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 Case No. 91229891

APPLE INC.'S OPPOSITION TO APPELLANT'S MOTION FOR PERMISSION TO SUPPLEMENT THE RECORD

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CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rule 47.4, counsel of record for Appellee Apple, Inc. certifies as follows:

1. The full name of every party represented by our firm is:

Apple Inc.

2. The names of the real parties in interest represented by our firm are:

None.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the parties represented by our firm are:

None.

4. The names of all law firms and the partners or associates that appeared for the parties represented by us in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

Jason M. Gonder, Kilpatrick Townsend & Stockton LLP
Glenn A. Gunderson, Dechert LLP
Daniel P. Hope, Dechert LLP

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal.

None.

6. Organizational Victims and Bankruptcy Cases: Any information required under Fed. R. App. P. 26(1)(b) and 26.1(c).

None.

Dated: October 25, 2021

Respectfully submitted,

/s/ Joseph Petersen
Joseph Petersen

Attorneys for Appellee
APPLE INC.

Appellant Charles Bertini seeks permission to supplement the record on appeal with documents described only generally and not included with his motion. He claims that they are relevant to the alleged bias of one of the three Trademark Trial and Appeal Board ("TTAB") administrative law judges who rendered a final decision in the matter below in favor of Apple Inc. ("Apple") and thereafter joined with the other panel members in the denial of Mr. Bertini's subsequent motion for reconsideration. Mr. Bertini contends that judge should have disqualified himself pursuant to 28 U.S.C. § 455. Mr. Bertini also levels a substantively equivalent accusation of bias against the TTAB interlocutory attorney assigned to the matter between the initiation of the matter and its trial.

Mr. Bertini neither avers that the documents allegedly supporting his extraordinary claims of misconduct by the TTAB were unavailable to him prior to the motion for reconsideration nor offers any excuse for failing to submit the documents in connection with his motion for reconsideration. He nonetheless urges this Court to allow him to supplement the record on appeal to enable him to pursue allegations of bias brought for the first time before this Court.

No precedent exists for allowing Mr. Bertini to add to the record in the manner and for the purposes he seeks and, indeed, Mr. Bertini proffers none. The documents in question are not a part of the trial record, and Mr. Bertini had the

opportunity to present them to the TTAB in connection with his motion for reconsideration but failed to do so.

Furthermore, the entire premise of Mr. Bertini's motion is misplaced because the TTAB is an executive adjudicatory body within the Patent and Trademark Office ("PTO"), an executive agency within the Department of Commerce, and the TTAB's administrative law judges are not subject to the recusal requirements set out in 28 U.S.C. § 455.

Finally, the documents summarized by Mr. Bertini reflect merely routine and fleeting professional contacts. Such contacts fall far below the threshold of the personal contacts necessary to support disqualification on the basis of bias or prejudice. Mr. Bertini's motion for leave to supplement the record should therefore be denied on multiple grounds.

I. ARGUMENT

A. Mr. Bertini Improperly Seeks to Add New Material To the Record

The Court should deny the motion because an appellate court may consider only material that is part of the record on appeal. *See* Fed. R. App. P. 10(a). A limited exception to this rule appears in Rule 10(e)(2)(C) of the Federal Rules of Appellate Procedure, which provides that, "[i]f 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" by this

Court. Fed. R. App. P. 10(e)(2)(C). A motion to supplement the record under Rule 10(e)(2) is directed to evidence omitted from the record "by error or accident" and is not intended as a vehicle for introducing *new* evidence that was not before the lower court or tribunal. *Id*.; *see, e.g.*, *Abu-Joudeh v. Schneider*, 954 F.3d 842, 848 (6th Cir. 2020) ("While Federal Rule of Appellate Procedure 10(e)(2) allows for the correction of 'omissions from or misstatements in the record,' it does not allow parties 'to introduce new evidence in the court of appeals.'" (citations omitted)); *Long Beach Area Chamber of Com. v. City of Long Beach*, 603 F.3d 684, 698 (9th Cir. 2010) (rejecting attempt to supplement record on appeal based on the conclusion that "the district court was the appropriate forum in which to introduce this 'evidence,' and [the court] refrain[s] from usurping that court's function by entertaining new evidentiary submissions on appeal"); *In re Cap. Cities/ABC, Inc.'s Application for Access to Sealed Transcripts*, 913 F.2d 89 (3d Cir. 1990) ("This Court has said on numerous occasions that it cannot consider material on appeal that is outside of the district court record.").

