No. 23-

United States Court of Appeals for the Federal Circuit

IN RE CHARLES BERTINI,

Petitioner

On Petition for Writ of Mandamus to the United States Patent and Trademark Office in Cancellation Case No. 92068213 for APPLE Registration No. 4088195

PETITION FOR WRIT OF MANDAMUS

James Bertini
423 Kalamath Street
Denver, CO 809204
303 572-3122

Counsel for Charles Bertini

CERTIFICATE OF INTEREST

Counsel for Petitioner, James Bertini, certifies the following:

1. The full name of every party or amicus represented in the case by me is: Charles Bertini.

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is: None.

3. All parent corporations and any publicly held companies that own ten percent (10%) or more of the stock of the party or amicus curiae represented by me are: None.

4. The names of all law firms and the partners or associates that appeared for the party or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. None/Not applicable

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:

Charles Bertini v. Apple Inc.
2021-2301
Federal Circuit Court of Appeals
This appeal was decided by the Federal Circuit on April 4, 2023 and it reversed the April 16, 2021 decision of the TTAB dismissing Bertini's Opposition to the registration of APPLE MUSIC, Serial No. 86659444. Then, on August 1, 2023 Apple filed a Motion with the TTAB seeking to amend its application in order to circumvent the Federal Circuit's decision. A decision on that Motion is pending.

On September 13, 2020 Apple filed an application to register APPLE MUSIC 1, also in Class 41 for entertainment services, Serial No. 90177287. This application has been published for opposition. Bertini was granted an extension of time to file an opposition which expires soon.

On December 18, 2020 Apple filed a *second* application to register APPLE MUSIC, also in Class 41 for entertainment services, Serial No. 90394966. This application was suspended by the examining attorney due to a likelihood of confusion with Bertini's prior application to register APPLE JAZZ.

6. 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):
N/A.

Dated: October 31, 2023

/s/ James Bertini
James Bertini
Attorney for Petitioner
CHARLES BERTINI

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RELIEF SOUGHT

Charles Bertini seeks an order from this Court directing the U.S. Patent and Trademark Office ("USPTO") to decide his Cancellation case 92068213 ("the Cancellation") of APPLE Reg. No. 4088195 in Class 41 ("the Mark" or "APPLE '195") owned by Apple, Inc.

This case commenced on March 19, 2018 when Bertini filed a Petition to Cancel ("the Petition"). It concluded after he submitted his Reply Trial Brief on February 11, 2021. The Trademark Trial and Appeal Board ("TTAB") has not decided the case in nearly three years despite its written policy and frequent public statements by top USPTO officials that it decides cases after trial in approximately ten weeks. Bertini filed a Petition to the Director of the USPTO on May 4, 2023 asking her to decide the case. Her office has not decided this Petition to the Director despite the fact that most Petitions to the Director are decided in approximately two months. Bertini is prevented from registering his trademark APPLE JAZZ because the USPTO refused his application claiming there is a likelihood of confusion with the Mark.

INTRODUCTION AND BACKGROUND

After Bertini filed an application to register his common law trademark APPLE JAZZ on June 5, 2016, the examining attorney refused registration stating that there is a likelihood of confusion with the Mark, and also with Apple Inc.'s ("Apple") application Serial No. 86659444 for APPLE MUSIC. Bertini's APPLE JAZZ, APPLE '195, and APPLE MUSIC are all in Class 41 for entertainment services. Bertini then filed an Opposition to the registration of APPLE MUSIC ("the Opposition"). Apple pleaded the Mark as an Affirmative Defense along with two other APPLE marks in Class 9 (previously owned by foreign company Apple Corps Limited) in that Opposition case and alleged tacking to it in order to establish priority of use.

The Board dismissed the Opposition on April 16, 2021 by permitting tacking of an APPLE mark (of Apple Corps Limited) to APPLE MUSIC for services. Appx001-003 However, in that decision the Board found that "Opposer has established that his APPLE JAZZ mark as a whole is inherently distinctive", (Appx002) and "Opposer's earliest date of use of his APPLE JAZZ mark is June 13, 1985." Appx003

Bertini appealed the dismissal, and the Federal Circuit reversed it on April 4, 2023, stating "An opposer can block a trademark application in full

by proving priority of use and likelihood of confusion for *any* of the services listed in the trademark application." "Accordingly, Apple is not entitled to tack its use of APPLE MUSIC for live musical performances onto Apple Corps' 1968 use of APPLE for gramophone records. Because Apple began using the mark APPLE MUSIC in 2015, Bertini has priority of use for APPLE JAZZ as to live musical performances." *Bertini v. Apple Inc.*, 63 F.4th 1373, 1379, 1381 *; 2023 U.S. App. LEXIS 7935 **; 2023 U.S.P.Q.2D (BNA) 407 (Fed. Cir. 2021).

During that Opposition which successfully concluded in Bertini's favor, Bertini filed a Petition to Cancel the Mark - which is the subject of this mandamus request - on March 19, 2018 so as to eliminate the remaining obstacle to the registration of his APPLE JAZZ. Bertini alleged abandonment/non use, and fraud.[1] Appx004. The Petition was later amended. Appx006

One month after filing the Petition, on April 14, 2018, Bertini filed a

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[1] On April 11, 2019 Interlocutory Attorney ("IA") Michael Webster dismissed Bertini's fraud claims with prejudice stating his belief that Bertini cannot prove them: "The Board notes that a party alleging fraud bears a heavy burden of proof with no room for speculation." Despite the fact that fraud was pleaded properly and proof is to be presented later during the trial period, and after the discovery period – Mr. Webster prevented Bertini from developing this claim and obtaining relevant evidence from discovery.

motion in the Opposition case requesting that the case be suspended pending a decision on the Cancellation case. Bertini explained: "[I]f the Petition to Cancel is granted it strips away the main affirmative defense in the Opposition, i.e. Registration No. 4,088,195 for APPLE", and "suspending the instant Opposition case until the Petition to Cancel is decided will simplify the Opposition and save the Board time and resources because the Cancellation proceeding may have a bearing on this Opposition proceeding." Appx008-011 On June 7, 2018 Mr. Webster denied Bertini's motion, stating that "suspension of this proceeding pending the related cancellation would not be appropriate." Then, he acknowledged that the Board may consolidate the cases, but the Board never did so. Appx012-015 Bertini continued to litigate both cases.

After the Cancellation trial ended with the filing of Bertini's Reply Brief on February 11, 2021, the docket shows that the file was marked "Submitted for Final Decision" on February 23, 2021. Appx017 Thereafter, no action was taken for one year. Then, on February 9, 2022, the TTAB issued an unsigned Order suspending the case indefinitely ("Suspension Order"). Appx019-020 Bertini then filed a Motion for Reconsideration on February 17, 2022. Appx021 Apple opposed the Motion. Bertini filed his

Reply on March 12, 2022. Appx035 To date, neither the trial nor the motion has been decided.

The Suspension Order refers to 37 C.F.R. § 2.117(a): "Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a civil action, another Board proceeding, or an expungement or reexamination proceeding may have a bearing on a pending case, proceedings before the Board may be suspended..." Appx019 In fact, the Opposition case came to the attention of TTAB when Bertini filed his March 19, 2018 Petition and he was required to respond to a box stating "Related Proceedings" and he responded "Opposition No. 91229891". Also, Bertini quickly filed a Motion to suspend the Opposition on April 14, 2018 as explained just above, which was also handled by the same Interlocutory Attorney, Michael Webster. Thus, during a period of four years the TTAB didn't think that the Opposition case may have a bearing on the Cancellation case.

ADDITIONAL FACTS NECESSARY TO UNDERSTAND THE ISSUE PRESENTED BY THE PETITION

1. The TTAB Decided the APPLE MUSIC Case (Wrongly) in Apple's Favor in Five Months, but Will Not Decide This Cancellation Case in Nearly Three Years

An oral hearing requested by Apple in the Opposition case was held on November 5, 2020, and the TTAB issued its final decision five months later, on April 16, 2021.

The Final Decision wrongly dismissed Bertini's Opposition and was reversed by the Federal Circuit. Bertini has established his *unchallenged* priority right in APPLE JAZZ since June 1985, and the application to register APPLE MUSIC is blocked. Thus, the Mark is the only remaining obstacle to Bertini's registration of APPLE JAZZ.

The Board decided a complicated tacking case in Apple's favor in five months - and did so wrongly - yet it will not decide this simple case in nearly three years. It is simple because the only issue is whether Apple did or did not use the Mark in commerce in Class 41.

The Board refused to suspend the Opposition, failed to consolidate the two cases, didn't suspend the Cancellation, and allowed Bertini to litigate the case to the end, only then suspending the Cancellation claiming that a decision in the Opposition case might affect the Cancellation, as if it was suddenly surprised *when it knew about the Opposition for four years.* During those four years the Board didn't view the Opposition case as related to the Cancellation case, but suddenly decided to change its mind. The Board is aware that Bertini is a sole proprietor and his attorney James Bertini ("Counsel") is a sole practitioner, yet the Board required Bertini to litigate two separate cases when there were alternatives that would have preserved judicial resources and avoided exhausting Bertini and Counsel.

2. Bertini More than Exhausted His Administrative Remedies in an Effort to Convince the TTAB to Decide This Case.

Not only has Bertini exhausted his administrative remedies by filing a Motion for Reconsideration and a Petition to the Director of the USPTO, but he also took several extraordinary measures to convince the USPTO to perform its duty and decide the case.

A. Bertini's Request for Constituent Services from Congresswoman Val Demings

On January 23, 2022, Bertini, on advice of Counsel, exercised his First Amendment right to seek redress from government, and he wrote to his then-Congresswoman Val Demings to request that she contact the USPTO to ask it to decide the Cancellation. The Congresswoman then wrote to the USPTO, and shortly thereafter on February 9, 2022 the Suspension Order was filed. On February 24, 2022 Acting Director of Governmental Affairs Kimberley Alton wrote a letter to the Congresswoman explaining that "Opposer has not established the necessary element of priority", so "the Board has suspended the cancellation proceeding until the appeal of the opposition case is completed." Appx042 (On April 4, 2023 this Court established the priority of APPLE JAZZ over APPLE MUSIC and the appeal is completed, but the USPTO still doesn't want to decide the Cancellation even though it is unrelated as shown below.)

B. Counsel's Request for a Listening Session with USPTO Director Kathi Vidal

After reading an April 4, 2022 USPTO Director's Message by newly-installed Director Kathi Vidal announcing listening sessions to "engage with and listen to as many stakeholders as I can" "while minimizing inappropriate opportunistic behavior," Counsel filed an application for a listening session. On May 4, 2022 her office responded "Thank you for your request. We are processing these submissions as quickly as we can. A USPTO official will be in touch with you. Have a great day." Appx044 To date no one has responded to Counsel about a listening session.

C. Bertini's Request for Constituent Services from Senator Marco Rubio

On January 9, 2023 Bertini, on advice of Counsel, exercised his First Amendment right to seek redress from government, and he wrote to his U.S. Senator Marco Rubio and requested that he contact the USPTO to ask it to decide the Cancellation. The Senator then wrote to the USPTO, and on March 10, 2023 Director of Governmental Affairs Ellen McLaren wrote a letter to the Senator stating "The pending appeal at the Federal Circuit is the sole reason the Board suspended the parties' cancellation proceeding" (Appx045) and Bertini's case is of those with "anomalous prosecution histories".[2] Appx046 But the Cancellation case was completed before the

appeal was filed, yet the Board didn't decide it. Now, the appeal is completed and the Board still won't decide the Cancellation.

D. Counsel's Direct Letter to Chief Judge Gerard Rogers

On April 4, 2023 Counsel wrote a letter addressed to Chief Administrative Law Judge Gerard Rogers and filed it in the litigation file asking the Judge to assign ALJs to decide the case. Appx048 The Judge has not responded to this letter directly, or indirectly by performing his most fundamental duty: assign judges to decide this case and motion.

E. Bertini's Petition to the Director of the USPTO

On May 4, 2023, Bertini filed a Petition to the Director of the USPTO requesting that her office decide the Cancellation since the TTAB will not do so. The online filing form was inappropriately designed and doesn't account for the fact that someone other than a registrant's attorney may choose to file a petition. It appears in the USPTO files without paragraph breaks and is difficult to read; attached is the copy submitted for filing. Appx051-055

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[2] "Anomalous" is not defined in Title 37 of the Code of Federal Regulations or in the Trademark Trial and Appeal Board Manual of Procedure.

The Petitions office is managed by Deputy Commissioner for Trademark Examination Policy Amy Cotton. At the beginning of every month, Ms. Cotton's office publishes statistics on the previous months' Petitions that were decided. Counsel analyzed these decisions and calculated that the average and median pendency is approximately two months. "Pendency" is used by the agency to refer to the length of time to take a certain action.

On August 15, 2023, Counsel wrote to the TEAS Office seeking information about a decision on Bertini's Petition to the Director, and two days later the Petitions Office itself responded "Based on current pendency, your petition should be reviewed in approximately two months." The email also stated "Please know that we are taking action to move cases swiftly and prioritize time-sensitive filings." Appx056 However, most if not all other Petitions to the Director filed *after* Bertini's May 4, 2023 filing have already been decided and a two month period from the date of the letter has expired.

JURISDICTIONAL STATEMENT

This Court has jurisdiction under the All Writs Act, 28 U.S.C. § 1651.

ISSUES PRESENTED

1. Did the TTAB fail to decide the Cancellation for a valid reason?
2. Was the Cancellation case suspended for a valid reason?

3. Did the TTAB fail to decide Bertini's Motion for Reconsideration of the Suspension Order for a valid reason?

4. Did the TTAB act in an arbitrary and capricious manner by failing to decide the Cancellation which was marked "Ready for Decision" on February 23, 2021?

5. Does the TTAB's and USPTO's failure to decide the case constitute a violation of the Administrative Procedure Act at 5 U.S.C. § 706(1), and §§ 706(2)(A)-(E).

REASONS FOR ISSUING THE WRIT

The TTAB has an obligation to decide *inter parte* cases brought before it, but it will not decide Bertini's case. Deciding contested cancellation cases such as this one is a discrete agency action that the TTAB is required to make. By refusing to decide the case, the TTAB prevents Bertini from requesting that the examining attorney continue processing his application to register APPLE JAZZ.

Bertini has exhausted his administrative remedies by filing the Petition to the Director.

I. LEGAL STANDARD

Appellate courts "may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of

law." 28 U.S.C. § 1651(a). The court must determine (1) there are no other adequate means to attain relief, (2) the right to the writ is clear and indisputable, and (3) the writ is appropriate under the circumstances. See *Cheney v. United States Dist. Court*, 542 U.S. 367, 380– 81 (2004). Courts may also review the actions of an agency that are unlawful actions during the conduct of proceedings. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018) at 1359 (judicial review available to set aside agency "shenanigans"). Mandamus is appropriate "where there is clear abuse of discretion or 'usurpation of judicial power'…" *Bankers Life & Cas. Co. v. Holland*, 346 U.S. 379, 383 (1953). "[M]andamus is an important means to correct abuses of discretion by an administrative agency when other relief would be inadequate to protect the rights of those injured by the agency's action." *Queenan v. Heckler*, 581 F. Supp. 1216, 1218 (S.D.N.Y. 1984) (citing *Schlagenhauf v. Holder*, 379 U.S. 104 (1964)). Mandamus may set aside agency action that is "contrary to constitutional right, power, privilege, or immunity," "in excess of statutory jurisdiction, authority, or limitations," or does not observe "procedure required by law." 5 U.S.C. §§ 706(2)(A–D). II.

The Administrative Procedure Act at 5 U.S.C. § 706 states: "To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory

provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall— (1) compel agency action unlawfully withheld or unreasonably delayed."

This section of the law has been interpreted by several U.S. Supreme Court decisions. "The final term in the definition, 'failure to act,' is in our view properly understood as a failure to take an agency action--that is, a failure to take one of the agency actions (including their equivalents) earlier defined in § 551(13)." *Norton v. S. Utah Wilderness Alliance,* 542 U.S. 55, 62; 124 S. Ct. 2373 (2004). This definition reads: "'agency action' includes the whole or a part of an agency rule, order, license, sanction, relief, or the equivalent or denial thereof, or failure to act." 5 U.S.C. 551(13).

In another case an appellate court stated that "Because the statutory obligation of a Court of Appeals to review on the merits may be defeated by an agency that fails to resolve disputes, a Circuit Court may resolve claims of unreasonable delay in order to protect its future jurisdiction." *Telecommunications Research & Action Center v. FCC,* 750 F.2d 70, 76 *; 1984 U.S. App. LEXIS 17422 **, (D.C. Cir. 1984).

The Supreme Court also stated that "We have recognized previously that the weight of an administrative interpretation will depend, among other things, upon 'its consistency with earlier and later pronouncements' of an

agency", *Morton v Ruiz*, 415 U.S. 199, 267, 94 S. Ct. 1055 (1974), referring to *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944): "Good administration of the Act and good judicial administration alike require that the standards of public enforcement and those for determining private rights shall be at variance only where justified by very good reasons."

II. BERTINI HAS NO OTHER ADEQUATE MEANS TO ATTAIN RELIEF

The refusal of the TTAB to decide the Cancellation case, and the refusal of the USPTO to respond to Bertini's Petition to the Director has injured, and continues to injure, Bertini. Mandamus is Bertini's only means to correct the unlawful agency inaction. Bertini does not ask this Court to order the USPTO to decide the case in any particular manner, but just to decide it, either by granting the Petition or dismissing it.

The ongoing and specific injuries to Bertini, a sole proprietor, are that he is unable to register his trademark, and he has been embroiled in continuous litigation against a large company represented by 14 lawyers for three large law firms for more than seven years due to the shenanigans of the USPTO and the TTAB.

Bertini has no other means to obtain the relief he seeks. He has exhausted his administrative remedies and has even sought help from the second branch of government, the legislative branch. Now he seeks help

from the third branch of government, the judicial branch. Mandamus is appropriate and necessary.

III. BERTINI'S RIGHT TO MANDAMUS RELIEF IS CLEAR AND INDISPUTABLE IN LIGHT OF THE USPTO'S REFUSAL TO DECIDE HIS CASE NEARLY THREE YEARS AFTER COMPLETION OF TRIAL

The USPTO was created by Congress to administer federal trademark law, the Lanham Act. This includes registration of trademarks, and cancellation of marks abandoned or not used. After allowing Bertini to file a Petition to Cancel the Mark and litigate it through trial, the TTAB and the USPTO will not take action, suspending a decision indefinitely.

A. The USPTO Has Authority to Register and Cancel Trademarks

The Lanham Act at 15 USC §1051 authorizes registration of trademarks. The Act at 15 USC §1064 allows a petition to cancel registration of a mark to be filed if such registered mark "has been abandoned, or its registration was obtained fraudulently."

B. The USPTO Has a Duty to Decide Disputes

According to 35 USC §1, the USPTO has responsibility for "management and administration of its operations". According to 35 USC §2(a)(1), the USPTO "shall be responsible for the granting and issuing of patents and the registration of trademarks." According to 35 USC

§3(a)(2)(A) "The Director shall be responsible for providing policy direction and management supervision for the Office and for the issuance of patents and the registration of trademarks. *The Director shall perform these duties in a fair, impartial, and equitable manner*." (Emphasis added.)

The USPTO is charged with not only regulating intellectual property issues, but also with ensuring the integrity and fairness of the system itself – including those practitioners who represent the intellectual property interests of others before the USPTO.

