

ESTTA Tracking number: **ESTTA870275**

Filing date: **01/10/2018**

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	The Icelandic Milk and Skyr Corporation
Granted to Date of previous extension	01/10/2018
Address	135 West 26th Street 6th Floor New York, NY 10001 UNITED STATES
Attorney information	Susan M. Kayser Jones Day 51 Louisiana Avenue, NW Washington, DC 20001 UNITED STATES Email: skayser@jonesday.com, agaransi@jonesday.com, nytéf@jonesday.com, rgeist@jonesday.com, kwells@jonesday.com

Applicant Information

Application No	87464229	Publication date	09/12/2017
Opposition Filing Date	01/10/2018	Opposition Period Ends	01/10/2018
Applicant	The Dannon Company, Inc. 100 Hillside Avenue, Floor 3 White Plains, NY 106032863 UNITED STATES		

Goods/Services Affected by Opposition

Class 029. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Dairy products, namely, skyr; yogurt and yogurt-based beverages; dairy-based beverages

Grounds for Opposition

The mark is merely descriptive	Trademark Act Section 2(e)(1)
Failure to function as a mark	Trademark Act Sections 1, 2 and 45
Other	a) The mark is merely informational and incapable of functioning as a trademark pursuant to Sections 1, 2, and 45 of the United States Trademark Act of 1946, 15 U.S.C. Sections 1051, 1052, and 1127. (b) The mark is so highly laudatory that it is incapable of acquiring trademark significance pursuant to Section 2 of the United States Trademark Act of 1946, 15 U.S.C. Section

	1052(e)(1).
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Attachments	Notice of Opposition - App. No. 87464229.pdf(1785957 bytes)
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Signature	/Susan M. Kayser/
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Name	Susan M. Kayser
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Date	01/10/2018
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

The Icelandic Milk and Skyr Corporation,)	
)	Opposition No. _____
Opposer,)	
)	Application No: 87/464,229
v.)	
)	Filed: May 25, 2017
The Dannon Company, Inc.,)	
)	Published: September 12, 2017
Applicant.)	
)	
)	

NOTICE OF OPPOSITION

Opposer, The Icelandic Milk and Skyr Corporation (hereinafter, “IMSC” or “Opposer”), a Delaware corporation with its principal place of business at 135 West 26th Street, 6th Floor, New York, NY 10001, believes that it will be damaged by the registration of the mark shown in Application Serial No. 87/464,229, and therefore opposes registration of the same under Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063.

Application Serial No. 87/464,229 was published for opposition in the Trademark Official Gazette on September 12, 2017. Opposer timely filed a request to extend the opposition period to January 10, 2018, which was granted.

As grounds for this Opposition it is alleged that:

Factual Background

A. Opposer and Use of Generic Term “Skyr”

1. IMSC is a dairy company that is well known for its SIGGI’S brand of Icelandic-style skyr and yogurt products, which Opposer has manufactured and offered for sale for over a decade.

2. IMSC's SIGGI'S brand products are sold as an "Icelandic style skyr" and "strained non-fat yogurt." An example of such use is displayed below:



3. IMSC advertises its products on its website www.siggis.com as "based on Scandinavian dairy traditions, such as skyr, the traditional Icelandic yogurt."

4. On the frequently asked questions portions of its website at www.siggis.com/frequently-asked-questions/, IMSC answers the question of "what is Icelandic-style skyr" as "Skyr is the traditional yogurt of Iceland that has been made for over 1,000 years. It is a strained non-fat yogurt. It is made by incubating skim milk with live active cultures. Then the whey, the water naturally found in milk, is strained away to make for a much thicker, creamier and concentrated yogurt. It takes four times the milk to make one cup of siggi's compared to regular yogurt."

5. IMSC uses the term "skyr" in connection with the marketing of its Icelandic-style skyr yogurt products, including in connection with social media, to inform prospective customers of the type of product it sells. IMSC also owns and markets its skyr products through the website www.skyr.com in which it describes what skyr is: "skyr noun| \ 'skir \ :an Icelandic dairy product made by fermenting milk, better known as strained yogurt." skyr.com states that "Skyr

is a strained yogurt that has been a staple of the Icelandic diet since the Vikings settled more than 1,100 years ago. Skyr is even mentioned in some of the Sagas, the famed stories about the Vikings and early Icelandic history and settlement. Skyr today is almost only made with cow's milk but was originally made from both the milk of sheep and cow." skyr.com also describes how skyr is made, and includes a video of how to make skyr.