Mr. Bertini never filed with the TTAB the documents underlying his current motion. He unquestionably had full opportunity to do so because the documents at issue were fully available to him at least as early as the time that he sought reconsideration of the TTAB's decision (and he does not aver otherwise). Specifically, Mr. Bertini was fully aware of the composition of the panel at the

time of his reconsideration motion and, as Mr. Bertini concedes in the timeline he includes on page 8 of his motion, he had long-standing knowledge of opposing counsel's identities. Nonetheless, Mr. Bertini failed to introduce the documents or any arguments regarding bias to the TTAB. Instead, he elected to focus his motion for reconsideration on other aspects of the TTAB's rulings.

Mr. Bertini now regrets the record on appeal, and he attempts to add to it by asserting that this Court may take judicial notice of the documents not simply for the fact that the documents exist *but rather for the truth of the matters they allegedly assert*. However, "courts do not take judicial notice of documents, they take judicial notice of facts." *Abu-Joudeh*, 954 F.3d at 848.

The facts referenced by Mr. Bertini in his motion relate to alleged professional contacts between Judge Hudis and the TTAB interlocutory attorney assigned to the proceeding, on the one hand, and two attorneys representing Apple, on the other. Such allegations do not qualify for judicial notice. They are neither generally known within the court's jurisdiction nor can they be accurately and readily determined from sources whose accuracy cannot reasonably be questioned. *See* Fed. R. Evid. 201(b). Thus, judicial notice does not afford Mr. Bertini an alternative route for supplementing the record. He must meet the requirements for an expansion of the record, and he plainly cannot do so. *See Abu-Joudeh*, 954 F.3d at 848 (viewing appellant's request that the court take judicial notice of certain

documents as a request to supplement the record and denying that request as appellant had no excuse for failing to make the documents part of the trial record).

Mr. Bertini also fails to satisfy the standard for supplementing the record under Rule 10(e)(2) of the Federal Rules of Appellate Procedure. The documents were *not* omitted by error or accident from the proceedings below. Mr. Bertini could have made those documents of record in connection with his unsuccessful motion for reconsideration, but he failed to do so.

B. No Extraordinary Circumstances Warrant Supplementation of the Record

Mr. Bertini attempts to gloss over his failure to make the documents of record before the TTAB by claiming that "extraordinary circumstances" exist for overriding and forgiving that omission. To begin, Mr. Bertini cites no precedent from this Court allowing supplementation for alleged extraordinary circumstances; the cases Mr. Bertini cites fall outside of this Circuit. *See* Mot. at 13-14 (relying upon extra-Circuit authority for the proposition that this Court may allow Mr. Bertini to supplement the record outside of Rule 10(e)(2) based upon a finding of extraordinary circumstances). Moreover, the authority upon which Mr. Bertini relies to support his contention of extraordinary circumstances are all readily distinguishable.

For example, Mr. Bertini cites the Ninth Circuit's decision in *Lowry v. Barnhart*, 329 F.3d 1019, 1024-25 (9th Cir. 2003), in support of his contention that

courts permit parties to supplement the trial record in extraordinary circumstances. However, *Lowry* addressed the *impropriety* of one party's attempt to add to the record without formally seeking leave to supplement the record. *Id.* at 1025. Indeed, the Ninth Circuit sanctioned the introducing party for impermissibly adding to the record matters outside of the trial record. *Id.* at 1026. Far from supporting Mr. Bertini's position, *Lowry* contradicts it by illustrating the extent to which appellate courts properly limit their evaluation of an appeal to the trial record.

Mangini v. United States, 314 F.3d 1158 (9th Cir. 2003), is equally inapposite. The court in that case granted a motion to supplement to correct material misstatements submitted to the trial judge regarding whether the trial judge's brother-in-law acted as a lawyer for the plaintiff in the case unbeknownst to the trial judge. *Id*. at 1160-61. In contrast, there is no contention here that the supplemental documents proffered by Mr. Bertini contradict in any manner material documents presented to the TTAB on the issue of conflicts. *Mangini* does not apply here.

Even if this Circuit were to recognize an extraordinary circumstances exception to Rule 10(e)(2)(C), the circumstances set out in Mr. Bertini's motion do not qualify. His contention that extraordinary circumstances exist here rests on two fundamental misapprehensions of TTAB administration and procedure.

First, Mr. Bertini claims that it is unusual for the TTAB to constitute different panels at the summary judgment and trial phases of proceedings and appears to go so far as to suggest that the PTO altered the panel's composition for insidious reasons. Second, he claims that TTAB administrative law judges and administrative staff such as the Interlocutory Attorney assigned to a matter are subject to 28 U.S.C. § 455, which governs recusal of *judicial* officials.