A TTAB FAQ currently published online entitled "About TTAB In a nutshell" states: "The Trademark Trial and Appeal Board (TTAB) is a neutral body that functions like a court for trademark matters at the United States Patent and Trademark Office (USPTO). The Board's administrative trademark judges are authorized to determine a party's right to register a trademark with the federal government." "The Board only determines whether an applicant or registrant has the right to register a mark or to retain a registration under challenge." Appx057

Federal Rules of Civil Procedure §1 states that the rules "should be construed, administered, and employed by the court and the parties to secure the just, speedy, and inexpensive determination of every action and proceeding." Chief Judge Gerard Rogers wrote in the Director's Forum

Blog published on the USPTO's website on January 5, 2018: "The TTAB…seeks to spur job creation *by the timely adjudication of trademark disputes*." (Emphasis added.) Appx059

Refusing to decide a Cancellation trial for nearly three years after it has been concluded is not fair or equitable. It is not just, speedy or inexpensive. And it is not timely adjudication.

C. The TTAB Has Established Policies for Deciding Cases and Motions in 10-12 Weeks, and Trials in Three Years or Less

The TTAB has a policy of deciding *inter parte* cases and also motions in ten weeks or less. This policy is articulated on the USPTO's website, and in frequent statements made by USPTO and TTAB officials in public. The TTAB FAQ located on the USPTO's website reads:

> **"When will my contested motion be decided?**
> Our goal is to decide contested motions in less than three months. Your case will be decided in turn. If you have not received something from us after four months, you may call to check the status of your motion."
>
> **"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." Appx062

Following are the words of Judge Rogers captured in minutes of recent TPAC meetings. Appx064-073

November 4, 2022
Motion decision pendency was up a bit in 22', but still under the goal of 12 weeks for processing contested motions.
Trial decision pendency still under goal…the goal is to get the trial decisions out by panels of judges in 15 weeks or less.

April 8, 2022
So, in fiscal 21'…we met all our goals. All of these figures you see are well below the goals. Twelve weeks is the goal for motion pendency processing…and trial decision pendency, the goal is under 15 weeks on average. So, we met the figures.
And you can see the average pendency and median pendency for trial cases, oppositions and cancellations ran about 3 years or a little less.

January 28, 2022
And our trial decision pendency for trial cases, ready for decision by a panel of judges, on average, just under 10 weeks.
In the first quarter of this fiscal year, we've reduced all the pendency measures, even more than we had in Fiscal '21. And one of the reasons that we're doing this, that we really worked hard to bring down these pendency measures. But when contested motions come up in those trial cases, we have control over that. We want to make sure we get them done quickly and allow the case to continue on its path. And once cases, whether they're appeals or trial cases, have gone through the entire process and become ready for decision, we want to get those decisions out as quickly as we can. So, in Fiscal '21, we got contested motion decisions out, on average, in just under 10 weeks' time.
Trial pendency is…approximately three years. Again, these are averages. Many cases go much faster than that.

July 24, 2020
You know, please, if you think of a contested motion that should have been decided more quickly… **If something falls through the crack, please, you know, let us know.** Contact the paralegal who's assigned to the case or feel free to contact Ken Solomon, who's the managing interlocutory attorney, so that we can move work around and make sure that it gets done. **If something takes too long, we want to know about it.** (Emphasis added.)

--- end of transcript excerpts ---

The Cancellation trial pendency from beginning to now is almost six years (and the APPLE MUSIC trial pendency from beginning to end was almost five years).

As recommended by the TTAB FAQ, Counsel called the interlocutory attorney on July 27, 2022, four months after he filed his Reply to his Motion for Reconsideration, in order to ascertain the status of the overdue decision. The interlocutory attorney assigned to the case, Jennifer Elgin, did not return his voice mail. Instead, the previous interlocutory attorney, Michael Webster called Counsel and said that he supervises Ms. Elgin and is calling on her behalf.

Mr. Webster told Counsel that he spoke to Chief Judge Rogers who told him that the motion will be decided in due course. He also said that Judge Rogers has not assigned any judges to decide the Cancellation case. Declaration of James Bertini. However, there had been three ALJs assigned to the case as they decided (and denied) Bertini's Motion for Summary Judgment on May 21, 2020. Appx074

Judge Rogers is the sole individual who assigns judges to cases, according to an interview he gave to World Intellectual Property Review on May 23, 2018 . Appx075-079 The USPTO, which issues regulations down

to the last comma, has never created any regulations explaining how judges are to be assigned to cases.

Clearly, it appears that the USPTO is engaging in misconduct and is treating Apple with extreme favoritism. Its actions and inaction are a clear abuse of discretion. As a consequence it is blatantly disregarding Bertini's Due Process rights under the First and Fourteenth Amendments to the United States Constitution.

D. The TTAB Cited a Specious Reason for Suspending the Case Which it Did Not and Cannot Support

The TTAB issued its Suspension Order on February 9, 2022. This was one year after the trial was completed and the docket marked "Submitted for Final Decision" on February 23, 2021. No reason was given for the failure to decide the case for one year. However, a reason was given for the suspension and it is specious.

The main issue in the Opposition case was the ability of Apple to tack its use of APPLE MUSIC onto Apple Corps' 1968 use of the APPLE mark for gramophone records. The only issue in the Cancellation case is use or non-use/abandonment of the Mark for services in Class 41. There is no conceivable way that the Opposition "may have a bearing on the issues before the Board in this case". The Board didn't see any "bearing" during

four years and allowed the parties go through the entire litigation process despite being informed about the Opposition case from day one.

Ignoring all that, and assuming *arguendo* that the reason for the suspension was legitimate, that reason has ended: the Opposition appeal was decided by this Court on April 4, 2023, Apple's Petition for Rehearing was denied by this Court on July 6, 2023, and Apple failed to seek certiorari review at the U.S. Supreme Court before the deadline for doing so expired. According to 37 C.F.R. §2.136, "After the Board has issued its decision in an opposition…proceeding, and after the time for filing any appeal of the decision has expired, or any appeal that was filed has been decided and the Board's decision affirmed, the proceeding will be terminated by the Board. If the judgment is adverse to the applicant or registrant, the application stands refused or the registration will be cancelled in whole or in part without further action and all proceedings thereon are considered terminated."

The Suspension Order justified the suspension by stating "A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has

expired." Thus, even by the TTAB's own (wrong) analysis, the case that "may have a bearing on the issues before the Board in this case" is over.

The Suspension Order reads: "Accordingly, and inasmuch as a ruling on the appeal [of APPLE MUSIC] may have a bearing on the issues before the Board in this case, proceedings herein are suspended pending the final disposition of the appeal." *The Board did not articulate any explanation of such issues.* "The expiration of any further review includes the time for petitioning for rehearing or U.S. Supreme Court review." Here are the reasons that the ruling on the Opposition will have no bearing on the Cancellation.

First, in its April 16, 2021 Final Decision in the APPLE MUSIC Opposition, the Board wrote: "Applicant was unable to establish its use of the mark for any of these services prior to Opposer's 1985 priority date." (The Federal Circuit later left this finding undisturbed.) By this finding the TTAB disconnected the Mark from APPLE MUSIC. Yet nearly a year later, on February 9, 2022, the TTAB suspended the Cancellation case stating just the opposite: that the APPLE MUSIC decision will affect the Cancellation case. Notably, this wrongful Suspension Order was not signed. Bertini filed a Motion for Reconsideration on February 17, 2022 explaining the mistaken

position taken in the Suspension Order, but the Motion has never been decided.

Second, interlocutory attorney Michael Webster, who acted in both of the cases until replaced by Jennifer Elgin, denied Bertini's Motion to suspend the APPLE MUSIC case pending a decision on the Cancellation case as described above. This meant that Mr. Webster did not believe that the two cases were connected, or that the Cancellation case could be affected by any decision on the APPLE MUSIC Opposition case. Thus, for the second time, the TTAB took the position that the two cases are not connected.

Third, in that same Order, Mr. Webster considered consolidation but did not consolidate. "However, the Board may sua sponte consolidate the related proceedings once an answer has been filed in the cancellation proceeding and a decision on the motions to compel has been issued." Of course, no consolidation was ever ordered, which is contrary to standard Board policy, and in spite of Mr. Webster also stating that: "The cancellation proceeding involves the same parties and the same or similar marks as this opposition proceeding." The Board managed both cases to be litigated separately demonstrating its position that the two cases are independent.

Fourth, even Apple agrees that the two cases are not connected. Apple first pleaded the Mark as a defense in its Answer in the Opposition case, but then in its Trial Brief it changed course and didn't refer to this mark for pleaded tacking.

Fifth, even Apple's lead counsel Joseph Petersen took the position that the Opposition case will not affect the Cancellation case, explaining this position in a motion filed in the appeal at the Federal Circuit on April 26, 2023 seeking a rehearing of its loss. Appx081 Mr. Petersen was required to respond to this question in his Motion:

"(5) 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."

Mr. Petersen responded: "In light of the grounds on which the Federal Circuit panel decided this appeal, we do not believe there are any."

Therefore, there is no outcome from the APPLE MUSIC case that could affect the Cancellation case, and this has been agreed by Bertini, Apple, and the TTAB. Furthermore, the "the time for petitioning for rehearing or U.S. Supreme Court review" has expired and Apple did not seek such review.

E. The TTAB Declared That it Will Not Decide the Case Until and Unless the Parties Settle It

The Board took an additional and astonishing position for suspending the case. The final sentence of the Suspension Order reads: "If proceedings involving these parties are not settled following final determination of the appeal, a decision on the merits in this case will issue in due course."

The TTAB has absolutely no authority to withhold a decision until and unless a case is settled, and the Suspension Order did not cite any authority supporting this position. Moreover, there is no law, regulation, court decision or practice to guide the TTAB as to how long it should wait for such a possible settlement to occur. Already Bertini learned that the TTAB does not use the phrase "in due course" as anyone else would understand it, since Judge Rogers reportedly told Mr. Webster in July 2022 that he would assign judges to decide the Motion for Reconsideration "in due course". The only way this final sentence can be interpreted is that it is an excuse to never decide the case.

The Administrative Procedures Act states that an appellate court can "compel agency action unlawfully withheld or unreasonably delayed." 5 U.S.C. § 706(1). Several U.S. Supreme Court decisions cited above support this statute.

Additionally, Counsel is mystified as to how TTAB Officials could even imagine some possible future settlement since the parties have never

asked the Board to delay proceedings based on pending settlement discussions.

Referring to the USPTO acting outside its statutory limits, the U.S. Supreme Court stated in *Cuozzo Speed Techs., LLC v. Lee* 136 S. Ct. 2131 (2016): "Such 'shenanigans' may be properly reviewable in the context of § 319 and under the Administrative Procedure Act, which enables reviewing courts to 'set aside agency action' that is 'contrary to constitutional right,' 'in excess of statutory jurisdiction,' or 'arbitrary [and] capricious.'" The USPTO and the TTAB have violated 5 U.S.C. § 706(1), and §§ 706(2)(A)-(E).

The Suspension Order is contrary to Bertini's Due Process right, in excess of statutory jurisdiction, and arbitrary and capricious, and a clear abuse of discretion.

F. Top TTAB Officials Conspired to Write the Suspension Order in Order to Deceive a Member of Congress

On July 27, 2022 Counsel made a Freedom of Information Act ("FOIA") seeking documents regarding the Suspension Order. The responsive emails show that top TTAB officials conspired to write and file the Suspension Order for the sole purpose of responding to an inquiry from Congresswoman Val Demings. Appx082-093 These individuals are Gerard

Rogers, Chief Judge of the TTAB; Mark Thurmon, Deputy Chief Judge of the TTAB; Cheryl Butler, Sr. Counsel TTAB; and Denise DelGizzi, Chief Clerk of TTAB. Later events regarding the failure to decide Bertini's Petition to the Director involve the Petitions Office headed by Deputy Commissioner Amy Cotton.

The emails show that the Suspension Order was crafted immediately after an employee in the Office of Governmental Affairs wrote to the TTAB on January 27, 2022 seeking direction in handling the Congresswoman's inquiry.

Had the TTAB officials been able to dismiss the Cancellation case, they surely would have done so in the spring of 2021. Instead, they refused to perform their duties and decided to let the case rot. For an entire year they demonstrated that they had no intention of deciding the case, and they never provided any justification for not doing so during this year. Therefore, the only reason they suddenly made the Suspension Order was in order to deceive a member of Congress.

The improper actions of these officials have caused and are continuing to cause unnecessary burdens to Bertini, and also to all three branches of the federal government: the USPTO itself, members of Congress, and now this Court. This is not to mention the erosion in the public's confidence in

government that invariably results from news about what appears to be a government conspiracy to subvert its own legal processes in an effort to aid "the most valuable brand" in the world, as Apple has referred to itself in this case. Nor is it idle speculation to imagine that this request or any subsequent order could become public: the Federal Circuit's decision in *Bertini v. Apple* was widely reported in the media in the United States and abroad.

Counsel notes that Bertini has never mentioned the cases on his website at http://www.applejazz.com, he has never blogged about them or announced them at an APPLE JAZZ musical event, and neither he nor Counsel have spoken publicly about them until questioned by the media after the APPLE MUSIC case was decided.

The dedication of these top officials to protecting a registration that Bertini alleged its owner has never used other than to bully small businesses [3] - and to prevent registration of Bertini's own trademark – is such that they simply do not care how their actions are perceived or what kind of credit they bring to their employer, an agency of the United States government.

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[3] Bertini's Reply Supporting Motion for Reconsideration of the Suspension Order referenced a New York Times article published March 11, 2022 entitled "Apps and Oranges: Behind Apple's 'Bullying' on Trademarks". Appx040, see also Appx030

G. The USPTO, TTAB and Individual Officials Have Violated Bertini's Due Process Rights by Failing to Decide the Case or Motion for Reconsideration

It is axiomatic that "[a] fair trial in a fair tribunal is a basic requirement of due process." *Caperton v. A.T. Massey Coal Co*., 556 U.S. 868, 876 (2009) (quoting *In re Murchison*, 349 U.S. 133, 136 (1955)). "A fundamental requirement of due process is 'the opportunity to be heard.'" *Grannis v. Ordean*, 234 U. S. 385, 234 U. S. 394. It is an opportunity which must be granted at a meaningful time and in a meaningful manner." *Armstrong v. Manzo*, 380 U.S. 545, 552 (1965). The failure of the TTAB and the USPTO to decide the Cancellation and to suspend it indefinitely, and to decide the Motion for Reconsideration, is tantamount to a refusal of a fair trial and the opportunity to be heard.

University of Texas law professor John Golden published an *Iowa Law Review* article about panel stacking whose title is descriptive: "PTO Panel Stacking: Unblessed by the Federal Circuit and Likely Unlawful." The professor makes the case that panel stacking is likely unconstitutional.

In this case, such is the strength of Bertini's position that the top TTAB officials are apparently unable to find administrative law judges willing to be stacked. Consequently, Bertini is worse off with no panel then a stacked panel because even with a stacked panel which wrongly decides

his case he could rectify the decision on appeal, as he did with the Opposition.

Actually, these officials don't need to stack a panel in order to decide Bertini's case: they have the authority to decide it themselves. Indeed, they issued an Order suspending the case. However, none of them are willing to put their names on an Order dismissing the case – they wouldn't even sign the Suspension Order that they crafted.

For all these reasons, the right to the writ is clear and indisputable.

IV. MANDAMUS IS APPROPRIATE HERE WHERE THE TTAB WILL NOT DECIDE THE CASE AND THE USPTO WILL NOT DECIDE THE PETITION TO THE DIRECTOR

Mandamus "is a 'drastic and extraordinary' remedy reserved for really extraordinary causes." *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380 (2004) (internal quotation marks and citation omitted). Bertini has established entitlement to such relief on each of the three necessary points.

As explained thoroughly above, Bertini has no other adequate means to effectuate a decision on its case. His right to the writ is "clear and indisputable" since the TTAB must decide cases brought before it, and delay is a cause for a court to issue a mandamus. The writ is appropriate under the circumstances because there is simply no other way for Bertini to get his case decided, and the Board has suspended it for an improper reason and

indicated it has the right to keep it suspended essentially forever. Its failure to decide is inconsistent with its regular pronouncements regarding pendency. The extraordinary remedy of an order of mandamus from this Court is clearly appropriate.

V. THE COURT MAY AWARD ATTORNEY FEES TO BERTINI FROM THE USPTO

According to *Court of Appeals for the Federal Circuit: Practice and Procedure*, there are five bases for arguing for an award of attorney fees in appeals from the PTO.

First, 35 U.S.C. § 285 reads: "The court in exceptional cases may award reasonable attorney fees to the prevailing party." If the Court grants this Petition, it means it has found Bertini's cause to be extraordinary. The word "extraordinary" is a synonym of the word "exceptional".

Second, according to *CAFC: Practice and Procedure*: "The second basis for arguing for an award of attorney fees in appeals from the PTO is FRAP 38. While no case is known where the court has awarded attorney fees in an appeal from the PTO on that basis, no reason is known why the court would not have authority to do so."

Third, regarding the Equal Access to Justice Act, 272 Pub. L. 94-481, 94 Stat. 2325 (1980), the *CAFC* guide states:

It is believed that awards of attorney fees and expenses against the PTO will be available from the Federal Circuit under the Equal Access to Justice Act in only a few unusual situations. This belief is based on the fact that, to trigger the Equal Access to Justice Act in a court review of an administrative decision, the decision complained of must be of a 'matter [not] subject to a subsequent trial of the law and facts de novo in a court.' 5 U.S.C. § 554(a)(1).

Fourth, again quoting from *CAFC: Practice and Procedure*:

In addition to these three bases for seeking attorney fees, two additional bases likely include 28 U.S.C. § 1927 ("Any attorney or other person admitted to conduct cases in any court of the United States or any Territory thereof who so multiplies the proceedings in any case as to increase costs unreasonably and vexatiously may be required by the court to satisfy personally such excess costs."), as well as the general, non-statutory rule enunciated in *Alyeska Pipeline Serv. Co. v. Wilderness Soc'y*, 421 U.S. 240, 257, 95 S. Ct. 1612, 44 L. Ed. 2d 141 (1975) (attorney fees may be awarded against a party which "has acted in bad faith, vexatiously, wantonly, or for oppressive reasons"). Both of these options were discussed with approval by the CCPA in *Meitzner v. Mindick*, 549 F.2d 775, 193 U.S.P.Q. 17 (C.C.P.A. 1977), cert. denied, 434 U.S. 854, 195 U.S.P.Q. 465 (1977), the court noting in connection with 28 U.S.C. § 1927 that attorney fees could be included in determining "excess costs."

Fifth, again quoting *CAFC*:

The Meitzner court also held that 35 U.S.C. § 285 and 28 U.S.C. § 1912 ('Where a judgment is affirmed by the Supreme Court or a court of appeals, the court in its discretion may adjudge to the prevailing party just damages for his delay, and single or double costs') do not apply to cases before the CCPA. That holding, however, is not viable insofar as the Federal Circuit is concerned, since that court has held that both 35 U.S.C. § 285 and FRAP 38 are applicable to proceedings before it and the language of 28 U.S.C. § 1912 is similar to that of FRAP 38.

For all the reasons explained above, this case is exceptional and attorney fees should be awarded to Bertini.

CONCLUSION

The TTAB and the USPTO have violated their own procedures and policies to favor Apple and indefinitely delay Bertini from having his day in court. While the agency has developed firmly-established policies to decide cases after trial in ten weeks, it will not decide Bertini's case nearly three years after trial. They suspended the Cancellation, and they failed to decide it and Bertini's Motion for Reconsideration of the Suspension Order for no valid reasons. They acted in an arbitrary and capricious manner, and their failure to decide the case is a violation of the Administrative Procedure Act.

