—is exactly what Opposers have provided in this case. *Id.* In fact, Opposers provide much more, all of it weighing in favor of finding both genericness and lack of control. Therefore, consistent with the Board’s *Fontina* decision, it should likewise refuse to register gruyere.

CONCLUSION

For these reasons, Opposers respectfully request that the Board find that Applicants have not controlled the term "gruyere" and further that the term is generic for a style of cheese. Doing so, the Board should reject the application for a certification mark covering the term.

Dated this 8th day of February, 2019.

Respectfully submitted,  
GODFREY & KAHN, S.C.

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## APPENDIX A: TABLE OF EVIDENCE OF RECORD

<b>Party</b>	<b>Description</b>	<b>TTABVUE No.</b>	<b>Ex. Nos.</b>
Opposers	Declaration of John Umhoefer, including: <ul style="list-style-type: none"> <li>• Subpoena received by Mr. Umhoefer (Exh. A)</li> <li>• Documents responsive to the subpoena mainly consisting of world cheese contest winners (Exh. B)</li> </ul>	20	A, B
Opposers	Declaration of Matthias Kunz, including: <ul style="list-style-type: none"> <li>• Subpoena received by Mr. Kunz (Exh. A)</li> <li>• Written discovery responses (Exh. B)</li> <li>• Confidential sales document (Exh. C)</li> </ul>	21 (public) 22 (confid.)	A-C
Opposers	Declaration of Shawna Morris, including: <ul style="list-style-type: none"> <li>• USDEC records showing gruyere products produced in the U.S. or in countries other than Switzerland and France (Appendix A)</li> <li>• Documents submitted as part of a Letter of Protest objecting to Application No. 86/759,759 (Appendix B)</li> <li>• IDFA records describing the potential impact that widespread adoption of geographical indications could have on the U.S. dairy industry (Appendix C)</li> </ul>	23 24 (Exs. 1-27) 25 (Exs. 28-42) 26 (Ex. 43)	Opposers' 1-43
Opposers	First Notice of Reliance, comprising: <ul style="list-style-type: none"> <li>• Entries in the C.F.R. (Ex. 67)</li> <li>• Records of prior applications and accompanying file histories for marks incorporating the term "GRUYERE" (Exs. 68-73)</li> <li>• Printed and online publications (Exs. 74-108)</li> </ul>	28 (Exs. 67-108) 29 (Exs. 109-159) <sup>18</sup> 30 (Ex. 160) <sup>19</sup> 40 (Exs. 109-112, 115-159) 41 (Exs, 113-114, 160)	Opposers' 67-160

<sup>18</sup> Replaced by corrected version filed February 7, 2019, at TTABVUE #40.

<sup>19</sup> Replaced by corrected version filed February 7, 2019, at TTABVUE #41.

	<ul style="list-style-type: none"> <li>• Applicants' written discovery responses (Exs. 109-111)</li> <li>• Applicants' document productions (Exs. 112-146)</li> <li>• Declarations and accompanying exhibits of Messrs. Umhoefer an Kunz (Exs. 147-159 &amp; 160 (confid.))</li> </ul>		
Opposers	Testimony Deposition of Thomas Gellert, with exhibits including marketing materials, invoices, and communications showing non-Swiss, non-French gruyere sold in the United States.	31	Opposers' 44-49
Opposers	Testimony Deposition of Fermo Jaeckle, with exhibits including marketing materials, publications, labels, invoices and communications showing non-Swiss, non-French gruyere produced and sold in the United States	32	Opposers' 50-66
Applicants	Notice of Reliance, made up of printed and online publications regarding the definition of gruyere	35	Applicants' 11-21
Applicants	Declaration of Marie Guittard, including French specification for gruyere	36	Applicants' 10
Applicants	Declaration of Philippe Bardet including: <ul style="list-style-type: none"> <li>• Swiss specification for gruyere (Ex. 1)</li> <li>• Photos of IDG booth at a trade show (Ex. 2)</li> <li>• IDG brochures and recipes promoting the Gruyere mark (Ex. 3)</li> <li>• Two third-party websites describing gruyere (Exs. 4-5)</li> <li>• IDG attorney letters and responses (Ex. 6)</li> <li>• 2018 cheese contest results (Exs. 7-9)</li> </ul>	37	Applicants' 1-9
Opposers	Second Notice of Reliance, made up of online publications	39	Opposers' 161-165

