No. 2021-2301

United States Court of Appeals for the Federal Circuit

CHARLES BERTINI,
Appellant,

v.

APPLE INC.,
Appellee

Appeal from the United States Patent and Trademark Office,
Trademark Trial and Appeal Board in Case No. 91229891

APPELLANT CHARLES BERTINI'S MOTION FOR PERMISSION TO SUPPLEMENT THE RECORD

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Counsel for Charles Bertini

James Bertini, Counsel for Appellant Charles Bertini ("Counsel") discussed this motion with Appellee Apple Inc. lead counsel Joseph Petersen. Mr. Petersen will file an opposition.

Charles Bertini makes this Motion requesting that the Court allow him to present material evidence not of record due to extraordinary circumstances and pursuant to Rule 10(e)(2)(C) of the Federal Rules of Appellate Procedure, Rule 201 of the Federal Rules of Evidence, case law, and the inherent equitable authority of the federal courts of appeals.

It is not Bertini's intention to argue the merits of the case in this Motion, but it is necessary to refer to decisions and positions of the Trademark Trial and Appeal Board ("TTAB") in order to demonstrate the extraordinary circumstances surrounding this case and the necessity to supplement the record.

I. INTRODUCTION

A. The following is of record

Charles Bertini began use of his mark Apple Jazz in 1985 for entertainment services in Class 41 with the creation of a jazz band called Apple Jazz which performed live concerts on a regular basis. In the following years, he expanded the use of his mark to encompass other entertainment services. At that time in 1985, Apple Computer, Inc. (the

name was changed to Apple Inc. in 2007) sold hardware and software *and didn't provide any entertainment services*. Bertini provided entertainment services under Apple Jazz *30 years before* Apple Inc. *or any predecessors* provided entertainment services under Apple Music, or Apple marks.

Bertini hired a lawyer to register his mark in 1991, but the lawyer registered it only in New York State. In 2012 Bertini signed a Cloud Service License Agreement with Apple Inc. using another variation of his mark, AppleJazz Music. Apple Inc. began using the Apple Music mark for entertainment services in 2015, and this mark is remarkably similar to that of its customer. Until the Apple Music mark was published for opposition, Bertini did not realize that he did not have federal registration for Apple Jazz.

Common law marks such as Apple Jazz are recognized under the Lanham Act, albeit they are harder to enforce than a federally-registered trademark. Consequently, in 2016 Bertini filed an application to register Apple Jazz with the USPTO and simultaneously filed an Opposition to the registration of Apple Music, believing that there would be a likelihood of confusion between the two marks. Both Apple Inc. and TTAB agreed that there would be a likelihood of confusion between the two marks. That meant that the clash became essentially a priority contest.

Bertini filed a Motion for Summary Judgment ("MSJ") on September 18, 2018 which was partially granted on March 1, 2019 ("Decision on MSJ") by Administrative Law Judges ("ALJs") Frances Wolfson, George Pologeorgis, and Linda Kuczma ("the **Original Board**"). Then, two of the judges were removed and replaced. After trial, an April 16, 2021 Final Decision dismissing Bertini's Opposition was made by ALJs Jonathan Hudis, Thomas Shaw and Linda Kuczma ("the **New Board**"). Interlocutory Attorney ("IA") Michael Webster had also been removed, and he was replaced with Jennifer Elgin. [1]

B. The following is not of record.

One of the two new ALJs, Jonathan Hudis, has had professional relationships with two of the Kilpatrick Townsend attorneys representing Apple Inc. on this case for more than a decade. New IA Jennifer Elgin had previously been *of counsel* to Kilpatrick Townsend for five years.