For four years the Board took the position that the Opposition and Cancellation cases are not connected, refusing Bertini's request to suspend the former pending a decision on the latter. Then, when they were pressured by a congressional inquiry, they suddenly decided that the cases are connected and this one had to be suspended.

For all the reasons set forth above, Bertini respectfully requests that the Court issue a writ of mandamus directing the USPTO to issue a final decision in the Petition to Cancel APPLE Reg. No. 4088195 filed by Charles

Bertini within two weeks, maintain jurisdiction over the case until such decision is made, and award attorney fees to him from the USPTO.

October 31, 2023

/s/ James Bertini_____

JAMES BERTINI
Attorney for Petitioner Charles Bertini
423 Kalamath Street
Denver, CO 80204
303 572-3122
jamesbertini@yahoo.com

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of **PETITION FOR WRIT OF MANDAMUS** has been served on the following by email on October 31, 2023 by James Bertini.

Joseph Petersen
Kilpatrick Townsend
JPetersen@kilpatricktownsend.com

Theodore Davis
Kilpatrick Townsend
TDavis@kilpatricktownsend.com

Sarah Stadler
Kilpatrick Townsend
SStadler@kilpatricktownsend.com

Bill Bryner
Kilpatrick Townsend
bbryner@kilpatricktownsend.com

Alberto Garcia
Agarcia@kilpatricktownsend.com

tmadmin@kilpatricktownsend.com

Additionally, I served the following by U.S. Express Mail:
Office of the General Counsel
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

I also served the USPTO by email at:
Farheena.rasheed@uspto.gov
Macia.fletcher@uspto.gov
Shane.walter@uspto.gov
Darryl.gibson@uspto.gov

/s/ James Bertini
JAMES BERTINI

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

1. This petition complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B); Fed. Cir. R. 32(b); Fed. R. App. P. 32(f); because:

   this petition contains 7,428 words, excluding the parts of the petition exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b).

2. This petition complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because:

   This petition has been prepared in proportionally space typeface using Microsoft Word in 14-point Times New Roman.

Dated: October 31, 2023

/s/ James Bertini
James Bertini
Attorney for Petitioner
CHARLES BERTINI

No. 23-

United States Court of Appeals
for the Federal Circuit

IN RE CHARLES BERTINI,

Petitioner

DECLARATION OF JAMES BERTINI,
Attorney for Charles Bertini

James Bertini
423 Kalamath Street
Denver, CO 809204
303 572-3122

Counsel for Charles Bertini

I, James Bertini, hereby declare as follows:

1. I am the attorney for Petitioner Charles Bertini in this proceeding. I make this Declaration based on my personal knowledge in support of Charles Bertini's Petition for Writ of Mandamus. I am over the age of twenty-one and competent to make this Declaration.

2. On July 27, 2022 I called the interlocutory attorney assigned to the APPLE '195 Cancellation case in order to ascertain the status of the overdue decision on the case. The interlocutory attorney assigned to the case, Jennifer Elgin, did not return my voice mail. Instead, the previous interlocutory attorney, Michael Webster called me and said that he supervises Ms. Elgin and is calling on her behalf.

3. Mr. Webster told me that he spoke to Chief Judge Rogers who told him that the motion will be decided in due course. He also said that Judge Rogers has not assigned any judges to decide the case.

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

October 31, 2023

/James Bertini/
James Bertini

No. 23-

United States Court of Appeals for the Federal Circuit

IN RE CHARLES BERTINI,

Petitioner

NON-CONFIDENTIAL APPENDIX TABLE OF CONTENTS

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Hearing: November 5, 2020 Mailed: April 16, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Charles Bertini
v.
Apple, Inc.

Opposition No. 91229891

James Bertini, for Charles Bertini.

Joseph Petersen of Kilpatrick Townsend & Stockton LLP, for Apple, Inc.

Before Shaw, Kuczma and Hudis,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Apple, Inc. ("Applicant") has applied to register the standard character mark APPLE MUSIC for:

> Arranging, organizing, conducting, and presenting concerts, live musical performances, entertainment special events in the nature of musical and cultural events, arts and cultural events, theatrical entertainment in the nature of live theatrical performances, competitions in the field of entertainment, contests, fairs for entertainment purposes, musical or film festivals for cultural or entertainment purposes, and exhibitions for entertainment purposes; production and distribution of radio programs, television programs, and sound recordings; entertainment services, namely, providing ongoing television, radio, audio programs, video programs, podcast, and webcast programs in the field of entertainment; providing audio and video

Applicant also relies on section 1210.02(a) of the TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") (OCT. 2018), which states that "[a] geographic nickname (e.g., 'Big Apple' or 'Motown'), or an abbreviation or other variant of the name of a geographic location, is treated the same as the actual name of the geographic location, if it is likely to be perceived as such by the purchasing public." This argument is unpersuasive because, as noted above, Opposer's mark does not contain the full nickname of the New York apple producing region, i.e., "apple country." Thus, neither APPLE alone nor APPLE JAZZ can be considered to be a geographic nickname, abbreviation, or variant of the name of a geographic location to the purchasing public. We find, therefore, that Applicant has failed to establish that the primary significance of APPLE in Opposer's mark APPLE JAZZ is a geographic location. *See In re Dixie Ins. Co.*, 223 USPQ 514 (TTAB 1984) (no evidence to support the conclusion that the primary significance of DIXIE is geographical).

In the absence of evidence that APPLE JAZZ is primarily merely geographically descriptive, we find Opposer has established that his APPLE JAZZ mark as a whole is inherently distinctive and not lacking in secondary meaning. Opposer may claim priority of use of the mark APPLE JAZZ for use in connection with "[a]rranging, organizing, conducting, and presenting concerts [and] live musical performances" at least as early as June 13, 1985.

C. Applicant's mark and priority

1. Applicant's use of APPLE marks

Since at least 1977, Applicant has used its APPLE word mark in connection with personal computers and mobile communication and media devices, as well as with a

registrations to be "the same or similar" for purposes of tacking as the production and distribution of sound recordings identified in Applicant's application. *Baroid,* 24 USPQ2d at 1052. That is, sound recordings are inseparable from the production and distribution of sound recordings. As Jones testified:

> Apple Corps has been involved in the production and distribution of some of the *most famous sound recordings ever created* . . . . Apple Corps and/or affiliates and licensees produced and distributed sound recordings under its Apple Corps record label and APPLE word mark for The Beatles and other famous recording artists, and such sound recordings were (and many continue to be) distributed in the United States and worldwide.[110]

Accordingly, we find Applicant may claim priority as to the mark APPLE for production and distribution of sound recordings as early as August 1968.

VI. Conclusion

Opposer has established that he owns an inherently distinctive mark, APPLE JAZZ, which he uses in connection with "arranging, organizing, conducting, and presenting concerts and live musical performances." Opposer's earliest date of use of his APPLE JAZZ mark is June 13, 1985. Applicant, by tacking the use of the mark APPLE by Apple Corps, has established use of the mark APPLE MUSIC for the "production and distribution of sound recordings" as early as August 1968.

In view of Applicant's earlier priority date, Opposer has not established the necessary element of priority required to prevail.

VII. Decision

The opposition is dismissed.

[110] Jones Decl. ¶ 4, 71 TTABVUE 3-4.

Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA884099**

Filing date: **03/19/2018**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Charles Bertini		
Entity	Individual	Citizenship	UNITED STATES
Address	10825 Wheaton Ct Orlando, FL 32821 UNITED STATES		

Attorney information	James Bertini 423 Kalamath st Denver, CO 80204 UNITED STATES Email: jamesbertini@yahoo.com Phone: 3035723122

Registration Subject to Cancellation

Registration No.	4088195	Registration date	01/17/2012
International Registration No.	NONE	International Registration Date	NONE
Registrant	Apple Inc. One Apple Park Way Cupertino, CA 95014 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 1981/03/01 First Use In Commerce: 1981/03/01
All goods and services in the class are subject to cancellation, namely: Education and training services, namely, arranging and conducting personal training, classes, workshops, conferences and seminars in the field of computers, computer software, online services, information technology, website design, and consumer electronics; arranging professional workshop and training courses; computer education training services; trainingin the use and operation of computers, computer software and consumer electronics; online journals, namely, blogs featuring general interest topics covering a wide variety of topics and subject matter; providing on-line publications in thenature of magazines, newsletter and journals in the field of computers, computer software and consumer electronics; providing information, podcasts and webcasts in the field of entertainment via the Internet concerning movies, music, videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events; digital video, audio and multimedia publishing services; providing entertainment information regarding movies, music, videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events; providing information, reviews and personalized recommendations of movies, music, videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events in the field of entertainment; entertainment services, namely, production of live musical performances; entertainment services, namely, providing live musicalperformances online via a global computer network; rental of digital entertainment content in the nature of movies, music,

videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events, by means of communications networks, namely, provision of non-downloadable audio and audiovisual programs via an online video-on-demand service; providing a database of digital entertainment content in the nature of movies, music, videos, television, sports, news, history, science, politics, comedy,children's entertainment, animation, culture, and current events via electroniccommunication networks; entertainment services, namely, providing prerecorded audio and audiovisual content, information and commentary in the fields of music,concerts, videos, movies, television, books, news, sports, games and cultural events all via a global computer network

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Related Proceedings	Opposition No. 91229891

Attachments	Petition to Cancel.pdf(32168 bytes)

Signature	/james bertini/
Name	James Bertini
Date	03/19/2018

Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA931378**

Filing date: **10/28/2018**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92068213
Party	Plaintiff Charles Bertini
Correspondence Address	JAMES BERTINI 423 KALAMATH STREET DENVER, CO 80204 UNITED STATES jamesbertini@yahoo.com 303-572-3122
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	James Bertini
Filer's email	jamesbertini@yahoo.com
Signature	/james bertini/
Date	10/28/2018
Attachments	Second Amended Petition for Cancellation.pdf(43230 bytes) Exhibit 1.pdf(4881928 bytes) Exhibit 2.pdf(4422346 bytes) Exhibit 3.pdf(1509523 bytes) Exhibits 4 to 22.pdf(3612579 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CHARLES BERTINI	)	
	)	
Petitioner,	)	Cancellation No. 92068213
v.	)	Registration No. 4088195
	)	Date of Issue: January 17, 2012
APPLE INC.	)	Mark: APPLE
	)	
Registrant.	)	
	)	

SECOND AMENDED PETITION FOR CANCELLATION

Charles Bertini, a Florida sole proprietor, believes that he is and will be damaged by Registration No. 4088195 for the mark APPLE, and hereby petitions to cancel this Registration in this Second Amended Petition to Cancel. As grounds therefore, it is alleged that:

1. Petitioner has been, and is, engaged in

Arranging, organizing, conducting, and presenting concerts, live musical performances, entertainment special events in the nature of musical and cultural events, arts and cultural events, theatrical entertainment in the nature of live theatrical performances, competitions in the field of entertainment, contests for entertainment purposes, musical and film festivals for cultural or entertainment purposes, and exhibitions for entertainment purposes; production and distribution of television programs and sound recordings; provision of live entertainment, namely, live musical performances, and temporary use of online non-downloadable recorded entertainment featuring musical performances; providing websites featuring entertainment information, music

Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA890024**

Filing date: **04/14/2018**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91229891
Party	Plaintiff Charles Bertini
Correspondence Address	JAMES BERTINI 423 KALAMATH STREET DENVER, CO 80204 UNITED STATES Email: jamesbertini@yahoo.com, iklych@yahoo.com
Submission	Motion to Suspend for Civil Action
Filer's Name	James Bertini
Filer's email	jamesbertini@yahoo.com
Signature	/james bertini/
Date	04/14/2018
Attachments	Motion to Suspend Opposition Proceeding.pdf(16216 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CHARLES BERTINI,	)	
	)	Opposition No. 91229891
Opposer	)	Serial No. 86659444
	)	Mark: APPLE MUSIC
v.	)	Filing Date: June 11, 2015
	)	Publication Date: May 10, 2016
APPLE INC.,	)	
	)	
Applicant.	)	
	)	

OPPOSER'S MOTION TO SUSPEND OPPOSITION PROCEEDING

Opposer Charles Bertini hereby moves under TBMP § 510.02(a) and 37 CFR § 2.117(a) and (c) for an order to suspend the instant proceeding. I emailed Applicant's counsel Joseph Petersen on Thursday, April 12, 2018 to ask him for his position on this Motion. The following day, Friday, April 13, 2018 I made a telephone call to Mr. Petersen and left him a voicemail asking him to call me to discuss it. Later that day Mr. Petersen sent me an email indicating that he was discussing this matter with his client and that he would respond shortly, but at the time this Motion is made he has not responded.

Brief Background

This Opposition proceeding was filed on September 2, 2016, and it opposes the application for registration of the mark Apple Music. One of the affirmative defenses raised by Applicant Apple Inc. in the Opposition is the existence of Registration No. 4,088,195 for APPLE in IC 041. Applicant also raised two other marks as affirmative defenses: Registration No. 2,034,964 for

APPLE in IC 009, and Registration No. 3,317,089 for APPLE in IC 009. (Opposer is seeking to register APPLE JAZZ in IC 041.)

On March 19, 2018 Opposer filed a Petition to Cancel Registration No. 4,088,195 for APPLE (Cancellation No. 92068213).

Law and Argument

According to TBMP § 510.02(a) and 37 CFR § 2.117(a), the Board may suspend a proceeding when another Board proceeding may have a bearing on the proceeding. Additionally, 37 CFR § 2.117(c) allows the Board to suspend a proceeding *sua sponte*, or for good cause upon motion of a party. In this instance, the Cancellation case has a bearing on the Opposition case, because if the Petition to Cancel is granted it strips away the main affirmative defense in the Opposition, i.e. Registration No. 4,088,195 for APPLE in IC 041. The other two APPLE marks listed as affirmative defenses are unlikely to be confusingly similar to Opposer's mark since they are (a) in different classes than that of Opposer's mark, and (b) for goods, as opposed to Opposer's mark which is for services. Additionally, these other two marks are (c) foreign marks (d) registered years after the date of Opposer's first use in commerce of his own mark.

Moreover, if in the Cancellation case the Board determines that the Applicant's APPLE mark Registration No. 4,088,195 and Opposer's marks are not confusingly similar, then all affirmative defenses will be moot. Consequently, suspending the instant Opposition case until the Petition to Cancel is decided will simplify the Opposition and save Board time and resources because the Cancellation proceeding may have a bearing on this Opposition proceeding.

Accordingly, the Opposer respectfully requests an Order suspending the Opposition case (Opposition No. 91229891) until such time as the Cancellation case (Cancellation No. 92068213) is decided.

April 14, 2018 /s/ James Bertini

JAMES BERTINI
Attorney for Opposer Charles Bertini
423 Kalamath Street
Denver, CO 80204
303 572-3122
jamesbertini@yahoo.com

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: June 7, 2018

Opposition No. 91229891

Charles Bertini

v.

Apple Inc.

Michael Webster, Interlocutory Attorney:

This proceeding now comes before the Board for consideration of Applicant's motion (filed April 5, 2018) to compel the deposition of Opposer, Opposer's motion (filed April 6, 2018) to compel written discovery, and Opposer's motion (filed April 14, 2018) to suspend the proceeding pending determination of Cancellation No. 92068213. The motions are fully-briefed. The Board also notes Opposer's motion (filed May 19, 2018) for summary judgment. However, for the reasons set forth below, the motion for summary judgment *will not be considered*.

A. Proceedings Suspended Pending Motions to Compel

In accordance with Trademark Rule 2.120(f), 37 C.F.R. § 2.120(f), when a party files a motion to compel disclosures or discovery, the Board will issue an order suspending the proceeding with respect to all matters not germane to the motion.[1]

[1] In this case, however, due to the parties' numerous additional filings through the Board's electronic filing system (ESTTA), the Board Attorney was not notified of the motions to compel and, therefore, was unable to promptly issue the suspension order.

"After the motion to compel is filed and served, no party should file any paper that is not germane to the motion except as otherwise specified in the Board's suspension order." Rule 2.120(f)(2). Accordingly, proceedings herein are **suspended** pending disposition of the motions to compel except as discussed below. The Board deems the proceeding suspended under Rule 2.120(f)(2)as of the filing date of Applicant's motion to compel. *See, e.g., Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1430 (TTAB 1998) (proceedings deemed suspended as of the filing of the compel motion).[2] Inasmuch as Opposer's motion for summary judgment is not germane to the motion to compel, the motion for summary judgment should not have been filed and **will not be considered**. Opposer may resubmit the motion for summary judgment upon resumption of the proceeding.

As noted above, the parties should not file any additional paper that is not germane to the motions to compel. *See* Trademark Rule 2.120(f)(2). The parties may not serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of the motions to compel disclosure or discovery shall not toll the time for a party to comply with any initial disclosure requirement, or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If the motions to compel were filed after the close of discovery, the parties need not make pretrial disclosures until directed to do so by the Board. *See* Trademark Rule 2.120(f)(2); TBMP § 523.01 (June 2017).

The motions to compel will be decided in due course.

[2] Although Opposer's motion to compel was filed after Applicant's motion, the Board exercises its discretion to consider both fully-briefed discovery motions despite the suspension.

B. Motion to Suspend Pending Cancellation Proceeding

Because the parties have fully-briefed Applicant's motion to suspend the proceeding pending determination of Cancellation No. 92068213, the Board has exercised its discretion to consider the motion despite the suspension under Rule 2.120(f)(2).

The cancellation proceeding involves the same parties and the same or similar marks as this opposition proceeding. Opposer argues that the cancellation proceeding will have a bearing on the opposition because Applicant identified the subject registration in the cancellation in its affirmative defenses in the opposition. Opposer argues that "if the Petition to Cancel is granted it strips away the main affirmative defense in the Opposition, i.e. Registration No. 4,088,195 for APPLE in IC 041." 23 TTABVUE 3. Opposer contends that "suspending the instant Opposition case until the Petition to Cancel is decided will simplify the Opposition and save the Board time and resources because the Cancellation proceeding may have a bearing on this Opposition proceeding." *Id.*

In response to the motion, Applicant argues that the cancellation proceeding involves only one of three registrations asserted by Applicant as an affirmative defense and that "Opposer's claims in the cancellation proceeding are exceptionally weak, bordering on frivolous." 28 TTABVUE 6. Applicant asserts that the motion to suspend should be denied because it "appears to be nothing more than an attempt to frustrate Apple's rightful efforts to depose Opposer." *Id.* at 7.

Pursuant to Trademark rule 2.117(a); 37 C.F.R. § 2.117(a), the Board may, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved. In this case, the Board finds that suspension of this proceeding pending the related cancellation would not be appropriate. *Cf. The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (suspended pending outcome of ex parte prosecution of opposer's application). However, the Board may *sua sponte* consolidate the related proceedings once an answer has been filed in the cancellation proceeding and a decision on the motions to compel has been issued.

In view of the foregoing, Opposer's motion to suspend pending Cancellation No. 92068213 is **DENIED**. The opposition proceeding is **suspended** pending disposition of the motions to compel.

