ESTTA Tracking number: **ESTTA797195**

Filing date: **01/25/2017**

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	Intercibus Inc
Granted to Date of previous extension	01/25/2017
Address	P.O. Box 1907 Marco Island, FL 34146 UNITED STATES

Attorney information	Marie Lavalleye Covington & Burling LLP One CityCenter, 850 Tenth Street NW Washington, DC 20001 UNITED STATES trademarks@cov.com Phone:202.662.5439

Applicant Information

Application No	86759759	Publication date	09/27/2016
Opposition Filing Date	01/25/2017	Opposition Period Ends	01/25/2017
Applicants	Interprofession du GruyÃ¨re La Maison du GruyÃ¨re 1662 Pringy, SWITZERLAND Syndicat Interprofessionnel du GruyÃ¨re 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

Grounds for Opposition

The mark is generic	Trademark Act Sections 1, 2 and 45
Other	Failure to exercise control, Trademark Act Sections 1, 4 and 45

Attachments	Notice of Opposition - GRUYERE_Intercibus Inc.pdf(252851 bytes)

Signature	/MarieLavalleye/
Name	Marie Lavalleye
Date	01/25/2017

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

In the Matter of:	Serial No. 86/759,759
Date of Filing:	September 17, 2015
Mark:	GRUYERE
Date of Publication:	September 27, 2016

Intercibus, Inc.

Opposer,

v.

Syndicat Interprofessionnel du Gruyère and Interprofession du Gruyère,

Applicants.

Opp. No. _____

NOTICE OF OPPOSITION

Intercibus, Inc., a Florida corporation located and doing business at P.O. Box 1907, Marco Island, FL 34146 ("Opposer"), believes that it will be damaged by registration of the generic term "GRUYERE" as a certification mark in International Class A for "cheese" as shown in Serial No. 86/759,759, and hereby opposes the same.

The grounds for opposition are as follows:

1. Applicants — Syndicat Interprofessionnel du Gruyère, a French registered association, and Interprofession du Gruyère, a Swiss registered association — jointly seek

registration of the generic term "GRUYERE" (in standard characters) on the Principal Register as a certification mark in International Class A for "cheese."[1]

2. Applicants filed the certification mark application, assigned Serial No. 86/759,759, on September 17, 2015.

3. In their application, Applicants have included the following certification statement:

> The certification mark, as used by persons authorized by the certifier, certifies that the cheese originates in the Gruyère region of Switzerland and France.
>
> 1). In Switzerland this region includes the cantons of Fribourg, Vaud, Neuchatel, Jura, and the districts of Courtelary, La Neuveville, Moutier as well as the communes of Ferenbalm, Guggisberg, Mühleberg, Münchenwiler, Rüschegg and Wahlern of the canton of Bern.
>
> 2). In France this region includes the departments of Doubs, Jura, Haute-Saône, Savoie and Haute-Savoie as well as the cantons of Amberieu-en-Bugey, Bellegarde-sur-Valserine, Belley, Brénod, Ceyzériat, Champagne-en-Valromey, Coligny, Collonges, Ferney-Voltaire, Gex, Hauteville-Lompnes, Izernore, Lagnieu, Lhuis, Nantua, Oyonnax-Nord, Poncin, Pont- d'Ain, Saint-Rambert-en-Bugey, Seyssel, Treffort- Cuisiat, Virieu-le-Grand, Péronnas, Oyonnax-Sud, Viriat, Oyonnax, Bourg-en-Bresse in the department of Ain, the cantons of Fontaine-Française, Saint-Jean-de-Losne, Seurre in the department of Côte-d'Or, the cantons of Saint-Laurent-du-Pont and Touvet in the department of Isère, the cantons of Bourbonne-les- Bains, Bourmont, Clefmont, Fayl-la-Forêt, Laferté- sur-Amance, Langres, Longeau-Percey, Val-de-Meuse, Neuilly-l'Evêque, Nogent, Prauthoy, Terre- Natale in the department of Haute-Marne, the cantons of Beaurepaire-en-Bresse, Cuiseaux, Pierre-de-Bresse, Saint-Germain-du-bois in the department of Saône-et- Loire, the cantons of Bains-les-Bains, Darney, Lamarche, Monthureux-sur- Saône, Plombières-les-