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[1] Jennifer Elgin has also replaced IA Michael Webster in Bertini's related case to cancel APPLE mark Reg. No. 4088195 for abandonment/nonuse in Class 41. The ALJs who decided Bertini's MSJ on that case on May 21, 2020 were Peter Cataldo, Frances Wolfson and Christen English. The case was marked "ready for decision" on February 23, 2021. Counsel does not know whether those judges have also been replaced and if so by whom. What Counsel does know is that as of today the USPTO website FAQ states: "When can I expect a final decision in my opposition or cancellation proceeding? Presently, the TTAB is rendering decisions in these proceedings approximately 10 weeks after the case is ready for decision." *This case has not been decided for almost eight months.*

II. ALJ JONATHAN HUDIS' RELATIONSHIP WITH PARTNERS WILLIAM BRYNER AND THEODORE DAVIS OF KILPATRICK TOWNSEND AND HIS DUTY TO DISQUALIFY HIMSELF

Administrative Law Judge Jonathan Hudis was appointed March 20, 2019. He had previously been a partner in the law firm of Quarles & Brady. He has been an adjunct professor of law at George Mason University School of Law teaching trademark law and has written a number of scholarly articles about trademark law. He has held leadership positions in the American Bar Association's Section of Intellectual Property Law ("the ABA IP Section") until at least May 2019, and with the American Intellectual Property Law Association ("AIPLA"). He was a member of the Trademark Public Advisory Committee from 2014 or 2015 to 2017.

A. Relationship Between Jonathan Hudis and William Bryner.

William Bryner is a partner at Kilpatrick Townsend and one of the attorneys representing Apple Inc. in this case. He has made an appearance before this Court. Beginning in 2010 and continuing through 2016, Mr. Hudis was the editor of a book entitled *A Legal Strategist's Guide to Trademark Trial and Appeal Board Practice*. Mr. Bryner was a chapter author for several of these editions.

B. Relationship Between Jonathan Hudis and Theodore Davis

Theodore Davis is a partner at Kilpatrick Townsend and one of the attorneys representing Apple Inc. in this case. He has made an appearance before this Court. Mr. Davis has had a professional relationship with Mr. Hudis which has extended for several years. They have both been officers on the ABA IP Section at the same time or approximately the same time: in 2018 Mr. Hudis was the Secretary when Mr. Davis was Past President. Both have held leadership positions in the AIPLA.

Both Messrs. Hudis and Davis have appeared at USPTO public meetings together. At one of those meetings they attended as representatives of the ABA IP Section. After the last publication of the book for which Mr. Hudis was editor, Mr. Davis took over as editor.

C. ALJ Hudis Was Required to Disqualify Himself

Judge Hudis was required to disqualify himself pursuant to 28 U.S.C. § 455. This statute reads in part:

(a) Any justice, judge, or magistrate judge of the United States shall disqualify himself in any proceeding in which his impartiality might reasonably be questioned.

(b) He shall also disqualify himself in the following circumstances:

(1) Where he has a personal bias or prejudice concerning a party.

According to 28 USC § 451: "The term "judge of the United States" includes judges of the courts of appeals, district courts, Court of International Trade *and any court created by Act of Congress*, the judges of which are entitled to hold office during good behavior." (Emphasis added.)

Congress established the USPTO via 35 U.S.C. §1.

Consequently, the TTAB, as part of the USPTO, was established by an Act of Congress, and ALJ Hudis was required to disqualify himself because he was involved in a "proceeding in which his impartiality might reasonably be questioned," due to his relationship with attorneys representing Apple Inc. and because he likely has "a personal bias or prejudice concerning a party." In his eagerness to join the Board and participate in making the Final Decision, ALJ Hudis chose to ignore this law.

III. THE CHANGE IN ADMINISTRATIVE LAW JUDGES AFFECTED THE OUTCOME OF THE CASE

A. Management at the TTAB Reassigned the ALJs Knowing that it Could Affect the Case and That it Would Negatively Affect its Mission

The Management removed two ALJs and replaced them with two ALJs - at least one of whom has an appearance of bias - and an IA who has an appearance of bias. Management did this knowing it would create more work for its staff, since two ALJs and an IA already familiar with the case would be replaced with two ALJs and an IA who were not familiar with it.

Administrative law judges at the TTAB are not randomly assigned. They are assigned to cases by Management in an opaque process that is not described in any document available to the public. This is contrary to the practice at federal district courts – and probably at most/all state trial courts - where judges are randomly assigned. No notice is placed on the record regarding assignments, removals, replacements, and therefore litigants have no opportunity to object to a conflict or appearance of bias. Generally, even the first names of the ALJs are not listed on decisions. Counsel only comprehended the significance of these changes recently.