Cancellation

Number: 92068213 **Filing Date:** 03/19/2018
Status: Pending Court Appeal **Status Date:** 05/09/2023
General Contact Number: 571-272-8500
Interlocutory Attorney: YONG OH (RICHARD) KIM
Paralegal Name: LALITA R WEBB

Defendant

Name: Apple Inc.
Correspondence: JOSEPH PETERSEN
KILPATRICK TOWNSEND & STOCKTON LLP
1302 EL CAMINO REAL, SUITE 175
MENLO PARK, CA 94025
UNITED STATES
JPetersen@kilpatricktownsend.com,
TDavis@kilpatricktownsend.com,
BBRYNER@kilpatricktownsend.com,
SStadler@kilpatricktownsend.com,
agarcia@kilpatricktownsend.com,
tmadmin@kilpatricktownsend.com
Phone: 650-614-6427

Serial #: 77428980 Application File Assignment **Registration #:** 4088195
Application Status: CANCELLATION PENDING
Mark: APPLE

Plaintiff

Name: Charles Bertini
Correspondence: JAMES BERTINI
423 KALAMATH STREET
DENVER, CO 80204
UNITED STATES
jamesbertini@yahoo.com
Phone: 303-572-3122

Serial #: 87060640 Application File Assignment
Application Status: REPORT COMPLETED SUSPENSION CHECK - CASE STILL SUSPENDED
Mark: APPLE JAZZ

Prosecution History

#	Date	History Text	Due Date
83	08/03/2023	COPY OF MAY 4, 2023 PETITION TO DIRECTOR	
82	07/13/2023	P FILED COPY OF DENIAL OF PETITION FOR REHEARING	
81	05/08/2023	D CHANGE OF CORRESP ADDRESS	
80	05/08/2023	D PETITION TO DIRECTOR	
79	04/04/2023	COPY OF COURT DECISION	
78	04/04/2023	P COMMUNICATION	

Prosecution History

#	Date	History Text	Due Date
77	03/12/2022	P RESP TO BD ORDER/INQUIRY	
76	03/09/2022	D OPP/RESP TO MOTION	
75	03/09/2022	D CHANGE OF CORRESP ADDRESS	
74	02/17/2022	P REQ FOR RECON OF BD ORDER	
73	02/09/2022	SUSPENDED	
72	02/23/2021	SUBMITTED FOR FINAL DECISION	
71	02/11/2021	P REBUTTAL BRIEF: TM RULE 2.128	
70	01/27/2021	D MAIN BRIEF: TM RULE 2.128	
69	12/28/2020	P MAIN BRIEF: TM RULE 2.128	
68	12/28/2020	P MAIN BRIEF: TM RULE 2.128	
67	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 12	
66	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 11	
65	09/14/2020	CONFIDENTIAL - DECLARATION OF THOMAS R LA PERLE ANNEZURE D	
64	09/14/2020	DECLARATION OF THOMAS R. LA PERLE PARTS 1-9	
63	09/14/2020	DECLARATION OF THOMAS R. LA PERLE EXH 1-11	
62	09/14/2020	DECLARATION OF THOMAS R. LA PERLE PART 2 OF 2	
61	09/14/2020	D DECLARATION OF THOMAS R. LA PERLE	
60	09/14/2020	DECLARATION OF THOMAS R. LA PERLE ANNEXURE E 11-12 OF 12	
59	09/14/2020	DECLARATION OF THOMAS R. LA PERLE ANNEXURE E 1-10 OF 12	
58	09/14/2020	DECLARATION OF THOMAS R. LA PERLE ANNEXURED D 1-9	
57	09/14/2020	D DECLARATION OF THOMAS R. LA PERLE ANNEXURE C 1-10	
56	09/14/2020	D DECLARATION OF THOMAS R. LA PERLE ANNEXURE B 1-11	
55	09/14/2020	D DECLARATION THOMS R. LA PERLE ANNEXURE A 1-9	
54	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER EXH B	
53	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 14 EXH A	
52	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 13 EXH A	
51	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 10 EXH A	
50	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 9 EXH A	
49	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 8 EXH A	
48	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 7 EXHS	
47	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 6 EXH A	
46	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 5 EXH A	
45	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 4 EXH 4	
44	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER PART 3 EXH A	
43	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER EXH A PART 2	
42	09/14/2020	D AFFIDAVIT OF CHRISTOPHER BUTLER EXH A	
41	09/14/2020	D NOTICE OF RELIANCE	
40	07/15/2020	P NOTICE OF RELIANCE	
39	07/15/2020	P NOTICE OF RELIANCE	
38	07/15/2020	P NOTICE OF RELIANCE	
37	07/15/2020	P NOTICE OF RELIANCE	
36	07/15/2020	P TESTIMONY	
35	05/21/2020	P MOT FOR SUMMARY JGT DENIED	
34	04/13/2020	P OPP/RESP TO MOTION	
33	04/02/2020	D REQ FOR LEAVE TO FILE A LIMITED SUR-REPLY	
32	02/29/2020	P REPLY IN SUPPORT OF MOTION	
31	02/10/2020	D OPP/RESP TO MOTION	

Prosecution History

#	Date	History Text	Due Date
30	02/10/2020	D OPP/RESP TO MOTION	
29	02/10/2020	D OPP/RESP TO MOTION	
28	02/10/2020	D OPP/RESP TO MOTION	
27	02/10/2020	D OPP/RESP TO MOTION	
26	02/10/2020	OTHER MOTIONS/PAPERS	
25	02/10/2020	D OPP/RESP TO MOTION	
24	02/10/2020	D OPP/RESP TO MOTION	
23	02/10/2020	D OPP/RESP TO MOTION	
22	02/10/2020	D OPP/RESP TO MOTION	
21	02/04/2020	SUSP PEND DISP OF OUTSTNDNG MOT	
20	01/10/2020	P MOT FOR SUMMARY JUDGMENT	
19	05/01/2019	ANSWER	
18	04/11/2019	PROCEEDING RESUMED; ANSWER DUE	
17	01/07/2019	D REPLY IN SUPPORT OF MOTION	
16	12/18/2018	P OPP/RESP TO MOTION	
15	12/11/2018	SUSP PEND DISP OF OUTSTNDNG MOT	
14	11/29/2018	D MOT TO DISMISS: FRCP 12(B)	
13	11/02/2018	TRIAL DATES REMAIN AS SET	
12	10/28/2018	P MOT TO AMEND PLEADING/AMENDED PLEADING	
11	10/09/2018	D MOT GRANTED; PROCEEDING RESUMED	
10	07/16/2018	D REPLY IN SUPPORT OF MOTION	
9	06/26/2018	P OPP/RESP TO MOTION	
8	06/13/2018	SUSP PEND DISP OF OUTSTNDNG MOT	
7	06/07/2018	D MOT TO DISMISS: FRCP 12(B)	
6	05/24/2018	P MOT TO AMEND PLEADING/AMENDED PLEADING	
5	05/04/2018	D MOT TO DISMISS: FRCP 12(B)	
4	05/04/2018	D CHANGE OF CORRESP ADDRESS	
3	03/27/2018	PENDING, INSTITUTED	
2	03/27/2018	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	05/06/2018
1	03/19/2018	FILED AND FEE	

Results as of 10/02/2023 06:42 PM

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

February 9, 2022

Cancellation No. 92068213

Charles Bertini

v.

Apple Inc.

By the Trademark Trial and Appeal Board:

Proceedings are suspended pending disposition the appeal pending in the United States Court of Appeals for the Federal Circuit, filed on September 8, 2021, in another Board proceeding, namely, Opposition No. 91229891.[1]

Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a), provides the following:

> Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a civil action, another Board proceeding, or an expungement or reexamination proceeding may have a bearing on a pending case, proceedings before the Board may be suspended until termination of the civil action, the other Board proceeding, or the expungement or reexamination proceeding. A civil action or proceeding is not considered to have been terminated until an order or ruling that ends litigation has been rendered and noticed and the time for any appeal or other further review has expired with no further review sought.

Suspension of a Board proceeding pending the final determination of another Board proceeding is solely within the discretion of the Board and is generally suitable when a ruling on the other proceeding will have a bearing on the issues before the

[1] Appeal styled *Charles Bertini v. Apple Inc.,* Case No. 21-2301.

Board. *See* Trademark Board Manual of Procedure (TBMP) (2021) § 510.02(a) and authorities discussed therein; and *The Tamarkin Co. v. Seaway Food Town Inc.,* 34 USPQ2d 1587, 1592 (TTAB 1995); *Martin Beverage Co., Inc. v. Colita Beverage Corp*., 169 USPQ 568 (TTAB 1971).

Accordingly, and inasmuch as a ruling on the appeal may have a bearing on the issues before the Board in this case, proceedings herein are suspended pending the final disposition of the appeal. A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired. *See* 37 C.F.R. § 2,117(a). The expiration of any further review includes the time for petitioning for rehearing or U.S. Supreme Court review. The Board does not resume its proceedings until after the time for seeking such review has expired, a decision denying or granting such review has been rendered, and any further review has been completed. TBMP § 510.02(b)

Within twenty days after final determination of the appeal, either party should notify the Board so that this case may be called up for appropriate action.

During the suspension period, the parties shall notify the Board of any address or email address changes.

If proceedings involving these parties are not settled following final determination of the appeal, a decision on the merits in this case will issue in due course.

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Trademark Trial and Appeal Board Electronic Filing System. https://estta.uspto.gov

ESTTA Tracking number: **ESTTA1191741**

Filing date: **02/17/2022**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	92068213
Party	Plaintiff Charles Bertini
Correspondence address	JAMES BERTINI 423 KALAMATH STREET DENVER, CO 80204 UNITED STATES Primary email: jamesbertini@yahoo.com 303-572-3122
Submission	Request for Reconsideration of Non-Final Board Order
Filer's name	James Bertini
Filer's email	jamesbertini@yahoo.com
Signature	/james bertini/
Date	02/17/2022
Attachments	Motion for Reconsideration and for Augmented Panel.pdf(154352 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CHARLES BERTINI	)	
Petitioner,	)	Cancellation No. 92068213
v.	)	Registration No. 4088195
	)	Date of Issue: January 17, 2012
APPLE INC.	)	Mark: APPLE
Respondent.	)	

PETITIONER CHARLES BERTINI'S
MOTION FOR RECONSIDERATION OF ORDER SUSPENDING CASE
AND MOTION FOR AUGMENTED HEARING PANEL

In accordance with 37 CFR §2.127, Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §§510.02(a) and 540, and 15 USC §1064, Petitioner Charles Bertini ("Bertini") respectfully requests reconsideration of the Trademark Trial and Appeal Board ("TTAB") February 9, 2022 Order to Suspend, granting this Motion for an Augmented Hearing Panel, and making a final decision on the merits within ten days from the date this Motion is fully briefed. The decision on this case has been unofficially suspended for one year even though such cases are decided approximately ten weeks after trial. The Order makes the suspension official and for an indefinite period.

I. INTRODUCTION

Petitioner Charles Bertini ("Bertini") filed this Petition to Cancel APPLE mark Registration No. 4088195 ("the Mark") on March 19, 2018. The cover sheet on the filing shows that there is a related proceeding, i.e. Bertini's Opposition to the registration of APPLE MUSIC, Opposition No. 91229891, Serial No. 86659444 ("Opposition"). Bertini

filed this Petition because the trademark examining attorney refused registration to Bertini's APPLE JAZZ mark, Serial No. 87060640, citing a likelihood of confusion with the Mark. Apple also used the Mark as an affirmative defense in the Opposition case. 48 TTABVUE 22. Upon investigation, Bertini concluded that Apple Inc. ("Apple") never used the Mark in commerce for entertainment services listed in the Registration Certificate.

As demonstrated in Bertini's Trial Brief in this Cancellation case, Apple offered no evidence that it has ever used the Mark in commerce in Class 41 for entertainment services listed in the registration certificate. It has used iTunes and unitary marks comprising the word "apple" for entertainment services until 2015 when it also began using the unitary mark APPLE MUSIC. Apple didn't deny that it didn't use the Mark for entertainment services listed in the Registration Certificate, but argued that use of other, different marks, e.g. Apple TV, constituted use of the Mark in commerce. As demonstrated in Bertini's Trial Brief the word "apple" is used in all documents presented at trial in reference to Apple Inc. or as an integrated part of unitary marks such as Apple Store, Apple TV and it doesn't constitute use of "apple" as a service mark.

After trial, this case was marked "Ready for Decision" on February 23, 2021. No decision has been made to date, one year later. On February 9, 2022, the TTAB issued an order suspending "proceedings", although the only proceeding remaining was its decision. Other cases are decided approximately ten weeks after trial, according to the USPTO's website.

The TTAB's stated reason for the suspension is that the Opposition case came "to its attention" and that it may affect the outcome of this Cancellation case. *However,*

as stated above, the Opposition case came to the attention of the TTAB four years earlier. In any event, it is logically impossible for the Opposition case to affect the outcome of the Cancellation case as explained below, and the Order to Suspend is not supported by any law or facts. [1]

These actions by the TTAB demonstrate the appearance of bias in favor of Apple and they violate Bertini's constitutional rights to Due Process of law.

II. THE ORDER TO SUSPEND WAS BASED ON AN INCORRECT STATEMENT OF THE RELATIONSHIP BETWEEN THIS CASE AND THE OPPOSITION CASE

The Order to Suspend states that since "a ruling on the appeal [of the dismissal of Bertini's Opposition] may have a bearing on the issues before the Board in this case, proceedings herein are suspended pending the final disposition of the appeal."

Apple raised the Mark as an affirmative defense in the Opposition case. The essence of this defense is that Apple could tack use of the Mark to APPLE MUSIC and therefore show a date of first use for APPLE MUSIC (2015) earlier than that of APPLE JAZZ (1985).

However, in its Trial Brief in the Opposition case, Apple gave up on this defense; it did not argue this defense at all. Additionally, in its Final Decision, the Board did not rely on the Mark as a defense for Apple. Instead, Apple and the Board relied on an unpleaded defense, i.e. an unregistered foreign mark APPLE for production and distribution of sound recordings: *"Apple seeks to tack its constructive use of APPLE MUSIC for production and distribution of sound recordings to Apple Corps' use of*

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[1] The Opposition case has been appealed to the U.S. Circuit Court of Appeals for the Federal Circuit, *Charles Bertini v. Apple Inc.*, Case No. 2021-2301 ("the Appeal").

APPLE for the very same services." 90 TTABVUE 38 (Footnote 109). *"Applicant, by tacking the use of the mark APPLE by Apple Corps, has established use of the mark APPLE MUSIC for the "production and distribution of sound recordings"* 101 TTABVUE 52.

It is clear that the Mark is not involved in the Final Decision now under Appeal, and accordingly the Appeal is not related to the Mark. Production and distribution of sound recordings are not listed in the registration certificate of the Mark. The Mark was never owned by Apple Corps. For these reasons, and because Apple abandoned using the Mark as a defense, *a decision regarding the Opposition case cannot affect this Cancellation case.*[2]

III. THE ORDER TO SUSPEND WAS BASED ON INCORRECT INTERPRETATION OF CASE LAW

The Order to Suspend cites a case that is completely inapposite. *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995). In that case, the Board suspended a proceeding (a) by motion of a party, (b) in a likelihood of confusion case, (c) due to an ex parte proceeding, (d) when "the parties have resolved their dispute, in principle", (e) "subject to the right of either party to request resumption of proceedings at any time".

The other case cited in the Order, *Martin Beverage Co., Inc. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971), also does not support the suspension as it states: "Suspension under such circumstances is granted only after both parties have been suit to determine if the outcome thereof will have a bearing on the question of the rights

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[2] Apple only pleaded three registered marks as defenses, including the Mark, but didn't rely on any of them in its Trial Brief.

heard on the question and the Board has carefully reviewed the pleadings in the civil of the parties in the Patent Office proceeding." In this Cancellation case, neither Bertini nor Apple has been heard, and the TTAB could not have carefully reviewed the pleadings in the Federal Circuit because if so it could not have issued its Order to Suspend.

The court in *Shire City Herbals v. Blue*, 2015 U.S. Dist. LEXIS 122678 *, *6 (Mass. 2015) stated, quoting *Water Quality Prot. Coal. v. Municipality of Arecibo*, 858 F. Supp. 2d 203, 212 (D.P.R. 2012): "a stay's duration must be reasonable."
The Court also stated at *5 that "The decision of whether to grant a stay 'calls for the exercise of judgment, which must weigh competing interests and maintain an even balance.'" The TTAB did not weigh any interests in suspending this case, and forcing the parties to wait a period of one year, and now forcing them to wait some indefinite period longer, is not an even balance for either of the parties, or the TTAB.

IV. A POSSIBLE FUTURE "SETTLEMENT" OF THE OPPOSITION APPEAL CANNOT AFFECT THE OUTCOME OF THIS CANCELLATION CASE AND THIS IS NOT A LAWFUL BASIS FOR SUSPENSION

The Order to Suspend states: "If proceedings involving these parties are not settled following final determination of the appeal, a decision on the merits in this case will issue in due course." According to 37 C.F.R. § 2.117(a) a case may be suspended "…until termination of the civil action, the other Board proceeding…" However, in this situation nothing can change the fact that the Mark was not used in commerce, and therefore it must be cancelled according to 15 USC §1064 of the Lanham Act. A termination of the Appeal, even if followed by settlement, won't have any effect on cancellation of the Mark for nonuse/abandonment.

This rule does not authorize a suspension in anticipation of some possible future settlement in a different action. Neither does any case law provide authority to suspend a proceeding for this reason.

V. THE TTAB HAS DEMONSTRATED THE APPEARANCE OF BIAS BY ITS FAILURE TO DECIDE THIS CASE AND BY ISSUING THIS ORDER

A. Despite knowing that Bertini is a sole proprietor and his counsel is a sole practitioner, the TTAB allowed this case to be litigated for three years without even a hint of a suspension

This Cancellation case was filed on March 19, 2018. The TTAB suspended the case three times for different reasons prior to trial. None of these reasons was related to the reason given in the Order to Suspend.

The Order to Suspend quotes 37 C.F.R. § 2.117(a) as the basis for the suspension now, i.e. "Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a civil action, another Board proceeding... proceedings before the Board may be suspended"

The TTAB knew about the existence of the Opposition case at the time the Cancellation case was filed. The first entry in the Cancellation docket states in a cover sheet: "Related Proceedings Opposition No. 91229891". 1 TTABVUE 2. *Thus, the existence of the Opposition case had "come to the attention" of the TTAB when the Petition to Cancel was filed on March 19, 2018, and the TTAB did not see fit to suspend the Cancellation case at that time or for four years thereafter.*

The case was marked "Submitted for Final Decision" on February 23, 2021. Bertini's Opposition was dismissed on April 16, 2021. Bertini appealed this dismissal by timely filing of a Notice of Appeal on September 8, 2021 with the U.S. Circuit Court of Appeals for the Federal District. This notice was mailed to Drew Hirshfeld, Esq., Acting

Director of the United States Patent and Trademark Office c/o Office of the General Counsel, PO Box 1450 Alexandria, Virginia 22313-1450. Bertini also filed a notice of appeal that day in the TTAB Opposition docket. Thus, the TTAB knew about this appeal **for five months** before it decided to issue its Order to Suspend.

B. In the Opposition case, the TTAB denied Bertini's motion to suspend the Opposition proceedings due to the Cancellation case, and this denial shows issues in the cases have no bearing on the other

Section 510.02(a) of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") cites judicial economy as one reason for suspending proceedings in a case. However, since the TTAB suspended this Cancellation case after trial, no such argument can be made for suspension.

In the Opposition case, Bertini filed a motion requesting suspension of that case until the conclusion of this Cancellation case, explaining that a decision on the Cancellation case could affect the outcome of the Opposition case – *not* the other way around. Bertini further explained that since the Mark was used as a defense in the Opposition case, if it is cancelled it may result in the Opposition being granted. Bertini also explained that this will facilitate judicial economy because the TTAB would not have to process two cases. It would also help the parties conserve their own resources, which is especially important for Bertini and his counsel.