The root cause of Mr. Bertini's confusion appears to be his mistaken conflation of TTAB and Article III tribunals. Although the TTAB is similar to an Article III court in some respects, it is distinguishable in others, and those differences render Mr. Bertini's challenge to the routine reassignment of judges and personnel by the PTO meritless.

Unlike an Article III court, the TTAB is an executive adjudicative body within an executive agency, namely, the PTO. As the Supreme Court recently held in *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021), the constitutionality of the appointment of inferior officers of the United States such as the TTAB's administrative law judges turns on their being subject to oversight by the Director of the PTO. *Id*. at 1987-88. The Lanham Act provides for just such Director oversight. *See* 15 U.S.C. §§ 1068, 1070, 1074.

In other words, numerous rules and procedures applicable to Article III courts do not apply to the TTAB. Although *Arthrex* addressed the constitutionality

of judges appointed to the *Patent* Trial and Appeal Board, this Court has since confirmed that the same considerations apply to TTAB judges. *See Piano Factory Grp. v. Schiedmayer Celesta GmbH*, 11 F.4th 1363, 1372-75 (Fed. Cir. 2021) (rejecting constitutional challenge to the constitution of a TTAB panel based on Director of the PTO's authority to regulate not only the procedures employed by the TTAB but also the substance of the TTAB's decision-making process).[1]

Against this administrative background, it is not surprising that the composition of TTAB panels and assigned staff sometimes change during a particular proceeding (it is not an uncommon occurrence in Article III courts as well). It therefore is not unusual for one TTAB panel to rule at an intermediate stage of a proceeding and a different panel to rule at trial. In fact, panels reconstituted at the PTO's direction have in the past rejected outright decisions of earlier panels *in the very same proceedings*. *See Plus Prods. v. Med. Modalities Assocs.*, 217 U.S.P.Q. (BNA) 464, 465-66 (T.T.A.B. 1983) (rejection by reconstituted panel of dismissal of opposition by original panel); *In re Ferrero*

[1] This Court's holding in *Piano Factory* is, of course, consistent with the Supreme Court's suggestion to identical effect in *Arthrex*. *See* 141 S. Ct. at 1987.

S.p.A., 22 U.S.P.Q.2d 1800, 1800 (T.T.A.B. 1992) (reversal by reconstituted panel of original panel's denial of request for reconsideration).[2]

Such administrative changes are inherently part of the nature of the TTAB as an *executive* branch adjudicatory body. As this Court noted in *Piano Factory*, the "Director has discretion regarding the size and composition of TTAB panels, which the Director can exercise pursuant to his authority to establish rules and regulations governing procedures before the TTAB." *Piano Factory*, 11 F.4th at 1372. Even a cursory review of proceedings before the TTAB reveals that the composition of panels frequently changes at various stages of the proceedings.[3] Indeed, and to reiterate, the Director's right and ability to make changes to panels is both authorized by statute and central to the constitutionality of the TTAB, for the same reasons articulated at length in the Supreme Court's *Arthrex* decision.

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[2] Without elaboration, Mr. Bertini contends that the panel constituted for the final decision "ignor[ed]" the "legal position of Original Board that benefitted Bertini." Motion at 9. That Panel had every right to disagree with the earlier panel. However, the two panels' decisions are not, in fact, inconsistent. Specifically, the earlier panel's decision on Mr. Bertini's summary judgment motion found an issue of fact as to whether Apple satisfied the requirement for tacking. The later panel found in Apple's favor on that same issue based on a voluminous trial record. Accordingly, the two decisions are wholly consistent.

[3] *See, e.g.*, Board Proceeding Nos. 91241549; 91247770; 91245750; 92065804; 91241842; 92067143; 91241107; 91205331; 92056381; 91232597; 92065178; 92063808; 92058609; and 92065388.

Similarly, 28 U.S.C. § 455, which governs disqualification of "[a]ny justice, judge, or magistrate judge of the United States," does not apply to administrative law judges such as the panel that rendered its final decisions in this proceeding. This is because the TTAB's administrative law judges sit in the executive branch and fall outside the definition of "judge of the United States" as that term is defined in 28 U.S.C. § 451. *See Bunnell v. Barnhart*, 336 F.3d 1112, 1114-15 (9th Cir. 2003) (holding administrative law judges do not fall within 28 U.S.C. § 455); *Greenberg v. Bd. of Governors of Fed. Rsrv. Sys.*, 968 F.2d 164, 166-67 (2d Cir. 1992) (same); *see also Prospector Cap. Partners, Inc. v. Dttm Operations LLC*, 123 U.S.P.Q.2d 1832, 1834 (T.T.A.B. 2017) (properly holding judicial disqualification provision in 28 U.S.C. § 455 inapplicable to TTAB proceedings).