B. Applicant and Application at Issue

6. Upon information and belief, Applicant The Dannon Company, Inc. (hereinafter, "Dannon" or "Applicant") is a Delaware corporation with an address of 100 Hillside Avenue, Floor 3, White Plains, New York 106032863.

7. Applicant is the owner of Application No. 87/464,229 for the alleged mark TRUESKYR (hereinafter, the "Opposed Application").

8. Applicant's Opposed Application covers "dairy products, namely, skyr; yogurt and yogurt-based beverages; dairy-based beverages" in International Class 29.

9. Application No. 87/464,229 was filed on May 25, 2017 as an intent-to-use application.

10. The alleged mark "TRUESKYR" is merely informational, merely descriptive, and/or highly laudatory of the skyr and yogurt goods identified in the Opposed Application.

11. The term "skyr" is generic for a cultured milk-based dairy product that originated in Iceland and is similar to a yogurt, fresh strained cheese, and/or a product made of milk curds.

12. Multiple third party sources (including numerous dictionaries, encyclopedias, recipes, newspapers, scholarly journals, and dairy producers) describe skyr as a fermented, curdled, or sour milk product, similar in consistency to thick yogurt.

13. The generic nature of the term “skyr” is further evident from Applicant’s identification of goods which lists “skyr”, “yogurt” and yogurt/dairy based- beverages, as the goods for which the alleged mark “TRUESKYR” will be used in connection with.

14. “True” merely describes a characteristic or feature of the skyr, yogurt, and yogurt/dairy based beverages.

15. Upon information and belief, Dannon also uses the alleged mark “TRUESKYR” to inform consumers of its skyr or yogurt products as a proper Icelandic style yogurt. For example, the products (shown below) claim that Dannon’s yogurt is a “Classic Icelandic Style Yogurt.”



The product description available at <https://www.influenster.com/reviews/dannon-of-the-worldtm-true-skyrtm-strawberry-honeyberries-yogurt-53-oz-single-serve>, <https://www.influenster.com/reviews/dannon-of-the-worldtm-true-skyrtm-raspberries-yogurt-53-oz-single-serve>, and <https://www.influenster.com/reviews/dannon-of-the-worldtm-true-skyrtm-vanilla-yogurt-53-oz-single-serve> further states that “Our skyr (pronounced “skeer”) is made with exclusive cultures that give it a smooth and full texture with just the right balance of sweet and tart taste.” A true and correct copy of Dannon’s alleged “TRUESKYR” products available on the Internet are attached as Exhibit A.

16. Consumers even view the “TRUESKYR” skyr product as informing them that the product is a “proper skyr” product such as those made in Iceland. For example, on the website <https://www.influenster.com/reviews/dannon-of-the-worldtm-true-skyrtm-strawberry-honeyberries-yogurt-53-oz-single-serve> Darlene F. states in a review for Dannon’s TRUESKYR product that “Skyr is sooo good for you! It’s low in fat, high in protein and nice and thick, almost a cream cheese consistency. True Skyr is close enough to eating proper skyr in Iceland without having to pay for a flight there.” *See* Exhibit A.

COUNT I
“TRUESKYR” is Merely Informational and
Incapable of Functioning as a Trademark

17. IMSC realleges and incorporates Paragraphs 1-16 as though fully set forth herein.

18. The primary function of the alleged mark “TRUESKYR,” as understood by the relevant public when used in connection with Dannon’s skyr and yogurt is to factually identify that the content of the goods is a “true skyr” product as originated in Iceland.

19. Because the alleged mark “TRUESKYR” as used by Dannon in connection with its skyr and yogurt is merely informational in nature, the alleged mark is incapable of functioning as a trademark denoting a single source for skyr and/or yogurt.

20. Dannon’s application for the Opposed Application should therefore be refused registration on the basis that the alleged mark “TRUESKYR” is merely informational and incapable of functioning as a trademark pursuant to Sections 1, 2, and 45 of the United States Trademark Act of 1946, 15 U.S.C. §§ 1051, 1052, and 1127. *See* TMEP 1202.04 (“If a proposed mark is merely informational, a failure-to-function refusal must issue. If registration is sought on the Principal Register, the statutory basis for this refusal is §§1, 2, and 45 of the Trademark Act, 15 U.S.C §§1051, 1052, and 1127”).