Neither ALJ Hudis nor ALJ Shaw declined the assignment or notified Counsel of their assignment, nor did anyone in the Management of the TTAB notify Bertini of their assignment.

B. A Timeline of Events Shows the Judge Reassignments and Corresponding Decisions

March 1, 2019	**Original Board** grants Bertini's MSJ in part
March 20, 2019	Jonathan Hudis appointed ALJ
April 1, 2019	Theodore Davis appears on the legal team representing Apple Inc. by participating in the filing of Apple Inc.'s Motion to Reconsider Decision on MSJ
April 12, 2019	Bill Bryner joins the legal team for Apple Inc.[2]
Sept 30, 2019	Apple Inc.'s Motion for Reconsideration denied. ALJ Thomas Shaw is rotated in and shown on decision replacing ALJ Frances Wolfson.
Prior to Sept 15, 2020	Jennifer Elgin replaces existing IA

[2] Based on Counsel's search of his emails for Mr. Bryner's name.

April 16, 2021	Final Decision dismissing Bertini's Opposition. ALJ Jonathan Hudis is staggered onto the Board and is shown on Decision replacing ALJ George Pologeorgis. **New Board** ignores legal position of **Original Board** that benefited Bertini.

C. The New Board Ignored the Most Significant Legal Position of the Original Board

In its Decision on MSJ the **Original Board** had established its position on tacking *for this particular case* based on case law from the U.S. Supreme Court, the Federal Circuit Court of Appeals and the TTAB, all requiring a strict standard for tacking which would vitiate Apple Inc.'s tacking defense. The **New Board** *ignored* this strict tacking standard.

D. The New Board Ignored the Genericness Standard That the Three ALJs of That New Board Applied in Precedential Cases *That They Themselves Decided*

While no mention of "generic" or "genericness" of a portion of the APPLE MUSIC mark appears in Apple Inc.'s Amended Answer, its Response to MSJ, or in the **Original Board's** Decision on MSJ, the **New Board** mentioned it *one time* in its Final Decision (to support that APPLE and APPLE MUSIC are legal equivalents for tacking purposes). The **New Board** relied on its own single statement of genericness without any evidentiary record and without a required two-part inquiry for genericness of a term. *In doing so the **New Board** ignored standards for genericness of*

*terms that the members of the **New Board** - ALJs Hudis, Shaw and Kuczma - previously applied in other precedential TTAB cases.*[3] This suggests an appearance of bias by the **New Board**.

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[3] *In re Empire Tech. Dev. LLC*, 123 U.S.P.Q.2D 1544 (TTAB 2017) PRECEDENTIAL - **Shaw** https://ttabvue.uspto.gov/ttabvue/v?pno=85876688&pty=EXA&eno=22 ("…must have the genericness of its proposed mark 'assessed without limitation…'")

Milwaukee Electric Tool Corp. v. Freud America, Inc., 2019 U.S.P.Q.2D 460354 (2019 TTAB) PRECEDENTIAL – **Shaw** https://ttabvue.uspto.gov/ttabvue/v?pno=92059637&pty=CAN&eno=18 ("But we must analyze genericness based on the identification of goods as written.")

In re James Haden, M.D., P.A, 2019 WL 6650556 (TTAB 2019) PRECEDENTIAL - **Shaw, Kuczma** https://ttabvue.uspto.gov/ttabvue/v?pno=87169404&pty=EXA&eno=23 ("The Examining Attorney must establish by clear evidence that a mark is generic.")

Performance Open Wheel Racing, Inc. v. United States Auto Club Inc. WL 2404075 (TTAB 2019) PRECEDENTIAL - **Shaw** https://ttabvue.uspto.gov/ttabvue/v?pno=91229632&pty=OPP&eno=41 (("Whether an asserted mark is generic or descriptive is a question of fact" based on the entire evidentiary record). As noted above, we must give due consideration to the evidence of consumer perception of the use of the mark as a whole.")

In re Serial Podcast, LLC, 126 U.S.P.Q.2d 1061 (TTAB 2018) PRECEDENTIAL - **Shaw** https://ttabvue.uspto.gov/ttabvue/v?pno=86454420&pty=EXA&eno=18 ("Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?")