Apple opposed the motion by stating that it should be denied because it "appears to be nothing more than an attempt to frustrate Apple's rightful efforts to depose Opposer". 28 TTABVUE 7. Thus, Apple offered *no valid reason* that the motion for suspension should not be granted. (Since Apple later – in its Trial Brief – abandoned

the Mark as an affirmative defense, it had eliminated the only connection between the Cancellation and Opposition cases.)

The Board denied Bertini's motion, stating only that suspension "would not be appropriate." *No other explanation was offered by the Board for denying Bertini's motion.*[3] Obviously, the Board didn't find any connection between the cases.

C. In the Opposition Appeal, Bertini alleged an appearance of bias by the TTAB due to judge-switching and professional and business relationships between one of the new judges and two of the Apple Lawyers

Details set forth in the Appeal show that after Bertini's legal position was deemed correct by the Board and his Motion for Summary Judgment was partially granted, two of the judges were replaced. One of the new judges edited several books with one of the Apple lawyers. With another he served on the ABA's IP Section as officers. Bertini moved the Federal Circuit for permission to present this evidence in a supplemental filing for his allegation that the TTAB made a decision not on the merits, but on a relationship among a judge and connected lawyers. His motion was granted *per curium*.

VI. IT IS AGAINST PUBLIC INTEREST TO MAINTAIN THIS MARK IN THE PRINCIPAL REGISTER

Apple Inc. does not use the mark in commerce, but as a weapon to thwart legitimate applications to register marks comprised of the word "apple". The Order

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[3] The Board also stated: "However, the Board may s*ua sponte* consolidate the related proceedings once an answer has been filed in the cancellation proceeding and a decision on the motions to compel has been issued." Relying on the Board's presumed fairness, its presumed desire not to allow Bertini and his counsel to be crushed with unnecessary litigation, and its own policy of seeking judicial economy turned out to be an impossible dream for Bertini as no consolidation was ever ordered. The TTAB forced Bertini to litigate two cases for years when it may only have been necessary to litigate one…and now it has suspended the Cancellation case after all litigation has been completed for cancellation of a trademark owned by a company whose lawyers have business and professional ties to at least one TTAB judge.

to Suspend states: “Suspension of a Board proceeding pending the final determination of another Board proceeding is solely within the discretion of the Board and is ***generally suitable*** when a ruling on the other proceeding will have a bearing on the issues before the Board.” Emphasis added. As explained above, a ruling on the Opposition case will have no bearing on this Cancellation case.

Beyond that, suspension of this proceeding *is not suitable at all* because Apple uses the Mark to bully applicants for registration of trademarks when their applications are published for opposition. Since this case was commenced, Apple has used the Mark to contest approximately 27 word mark applications. These are applications that trademark examining attorneys have published for opposition, meaning they see no likelihood of confusion with the Mark. Examples are BIG APPLE TUTORING, APPLES AND ORANGES ARTS, APPLETON AREA SCHOOL DISTRICT, CRABAPPLE, AND FRANKI PINEAPPLE. As grounds for opposing FRANKI PINEAPPLE, Apple’s filing states that “apple” and “pineapple” “are both the names of fruits, and thus convey a similar commercial impression.” Kindergartners would disagree.

In virtually every case where Apple files legal action to prevent a company from registering a trademark, the company either abandons its application by consent or simply defaults. The only cases still in (the early stages of) litigation are for trademarks whose owners naively believe in the sincerity of Apple’s implied cooperation to find a resolution, manifested by endless extensions of time for “settlement”. They don’t yet know that this is a feint, and Apple will never cooperate with anyone who has a right to register a trademark containing the common English word apple, because Apple is determined to privatize this word. Even if the company were somehow able to pay a

lawyer to prove its case, after years of litigation against Apple it may find that in the end the TTAB is a willing partner with the tech company and will not let them win anyway.

Trademark examiners regularly approve applications that contain the word "apple" in them after determining there is no likelihood of confusion with the Mark APPLE, but these applications never get past first base. Apple pounces on them, filing an initial round of papers in the hundreds of pages in an attempt to prevent the applications from getting off the ground. Even though the applicants know that they are in the right, they soon realize that they cannot stand up to an aggressive bully with an unlimited budget, and they give up. Bertini is the only applicant who has passed first, second and third bases. Now, just as he is sliding into home plate with no ball in sight, he has discovered that the TTAB umpire has removed the plate.

VII. BERTINI REQUESTS AN AUGMENTED HEARING PANEL OF JUDGES TO DECIDE THIS MOTION AND ISSUE A FINAL DECISION ON THE MERITS

According to TBMP §540, a party may request an augmented hearing panel for "extraordinary cases." The "augmented panel may include any number of Board judges exceeding three, that is, from four to the entire body of judges and one or more of the above-noted senior executive officials of the USPTO." See *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909, 909 n.1 (TTAB 1984)

This case is extraordinary for all the reasons stated above. It is also very important for the parties, the public, and the government. Since the TTAB is the federal agency responsible for adjudicating trademark disputes, a prompt and fair adjudication of this case is critical to assure the public and the bar that the TTAB is impartial and unbiased.

Since Bertini has raised the appearance of bias issue in this case (and in the Opposition case), it is imperative that the government demonstrate its commitment to fairness by adjudicating this case not only on the merits, but promptly, particularly since its one-year delay already suggests the appearance of bias by the TTAB. Accordingly, Bertini requests that a panel of five judges decide this motion and the case on the merits, which judges do not include any of those who have presided over any cases for which James Bertini has been the attorney (there are only three; or four considering that one was consolidated, and then deconsolidated), or those in a supervisory capacity at the TTAB.

VIII. THE TTAB HAS VIOLATED AND IS CONTINUING TO VIOLATE BERTINI'S DUE PROCESS RIGHTS

The actions by the TTAB and unknown individuals who were involved in the decision to refrain from issuing a final order in this case, and who were involved in the decision to issue the Order to Suspend, have violated and are continuing to violate Bertini's Due Process rights under the 5th and 14th Amendments to the United States Constitution. The TTAB and such individuals have personally undertaken, contributed to, and conspired or otherwise been complicit in these actions that violated Bertini's constitutional rights, under color of federal law, during their tenure as officers, agents, employees, or representatives of the United States.

IX. CONCLUSION

Accordingly, pursuant to 37 C.F.R. § 2.127, §§510.02(a) and 540, and 15 USC §1064, Bertini respectfully requests reconsideration of the Board's Order to Suspend, granting of his Motion for an Augmented Hearing Panel, and making a final decision on

the merits within ten days from the date this Motion is fully briefed, considering the unreasonable delay in yet deciding this case.

February 17, 2022

/s/ James Bertini

JAMES BERTINI
Attorney for Petitioner Charles Bertini
423 Kalamath Street
Denver, CO 80204
303 572-3122
jamesbertini@yahoo.com

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of **PETITIONER BERTINI'S MOTION FOR RECONSIDERATION OF ORDER SUSPENDING CASE AND MOTION FOR AUGMENTED HEARING PANEL** has been served on the following attorneys by email on February 17, 2022 by James Bertini.

Joseph Petersen
Kilpatrick Townsend
JPetersen@kilpatricktownsend.com

Hannah Yang
Kilpatrick Townsend
hyang@kilpatricktownsend.com

Bill Bryner
Kilpatrick Townsend
bbryner@kilpatricktownsend.com

Alberto Garcia
Agarcia@kilpatricktownsend.com

tmadmin@kilpatricktownsend.com

/s/ James Bertini_____
JAMES BERTINI

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing PETITIONER BERTINI'S MOTION FOR RECONSIDERATION OF ORDER SUSPENDING CASE AND MOTION FOR AUGMENTED HEARING PANEL is being filed electronically with the TTAB via ESTTA on February 17, 2022.

/s/ James Bertini_____
JAMES BERTINI

Trademark Trial and Appeal Board Electronic Filing System. https://estta.uspto.gov

ESTTA Tracking number: **ESTTA1196267**

Filing date: **03/12/2022**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	92068213
Party	Plaintiff Charles Bertini
Correspondence address	JAMES BERTINI 423 KALAMATH STREET DENVER, CO 80204 UNITED STATES Primary email: jamesbertini@yahoo.com 303-572-3122
Submission	Reply in Support of Motion
Filer's name	James Bertini
Filer's email	jamesbertini@yahoo.com
Signature	/james bertini/
Date	03/12/2022
Attachments	Reply in Support of the Motion.pdf(112684 bytes) Exhibits.pdf(1640239 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CHARLES BERTINI Petitioner, v. APPLE INC. Respondent.	Cancellation No. 92068213 Registration No. 4088195 Date of Issue: January 17, 2012 Mark: APPLE

PETITIONER CHARLES BERTINI'S REPLY SUPPORTING HIS MOTION FOR RECONSIDERATION OF ORDER SUSPENDING CASE AND MOTION FOR AUGMENTED HEARING PANEL

In Petitioner's appeal pending in the United States Court of Appeals for the Federal Circuit, filed on September 8, 2021 regarding another Board proceeding involving the parties, namely, Opposition No. 91229891 (the "Appeal"), Petitioner was required to respond to the following inquiry listed in the Certificate of Interest: "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".

Petitioner responded: "Charles Bertini v. Apple Inc. Cancellation No. 92068213 Trademark Trial and Appeal Board, US Patent and Trademark Office." The question does not inquire as to which case may affect which. Petitioner has always maintained that the Cancellation case may affect the Opposition case, and not the other way around.

Indeed, on April 14, 2018 Petitioner filed a Motion with the Board in the Opposition case requesting suspension of that case. His motion was denied, the

Board stating: “Opposer argues that the cancellation proceeding will have a bearing on the opposition because Applicant identified the subject registration in the cancellation in its affirmative defenses in the opposition. Opposer argues that ‘if the Petition to Cancel is granted it strips away the main affirmative defense in the Opposition, i.e. Registration No. 4,088,195 for APPLE in IC 041.’” Opposition No. 91229891 (“the Opposition”), 34 TTABVUE 4. Obviously, Petitioner didn’t allege that the Opposition case may affect this Cancellation case and the Board didn’t view it this way.

The Board stated: “Pursuant to Trademark rule 2.117(a); 37 C.F.R. § 2.117(a), the Board may, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved. In this case, the Board finds that suspension of this proceeding pending the related cancellation would not be appropriate. *Cf. The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (suspended pending outcome of ex parte prosecution of opposer’s application). However, the Board may *sua sponte* consolidate the related proceedings once an answer has been filed in the cancellation proceeding and a decision on the motions to compel has been issued.” The Opposition, 34 TTABVUE 4. The cases were not consolidated. It is clear that after the Answer was filed the Board didn’t view these two cases as related.

Moreover, in its April 16, 2021 Final Order dismissing the Opposition, the Board stated at 101 TTABVUE 25, Ftnt. 58: “Although Applicant’s [Respondent’s] Registration No. 4088195 recites a variety of entertainment services, including

'entertainment services, namely, production of live musical performances,' and claims a date of first use as early as March 1, 1981, Applicant was unable to establish its use of the mark for any of these services prior to Opposer's [Petitioner's] 1985 priority date." Thus, the TTAB itself has determined in its Final Order that Registration No. 4088195 for standard character mark APPLE was not in use prior to the priority date of Petitioner's Apple Jazz. Consequently, no "ruling on the appeal may have a bearing on the issues before the Board in this case".[1] 73 TTABVUE 2.

Respondent's lead counsel Joseph Petersen states in his Response to this Motion that Petitioner asked the Federal Circuit to resolve a bias issue he raised in the Appeal, but this is misleading. Petitioner asked the Court to consider that the appearance of bias may have affected the Board's Final Decision in the Opposition case. He links Petitioner's claims about the appearance of bias in the two cases as proof that the Cancellation case affects

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[1] This decision does not affect Petitioner's standing which remains unchanged. In an official Trademark Office Action dated September 17, 2016, Petitioner's application to register APPLE JAZZ was refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), because it was deemed to be likely to cause confusion between Petitioner's mark and U.S. Trademark Registration No. 4088195 for APPLE, and also between Petitioner's mark and pending U.S. Application Serial No. 86659444 for mark APPLE MUSIC. 40 TTABVUE 88-91; 36 TTABVUE 24. After Petitioner's Response to the Office Action the examining attorney suspended Petitioner's application. 40 TTABVUE 97-99.

The Lanham Act at 15 U.S.C. § 1064(3) provides the basis for cancellation of the Mark: "A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged: At any time if the registered mark…has been abandoned." Petitioner alleged and provided proof in this Trial Brief that Registrant has abandoned the Mark or never used it.

the Opposition case, but the Board's February 9, 2022 decision in this case does not support this position.

Mr. Petersen attached the above Petitioner's Appeal Brief, and the *Issues Presented* don't even mention Registration No. 4,088,195. 76 TTABVUE 23-24. There is no point to wait for a decision in the Appeal because it is not related to this Cancellation proceeding.

Mr. Petersen raises the fame of Apple's marks, and states that "settled law requires Apple to protect its rights in its registered trademarks and to oppose registration of marks that are confusingly similar to or dilutive of Apple's famous marks." Fame and dilution are not affirmative defenses in this proceeding – or in the Opposition proceeding. 76 TTABVUE 5. The basis for this proceeding is abandonment/non use.

Although it is irrelevant, Mr. Petersen misleads the Board regarding Petitioner's willingness to engage in settlement discussions by stating: "Apple's counsel has reached out to Petitioner's counsel numerous times during this proceeding (and the Opposition proceeding) to discuss terms on which the parties might settle both of these disputes that Petitioner has initiated. See Declaration of Joseph Petersen ¶ 2, annexed as Exhibit C. Petitioner's counsel has consistently represented that his client has no interest in engaging in settlement discussions."

However, Mr. Petersen failed to comply with 28 U.S.C. § 1746 by neglecting to state at the end of his Declaration: "I declare under penalty of perjury that the foregoing is true and correct". Consequently, the statements in

his Declaration are not "made under penalty of perjury" and are not "evidenced, established, or proved". [2]

Perhaps this language was omitted because his statements are flatly contradicted by the Declaration of Petitioner's counsel James Bertini filed with this Reply (Exhibit 1) and supported by an attached email James Bertini sent to Mr. Petersen on February 1, 2018 in which he wrote: "We can certainly continue to discuss settlement possibilities…" In his response to this email on the same date, Mr. Petersen didn't demonstrate any interest in settlement possibilities. See Exhibit 2.

Mr. Petersen disputes Petitioner's claim in this Motion that Respondent uses the Mark against the public interest, stating: "In addition to using his Motion to broaden his publication of bias accusations against the Board, Petitioner argues Apple is an 'aggressive bully' that routinely contests applications by third parties to register marks including 'APPLE.' This argument is unfounded…"

A New York Times article published March 11, 2022 entitled "*Apps and Oranges: Behind Apple's 'Bullying' on Trademarks*" shows that in fact the argument is very well-founded. Exhibit 3.

Under Federal Rules of Evidence § 201(a)(2), the Board may take judicial notice of fact that are not subject to reasonable dispute, which "can be accurately and readily determined from sources whose accuracy cannot reasonably be

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[2] In numerous other Declarations Mr. Petersen filed in this case and in the Opposition case, Mr. Petersen did properly include this language. His Declaration here is the only Declaration devoid of this critical language.

questioned." Petitioner requests the Board take judicial notice of the facts contained in this recent news article, or in the alternative the publication of this news article.

Following the above it is in the public interest to cancel the unused mark, namely Registration No. 4,088,195 for APPLE.

March 12, 2022

/s/ James Bertini_____
JAMES BERTINI
Attorney for Petitioner Charles Bertini
423 Kalamath Street
Denver, CO 80204
303 572-3122
jamesbertini@yahoo.com

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

February 24, 2022

The Honorable Val Demings
U.S. House of Representatives
2295 South Hiawassee Road, Suite 301
Orlando, FL 32835

Dear Representative Demings:

Thank you for your letter to the United States Patent and Trademark Office (USPTO) on behalf of your constituent, Charles Bertini, regarding a cancellation proceeding, No. 92068213, against U.S. Trademark Registration No. 77428980 for the mark APPLE.

The cancellation proceeding is one of two Trademark Trial and Appeal Board (Board) proceedings involving Mr. Bertini and Apple, Inc. Both proceedings involve Mr. Bertini's registered mark APPLE JAZZ. The cancellation proceeding involves the APPLE mark, as noted above. In the other case, Mr. Bertini opposed a pending application by Apple, Inc. to register the mark APPLE MUSIC (Opposition No. 91229891). The Board issued a decision in that case on April 16, 2021, concluding:

> *Opposer has established that he owns an inherently distinctive mark, APPLE JAZZ, which he uses in connection with "arranging, organizing, conducting, and presenting concerts and live musical performances." Opposer's earliest date of use of his APPLE JAZZ mark is June 13, 1985. Applicant, by tacking the use of the mark APPLE by Apple Corps, has established use of the mark APPLE MUSIC for the "production and distribution of sound recordings" as early as August 1968.*
>
> *In view of Applicant's earlier priority date, Opposer has not established the necessary element of priority required to prevail.*

On May 15, 2021, Mr. Bertini filed a Request for Reconsideration of the Board's decision in the opposition case. The Request was denied by the Board on August 9, 2021. Mr. Bertini appealed this opposition case to the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) on September 8, 2021. Since the Federal Circuit's decision in Mr. Bertini's pending appeal is likely

to impact the Board's decision in the cancellation proceeding, the Board has suspended the cancellation proceeding until the appeal of the opposition case is completed.

I hope this information is helpful in responding to your constituent. Please do not hesitate to contact me should you have additional questions about this or any other matter.

Sincerely,

Kimberley Alton

Kimberley Alton
Acting Director
Office of Governmental Affairs

USPTO - Listening Session Meeting Request

From: Office of the Under Secretary (uspto@edms.uspto.gov)

To: jamesbertini@yahoo.com

Date: Wednesday, May 4, 2022 at 12:58 AM MDT

Thank you for your request. We are processing these submissions as quickly as we can. A USPTO official will be in touch with you.

Have a great day.

United States Patent and Trademark Office

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

March 10, 2023

The Honorable Marco Rubio
United States Senate
201 S. Orange Avenue, Suite 350
Orlando, FL 32801

Dear Senator Rubio:

Thank you for your letter to the United States Patent and Trademark Office (USPTO) on behalf of your constituent, Charles Bertini, regarding a cancellation proceeding, No. 92068213, against U.S. Trademark Registration No. 4088195 for the mark APPLE.

The cancellation proceeding is one of two Trademark Trial and Appeal Board (Board) proceedings involving Mr. Bertini and Apple, Inc. Both proceedings involve Mr. Bertini's registered mark APPLE JAZZ. The cancellation proceeding involves the APPLE mark, as noted above. In the other case, Mr. Bertini opposed a pending application by Apple, Inc. to register the mark APPLE MUSIC (Opposition No. 91229891). The Board issued a decision in that case on April 16, 2021, concluding:

> *Opposer has established that he owns an inherently distinctive mark, APPLE JAZZ, which he uses in connection with "arranging, organizing, conducting, and presenting concerts and live musical performances." Opposer's earliest date of use of his APPLE JAZZ mark is June 13, 1985. Applicant, by tacking the use of the mark APPLE by Apple Corps, has established use of the mark APPLE MUSIC for the "production and distribution of sound recordings" as early as August 1968.*
>
> *In view of Applicant's earlier priority date, Opposer has not established the necessary element of priority required to prevail.*

Mr. Bertini appealed this decision to the Court of Appeals for the Federal Circuit ("Federal Circuit") on September 8, 2021. Oral arguments were heard by the Court on December 5, 2022. We cannot predict when the Court will issue its decision, but a decision is possible within the next six months.