21. The registration of the Opposed Application will damage IMSC by interfering with its ability to use the phrase “true skyr” to describe its product as Icelandic style skyr.

COUNT II
“TRUESKYR” is Merely Descriptive and
Incapable of Functioning as a Trademark

22. IMSC realleges and incorporates Paragraphs 1-21 as though fully set forth herein.

23. The alleged mark “TRUESKYR” is merely descriptive of the goods covered by Application No. 87/464,229 because it only factually identifies Dannon’s skyr or yogurt as a “true skyr” product.

24. Dannon uses the alleged mark “TRUESKYR” in a descriptive manner to inform consumers that it is a skyr product as originated in Iceland.

25. The alleged mark “TRUESKYR” is merely descriptive of the qualities of Dannon’s Icelandic-style skyr or yogurts, and also IMSC’s Icelandic-style skyr or yogurt, that the phrase is incapable of achieving trademark significance, cannot function as a trademark to distinguish Dannon’s yogurt, and cannot serve as an indicator of origin when used in connection with the skyr or yogurt goods identified in the Opposed Application.

26. Dannon’s application for the Opposed Application removes a descriptive phrase “true skyr” from the public domain, preventing others from using this phrase to describe their skyr or yogurt as a “true skyr” product.

27. Dannon’s application for the Opposed Application should therefore be refused registration on the basis that the alleged mark “TRUESKYR” is merely descriptive and incapable of functioning as a trademark pursuant to Section 2 of the United States Trademark Act of 1946, 15 U.S.C. § 1052(e)(1).

28. The registration of the Opposed Application will damage IMSC by interfering with its ability to use the phrase “true skyr” to describe its Icelandic style skyr.

COUNT III
“TRUESKYR” is So Highly Laudatory as to be
Incapable of Functioning as a Trademark

29. IMSC realleges and incorporates Paragraphs 1-28 as though fully set forth herein.

30. The alleged mark “TRUESKYR” is highly laudatory of the goods covered by Application No. 87/464,229 because the combination of the terms “true” and “skyr” immediately conveys to consumers information that it is a “real” or “authentic” skyr or dairy product, and therefore retains its descriptive nature.

31. Dannon uses the alleged mark “TRUESKYR” in a highly laudatory manner to praise its product as a “true skyr” product as originated in Iceland.

32. The alleged mark “TRUESKYR” is so highly laudatory of the qualities of Dannon’s Icelandic-style skyr or yogurt, and also IMSC’s Icelandic-style skyr or yogurt, that the phrase is incapable of achieving trademark significance, cannot function as a trademark to distinguish Dannon’s yogurt, and cannot serve as an indicator of origin when used in connection with the skyr or yogurt goods identified in the Opposed Application.

33. Dannon’s application for the Opposed Application removes a highly laudatory phrase “true skyr” from the public domain, preventing others from using this phrase to praise their skyr or yogurt as a “true skyr” product.

34. Dannon’s application for the Opposed Application should therefore be refused registration on the basis that the alleged mark “TRUESKYR” is highly laudatory and incapable of functioning as a trademark pursuant to Section 2 of the United States Trademark Act of 1946, 15 U.S.C. § 1052(e)(1).

35. The registration of the Opposed Application will damage IMSC by interfering with its ability to use the phrase “true skyr” to praise its Icelandic style skyr.

Relief Requested

WHEREFORE, for the foregoing reasons, Opposer respectfully requests that the present opposition be sustained in favor of IMSC and Application No. 87/464,229 be refused registration on the grounds that (1) Dannon’s alleged Opposed Application is merely informational and incapable of functioning as a trademark, and/or (2) Dannon’s alleged Opposed Application is merely descriptive that it is incapable of acquiring trademark significance, and/or (3) Dannon’s alleged Opposed Application is so highly laudatory that it is incapable of acquiring trademark significance.

