

# Gruyère and Tequila® – Are they Generic, Registerable Trademarks, and/or Just Good Together?

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January 25, 2022



You may have seen some news recently about cheese. Specifically, the E.D. Va. District Court has recently decided to uphold a Trademark Trial & Appeals Board (TTAB) decision finding “GRUYERE” to be generic for cheese, and therefore unregistrable as a certification mark.

In September of 2015, Interprofession du Gruyère filed an application with the U.S. Patent & Trademark Office (USPTO) to register the term GRUYERE as a certification mark. With a certification mark registration in place, to use the word GRUYERE in association with cheese would require the cheese a certification process confirming that it originates from the Gruyère region of Switzerland and France. U.S. Dairy Export Council (as well as several other parties) filed an opposition to the mark arguing that US customers understand the term GRUYERE to indicate a type of cheese having certain characteristics involving taste and softness, etc., but that it could be produced anywhere, not necessarily in Switzerland or France.

In August of 2020, the TTAB issued a decision in the opposition, finding that “purchasers and consumers of cheese understand the term ‘gruyere’ as a designation that primarily refers to a category within the genus of cheese that can come from anywhere.” **U.S. Dairy Export Council et al. v. Interprofession du Gruyère and Syndicat Interprofessionnel du Gruyère, 2020 USPQ2d 10892 (TTAB 2020)**. This decision was in favor of the U.S. Dairy Export Council’s view that GRUYERE is generic<sup>1</sup> and incapable of being registered as a certification mark.

In the decision, the TTAB cited overwhelming evidence demonstrating that cheese identified as “gruyere” is made in many locations including Germany, Austria, and the United States. This weighed heavily against a view that for a cheese to be called “gruyere” it must come from a specific country or region. “After carefully considering all of the arguments and evidence of record, we find that purchasers and consumers of cheese understand the term “gruyere” as a designation that primarily refers to a category within the genus of cheese that can come from anywhere.” U.S Dairy Export Council et al, page 65.

Dissatisfied with the TTAB decision, the Interprofession du Gruyère et al. filed a civil action with the U.S. District Court for the Eastern District of Virginia, appealing the TTAB finding. However, in the recent decision, the District Court for the Eastern District of Virginia upheld the TTAB’s decision finding the term GRUYERE to be generic for cheese, and therefore unregistrable as a certification mark. On the Dairy Export Council’s motion for summary judgment, the court found that “the undisputed evidence produced by the parties in this case makes clear that the primary significance of the term GRUYERE, as understood by the relevant purchasing public in the United States, is a generic term for a type of cheese and does not refer solely to cheese from a specific geographic region.” *Interprofession du Gruyère et al. v. U.S. Dairy Export Council et al.*, Civil Action No. 1:20-cv-1174 (E.D. Va. December 15, 2021).

Interprofession du Gruyère filed a notice of appeal on January 7, 2022, so this may not be the last we hear on whether GRUYERE is generic or worthy of a certification mark registration.

After reading this news about gruyere cheese, I was reminded of another recent case regarding genericness and certification marks.

A term that once was an indication of the quality or origins of a product can become generic over time through a process called genericide. Genericide is when the mark's primary significance to the relevant consuming public is as a generic term for the goods or services and not an indicator of source (15 U.S.C. § 1064(3); see *E.T. Browne Drug Co. v. Cococare Prods., Inc.*, 538 F.3d 185, 192 (3d Cir. 2008); *Nora Beverages, Inc. v. Perrier Group of Am., Inc.*, 164 F.3d 736, 744 (2d Cir. 1998) (trade dress)). The CAFC has also indicated that "the relevant public's perception is the primary consideration in determining whether a term is generic." *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 969 (Fed. Cir. 2015). The party opposing registration has the burden to prove genericness by a preponderance of the evidence. *Royal Crown Co.*, 892 F.3d at 1366.

In rare instances, a term that some may perceive as being generic, can sometimes be reclaimed as a trademark. For years, the USPTO considered "tequila" a generic term in describing such spirits. Consejo Regulador del Tequila, A.C. ("CRT") is the association charged with assuring that all things labeled "tequila" must comply with the laws of Mexico. CRT lead the effort to seek a certification mark in the United States. In 2003, they filed an application to register TEQUILA as a certification mark for distilled spirits, namely, spirits distilled from the blue tequilana weber variety of agave plant. After a lengthy battle with the USPTO, and an opposer to its registration, in 2017 the USPTO did issue a registration certificate indicating "The certification mark "Tequila", as used by persons authorized by the Consejo Regulador del Tequila, A.C. ("CRT" or "Certifier"), certifies that (1) the goods are manufactured in Mexico from a specific variety of the blue agave plant grown in certain regions of Mexico as defined by Mexican law and standards; (2) the goods are manufactured in Mexico in compliance with Mexican law and standards including fermentation, distillation, aging, the percentage of blue agave sugars and physical-chemical specifications; and (3) the finished product is or contains within it the goods manufactured in accordance with (1) and (2) above."

Therefore, since 2017 the USPTO has now actively prohibited the use of the term "TEQUILA" in the goods descriptions of trademark applications. This is the opposite outcome of the GRUYERE determination on genericness, and an indication that you never can definitively predict the outcomes when it comes to trademarks.

After all of this discussion regarding generic marks, a remaining question for some may be whether there is such a thing as a Tequila® and cheese pairing? Faced with this quandary, I did some quick Internet searching and confirmed that yes, indeed, Tequila® and cheese pairings do exist.

Based on my research, here are some basic rules:

1. Blanco Tequila® spirits are never aged in an oak barrel. It tends to be hotter (more alcohol taste) and can include grassy herbal notes, citrus, pepper, and sometimes a sweetness from the agave plant. Blanco tends to go well with mild and slightly sweet cheeses, such as brie-style cheese.
2. Reposado Tequila® spirits are formed from blanco that is aged in American or French oak barrels for between two months and one year. This barrel-aging adds flavors of caramel and honey, sometimes chocolate, vanilla, cinnamon, and also creates a gold hue to the color. Reposado tends to go well with cheeses that are higher in fat, such as sheep's milk cheese or water buffalo milk cheese.
3. Anejo Tequila® spirits are also formed from blanco but aged in American or French oak barrels longer than reposado for between one year and three years. With more time in the oak barrel, more character from the wood is absorbed. The anejo becomes even darker in color and includes notes of oak, sugar, caramel, and vanilla. Anejo goes well with Alpine-style cheeses, such as Emmental, Asiago, fontina, Reblochon, Comte, and of course gruyere!

In an effort to continue my research into all of the above, it may be time to break open a nice Anejo Tequila® beverage and a well-respected gruyere cheese and see just how good they are together, regardless of their generic or non-generic status. Updates to follow...

For more information, please contact **Sean Detweiler**.

1. “A generic name—the name of a class of products or services—is ineligible for federal trademark registration.” *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2020 USPQ2d 10729, \*1 (2020). There is a two-part test used to determine whether a designation is generic: (1) what is the genus of goods or services at issue; and (2) does the relevant public understand the designation primarily to refer to that genus of goods or services? *H. Marvin Ginn Corp. v. Int’l Assn. of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). The relevant public’s perception is the primary consideration in determining whether a term is generic. *Loglan Inst. Inc. v. Logical Language Grp. Inc.*, 902 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992). [\[?\]](#)