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THE FOURTH CIRCUIT COURT OF APPEALS ENTERS THE CHEESE WARS: DETERMINING GENERICNESS FOR TRADEMARK REGISTRATION

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Recently, the United States Court of Appeals for the Fourth Circuit considered whether “gruyere” cheese can be registered as a trademark in the United States, or whether it is merely a generic term that is not entitled to trademark protection.

In its **opinion** in *Interprofession du Gruyere v. U.S. Dairy Export Council*, the court did not miss the opportunity for some cheesy puns. It also addressed several important issues concerning the evidence that is admissible to show genericness.

An application to register a trademark with the U.S. Patent and Trademark Office (“USPTO”) often gives rise to opposition from other industry participants. One basis for opposition is that the proposed mark is generic. A trademark is generic and cannot be registered if it merely identifies a *type* of product (like lemonade), whereas a name identifying the source of a product (like Minute Maid) is not generic and can be registered. The USPTO and the courts consider a variety of evidence in making this determination of genericness.

Gruyere is a nutty, alpine cheese that originated in the 12th Century in the Gruyere region of Switzerland and in surrounding areas of France. Since then, production has expanded internationally. In this case, Swiss and French gruyere cheesemaking consortiums sought registration of the certification mark “GRUYERE” with the USPTO.

If granted, such a certification mark would only permit cheese produced in the Gruyere region of Switzerland and France to be labeled and sold as gruyere cheese. As such, several American cheesemaking companies that produce their own versions of gruyere cheese opposed the European consortiums’ registration application. Citing several categories of evidence, the American companies argued that members of the general public who purchase or consume cheese understand the term ‘gruyere’ to refer to a type of cheese, not to cheese produced *only* in Switzerland or France. The USPTO agreed, concluding that gruyere is a generic term and ineligible for registration. The European consortiums challenged that decision in a Virginia federal court. The court agreed with the USPTO and the consortiums appealed to the Fourth Circuit.

The Fourth Circuit’s Decision

The European consortiums’ appeal focused on three categories of evidence: (1) federal regulations; (2) data showing gruyere imports and domestic production; and (3) common usage of the term “gruyere.”

The Fourth Circuit explained that the touchstone of the genericness inquiry was whether the general public understood gruyere to refer to a type of nutty, alpine cheese or as indicating that the cheese was produced in a particular region of Switzerland and France. The court then explained that each of the challenged categories of evidence supported a finding that gruyere is a generic term. Accordingly, it cannot be registered.

As for federal regulations, the Fourth Circuit determined that FDA regulations defining gruyere cheese as a cheese containing “small holes” with “a mild flavor” and other, non-geographic qualities supported a finding that the proposed mark was generic. Because those FDA regulations had governed the labeling of gruyere cheese since the 1970s, the regulations’ non-geographic definition accorded with consumer expectations about gruyere.

Next, the data showed that American consumers had been exposed to significant amounts of gruyere cheese produced outside Switzerland and France, including in Wisconsin and other U.S. states. This, the Fourth Circuit reasoned, supported a conclusion that consumers perceived gruyere cheese to signify a type of cheese “regardless of regional origin.”

Finally, the court looked at the common usage of the term “gruyere.” The dictionary definitions on this point were mixed. Some referred to gruyere as originating in Switzerland and France; others described gruyere as a type of cheese without geographic constraints. Numerous websites supported the view that the geographic origin was not important. Overall, the court determined that consumers asking for gruyere were not generally expecting to find cheese originating only in France or Switzerland.

In its final analysis, the Fourth Circuit held that these three categories of evidence were so “one-sided” that they supported the district court’s finding that gruyere is a generic term and not subject to registration.

In so holding, the Fourth Circuit also rejected the notion that the genericness analysis requires parties to provide consumer survey evidence. Consumer survey evidence is common in genericness cases. But the court explained that evidence of a public’s understanding of a proposed mark may be obtained from “any competent source,” including those presented here.

Takeaways from *Interprofession du Gruyere*

The *Interprofession du Gruyere* case illustrates some of the nuanced evidentiary issues that will arise in trademark disputes. The Fourth Circuit’s opinion demonstrates that parties must consider many categories of evidence in determining whether proposed marks are generic and, therefore, ineligible for registration. And, while consumer survey evidence can be powerful in many cases, the Fourth Circuit’s opinion shows that such evidence is not essential.

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