Respectfully submitted,

The Icelandic Milk and Skyr Corporation

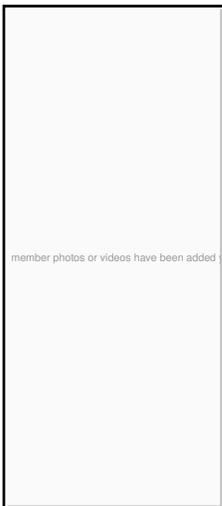
Dated: January 10, 2018

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Exhibit A

Find Dry Shampoo, Top Moisturizer, Gre

SEARCH



Dannon of the World™ True Skyr™ Strawberry & Honeyberries Yogurt 5.3 oz. Single Serve

BY SKYR [Is This Your Brand?](#)

4.50 / 5 based on [4 Reviews](#)

PRODUCT DESCRIPTION

Our skyr (pronounced "skeer") is made with exclusive cultures that give it a smooth and full texture with just the right balance of sweet and tart taste.

TOP QUESTIONS *No one has asked a question yet! Be the first!*

Sort by

REVIEWS

Featured



Dec. 28, 2017, 9:34 a.m.

I really love these with some granola on top as a healthy breakfast, they're full of flavour and super quick and easy to grab in the mornings, I really enjoy these and they keep me full until lunch time whereas other products only satisfy my hunger for briefer periods if time

Rachel F.

Diet: No Special Diet

Warwickshire ,
Kenilworth

Like This?

79 reviews



Oct. 26, 2017, 8:23 p.m.

Skyr is sooo good for you! It's low in fat, high in protein and nice and thick, almost a cream cheese consistency. True Skyr is close enough to eating proper skyr in Iceland without having to pay for a flight there.

Darlene F.

Diet: No Special Diet

Edmonton

Like This? 1

273 reviews



Jan. 3, 2018, 4:36 p.m.

Join now to gain access to over 20 million product reviews, free full size samples, and the latest product news.

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Jan. 5, 2018, 3:25 p.m.

Healthy and delicious! We love these yoghurts! A must have in our weekly shop. Will continue to buy SKYR products

Paige C.

Diet: No Special Diet

Like This?

27 reviews

Q & A

Looking for your answer?

Be the First to Ask a Question

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The Greek Gods Greek Yogurt Style Honey

based on 2473 reviews



YoCrunch Cookies n' Cream Lowfat Yogurt with Oreo Cookie Pieces

based on 585 reviews



Chobani® Blended Key Lime

based on 1227 reviews



Danimals Smoothie Strawberry Explosion/Strikin Strawberry Kiwi Pack

based on 874 reviews





Original Strawberry Banana Low Fat Yogurt

based on 5647 reviews



Chobani® Blended Coconut

based on 865 reviews



Yoplait® Disney Low Fat Yogurt Variety Packs

based on 367 reviews



Yoplait® Despicable Me™ Bello! Strawberry Banana Low Fat Yogurt

based on 395 reviews

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Dannon of the World™ True Skyr™ Raspberries Yogurt 5.3 oz. Single Serve

BY SKYR [Is This Your Brand?](#)



PRODUCT DESCRIPTION

Our skyr (pronounced "skeer") is made with exclusive cultures that give it a smooth and full texture with just the right balance of sweet and tart taste.

TOP QUESTIONS *No one has asked a question yet! Be the first!*

REVIEWS

Be the first to review this item!

Start your review of Dannon of the World™ True Skyr™ Raspberries Yogurt 5.3 oz. Single Serve!

RELATED ARTICLES



Join now to gain access to over 20 million product reviews, free full size samples, and the latest product news.

GET STARTED

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Dannon of the World™ True Skyr™ Vanilla Yogurt 5.3 oz. Single Serve

BY SKYR [Is This Your Brand?](#)

★★★★☆ 4.00 / 5 based on [2 Reviews](#)

PRODUCT DESCRIPTION

Our skyr (pronounced "skeer") is made with exclusive cultures that give it a smooth and full texture with just the right balance of sweet and tart taste.

TOP QUESTIONS *No one has asked a question yet! Be the first!*

REVIEWS

Sort by **Featured**



Tora V.
Bourmemouth
11 reviews



I love skyrocket yoghurts! They are high in protein and low in fat and is a perfect snack or boost after your workout! The price is good and it is a good option if you are going to eat yoghurt and still be healthy. Not as much added sugar in them 😊

Diet: Vegetarian, Vegan, Organic

[See More](#)

Like This?

Nov. 22, 2017, 7:34 p.m.



Good quality but have gone off the flavour. Very thick and creamy. Can be quite expensive.

Dec. 17, 2017, 3:29 p.m.

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