**APPENDIX B: MEMORANDUM OF UNDERSTANDING  
BETWEEN SWISS APPLICANT AND EMMI ROTH  
Gruyère AOC Etats-Unis / Protocole d'accord Emmi-IPG**

**Préambule :**

Le 4 mai 2012, une séance a réuni MM. U. Riedener, M. Kunz et P-I Guyot de Emmi, et O. Kessler, P. Bardet et M. Gendre de l'Interprofession du Gruyère. Son objectif était de définir précisément les modalités d'un accord visant à la protection et la promotion du Gruyère AOC aux Etats-Unis.

<b>Point 1 :</b>	<b>Enregistrement de la marque Gruyère aux Etats-Unis</b> L'IPG entreprend les démarches nécessaires en vue de l'enregistrement de la marque Gruyère aux Etats-Unis. Emmi Roth USA (ERUSA) soutient activement l'IPG dans ses démarches.
<b>Remarques :</b>	L'IPG vérifie avec son avocat L. Hirt quelle est la meilleure stratégie pour obtenir l'enregistrement de la marque Gruyère aux Etats-Unis. ERUSA a préparé un courrier à l'attention du «U.S Patent and Trademark Office», dont les termes ont été discutés en séance et admis par les parties. Ce courrier sera envoyé dès que l'IPG aura clarifié la meilleure stratégie en la matière. D'une manière générale, un échange d'informations régulier et ouvert aura lieu entre ERUSA et l'IPG.
<b>Point 2 :</b>	<b>Renoncement à l'utilisation de la marque Gruyère</b> Emmi Roth USA renonce à l'utilisation de la marque Gruyère sur ses propres marques indigènes et dont la marque est détenue par Emmi, en particulier le fromage dénommé Grand Cru. Compte tenu d'une période de transition nécessaire, l'abandon complet de la marque Gruyère sera effectif dès le 1 <sup>er</sup> mai 2013.
<b>Remarques :</b>	La marque Gruyère n'étant pas protégée aux Etats-Unis, l'engagement de renoncer à l'utiliser constitue une décision unilatérale de ERUSA n'engageant pas les autres acteurs du marché. ERUSA porte une responsabilité exclusivement sur ses propres marques. L'utilisation éventuelle de la marque Gruyère par les clients de ERUSA, dans le cadre de «private labels» ou de la gastronomie, ne saurait être de la responsabilité de ERUSA. ERUSA donnera toutes les informations nécessaires à ses clients, mais sans tenir un rôle de contrôle ou d'inspection. D'une manière générale, un échange d'informations régulier et ouvert aura lieu entre ERUSA et l'IPG.
<b>Point 3 :</b>	<b>Mesures de soutien de l'IPG</b> Des mesures supplémentaires seront discutées au sein de la commission marketing de l'IPG en vue de soutenir la promotion, avec les maisons exportatrices, du Gruyère AOC aux Etats-Unis.
<b>Remarques :</b>	Le succès du Gruyère AOC aux Etats-Unis passe par une meilleure notoriété, d'autant plus qu'il ne bénéficie d'aucune protection. Les mesures marketing supplémentaires sont à discuter avec les principaux acteurs du marché et décider au sein de l'IPG.

Lucerne et Pringy, le 10 mai 2012.

**Emmi AG :**

Urs RIEDENER

Matthias KUNZ

**IPG :**

Oswald KESSLER

Philippe BARDET

The image shows four handwritten signatures in blue ink, each placed over a dotted line. From top to bottom, they correspond to the names listed in the adjacent text: Urs Riedener, Matthias Kunz, Oswald Kessler, and Philippe Bardet.