Instead, TTAB judges are subject to the ethical guidelines of the Department of Commerce set forth in 5 C.F.R. Part 2635. These guidelines require recusal in circumstances where a TTAB judge would otherwise serve on a matter where one of the parties is (or is represented by): (i) someone with whom the TTAB judge has or seeks a financial or business relationship; (ii) a close relative; (iii) a household member; (iv) an employer (or prospective employer); or (v) a client of a parent, spouse, or dependent child or an organization in which they of them serves as an officer or director; (vi) a former employer or client for a period of one year after the TTAB judge left employment or two years for a political appointee or if the

TTAB judge received an extraordinary severance payment; or (vii) an organization in which the TTAB judge is an active participant.

There is no contention that any of those ethical guidelines is implicated here, because neither Apple nor its counsel fall into any of those enumerated categories. In fact, even under the standard applicable to a federal trial court (as opposed to the TTAB), there would be nothing improper with Judge Hudis serving on the panel in this matter. To disqualify a judge under 28 U.S.C. § 455(b)(1), the Appellant must prove bias "by compelling evidence" and "[t]he bias or prejudice 'must be grounded in some personal animus or malice that the judge harbors . . . of a kind that a fair-minded person could not entirely set aside when judging certain persons or causes.'" *Grove Fresh Distribs., Inc. v. John Labatt, Ltd.*, 299 F.3d 635, 640 (7th Cir. 2002) (alteration in original) (citation omitted).

Even if the Court were to accept Mr. Bertini's characterizations of the proposed new documents, all of the documents summarized in his motion reflect at most routine and fleeting professional contacts between Judge Hudis and two lawyers representing Apple in this matter. Such contacts fall far short of demonstrating bias or prejudice by compelling evidence even under case law interpreting 28 U.S.C. § 455 (which, as noted, in fact does not apply to the TTAB). *See Parrish v. Bd. of Comm'rs of Ala. State Bar*, 524 F.2d 98, 104 (5th Cir. 1975) (affirming denial of motion to disqualify based on a finding that the court's

"acquaintanceship or friendship with witnesses and defense counsel . . . . [did] not exceed what might be expected as background or associational activities with respect to the usual district judge").

In fact, in another Circuit far greater contacts between a judge and lawyer have been rejected as a basis for invalidating a court's decision under 28 U.S.C. § 455. *See e.g.*, *Parker v. Connors Steel Co.*, 855 F.2d 1510, 1524-28 (11th Cir. 1988) (finding failure to disqualify harmless error where the judge's law clerk's father—who himself had been the judge's law clerk—was a partner in the law firm representing one of the parties).

Accordingly, in addition to violating appellate procedure, allowing Mr. Bertini to supplement the record in the manner he requests would serve no point because even if the contacts he identifies were correct they would fall far short of establishing compelling evidence of bias. Accordingly, Mr. Bertini's motion should be denied.

II. CONCLUSION

For all of the foregoing reasons, Apple Inc. respectfully urges the Court to deny Bertini's motion for permission to supplement the record.

Dated: October 25, 2021

Respectfully submitted,

/s/ Joseph Petersen

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

an affidavit or unsworn declaration under penalty of perjury under 28 U.S.C. § 1746, if the facts relied on in the motion are subject to dispute.

Dated: October 25, 2021

Respectfully submitted,

/s/ Joseph Petersen
Joseph Petersen

CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Fed. R. App. P. 27(d)(2)(A) and 32(g). This brief contains 2,844 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b).

2. The brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Civil Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft Office Word Version 2010 in 14-point Time New Roman.

Dated: October 25, 2021

Respectfully submitted,

/s/ Joseph Petersen
Joseph Petersen

CERTIFICATE OF SERVICE

I hereby certify that on October 25, 2021, a true and correct copy of the foregoing **APPLE INC.'S OPPOSITION TO APPELLANT'S MOTION FOR PERMISSION TO SUPPLEMENT THE RECORD** was filed with the Clerk of the United States Court of Appeals for the Federal Circuit and served on all counsel of record by the Court's CM/ECF system.

/s/ Joseph Petersen
Joseph Petersen