The pending appeal at the Federal Circuit is the sole reason the Board suspended the parties' cancellation proceeding. The opposition proceeding was ready for decision before the

United States Patent and Trademark Office

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

cancellation proceeding, so that case was decided first. The excerpts provided above are from the Board's final decision in the opposition proceeding.

Mr. Bertini notes that his cancellation case has taken much longer than the average pendency figures published by the Board. While we appreciate Mr. Bertini's concerns, the Board's pendency figures exclude decisions issued as precedents, considered for issuance as such, or with anomalous prosecution histories. Mr. Bertini's second case falls into the final category (anomalous prosecution histories), because of the delay created by the appeal of the first case.

We hope this information is helpful in responding to your constituent. Please do not hesitate to contact the USPTO should you have additional questions about this or any other matter.

Sincerely,

Ellen McLaren
Director
Office of Governmental Affairs

Trademark Trial and Appeal Board Electronic Filing System. https://estta.uspto.gov

ESTTA Tracking number: **ESTTA1276143**

Filing date: **04/04/2023**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	92068213
Party	Plaintiff Charles Bertini
Correspondence address	JAMES BERTINI 423 KALAMATH STREET DENVER, CO 80204 UNITED STATES Primary email: jamesbertini@yahoo.com 303-572-3122
Submission	Other Motions/Submissions
Filer's name	James Bertini
Filer's email	jamesbertini@yahoo.com
Signature	/James Bertini/
Date	04/04/2023
Attachments	Letter to Gerard Rogers.pdf(280340 bytes)

JAMES BERTINI
Attorney-at-Law
423 Kalamath Street
Denver, CO 80204
303 572-3122 jamesbertini@yahoo.com
April 4, 2023

Gerard Rogers
Chief Administrative Trademark Judge,
Trademark Trial and Appeal Board
U.S. Patent and Trademark Office

RE: *Charles Bertini v. Apple Inc,*
Cancellation No. 92068213
Registration No. 4088195

Dear Judge Rogers:

I am writing to you about a Motion I made that has been pending before the Trademark Trial and Appeal Board ("TTAB") for 13 months.

At a July 24, 2020 meeting of the Trademark Public Advisory Committee ("TPAC"), a trademark practitioner expressed concern about the length of time necessary for the TTAB to make decisions on contested motions and you responded: "If you think of a contested motion that should have been decided more quickly…" "If something falls through the crack, please, you know, let us know." "If something takes too long, we want to know about it."

You also stated at that meeting that the pendency (time to decide) of motions is eight to 12 weeks. Indeed, you have stated at numerous other TPAC meetings that the pendency of motions is shorter than 12 weeks. Here are three such statements you made at TPAC meetings, *one just before and two since my Motion has been pending.*
January 28, 2022 "[W]hen contested motions come up in those trial cases, we have control over that. We want to make sure we get them done quickly and allow the case to continue on its path."
April 8, 2022 "We met all our goals. All of these figures you see are well below the goals. Twelve weeks is the goal for motion pendency processing."
July 29, 2022 *The minutes of this public meeting are not available to the public.* https://www.uspto.gov/about-us/organizational-offices/public-advisory-committees/trademark-public-advisory-committee-2
November 4, 2022 "So, motion decision pendency was up a bit in 22', but still under the goal of 12 weeks for processing contested motions."

In the referenced case, I made a Motion for Reconsideration of the Board's February 9, 2022 order suspending my client's case on February 17,

2022, Apple filed a Response, and I filed my Reply on March 12, 2022. *Thus a decision on my Motion has been pending for 13 months.* (The underlying trial of this matter was completed, and the file marked "Submitted for final decision" on February 23, 2021. I note that you also cite statistics at TPAC meetings that pendency for final decisions is ten to 12 weeks after trial. Apparently my client's case was excluded from your statistics *for 11 months prior to the February 9, 2022 suspension order*.)

The TTAB FAQ reads: "When will my contested motion be decided? Our goal is to decide contested motions in less than three months. Your case will be decided **in turn**. If you have not received something from us after four months, you may call to check the status of your motion." (Emphasis added.) https://www.uspto.gov/trademarks/ttab/trademark-trial-and-appeal-board-ttab#type-browse-faqs_160473

I followed the government's rules, and consequently on July 27, 2022 – four months after I filed my Reply - I called interlocutory attorney Jennifer Elgin to check the status of my motion. (As a courtesy to opposing counsel Joseph Petersen of Kilpatrick Townsend, I offered him the opportunity to join the call but he declined.) Ms. Elgin did not return the call, but instead another interlocutory attorney, Michael Webster, returned the call and said that he speaks for her.

Mr. Webster said that no judges or other personnel have been assigned to the motion. He said he would look into this matter and get back to me. Several days later Mr. Webster called and told me that he spoke to you and that you told him that this Motion will be decided in due course, and that it will be denied. However, the Motion remains undecided, and by no definition can 13 months be considered "in due course", particularly when you repeatedly inform the USPTO, the public, and presumably Congress that contested motions are decided "well below" 12 weeks and the FAQ states that motions are decided "in turn".

Meanwhile, I have learned that it is you as Chief Administrative Trademark Judge who assign judges to cases, apparently based on your own private criteria that you secrete from the public. I learned this from an article about an interview you gave to World Intellectual Property Review. The article is dated May 23, 2018 and it states: "Judge Rogers reviews cases and the issues they present before assigning them to judges for disposition." Regarding pendency, you told WIPR that the TTAB is so efficient it meets or exceeds its performance targets, and you stated "we have repeatedly beaten this goal". Except, of course, for my client's case against Apple Inc. which you have quietly exempted from the agency's pendency goals and statistics while repeatedly misinforming TPAC. I note that this outstanding Motion *is not* the only motion in this case with a pendency greater than 12 weeks. Indeed, many motions I make in TTAB cases are decided *more than 12 weeks after the Reply is filed.*

To use your words this case has fallen through the crack, and I am following your advice to practitioners to let you know about it. Since you certify to the world that contested motions are decided in less than 12 weeks but will not allow my Motion to be decided in 13 months, my client wants to know if this is what the USPTO considers due process of law. What should I tell him, Judge Rogers?

I also attempted to contact the Director of the USPTO, Kathi Vidal, as she offered Listening Sessions after she took office last year. I received this response from her office on May 4, 2022: "Thank you for your request. We are processing these submissions as quickly as we can. A USPTO official will be in touch with you. Have a great day." Eleven months later, I am still waiting for that USPTO official to contact me and schedule the Listening Session.

I request that you assign appropriate judges to decide the Motion which I made on February 17, 2022 without further delay. In the event the Motion is not decided soon, I will make additional efforts to realize the Listening Session and take any other appropriate action.

Sincerely yours,
/s/ JAMES BERTINI

PS

The TPAC webpage states: "The Trademark Public Advisory Committee (TPAC) holds quarterly meetings to review policies, goals, performance, budget, and user fees." However, it appears that public meetings have been cancelled. Here is a link to the list of TPAC meetings scheduled for the year 2023. All of them are marked "executive session". https://www.uspto.gov/about-us/organizational-offices/public-advisory-committees/tpac-meetings I also contacted the Trademark Assistance Center and requested a list of public meetings for 2023, but they were unable to provide one.

I am hoping that public TPAC meetings will continue to be scheduled as required by (a) 35 USC §5, (b) the Charter of the USPTO's Patent Public Advisory Committee and Trademark Public Advisory Committee dated August 5, 2013, and (c) the Guidance on Public Advisory Committee Meetings dated August 19, 2009. Public meetings are useful to practitioners such as me. They allow me to become better informed about TTAB pendency goals made by trademark managers such as you, even if they are not met, and about pendency statistics you report, even if they are incomplete and misleading.

Incidentally, the last quarterly public meeting of TPAC was held five months ago on November 4, 2022 which I attended for the first time. Perhaps you saw my name on the list of attendees. *After I attended that meeting, no further public meetings have been scheduled.*

Petition to the Director of the USPTO
May 4, 2023

Please note the following.

1. I am not the attorney who is listed as the attorney of record for this registration. My position is explained immediately below.
2. I was instructed by the TEAS office to use this form and file it this way.
3. The deadlines for filing a Petition to the Director do not apply in this situation since my client is not contesting an interlocutory decision, but the refusal of the TTAB to make a decision and its failure to decide a motion.

My client, Charles Bertini, is the Petitioner in a Cancellation action. The trial was completed on February 23, 2021 but the TTAB refuses to decide the case after 27 months, and it has failed to decide a motion I made 15 months ago. We hereby ask the Director to decide this case - one way or the other - so we can move on. The case is Charles Bertini v. Apple Inc. and the mark is APPLE Reg. No. 4088195, Cancellation No. 92068213 registered in Class 41 for entertainment services. The Cancellation of this trademark is based on non-use and abandonment of the mark in commerce for services listed in the registration certificate.

The TTAB issued an Order suspending the case on February 9, 2022. Dkt. 73. Exhibit A. https://ttabvue.uspto.gov/ttabvue/v?pno=92068213&pty=CAN&eno=73 This was one year after the trial was completed and the case was then marked "Submitted for Final Decision." Dkt. 72. No reason was given for the failure to decide the case for one year. Then came the suspension order, and the reason given for suspending the case is not based on any facts or laws. The reason involves a different case between the parties, Bertini's Opposition to the registration of APPLE MUSIC, Serial No. 86659444, Opposition No. 91229891. This case was appealed to the Federal Circuit, 23-2301, and it was recently decided in Bertini's favor. Exhibit B. https://cafc.uscourts.gov/opinions-orders/21-2301.OPINION.4-4-2023_2105121.pdf

The suspension order reads: "Accordingly, and inasmuch as a ruling on the appeal may have a bearing on the issues before the Board in this case, proceedings herein are suspended pending the final disposition of the appeal." This statement is incorrect. The appeal has NO bearing on the issues before the Board in the Cancellation case, and the suspension order is contrary to the facts and the law. Furthermore, the TTAB did not articulate ANY EXPLANATION of such issues. In fact, the opposite is true. These are the reasons.

ONE

Apple first pleaded the APPLE '195 mark as a defense in its Answer in the Opposition case, but then in its Trial Brief it changed course and didn't refer to

this mark for pleaded tacking. Docket #90.
https://ttabvue.uspto.gov/ttabvue/v?pno=91229891&pty=OPP&eno=90

TWO
In the Board's Final Decision on the Opposition case dated April 16, 2021, it acknowledged that the Opposition case has no bearing on the Cancellation case by finding that APPLE '195 mark was not in use prior to Bertini's use of his own mark APPLE JAZZ. "Applicant was unable to establish its use of the mark for any of these services prior to Opposer's 1985 priority date." Dkt #101 P25. Exhibit C.
https://ttabvue.uspto.gov/ttabvue/v?pno=91229891&pty=OPP&eno=101

THREE
The Board in the Opposition case on June 7, 2918 denied Bertini's motion to suspend that case pending termination of the Cancellation case. Dkt. #34 P4. Exhibit D.
https://ttabvue.uspto.gov/ttabvue/v?pno=91229891&pty=OPP&eno=34
Bertini wrote on April 14, 2018: "In this instance, the Cancellation case has a bearing on the Opposition case, because if the Petition to Cancel is granted it strips away the main affirmative defense in the Opposition, i.e. Registration No. 4,088,195 for APPLE." Dkt. 23 P3. Exhibit E.
https://ttabvue.uspto.gov/ttabvue/v?pno=91229891&pty=OPP&eno=23

FOUR
The Board in the Opposition case stated that it would not consolidate the two cases. However, the law supports consolidation. Dkt. #34 P4. Exhibit D. *Fed. R. Civ. P. 42(a) Consolidation. If actions before the court involve a common question of law or fact, the court may: (1) join for hearing or trial any or all matters at issue in the actions; (2) consolidate the actions; or (3) issue any other orders to avoid unnecessary cost or delay.* If the Cancellation case would depend on the Opposition case, the Board was supposed to issue an order to postpone the Cancellation case from the beginning to avoid unnecessary costs for both parties. The Board managed both cases to be litigated separately demonstrating that the two cases are independent.

FIVE
Even Apple's lead counsel Joseph Petersen of Kilpatrick Townsend took the position that the Opposition case will not affect the Cancellation case, explaining this position in a motion filed at the Federal Circuit on April 27, 2023 seeking a rehearing of its loss on appeal. Bertini v. Apple, 21-2301, Dkt. 84 P10. Exhibit F. (I cannot link to this PACER document.)
Mr. Petersen was required to respond to this question in his Motion:
(5) 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.

Mr. Petersen responded: “In light of the grounds on which the Federal Circuit panel decided this appeal, we do not believe there are any.”

I filed a Request for Reconsideration of the suspension order at the TTAB on February 17, 2022, but the TTAB *has not decided* this motion AFTER 15 MONTHS. Dkt. #74 Exhibit G.
https://ttabvue.uspto.gov/ttabvue/v?pno=92068213&pty=CAN&eno=74
Four months after I made this motion, I called the interlocutory attorney to check the status of this case and he said that Chief Judge Gerard Rogers told him it will be decided “in due course” and it will be denied. He also said that no judges have been assigned to the case: Judge Rogers is the sole person who assigns judges. Apple presented no proof at trial that it ever used this trademark. If the TTAB could have denied this Cancellation case, it surely would have done so two years ago instead of refusing to decide it for 27 months.

In a New York Times article by Ryan Mac and Kellen Browning published last year entitled “Apps and Oranges: Behind Apple’s ‘Bullying’ on Trademarks *The company has opposed singer-songwriters, school districts and food blogs for trying to trademark names or logos featuring an apple — or a pear or pineapple*”, the authors explained that the mark is used to attack small companies who attempt to register trademarks the tech company does not want to see registered.
https://www.nytimes.com/2022/03/11/technology/apple-trademarks.html?searchResultPosition=1

Under 37 CFR 2.146, Petitions to the Director may be taken:
(2) In any case for which the Act of 1946, Title 35 of the United States Code, or parts 2, 3, 6, and 7 of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director; and
(3) To invoke the supervisory authority of the Director in appropriate circumstances.

Clearly, subsection 3 applies. This is an appropriate circumstance in which to invoke the supervisory authority of the Director since Bertini has no other recourse and the TTAB refuses to decide the case for no valid reason and fails to decide his motion.

Subsection 2 also applies. Here are the sections of federal law which apply.
35 U.S. Code § 1 - Establishment
(a)ESTABLISHMENT.—
[T]he United States Patent and Trademark Office shall be subject to the policy direction of the Secretary of Commerce, but otherwise shall retain responsibility for decisions regarding the management and administration of its operations… and other administrative and management functions in accordance with this title and applicable provisions of law.
35 U.S. Code § 2 - Powers and duties

(a) IN GENERAL.—The United States Patent and Trademark Office, subject to the policy direction of the Secretary of Commerce—
(2) may establish regulations, not inconsistent with law, which—
(A) shall govern the conduct of proceedings in the Office;
35 U.S. Code § 3 - Officers and employees
(2) COMMISSIONERS.—
(A) Appointment and duties.—
The Secretary of Commerce shall appoint a Commissioner for Patents and a Commissioner for Trademarks, without regard to chapter 33, 51, or 53 of title 5. The Commissioner for Patents and the Commissioner for Trademarks shall serve as the chief operating officers for the operations of the Office relating to patents and trademarks, respectively, and shall be responsible for the management and direction of all aspects of the activities of the Office that affect the administration of patent and trademark operations, respectively
(B) Salary and performance agreement.—
The annual performance agreements shall incorporate measurable organization and individual goals in key operational areas as delineated in an annual performance plan agreed to by the Commissioners and the Secretary
(C) Removal.—
The Commissioners may be removed from office by the Secretary for misconduct or nonsatisfactory performance under the performance agreement described in subparagraph (B), without regard to the provisions of title 5. The Secretary shall provide notification of any such removal to both Houses of Congress.
(3)OTHER OFFICERS AND EMPLOYEES.—The Director shall—
(A) appoint such officers, employees (including attorneys), and agents of the Office as the Director considers necessary to carry out the functions of the Office

At 37 CFR 2.146 it mentions filing deadlines for Petitions to the Director after action is taken by the USPTO, but these do not apply to this Petition because our complaint is about inaction, not any action. Additionally, Bertini acted promptly by filing a motion for reconsideration after the suspension order was made, and he followed up on the motion by calling the interlocutory attorney who told him the case will be decided “in due course”. By any definition “in due course” cannot mean a trial can remain undecided after 27 months and a motion after 15 months.

USPTO statistics show that trials and motions are decided in ten weeks. The TTAB FAQ located on the USPTO’s website reads:
“When will my contested motion be decided?
Our goal is to decide contested motions in less than three months. Your case will be decided in turn. If you have not received something from us after four months, you may call to check the status of your motion.”
“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.”

https://www.uspto.gov/learning-and-resources/trademark-faqs#type-browse-faqs_160475

However, my client's motion was not decided "in turn" as many other motions have been decided before his in the last 15 months, and a decision on the case has not been rendered in 27 months.

In its April 4, 2023 decision reversing the Board's dismissal of my clients Opposition, the Federal Circuit stated that "no reasonable person" would decide the way the Board decided. P12. Exhibit B. Link provided above. I imagine they would say something similar about this case.

To summarize, the TTAB has refused to decide this Cancellation case for 27 months, stating that the case must be suspended pending a final decision and termination of all appeals in the Opposition case, because a "ruling on the appeal may have a bearing on the issues" in the Cancellation case. It provided no explanation for this reasoning and this statement is flatly wrong. It is contrary to the facts and the law. Both Bertini and Apple believe that the Opposition case does not affect the Cancellation case. Additionally, the TTAB has failed to decide Bertini's Motion for Reconsideration of its erroneous suspension order, which Bertini filed 15 months ago. The TTAB FAQ explains that both final decisions and motions are decided in ten weeks.

Since this case has lingered for more than two years and the TTAB has refused to decide the case and a failure to decide the motion, we respectfully request that the Director resolve it without further delay by rendering a decision on my client's Petition to Cancel.

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

/s/ James Bertini
Dated: May 4, 2023

I HAVE ADDED MY EMAIL ADDRESS TO THE LIST OF SECONDARY ADDRESSES AS INSTRUCTED BY THE TEAS OFFICE.
James Bertini
Attorney for Charles Bertini
423 Kalamath Street
Denver, CO 80204
jamesbertini@yahoo.com
303 572-3122

Petition Status Inquiry - Re: 4088195

From: TMPetitionResolution (tmpetitionresolution@uspto.gov)

To: jamesbertini@yahoo.com

Cc: teas@uspto.gov

Date: Thursday, August 17, 2023 at 09:55 AM MDT

Dear Attorney Bertini -

We are in receipt of your inquiry regarding the status of the petition filed in U.S. Registration No. 4088195.

We sincerely apologize for the current delay. We are currently experiencing an unprecedented surge in new applications, which have increased by more than 58% over this time last year. As a direct result of this huge surge in new application filings in recent months, we have also experienced a surge in petition-related filings, which has created a backlog in the Petitions Office.

Please know that we are taking action to move cases swiftly and prioritize time-sensitive filings. I have checked the record and can confirm that we are in receipt of your petition to Director filed on May 4, 2023. Based on current pendency, your petition should be reviewed in approximately 2 months.

We trust the above information sheds some light on our current challenges and appreciate your patience.

Sincerely,

Office of the Deputy Commissioner for Trademark Examination Policy

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All informal e-mail communications relevant to this application will be placed in the official application record.

UNITED STATES PATENT AND TRADEMARK OFFICE

About TTAB

In a nutshell

The Trademark Trial and Appeal Board (TTAB) is a neutral body that functions like a court for trademark matters at the United States Patent and Trademark Office (USPTO). The Board's administrative trademark judges are authorized to determine a party's right to register a trademark with the federal government. The Board is not authorized to determine whether you have the right to use a trademark, and does not issue injunctions halting use. The Board only determines whether an applicant or registrant has the right to register a mark or to retain a registration under challenge. Additionally, the Board is not authorized to determine questions of trademark infringement or unfair competition or to award money damages or attorney's fees. For anything other than determining the right of federal registration, you must file a case in federal or state court.