[1] Applicants claim to own the GRUYERE certification mark jointly, but the entirety of this certification mark is contained (and not subject to a disclaimer) in a registered composite mark owned by only one of the Applicants. *See* Reg. No. 4,398,395. Opposer notes that this appears to be inconsistent with Applicants' claim in the certification mark application that both Applicants have exclusive right to use the term GRUYERE.

Bains, Xertigny in the department of Vosges, the cantons of Delle, Fontaine, Giromagny, Rougemont- le-Château, Valdoie, Châtenois -les-Forges, Danjoutin, Beaucort, Grandvillars, Offemont, Belfor in the department of Territoire de Belfortstate.

4. Applicants claim that the term GRUYERE was first used by authorized users anywhere to certify that their "cheese" originates in the Gruyère region of Switzerland and France as early as 1982 and was first used by authorized users in commerce to certify that their "cheese" originates in the Gruyère region of Switzerland and France as early as 1985.

5. The application herein opposed was filed on September 17, 2015, and was published for opposition on September 27, 2016. On October 27, 2016, Opposer filed a request for a 90-day extension of time to oppose the subject application. On October 27, 2016, the Trademark Trial and Appeal Board ("TTAB") granted Opposer's request for a 90-day extension of time (until January 25, 2017) to file a Notice of Opposition. Accordingly, the filing of this Notice of Opposition is timely.

6. Opposer has used the generic term GRUYERE in connection with the import and resale of gruyere cheese products produced in Finland and Austria and sold in the United States since 1990. Since then, Opposer has imported for resale over two hundred and fifty thousand (250,000) pounds of this gruyere cheese in the United States.

7. If Applicants' certification mark application for GRUYERE is approved for registration, Applicants would have the *prima facie* exclusive right to control the use of the term GRUYERE as a mark certifying certain kinds of cheese products. Such registration will directly damage Opposer, consumers, and others who have a right to use the common food name GRUYERE to identify gruyere cheese products in the United States.

8. Accordingly, Opposer has a real interest in being able to continue to use the generic term GRUYERE in the course of conducting its business and has standing to oppose Applicants' certification mark application for GRUYERE.

A. The Proposed Certification Mark Is Incapable of Functioning as a Certification Mark Because It Is a Generic Term for a Type of Cheese.

9. The proposed GRUYERE certification mark is composed entirely of a generic term for a type of cheese in violation of Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e).

10. In determining whether a term is generic, the Trademark Manual of Examining Procedure ("TMEP") instructs examining attorneys to apply a two-part test: "(1) What is the genus of goods or services at issue? (2) Does the relevant public understand the designation primarily to refer to that genus of goods or services?" TMEP § 1209.01(c)(i); *see also* TMEP § 1306.05(c) (applying the same analysis for certification marks). The TMEP further provides that the genus of goods "may be defined by an applicant's identification of goods and/or services," and the relevant public "refers to the purchasing or consuming public for the identified goods and/or services." *Id.*

11. If the relevant public is likely to "perceive[] the primary significance of a term as identifying a type or category of the relevant goods or services, without regard to the origin of the goods or services or the methods and conditions for producing them, then the term is generic and does not serve to certify regional origin." TMEP § 1306.05(c); *see also Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1887 (TTAB 2006).

12. Here, Applicants seek registration of GRUYERE as a mark that they contend is used by certifier users to certify the origin and mode of production of their cheese. In support thereof, Applicants have submitted images of cheese products bearing the term GRUYERE,

copies of which are attached hereto as Exhibit A. The genus of goods is therefore cheese, and the relevant public consists of purchasers of cheese.