IV. THE SUPPLEMENTAL DOCUMENTS ARE MATERIAL TO SHOWING EXCEPTIONAL CIRCUMSTANCES

The documents with which Bertini would like to supplement the record are material because they demonstrate the relationship, and the strength of that relationship, between ALJ Hudis and Messrs. Bryner and Davis of Kilpatrick Townsend. Combined with the change of two ALJs, the change in significant legal position from the **Original Board** to the **New Board**, Bertini contends that this shows the appearance of bias, if not actual bias, by ALJ Hudis and the TTAB.

This **New Board** managed to change the predicted outcome of the case by ignoring a legal position established by the **Original Board**, and by making a decision on genericness contrary to its own previous precedential decisions. All of this constitutes exceptional circumstances.

In re The Consumer Protection Firm PLLC, 2021 WL 825503 (TTAB 2021) PRECEDENTIAL - **Hudis**
https://ttabvue.uspto.gov/ttabvue/v?pno=87445801&pty=EXA&eno=10
("The genericness inquiry is a two-part test: 'First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?'")

In re Chronix Biomedical, Inc., 2018 WL 3740515, (TTAB 2018) – **Kuczma dissent opinion**
https://ttabvue.uspto.gov/ttabvue/ttabvue-86612457-EXA-13.pdf
("The Examining Attorney bears the burden of making a "strong" showing, with "clear evidence," that Applicant's mark is generic." "We must make a two-step inquiry to determine whether "second opinion" is generic.")

V. THIS COURT HAS THE AUTHORITY TO ALLOW BERTINI TO SUPPLEMENT THE RECORD

Rule 10(e)(2)(C) of the Federal Rules of Appellate Procedure, Correction or Modification of the Record, reads in part: "(2) If anything material to either party is omitted from or misstated in the record by error or accident, the omission or misstatement may be corrected and a supplemental record may be certified and forwarded (C) by the court of appeals."

As explained above, the evidence omitted is material. The evidence could be considered to be omitted from the record because it was not available when the record was being made: Bertini did not have notice about the assignment of ALJ Hudis to the case until after Counsel filed his Reply Trial Brief, and in any event, Counsel was unaware of ALJ Hudis' relationship with Messrs. Bryner and Davis at this time.

Rule 201 of the Federal Rules of Evidence, Judicial Notice of Adjudicative Facts, reads in part: "(b) Kinds of Facts That May Be Judicially Noticed. The court may judicially notice a fact that is not subject to reasonable dispute because it (2) can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned."

If the Court grants this motion, Counsel will attach documents (and provide links where available) which can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.

These sources include copyrights from the U.S. Copyright Office, biographies of ALJ Hudis and IA Elgin posted on their Linkedin pages, transcripts of public comments at TTAB meetings, ABA meeting minutes, AIPLA webpages, and official records of the TTAB regarding this case.

The Court also has the inherent power to allow the record to be supplemented on appeal.

According to *Acumed LLC v. Advanced Surgical Servs.*, 561 F.3d 199, 226 (3rd Cir. 2009) "in exceptional circumstances a court of appeals may allow a party to supplement the record on appeal." Another court allowed the record to be enlarged: "Here, we decide to exercise our discretion to consider the photograph, rather than to remand this case to the district court and prolong a case which has wound its way through courts for the past six years." (Bertini's case is now in its sixth year.) *Gibson v. Blackburn,* 744 F.2d 403, 405 ftnt 3 (5th Cir., 1984).

Another court discusses exceptions from the general rule that material outside the record is not to be used on appeal, explaining that it may "exercise inherent authority to supplement the record in extraordinary cases." It does so in the context of documents the government withheld from a party which it was required to disclose, and stated that it is a "particularly serious violation. Lowry's strongest argument was that the

Administration had not complied with its own procedures for handling bias claims by completing review of his complaint." *Lowry v. Barnhart,* 329 F.3d 1019, 1024-1025 (9th Cir. 2003).

Bertini's case has different facts, but the issue is equally grave.

One appellate court ruled that a district court judge was required to be disqualified even when he was unaware of a conflict. *Mangini v. United States,* 314 F.3d 1158 (9th Cir. 2003). In Bertini's case, the judge *did know* about his potential conflict and he did not disqualify himself or reveal it.