While the Board is authorized to handle five different types of cases, there are three main categories of proceedings that applicants and registrants should know about: appeals, oppositions, and cancellations. If you file a case at the TTAB or if someone files a case against you at the TTAB, you will be a party to a legal proceeding and may want to **consider hiring an attorney (http://www.uspto.gov/trademarks-getting-started/using-private-legal-services)**. Any party to such a proceeding without domicile in the United States must be represented by a properly-licensed U.S. attorney.

TMIN News 13: TTAB

TTAB overview video

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- **TTAB Manual of Procedure (http://tbmp.uspto.gov/RDMS/TBMP/current)** (TBMP)
- **Pro bono legal services (http://www.uspto.gov/learning-and-resources/inventors-and-entrepreneurs/ttab-pro-bono-clearinghouse-program)**
- **ESTTA User's Guide (http://estta.uspto.gov/estta12-usermanual.pdf)**
- **Filing with TTAB (/trademarks/trademark-trial-and-appeal-board/filing-ttab)**
- **Fees and payment information (http://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule)**

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- **Submit a TTAB filing (https://estta.uspto.gov/)** (ESTTA)
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Published on: Sep 30, 2021 12:18 PM EDT
Last Modified: Sep 15, 2022 12:06 PM EDT

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United States Patent and Trademark Office sent this bulletin at 01/05/2018 10:59 AM EST

Director's Forum Blog

UNITED STATES PATENT AND TRADEMARK OFFICE uspto

Trademark Trial and Appeal Board Celebrates 60 Years

Guest blog by Chief Administrative Trademark Judge Gerard Rogers and Administrative Trademark Judge Susan Hightower

Employees of the Trademark Trial and Appeal Board (TTAB) like to say: "We have our trials, but our work is appealing." So what does that mean, exactly? The Board's 60th birthday in 2018 offers the perfect opportunity to take a closer look.

The TTAB is an administrative tribunal within the U.S. Patent and Trademark Office (USPTO) and seeks to spur job creation by the timely adjudication of trademark disputes. The Board's trial proceedings are similar in many ways to a federal district court, except that we don't hear testimony from live witnesses. Instead, our proceedings are conducted outside the Board and in writing; and we make decisions based on written administrative records, although parties can opt for an oral hearing in their cases, after the presentation of evidence is complete.

Today, most cases commenced at the TTAB – around 70% – are trial cases, but most cases decided on the merits – around 75% – are ex parte appeals by applicants whose applications to register trademarks have been refused by a Trademark Examining Attorney. The trial part of the Board's work involves deciding trademark registration disputes between two or more parties, known as inter partes proceedings. Most of these inter partes proceedings before the TTAB are oppositions, where a plaintiff attempts to prevent registration of a pending trademark. Cancellations are cases in which the plaintiff is trying to cancel an existing registration. Approximately 50 paralegals, attorneys and administrative trademark judges work on these cases. Our decisions in both ex parte appeals and inter partes proceedings can be reviewed by either a U.S. district court or the U.S. Court of Appeals for the Federal Circuit.

Things were very different 60 years ago. When the Trademark Act (15 U.S.C. §§ 1051-1141) – also commonly known as the Lanham Act – was enacted in 1946, ex parte appeals were heard directly by the Commissioner of Patents, while inter partes cases were decided by an Examiner of Trademark Interferences, with the right to appeal to the Commissioner of Patents. (Both types of cases could be delegated to an Assistant Commissioner of Patents.) Due to the volume of these cases, in a 1955 article in the Journal of the Patent Society, Assistant Patent Commissioner Daphne Leeds, who was the first woman Assistant Commissioner and an active member of the American Bar Association committee that assisted in drafting the Trademark Act, suggested creating an administrative board to handle the workload.

Leeds' idea came to fruition on August 8, 1958, when President Eisenhower signed an amendment to Trademark Act Section 17, 15 U.S.C. § 1067. The amendment created the Trademark Trial and Appeal Board "to determine and decide the respective rights of registration" and provided for the appointment of Board members to hear and issue, by a three-member panel, final decisions in inter partes cases and ex parte appeals. Four members were appointed, and the Board consisted of those original four members through 1974. The Board still decides the merits of its cases by panels of three judges, now called administrative trademark judges – ATJs for short – appointed by the Secretary of Commerce. Board paralegals and attorneys handle motions and "interlocutory" filings to keep cases moving through the appeal and trial processes, so that they are ready for submission "on brief" or after oral argument.

The Board's leader was known as the "Chairman of the Board" until 1993 and today has the title "Chief Administrative Trademark Judge." Past and present Chairmen of the Board/Chief Administrative Trademark Judges include Saul Lefkowitz (1975-81), Dan Skoler (1982-84), David Sams (1984-2009), and Gerard F. Rogers (Acting Chief Judge 2009-10; Chief Judge 2010-present). The first Deputy Chief Judge, Susan Richey (2014-2017), was appointed in 2014.

Throughout the years, the TTAB has presided over a variety of cases presenting issues of "first impression" or which garnered significant public attention. While most cases involve word marks or designs such as logos, the Board has also had to rule on the registrability of scent marks, sound marks, color marks and the shape or "configuration of" products or product packaging.

TTAB decisions rarely are discussed in cases reaching the U.S. Supreme Court, but in 2015, in the case of B&B Hardware, Inc. v. Hargis Industries, Inc., 135 S. Ct. 1293, that court held that Board decisions "can be weighty enough to ground issue preclusion" when the parties that were involved in a Board case later are involved in a case in a U.S. district court. In other words, the Board decision may, in appropriate circumstances, bind the district court and bar the parties from relitigating the issue in that subsequent court proceeding.

Most recently, the U.S. Supreme Court issued a ruling in Matal v. Tam, 137 S. Ct. 1744 (2017), in which musician Simon Shiao Tam applied to register the mark "The Slants" for his dance-rock band. Tam's application was denied as disparaging to people of Asian descent under a provision of the Trademark Act that prohibits registration of any mark that "may disparage persons, institutions, beliefs, or national symbols," a decision which the TTAB affirmed. The U.S. Court of Appeals for the Federal Circuit, in an en banc decision, vacated the TTAB's decision on constitutional grounds and the case wound up before the Supreme Court. The Supreme Court ultimately agreed with Tam that the disparagement clause of the Trademark Act violated the Free Speech Clause of the First Amendment.

Twice within the last decade, the Board also decided challenges brought by Native Americans seeking to cancel as disparaging the "Redskins" trademark owned by the Washington Redskins professional football team. Though both decisions were appealed to district courts, neither reached the Supreme Court. The more recent of these two cases was rendered moot by the Supreme Court's decision in Matal v. Tam.

Examples of some other recent high-profile cases include refusals to register marks for marijuana products (illegal under federal law); disputes over who owns registrations after musical groups

break up; and attempts to register someone's name as a trademark without their permission ("Obama Bahama Pajamas," for one).

In the years to come, the Board will continue to hear and decide trials and appeals of cutting-edge trademark issues reflecting the rapid changes in U.S. commerce and society, and the products and services that we all use. We look forward to the challenge.

For more information, please visit the TTAB page of the USPTO website.

Read more from the Director's Forum Blog

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Rule Changes

- When did the rule changes come into effect?
- Under the rule changes discovery responses must be served prior to the close of discovery, will that apply to cases pending on Jan. 14, 2017?
- Under the rule changes motions to compel and motions for summary judgment must be filed prior to the pretrial disclosure deadline, will that apply to cases pending on Jan. 14, 2017?
- Under the rule changes motions to compel initial disclosures must be filed within 30 days after the deadline for initial disclosures, will that apply to cases pending on Jan. 14, 2017?
- My trial opens on Jan. 14, 2017, may I submit testimony by affidavit or declaration?
- As the plaintiff, do I need to serve a copy of my complaint on the defendant?
- Discovery responses must be served in the discovery period, what about supplemental responses?

Trademark Help - Trademark Trial and Appeal Board (TTAB) - Status Information

- What is the status of my case?
- How can I find out if you have received my filing?
- An answer was due in this proceeding a long time ago, and we have not received a copy of an answer from the defendant. What happens next?
- When will my contested motion be decided?

Our goal is to decide contested motions in less than three months. Your case will be decided in turn. If you have not received something from us after four months, you may call to check the status of your motion. For further pendency information, see the **TTAB's Dashboard (http://www.uspto.gov/dashboards/TTAB/main.dashxml)**.

- When can I expect a final decision on my appeal?
- 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. Up to date pendency information can be found on the **TTAB's Dashboard (http://www.uspto.gov/dashboards/TTAB/main.dashxml)**.

When can I expect a decision on my consented or uncontested motion?

Presently, the TTAB is rendering decisions on these filings approximately 10 days after the filing date of a consented motion or 10 days after a response to an unconsented motion was due.

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Published on: Aug 5, 2016 11:22 PM EDT
Last Modified: Feb 21, 2019 08:58 AM EST

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UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK PUBLIC ADVISORY COMMITTEE (TPAC)

PUBLIC MEETING

Alexandria, Virginia

Friday, November 4, 2022

eventually they were going to go up; and so, in 22' these numbers all climbed a bit -- still well under goal -- and that's what we're trying to do is make sure that we can stay under goal and plan accordingly. So, motion decision pendency was up a bit in 22', but still under the goal of 12 weeks for processing contested motions. Appeal decisions -- again -- up a little bit from 21', but still well under our goal; and trial decision pendency still under goal.

So, we're in the enviable position of having a docket that is not surging in terms of new cases coming in, which gives us time to work off the cases that are already in the pipeline; but we are cognizant of the fact that eventually that trademark filing surge is going to result in more work for us and the Trademark Modernization Act Appeals from Expungement and Reexamination Proceedings -- which we have not seen one yet, but we do expect that over time we will begin to see some of those as well. So, that's why we're kind of actively monitoring the incoming filings and

UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK PUBLIC ADVISORY COMMITTEE (TPAC)

PUBLIC MEETING

Alexandria, Virginia

Friday, April 8, 2022

kind of quarterly fluctuations in terms of the new cases coming in, the overall levels of work at the Board have been steady throughout the pandemic in terms of the total number of cases on our docket that have the potential to require attention by the Board. Next slide, please.

So, we have pendency goals because we want to make sure that we're doing things in a timely fashion. Our pendency goals focus on the parts of our processes that are completely within our control. So, in trial cases we have a goal for deciding contested motions within a certain period of time from when they are ready for decision and we have goals for how long it takes panels of judges to decide cases -- both appeals and trial cases -- on the merits from the time they are ready for decision. So, in fiscal 21' -- the previous fiscal year that closed last fall -- we met all our goals. All of these figures you see are well below the goals. Twelve weeks is the goal for motion pendency processing. Twelve weeks is the goal for getting out decisions in appeal

cases when those cases are ready for decision; and trial decision pendency, the goal is under 15 weeks on average. So, we met the figures and we're keeping pace with the work -- again -- because we have not yet seen a big impact from the trademark filing surge. Next slide, please.

So far in end-to-end processing -- again -- still this is the previous fiscal year. This is not so much a goal -- we don't have complete control over the processing time from the commencement of a case to the completion of a case -- so these figures -- we track them because we think that they are useful for counseling clients and for parties to know how long things are going to be pending at the Board; and these are -- again -- average figures and median figures, and we exclude from the calculations a small percentage of cases that involved anomalous prosecution histories. So, in fiscal 21' you can see that it took around 35 weeks or so for an average appeal -- one that didn't involve an anomalous prosecution history -- to be decided from the time

UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK PUBLIC ADVISORY COMMITTEE (TPAC)

PUBLIC MEETING

Alexandria, Virginia

Friday, January 28, 2022

compared to our goal of getting them decided in 12 weeks or less. When cases became ready for decision by a panel of judges, our appeal decision pendency was just under eight weeks, and that's compared to the goal of getting them within 12 weeks or less. And our trial decision pendency for trial cases, ready for decision by a panel of judges, on average, just under 10 weeks, when the goal is making sure we that we get them out under 15 weeks. At the end of that fiscal year, we were left with 186 cases, which handled motions, and 93 cases ready for decision on the merits. Next slide, please.

We also focus on end-to-end processing time, and in Fiscal '21, you can see on this slide that appeal processing averages between 35-36 weeks, from the time the appeals commence until we issue a final decision. Trial pendency is about a 150 a week, or approximately three years. Again, these are averages. Many cases go much faster than that, particularly ACR cases. But some go longer because the parties are in fist battles over very important laws and create very large presentations. But we have seen that these

UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK PUBLIC ADVISORY COMMITTEE (TPAC)

QUARTERLY MEETING

Alexandria, Virginia

Friday, July 24, 2020

focused on contested motions to extend because that's what we're measuring, not uncontested or consented.

Are you also focused on contested? I'm sorry, you were muted.

MS. NATLAND: Yeah, exactly, Judge Rogers, especially from the defendant side because, obviously, the defendant is opposing that in a contested motion. And, you know, three months or even two months to decide kind of defeats, you know, the purpose a little bit.

JUDGE ROGERS: Yeah, we understand. You know, please, if you think of a contested motion that should have been decided more quickly -- and I would think that normally a contested motion to extend is going to get decided pretty quickly. And it may be because of a situation, an attorney was on leave. We have an attorney on maternity leave at this point in time, for example, and some other attorneys have been out from time to time.

If something falls through the crack, please, you know, let us know. Contact the paralegal who's assigned to the case or feel free

to contact Ken Solomon, who's the managing interlocutory attorney, so that we can move work around and make sure that it gets done. If something takes too long, we want to know about it.

MS. NATLAND: Okay, thank you.

CHAIRWOMAN ESCOBAR: Great. Thank you so much, Chief Judge Rogers. We really appreciate your time and your availability to answer all these questions.

We are going to move along to our final speaker. First, I just wanted to mention that if you hear snoring, it's not me. It's the dog in the background. It's no comment on the presentation.

And with that, I'm going to pass the baton to Jamie Holcombe, our chief information officer. Thank you so much, Jamie.

MR. HOLCOMBE: Thank you for having me today. Usually I have on a suit and tie, but, as you can see if you're looking in the video, I have an Aloha shirt on. So, why? I meant to say aloha. Hopefully, that wakes everybody up.

All right. Once we got that done, my

THIS ORDER IS NOT A PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

MW

May 21, 2020

Cancellation No. 92068213

Charles Bertini

v.

Apple Inc.

Before Cataldo, Wolfson, and English,
Administrative Trademark Judges.

By the Board:

This proceeding now comes up for consideration of Petitioner's motion, filed January 10, 2020, for partial summary judgment on his claim of abandonment. Respondent filed a brief and evidence in response to the motion and Petitioner filed a reply brief.

Inasmuch as Trademark Rule 2.127(e)(1), 37 C.F.R. § 2.127(e)(1), clearly states, "[t]he Board will consider no further papers in support of or in opposition to a motion for summary judgment," Respondent's request for leave to file a surreply is denied and we have not considered either Respondent's surreply or Petitioner's response thereto in our determination of the motion. *See, e.g., No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000) (applicant's surreply not reviewed and returned to applicant).

Choose Your Battles

23-05-2018

BCFC / iStockphoto.com

As the workload of the U.S. Trademark Trial and Appeal Board grows, Gerard Rogers, Chief Administrative Trademark Judge, explains the challenges and his priorities to Ed Conlon.

“The most successful parties choose their battles wisely,” says The Honorable Gerard Rogers, Chief Administrative Trademark Judge at the Trademark Trial and Appeal Board (TTAB), a body within the

United States Patent and Trademark Office (USPTO). Having served in various roles on the TTAB for more than 25 years, Judge Rogers is particularly well placed to track the developments and challenges facing it.

The TTAB handles *ex parte* appeals from parties whose trademark applications have been denied by the USPTO, and adversarial opposition and cancellation proceedings. In both areas, parties have been known to push their luck.

“Trials are sometimes pursued because the parties have issues outside the TTAB that they’re grappling with and, it appears to us, they think it will give them another leverage point to deal with their differences.”

Judge Rogers says he has seen cases where parties have not properly followed the TTAB’s *Manual of Procedure,* which provides nonbinding guidelines on handling cases at the TTAB. The *Manual* contains an abundance of information on all the statutory, regulatory, and decisional authority that is relevant to the TTAB.

“Don’t increase your costs and file a lot of irrelevant evidence that would have a bearing in a district court but which is not relevant to our analysis.”

“There have been appeals and trial cases that have been lost but could have been won, due to a failure to follow the rules,” says Judge Rogers. “Many practitioners fail to follow the guidance on what evidence can be probative.”

Judge Rogers adds that it “never hurts” to remind stakeholders to be cognizant of the rules that the TTAB is required to apply—as well as the issues it must ignore—by the precedents of the U.S. Court of Appeals for the Federal Circuit. Among other issues, the TTAB often cannot take into account particulars relating to use of a trademark in the marketplace, even though U.S. district courts routinely do.

“We have to ignore that information, yet people bring it to us all the time,” Judge Rogers says.

Of the cases brought to the TTAB, just 30 percent are *ex parte* appeals, with trial proceedings making up the majority. Despite this balance, appeals account for 75 percent of cases ultimately decided on the merits, so what might explain the large swing?

Judge Rogers says that petitions for cancellation and opposition are similar to court disputes in that a settlement is available and, if that option is used, “fewer trial cases require disposition on the merits as the parties have worked it out.” In a small percentage of cases, a party might “misbehave” and be sanctioned, which could also lead to the case being terminated, says Judge Rogers.

The other major explanation for the statistics is that cancellations and oppositions can be much more expensive than appeals from examiner refusals, so a lot of cases are never pursued beyond the initial stages, says Judge Rogers. Adversarial proceedings, which can involve plenty of back and forth

between the parties, including on discovery and motion practice, naturally require more input from attorneys and therefore are more costly.

With *ex parte* appeals, in contrast, "when the attorney files the notice of appeal there is not much else to do other than file the briefs," says Judge Rogers. The TTAB will then hear the arguments, often in written rather than oral form, "so there's not much added expense to have an attorney pursue an appeal."

More Appeals

Judge Rogers notes that trademark application filings with the USPTO have risen year-on-year for eight years, so "this means more appeals and oppositions and the need to increase the staff to handle that work." This will be one of his major challenges in the coming years.

Judge Rogers recalls that in previous years some commentators raised concerns about the Board's slow pace in issuing decisions. While he admits that at some points those concerns were legitimate, he is adamant that these criticisms no longer apply.

One of the ways the TTAB seeks to reduce delays is through its Accelerated Case Resolution (ACR) procedure, which is available to parties in opposition and cancellation proceedings. Under the ACR, the TTAB seeks to expedite proceedings by, among other things, actively encouraging parties to consider placing limits on discovery and testimony, and adopting more efficient alternatives to the taking of discovery and the introduction of evidence at trial.

Judge Rogers and the TTAB have also introduced other working practices to boost speed. With pending contested motions, for example, he says that, while attorneys have individual responsibility for cases on their dockets, the TTAB's managing attorney will reassign cases with pending motions on a monthly basis in order to ensure that the oldest motions are handled each month.

The ACR and general efficiencies have helped the Board mostly to meet or exceed its performance targets, says Judge Rogers, despite a large variation in the complexity of cases, which affects how long they might take to resolve. TTAB judges aim to issue decisions on the merits in trial cases within 10 to 12 weeks of the case being ready to decide, says Judge Rogers (ready for decision means after all briefing is done and the case is submitted by a Board paralegal to the Chief Judge for assignment, or after oral argument, if one is requested).