13. On information and belief, gruyere cheese is produced in several different areas of the world (not just those regions of Switzerland and France identified in Applicants' application), including in the United States.

14. On information and belief, many companies other than Opposer have used or are using the term GRUYERE in connection with the sale of non-French and non-Swiss cheese in the United States to signify the type of cheese they are selling.

15. On information and belief, these non-Swiss and non-French gruyere cheese products are readily available through numerous local grocery stores and online retail stores in the United States, as well as through major food service establishments across the United States.

16. On information and belief, the term GRUYERE is also used in a generic sense in various recipes, menus, dictionaries, new articles, and informational websites that are readily available to consumers in the United States. For example, the Oxford Dictionary defines "gruyére" as a "firm, tangy cheese." *See* "Gruyére," English Oxford Living Dictionaries, https://en.oxforddictionaries.com/definition/gruyere. Similarly, Merriam-Webster defines "gruyére cheese" as "a pressed whole-milk cheese of a pale yellow color and nutty flavor and usually with small holes." *See* "Gruyére cheese," Merriam-Webster, https://www.merriam-webster.com/dictionary/Gruy%C3%A8re.

17. On information and belief, purchasers of cheese in the United States perceive the term GRUYERE, not as certifying that the cheese was manufactured in a particular way or that it was made in a particular geographic area, but merely as indicating a type of cheese.

18. Although gruyere cheese may have originated in the Gruyère region of Switzerland and France, to the extent the term at one point had any significance as an indication of geographic source, it has lost that significance and become a generic term identifying a type of cheese from the perspective of consumers.

19. Accordingly, as consumers in the United States perceive GRUYERE as a generic term for a type of cheese, the term (applied for in block-letter form) is incapable of functioning as a certification mark. Registration therefore should be refused under the provisions of Sections 1, 2, 4, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052, 1054, 1127.

B. Applicants Have Failed to Exercise Legitimate Control Over the Use of the Proposed Certification Mark.

20. Upon information and belief, Applicants have not controlled or limited the use of the proposed GRUYERE certification mark in a manner so as reliably to indicate to U.S. cheese consumers that goods bearing the term GRUYERE meet the certification standards set by the Applicants.

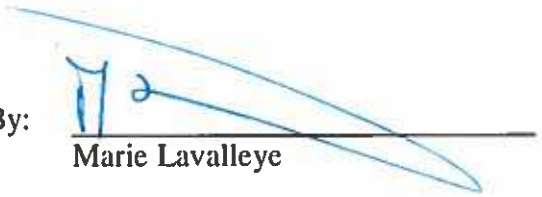
21. As noted above, since 1990, Opposer has imported for resale in the United States cheese products, not made in the Gruyère region of Switzerland and France, which are labeled with the term GRUYERE.

22. On information and belief, many companies other than Opposer have used or are using the term GRUYERE in connection with the sale of non-Swiss and non-French cheese in the United States to signify the type of cheese without complying with Applicants' certification standards.

23. On information and belief, the widespread uncertified use of the term GRUYERE in connection with gruyere cheese products precludes Applicants' mark from having significance as an indication of geographic source of such products.

24. Accordingly, the term as applied for in standard character form under Serial No. 86/759,759 is incapable of functioning as a certification mark and registration should be refused under the provisions of Sections 1, 4, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1054, 1127. *See also* TMEP §§ 1306.04(b)(i), 1306.05(g)(i).

WHEREFORE, Opposer prays that this opposition be sustained and that registration of Application Serial No. 86/759,759 be denied.

By: 
Marie Lavalleye

Counsel for Intercibus, Inc.

Dated: January 25, 2017

Exhibit A


IMPORTED FROM
SWITZERLAND
RAW MILK
GRUYERE
CHEESE
AGED OVER
120 DAYS
MILK
Nutrition Facts


Gruyère
FRANCE
Gruyère
FRANCE
Gruyère
FRANCE