## Gruyère AOC United States / Emmi-IPG Memorandum of understanding

### Introduction:

On May 4, 2012, a meeting brought together U. Riedener, M. Kunz and P-I Guyot from Emmi, and O. Kessler, P. Bardet and M. Gendre from the Interprofession du Gruyère [IPG: Gruyère joint trade organization]. The objective was to define exactly the terms of an agreement on protection and promotion of Gruyère AOC [*appellation d'origine contrôlée*: controlled designation of origin] in the United States.

<b><u>Point 1:</u></b>	<p><b><i>Registration of Gruyère as a trademark in the United States</i></b>                  The IPG is taking the necessary steps to register Gruyère as a trademark in the United States.                  Emmi Roth USA (ERUSA) is actively supporting the IPG in this process.</p>
<b><u>Comments:</u></b>	<p>The IPG is checking with its lawyer L. Hirt to find the best strategy for registering Gruyère as a trademark in the United States.                  ERUSA has prepared a letter to the U.S Patent and Trademark Office, the terms of which were discussed in the meeting and accepted by the parties. This letter will be sent once the IPG has clarified the best strategy in the matter. In general, a regular and open exchange of information will take place between ERUSA and the IPG.</p>
<b><u>Point 2:</u></b>	<p><b><i>Cessation of use of Gruyère as a brand name</i></b>                  Emmi Roth USA is ceasing use of Gruyère as a brand name on its own indigenous private labels for which Emmi owns the brand, in particular the cheese known as Grand Cru.                  Taking into account a necessary transition period, the complete abandonment of Gruyère as a brand name will be effective as of May 1, 2013.</p>
<b><u>Comments:</u></b>	<p>Since Gruyère is not a protected trademark in the United States, the commitment to cease using it is a unilateral decision by ERUSA not binding on the other players in the market.                  ERUSA bears responsibility exclusively for its private labels. Any use of Gruyère as a brand name by ERUSA's customers, in the context of "private labels" or gastronomy, would not be ERUSA's responsibility.                  ERUSA will provide its customers with all necessary information, without playing a control or inspection role.                  In general, a regular and open exchange of information will take place between ERUSA and the IPG.</p>
<b><u>Point 3:</u></b>	<p><b><i>IPG support measures</i></b>                  Additional measures will be discussed within the IPG marketing commission in order to support the promotion, with the export houses, of Gruyère AOC in the United States.</p>
<b><u>Comments:</u></b>	<p>The success of Gruyère AOC in the United States depends on greater visibility, all the more so in that it is not protected.                  The additional marketing measures will be discussed with the main players in the market and decided within the IPG.</p>

Lucerne and Pringy, May 10, 2012.

Emmi AG:	Urs RIEDENER	<u>[signed]</u>
	Matthias KUNZ	<u>[signed]</u>
IPG:	Oswald KESSLER	<u>[signed]</u>
	Philippe BARDET	<u>[signed]</u>



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**CERTIFICATE OF TRANSLATION**

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March 1, 2018

*I, Rachel Vanarsdall, hereby certify that I am competent in both French and English languages.*

*I further certify that under penalty of perjury translation of the aforementioned document:*

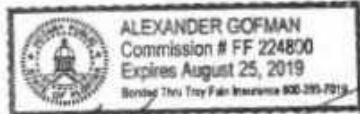
**[GRUY 1444\_English.pdf]**

*from the French language into the English language is accurate and correct to the best of my knowledge and proficiency.*

*Rachel Vanarsdall*

Rachel Vanarsdall

**Professional Translator**



*Alex Gofman*  
**03.01.2018**



## CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Opposers' Trial Brief – [Redacted] was served on counsel for Applicants, by forwarding said copy on February 8, 2019, via email as follows:

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*/s/ Zachary R. Willenbrink* \_\_\_\_\_

Zachary R. Willenbrink

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