"We have repeatedly beaten this goal," he adds.

Judge Rogers says that the TTAB has realized annual reductions in overall average pendency (from commencement to completion) of *ex parte* appeals for the last five years in a row, with that pendency measure falling in trial cases for five of the past six years.

"Judge Rogers explains that stakeholders have long expressed a preference for the TTAB to remain "a more relaxed alternative to litigation in federal district courts," where extensions and suspensions to accommodate settlement talks are routinely approved.

Out of the Limelight

In a wider context, while the TTAB has largely stayed out of the U.S. IP spotlight in recent times, at least one high-profile case has caused a stir. That was *B&B Hardware, Inc. v. Hargis Industries, Inc.*, which was decided by the United States Supreme Court in 2015. The Court said that TTAB rulings should have preclusive effect in subsequent district court litigation between the same parties that litigated an earlier case before the TTAB, as long as the "ordinary elements" of issue preclusion have been met and the issues are materially the same.

Despite the case receiving much attention in IP circles, Judge Rogers says its impact on the TTAB has been "almost none." However, he does note that it was a very positive ruling for trademark owners as it "reaffirmed the value of owning U.S. trademark registrations and the robust nature of TTAB proceedings."

He notes that many TTAB cases are settled and that even when they are not, parties are unlikely to pursue further litigation in court. Even if they take that step, he adds, the issues that the TTAB and district courts adjudicate are often different (e.g., the subsequent district court case very likely would consider additional issues relating to use in the marketplace).

"There was a lot of talk that, because of the possibility of issue preclusion, parties should take more discovery and introduce more evidence at the TTAB.

"But I say: issue preclusion is unlikely to arise in all but the rarest of cases, so you should not change your approach at the TTAB. Don't introduce more discovery than usual, and don't increase your costs and file a lot of irrelevant evidence that would have a bearing in a district court but which is not relevant to our analysis." he concludes.

TTAB parties would do well to heed Judge Rogers' advice; choose your battles wisely.

A Typical Day at the TTAB

When asked about his daily responsibilities, Judge Rogers, who has been in his current position since November 2010, says there is a "real variety and things can come up on any given day." His time includes meeting with the approximately 70 members of the TTAB staff, which includes judges, attorneys, and paralegals.

Judge Rogers reviews cases and the issues they present before assigning them to judges for disposition. A weekly summary of TTAB decisions distributed widely within the TTAB and other USPTO business units.

The TTAB hands down between 35 and 50 precedential decisions every year and that the judges are continually monitoring whether any given ruling should carry the weight of precedence.

Judge Rogers and his TTAB staff also work with other USPTO units, and he stresses the importance of working in harmony.

"We work closely with the Solicitor's Office; they will be in the position of defending various Board decisions before the Federal Circuit, so we want to put them in the best position possible," he says. The attorneys from the Solicitor's Office, Judge Rogers explains, can relay to the TTAB the questions that tend to be asked by Federal Circuit judges during those appeals.

While working as the TTAB's most senior judge may be his primary role, Judge Rogers says his responsibilities extend to managing and motivating his staff. The TTAB's staff are its biggest strength, says the judge.

"I find the time to remind our employees of what great work they do," he says.

With a busy schedule Judge Rogers has found a simple way to manage the long hours and stress—his bicycle.

"For many years I have ridden ten miles each way to the office and back; it provides a buffer between work and home life."

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CHARLES BERTINI, *Appellant*, v. APPLE INC., *Appellee*.	No. 21-2301

APPELLEE APPLE INC.'S UNOPPOSED MOTION FOR A 29-DAY EXTENSION OF TIME TO FILE A PETITION FOR PANEL AND/OR *EN BANC* REHEARING

Pursuant to Federal Rule of Appellate Procedure 26(b), Appellee Apple Inc. respectfully moves this Court for a 29-day extension of time, up to and until June 2, 2023, to file a petition for panel rehearing and/or rehearing *en banc*. Apple has not previously requested an extension of time to file a petition for rehearing.

On April 4, 2023, the Court issued its opinion and entered judgment reversing the Trademark Trial and Appeal Board's ("TTAB") dismissal of Appellant's opposition of Apple's application to register the mark APPLE MUSIC (Ser. No. 86/659,444). Under Federal Circuit Rule 40(d), the deadline for Apple to file a petition for panel rehearing and/or rehearing *en banc* is May 4, 2023.

An extension is warranted for several reasons. ***First***, Apple recently has engaged Dale M. Cendali and Joshua L. Simmons of Kirkland & Ellis LLP as

(5) 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 numbers(s) for this case.

In light of the grounds on which the Federal Circuit panel decided this appeal, we do not believe there are any. However, out of an abundance of caution we note the following pending proceeding: Cancellation No. 92068213, Trademark Trial and Appeal Board.

(6) Provide any information required under Fed. R. App. P. 261(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees).

Not applicable.

Date: April 26, 2023

/s/ Joseph Petersen

Joseph Petersen
KILPATRICK TOWNSEND & STOCKTON LLP
1302 El Camino Real
Suite 175
Menlo Park, California 94025
(650) 614-6427
jpetersen@kilpatricktownsend.com

Counsel for Appellee Apple, Inc.

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

August 25, 2022

VIA EMAIL

Mr. James Bertini
423 Kalamath St.
Denver, CO 80204
jamesbertini@yahoo.com

RE: ***Freedom of Information Act (FOIA) Request No. F-22-00186***

Dear Mr. Bertini:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated, July 27, 2022 requesting a copy of the following documents pursuant to the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

> Request (a) all documents showing the name or names of the persons who made this decision suspending TTAB Cancellation No. 92068213 on 2.09.22. (b) Any emails or other correspondence regarding the assignment of the person or persons who made this decision.

The USPTO has identified 9 pages of documents that are responsive to your request. A copy of the material is enclosed. Portions of the material, however, were redacted pursuant to Exemptions (b)(5) and (b)(6) of the FOIA.

Exemption (b)(5) of the FOIA, 5 U.S.C. 552(b)(5), protects an agency's deliberative process privilege. Mapother v. Dep't of Justice, 3 F.3d 1533, 1537 (D.C. Cir. 1993). This privilege applies to documents, which reflect "advisory opinions, recommendations and deliberations comprising part of a process by which governmental decisions and policies are formulated." NLRB v. Sears, Roebuck & Co., 421 U.S. 132, 150 (1975), quoting Carl Zeiss Stiftung & Co. v. V.E.B. Carl Zeiss, Jena, 40 F.R.D. 318, 324 (D.D.C. 1966).

Here, the withheld information consists of opinions and recommendations regarding proposed agency actions, i.e., antecedent to the adoption of an agency position (Judicial Watch, Inc. v. U.S. Dep't of Commerce, 337 F.Supp.2d 146, 172 (D.D.C. 2004)), and are deliberative, i.e., a direct part of the deliberative process in that it makes recommendations or expresses opinions on legal or policy matters. Skinner v. U.S. Dep't of Justice, 2010 WL 3832602 (D.D.C. 2010)(*quoting* Vaughn v. Rosen, 523 F.2d 1136, 1143-44 (D.C. Cir. 1975). Facts expressed in these deliberative communications are not reasonably segregable, and thus are not suitable for

disclosure. Pre-decisional, deliberative documents or comments "are at the heart of Exemption (b)(5), and sanctioning release of such material would almost certainly have *a chilling effect* on candid expression of views by subordinates ." Schell v. Dep't of HHS, 843 F.2d 933, 942 (6th Cir. 1988) (emphasis added). In particular, disclosure of documents or comments reflecting the positions discussed, but not ultimately adopted as agency decisions are deliberative, and thus exempt from disclosure. Arthur Andersen & Co. v. Internal Revenue Service, 679 F.2d 254, 258 (D.C.Cir. 1982).

Exemption (b)(6) of the FOIA, which permits the withholding of "personnel and medical files and similar files the disclosure of which would constitute a clearly unwarranted invasion of personal privacy." 5 U.S.C. § 552(b)(6). The term "similar files" has been broadly construed to cover "detailed Government records on an individual which can be identified as applying to that individual." Dep't of State v. Washington Post, 456 U.S. 595, 601 (1982). Information that applies to a particular individual meets the threshold requirement for Exemption (b)(6) protection. Id. The privacy interest at stake belongs to the individual, not the agency. See Dep't of Justice v. Reporter's Comm. for Freedom of the Press, 489 U.S. 749, 763-65 (1989). Exemption (b)(6) requires a balancing of an individual's right to privacy against the public's right to disclosure. See Dep't of the Air Force v. Rose, 425 U.S. 352, 372 (1976); Multi Ag Media LLC v. Dep't of Agric., 515 F.3d 1224, 1228 (D.C. Cir. 2008).

Here, the Agency withheld information that applies to particular individuals, and in which those individuals have a legitimate privacy interest. The burden is on the requester to establish that disclosure of this information would serve the public interest. See Bangoura v. Dep't of the Army, 607 F. Supp. 2d 134, 148-49 (D.D.C. 2009). When balancing the public interest of release against individual privacy interest, the Supreme Court has made clear that information that does not directly reveal the operations or activities of the federal government falls outside the ambit of the public interest. See Reporters Comm., 489 U.S. at 775. The withheld information does little to shed light or contribute significantly to public understanding of the operations or activities of the USPTO. Your FOIA request does not assert a public interest that outweighs the privacy interest, nor is one otherwise evident. As such, the FOIA dictates that the information be withheld.

You may contact the FOIA Public Liaison at 571-272-9585 for any further assistance and to discuss any aspect of your request. Additionally, you may contact the Office of Government Information Services (OGIS) at the National Archives and Records Administration to inquire about the FOIA mediation services they offer. The contact information for OGIS is as follows: Office of Government Information Services, National Archives and Records Administration, 8601 Adelphi Road-OGIS, College Park, Maryland 20740-6001, e-mail at ogis@nara.gov; telephone at 202-741-5770; toll free at 1-877-684-6448; or facsimile at 202-741-5769.

You have the right to appeal this initial decision to the Deputy General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 90 calendar days from the date of this letter. See 37 C.F.R. § 102.10(a). The appeal must be in writing. You must include a copy of your original request, this letter, and a statement of the reasons why the information should be made available and why this initial

denial is in error. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal."

Sincerely,

Dorothy G. Campbell
Dorothy G. Campbell
USPTO FOIA Officer
Office of General Law

Enclosure

From: Thurmon, Mark
Sent: Wed, 9 Feb 2022 23:29:38 +0000
To: Butler, Cheryl
Subject: RE: 92068213 Bertini v. Apple Inc. - Suspension pending appeal in 91229891

(b)(5) Delib Proc Priv

Mark A. Thurmon
(b)(6)
571-270-7040

From: Butler, Cheryl
Sent: Wednesday, February 9, 2022 2:18 PM
To: Rogers, Gerard <Gerard.Rogers@USPTO.GOV>; Thurmon, Mark <Mark.Thurmon@USPTO.GOV>; DelGizzi, Denise <Denise.DelGizzi@USPTO.GOV>
Subject: RE: 92068213 Bertini v. Apple Inc. - Suspension pending appeal in 91229891

Hi All,

(b)(5) Delib Proc Priv

Cheryl

Cheryl Butler
Senior Counsel,
Trademark Trial and Appeal Board
571-272-4259

TTAB Est. 1958 We have our trials but our work is appealing

EXPANDING AMERICAN INNOVATION

From: Rogers, Gerard
Sent: Wednesday, February 9, 2022 3:40 PM

To: Thurmon, Mark <Mark.Thurmon@USPTO.GOV>; DelGizzi, Denise <Denise.DelGizzi@USPTO.GOV>
Cc: Butler, Cheryl <Cheryl.Butler@USPTO.GOV>
Subject: RE: 92068213 Bertini v. Apple Inc. - Suspension pending appeal in 91229891

(b)(5) Delib Proc Priv

GFR

From: Thurmon, Mark
Sent: Wednesday, February 9, 2022 8:26 AM
To: DelGizzi, Denise <Denise.DelGizzi@USPTO.GOV>
Cc: Rogers, Gerard <Gerard.Rogers@USPTO.GOV>
Subject: RE: 92068213 Bertini v. Apple Inc. - Suspension pending appeal in 91229891

This looks good to me, Denise. (b)(5) Delib Proc Priv
(b)(5) Delib Proc Priv

Mark A. Thurmon
(b)(6)
571-270-7040

From: DelGizzi, Denise
Sent: Tuesday, February 8, 2022 1:18 PM
To: Thurmon, Mark <Mark.Thurmon@USPTO.GOV>
Cc: Rogers, Gerard <Gerard.Rogers@USPTO.GOV>
Subject: 92068213 Bertini v. Apple Inc. - Suspension pending appeal in 91229891

Hi Mark,

Attached is a draft suspension order for the case involving Bertini v. Apple Inc.

Please provide edits or comments.

Thank You.
Denise

Denise M. DelGizzi
Chief Clerk of the Board
Trademark Trial and Appeal Board

United States Patent and Trademark Office
571-272-4265 (Direct)
denise.delgizzi@uspto.gov

From: DelGizzi, Denise
Sent: Wed, 9 Feb 2022 23:53:05 +0000
To: Thurmon, Mark; Butler, Cheryl; Rogers, Gerard
Subject: RE: 92068213 Bertini v. Apple Inc. - Suspension pending appeal in 91229891

Mailed.

Thanks everyone for you input.

-Denise

Chief Clerk of the Board
USPTO Trademark Trial and Appeal Board
571-272-4265

From: Thurmon, Mark
Sent: Wednesday, February 9, 2022 6:34 PM
To: Butler, Cheryl <Cheryl.Butler@USPTO.GOV>; Rogers, Gerard <Gerard.Rogers@USPTO.GOV>; DelGizzi, Denise <Denise.DelGizzi@USPTO.GOV>
Subject: RE: 92068213 Bertini v. Apple Inc. - Suspension pending appeal in 91229891

I think this is ready to go. Denise, let's get this out tomorrow (Thursday).

Mark A. Thurmon
(b)(6)
571-270-7040

From: Butler, Cheryl
Sent: Wednesday, February 9, 2022 2:18 PM
To: Rogers, Gerard <Gerard.Rogers@USPTO.GOV>; Thurmon, Mark <Mark.Thurmon@USPTO.GOV>; DelGizzi, Denise <Denise.DelGizzi@USPTO.GOV>
Subject: RE: 92068213 Bertini v. Apple Inc. - Suspension pending appeal in 91229891

Hi All,

(b)(5) Delib Proc Priv

Cheryl

Cheryl Butler
Senior Counsel,
Trademark Trial and Appeal Board
571-272-4259

From: Rogers, Gerard
Sent: Wednesday, February 9, 2022 3:40 PM
To: Thurmon, Mark <Mark.Thurmon@USPTO.GOV>; DelGizzi, Denise <Denise.DelGizzi@USPTO.GOV>
Cc: Butler, Cheryl <Cheryl.Butler@USPTO.GOV>
Subject: RE: 92068213 Bertini v. Apple Inc. - Suspension pending appeal in 91229891

(b)(5) Delib Proc Priv

GFR

From: Thurmon, Mark
Sent: Wednesday, February 9, 2022 8:26 AM
To: DelGizzi, Denise <Denise.DelGizzi@USPTO.GOV>
Cc: Rogers, Gerard <Gerard.Rogers@USPTO.GOV>
Subject: RE: 92068213 Bertini v. Apple Inc. - Suspension pending appeal in 91229891

This looks good to me, Denise. (b)(5) Delib Proc Priv
(b)(5) Delib Proc Priv

Mark A. Thurmon
(b)(6)
571-270-7040

From: DelGizzi, Denise
Sent: Tuesday, February 8, 2022 1:18 PM
To: Thurmon, Mark <Mark.Thurmon@USPTO.GOV>
Cc: Rogers, Gerard <Gerard.Rogers@USPTO.GOV>
Subject: 92068213 Bertini v. Apple Inc. - Suspension pending appeal in 91229891

Hi Mark,

Attached is a draft suspension order for the case involving Bertini v. Apple Inc.

Please provide edits or comments.

Thank You.
Denise

Denise M. DelGizzi
Chief Clerk of the Board
Trademark Trial and Appeal Board
United States Patent and Trademark Office
571-272-4265 (Direct)
denise.delgizzi@uspto.gov

From: Rogers, Gerard
Sent: Tue, 8 Feb 2022 13:58:55 +0000
To: Thurmon, Mark; Butler, Cheryl
Subject: RE: TTAB Cancellation 92068213: Inquiry from Congress on Apple Jazz

Mark:

(b)(5) Delib Proc Priv

GFR

From: Thurmon, Mark
Sent: Tuesday, February 8, 2022 8:33 AM
To: Butler, Cheryl <Cheryl.Butler@USPTO.GOV>; Rogers, Gerard <Gerard.Rogers@USPTO.GOV>
Subject: RE: TTAB Cancellation 92068213: Inquiry from Congress on Apple Jazz

(b)(5) Delib Proc Priv

Mark A. Thurmon
(b)(6)
571-270-7040

From: Butler, Cheryl <Cheryl.Butler@USPTO.GOV>
Sent: Tuesday, February 8, 2022 6:03 AM
To: Rogers, Gerard <Gerard.Rogers@USPTO.GOV>; Thurmon, Mark <Mark.Thurmon@USPTO.GOV>
Subject: FW: TTAB Cancellation 92068213: Inquiry from Congress on Apple Jazz

FYI. We can talk about how to respond later today.

Cheryl Butler
Senior Counsel,
Trademark Trial and Appeal Board
571-272-4259

TTAB Est. 1958 We have our trials but our work is appealing

EXPANDING AMERICAN INNOVATION

From: Zazzaro, Caroline
Sent: Monday, February 7, 2022 12:37 PM
To: Butler, Cheryl <Cheryl.Butler@USPTO.GOV>
Subject: FW: TTAB Cancellation 92068213

Hi Cheryl,

(b)(5) Delib Proc Priv We'd like to respond by February 23. Thank you.

Carol

Carol Zazzaro
Office of Governmental Affairs
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
(571) 272-0158
Caroline.Zazzaro@uspto.gov

From: Joyner, Charles <Charles.Joyner@USPTO.GOV>
Sent: Monday, January 31, 2022 10:09 AM
To: Zazzaro, Caroline <Caroline.Zazzaro@USPTO.GOV>
Subject: RE: TTAB Cancellation 92068213

Hi Carol – I would send this to Cheryl Butler.

Cheryl is Senior Counsel at the TTAB, and will ensure this gets in the right hands as well as determine the best way to respond.

Please let me know if you have any follow-up questions or if I can provide any further assistance. Thanks!

-Chet

Charles G. Joyner
Acting Chief of Staff |Office of the Commissioner for Trademarks
Senior Attorney | Office of the Deputy Commissioner for Trademark Examination Policy
charles.joyner@uspto.gov |Phone: 571-272-8942 | Fax: 571-273-8942
uspto UNITED STATES PATENT AND TRADEMARK OFFICE

From: Zazzaro, Caroline <Caroline.Zazzaro@USPTO.GOV>
Sent: Thursday, January 27, 2022 8:35 AM
To: Joyner, Charles <Charles.Joyner@USPTO.GOV>
Subject: TTAB Cancellation 92068213

Hi Chet,

The attached refers to a TTAB matter. I wasn't sure who to send it to (we don't get many of these). If there's someone in TTAB who handles such requests, please let me know so I won't bother you with these.

Thank you!

Carol

Carol Zazzaro
Office of Governmental Affairs
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
(571) 272-0158
Caroline.Zazzaro@uspto.gov