VI. CONCLUSION AND REQUEST FOR RELIEF

There is an appearance of bias, and possibly actual bias, among personnel at the TTAB and that bias may have affected the outcome of this case. The impartiality of ALJ Hudis (and IA Elgin) might reasonably be questioned by anyone reviewing the facts of this case and he may have a personal bias or prejudice concerning a party. Bertini desires to supplement the record with documents that demonstrate the reasons for this bias.

The Court has the authority under statutory and case law to permit Bertini to supplement the record with evidence showing the relationship between ALJ Hudis and two of the attorneys on the Apple Inc. legal team, and the former employment of IA Elgin. The Court has this authority pursuant to Rule 10(e)(2)(C) of the Federal Rules of Appellate Procedure,

Rule 201 of the Federal Rules of Evidence, case law, and its inherent equitable authority if supplementing the record will advance the principles of fairness, truth, or judicial efficiency.

Switching judges and an IA after one party's MSJ is partially granted resulting in changed legal positions by the new judges is truly an extraordinary circumstance, especially when that judge has had professional relationships with two of the attorneys representing one party. Allowing Bertini to supplement will advance the principles of fairness, truth and judicial efficiency.

Consequently, Bertini respectfully requests that this Court grant him permission to supplement the record with evidence (a) regarding the relationships between ALJ Hudis and Messrs. Bryner and Davis, (b) the biographies of ALJ Hudis and IA Elgin, (c) news regarding appointment of ALJ Hudis, and (d) any other relevant information, and for any other relief the Court deems just and proper.

October 15, 2021 /s/ James Bertini_____

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DECLARATION PURSUANT TO FEDERAL CIRCUIT RULE 27(a)(4)

Some of the facts in this motion are likely the subject of a dispute between the parties.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

October 15, 2021 /s/ James Bertini

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of **APPELLANT BERTINI'S MOTION FOR PERMISSION TO SUPPLEMENT THE RECORD** has been served on the following attorneys by email on October 15, 2021 by James Bertini.

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/s/ James Bertini_____
JAMES BERTINI

FORM 19. Certificate of Compliance with Type-Volume Limitations **Form 19**
July 2020

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: 2021-2301

Short Case Caption: Bertini v. Apple Inc.

Instructions: When computing a word, line, or page count, you may exclude any items listed as exempted under Fed. R. App. P. 5(c), Fed. R. App. P. 21(d), Fed. R. App. P. 27(d)(2), Fed. R. App. P. 32(f), or Fed. Cir. R. 32(b)(2).

The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because it meets one of the following:

☑ the filing has been prepared using a proportionally-spaced typeface and includes 3311 words.

☐ the filing has been prepared using a monospaced typeface and includes _____ lines of text.

☐ the filing contains _____ pages / _____ words / _____ lines of text, which does not exceed the maximum authorized by this court's order (ECF No. _____).

Date: 10/15/2021

Signature: /s/ James Bertini

Name: James Bertini

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

Case Number 2021-2301

Short Case Caption Bertini v. Apple Inc.

Filing Party/Entity Charles Bertini, Appellant

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box**. Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 10/15/2021

Signature: /s/ James Bertini

Name: James Bertini

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	**2. Real Party in Interest.** Fed. Cir. R. 47.4(a)(2).	**3. Parent Corporations and Stockholders.** Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. ☑ None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. ☑ None/Not Applicable
Charles Bertini		

☐ Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

☑ None/Not Applicable ☐ Additional pages attached

5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

☐ None/Not Applicable ☑ Additional pages attached

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☑ None/Not Applicable ☐ Additional pages attached

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Date of Docketing: September 13, 2021

ADDITIONAL PAGE
CERTIFICATE OF INTEREST, FORM 9

5. Related Cases

Charles Bertini v. Apple Inc.
Cancellation No. 92068213
Trademark Trial and Appeal Board,
US Patent and Trademark Office

Case was submitted for final decision on February 23, 2021

A panel of three administrative law judges decided the Motion for Summary Judgment in this case, Peter W. Cataldo, Frances S. Wolfson and Christen English. However, it is unknown whether they have been replaced by other ALJs who will make the Final Decision.