

No. 2024-105

**IN THE 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 No. 92068213

**APPLE INC.'S RESPONSE TO
PETITION FOR WRIT OF MANDAMUS**

KILPATRICK TOWNSEND & STOCKTON LLP

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

Adam H. Charnes
2001 Ross Avenue
Suite 4400
Dallas, Texas 75201
(214) 922-7106
acharnes@kilpatricktownsend.com

Theodore H. Davis Jr.
Sara K. Stadler
The Grace Building
1114 Avenue of the Americas
New York, New York 10036
(404) 815-6534
(404) 532-6908
tdavis@kilpatricktownsend.com
sstadler@kilpatricktownsend.com

William M. Bryner
1001 W. Fourth Street
Winston-Salem, North Carolina 27101
(336) 607-7482
bbryner@kilpatricktownsend.com

Attorneys for Respondent Apple Inc.

CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rule 47.4(a), Respondent Apple Inc. (“Apple”) states as follows:

(1) Provide the full names of all entities represented by undersigned counsel in this case.

Apple Inc.

(2) Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.

None.

(3) Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.

None.

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

J. David Mayberry, Kilpatrick Townsend & Stockton LLP

Jason M. Gonder, Kilpatrick Townsend & Stockton LLP

(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.

None.

(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.

Dated: November 21, 2023

Respectfully submitted,

/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

Attorney for Appellee Apple Inc.

TABLE OF CONTENTS

CERTIFICATE OF INTERESTi
TABLE OF AUTHORITIESiv
ARGUMENT 1
CONCLUSION 3
CERTIFICATE OF COMPLIANCE 4

TABLE OF AUTHORITIES

CASES

Gulfstream Aerospace Corp. v. Mayacamas Corp., 485 U.S. 271
(1988) 1

STATUTES

15 U.S.C. § 1052(d) 2

OTHER AUTHORITIES

Brief for Appellee, *Bertini v. Apple Inc.*, No. 21-2301, Dkt. 20
(Fed. Cir. Mar. 4, 2022) 2

Order, *Bertini v. Apple Inc.*, Cancellation No. 92068213, 73
TTABVUE (T.T.A.B. Feb. 9, 2022) 1

Order, *Bertini v. Apple Inc.*, Cancellation No. 92068213, 85
TTABVUE (T.T.A.B. Nov. 13, 2023) 1

Petition for Writ of Mandamus, *In re: Bertini*, No. 2024-105,
Dkt. 1 (Fed. Cir. Oct. 21, 2023) 2

ARGUMENT

On November 13, 2023, the Trademark Trial and Appeal Board (“Board”) issued an order lifting the suspension in this cancellation proceeding (the “Cancellation”) and stated it “will be decided in due course.”¹ The Board issued this order only four days after terminating a separate opposition proceeding between the parties, styled as *Bertini v. Apple Inc.*, Opposition No. 91229891. This is persuasive evidence that the Board did, in fact, suspend these proceedings “pending disposition [in] the appeal pending in . . . Opposition No. 91229891”² and that Petitioner Charles Bertini’s (“Bertini”) allegations of conspiracy and malice on the parts of the United States Patent and Trademark Office (the “Office”) and the Board are wholly misplaced. Now that the Board has lifted the suspension, the “extraordinary remedy” of mandamus is unwarranted, *see Gulfstream Aerospace Corp. v. Mayacamas Corp.*, 485 U.S. 271, 289 (1988),

¹ Order at 3, *Bertini v. Apple Inc.*, Cancellation No. 92068213, 85 TTABVUE 3 (T.T.A.B. Nov. 13, 2023).

² Order at 1, *Bertini v. Apple Inc.*, Cancellation No. 92068213, 73 TTABVUE 1 (T.T.A.B. Feb. 9, 2022).

and the Petition for Writ of Mandamus (“Petition”) should be denied on that basis.

Apple also writes to briefly respond to the numerous claims by Bertini that a Board decision in his favor would “eliminate the remaining obstacle to the registration of his APPLE JAZZ [mark].”³ These claims are inaccurate. In addition to the ‘195 Registration and the ‘444 Application at issue in the two Board proceedings between the parties, the Office also has refused registration to Bertini’s mark over Apple’s incontestable Registration Nos. 2,034,964 and 3,317,089 of its APPLE mark, and issued an advisory under Section 2(d), 15 U.S.C. § 1052(d), citing Apple’s Application Serial No. 86/658,508 to register its APPLE MUSIC mark (which is now registered and incontestable).⁴ Thus, even if the Board ultimately grants Bertini’s petition for cancellation, his application will still be refused registration.⁵

³ Petition for Writ of Mandamus at 3, *In re: Bertini*, No. 2024-105, Dkt. 1 at 11 (Fed. Cir. Oct. 21, 2023); *see also id.* at 6, Dkt. 1 at 14 (“[T]he Mark is the only remaining obstacle to Bertini’s registration of APPLE JAZZ.”).

⁴ Brief for Appellee at 6 n.16, *Bertini v. Apple Inc.*, No. 21-2301, Dkt. 20 at 16 n.16 (Fed. Cir. Mar. 4, 2022), attached hereto as APPX094–095.

⁵ *Id.*

CONCLUSION

For the foregoing reasons, Apple respectfully asks this Court to deny the Petition as unwarranted in view of the Board's November 13, 2023, order removing the Cancellation from suspension.

Dated: November 21, 2023

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON
LLP

By: /s/ Joseph Petersen

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

Theodore H. Davis Jr.
Sara K. Stadler
The Grace Building
1114 Avenue of the Americas
New York, New York 10036
(212) 775-8830
tdavis@kilpatricktownsend.com
sstadler@kilpatricktownsend.com
William M. Bryner
1001 W. Fourth Street
Winston-Salem, North Carolina
27101
(336) 607-7482
bbryner@kilpatricktownsend.com

Attorneys for Respondent Apple Inc.

CERTIFICATE OF COMPLIANCE

Apple's counsel certify that this brief complies with the spacing, typeface, and style requirements of Federal Circuit Rule 32(b)(1) and contains 415 words excluding the cover page, certificate of interest, table of contents, table of authorities, signature block, and this certificate of compliance.

/s/ Joseph Petersen

Joseph Petersen
KILPATRICK TOWNSEND & STOCKTON
LLP

Attorney for Respondent Apple Inc.

No. 2024-105

**IN THE 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 No. 92068213

NON-CONFIDENTIAL APPENDIX VOLUME II

2021-2301

**United States Court of Appeals
for the Federal Circuit**

CHARLES BERTINI,

Appellant,

– v. –

APPLE INC.,

Appellee.

*On Appeal from the United States Patent and Trademark Office,
Trademark Trial and Appeal Board in PTO-1: 91229891*

BRIEF FOR APPELLEE

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

WILLIAM M. BRYNER
KILPATRICK TOWNSEND
& STOCKTON LLP
1001 W. Fourth Street
Winston-Salem, North Carolina 27101
(336) 607-7482
bbryner@kilpatricktownsend.com

J. DAVID MAYBERRY
THEODORE H. DAVIS JR.
SARA K. STADLER
KILPATRICK TOWNSEND
& STOCKTON LLP
The Grace Building
1114 Avenue of the Americas
New York, New York 10036
(212) 775-8830
dmayberry@kilpatricktownsend.com
tdavis@kilpatricktownsend.com
sstadler@kilpatricktownsend.com

Counsel for Appellee

DATE FILED: MARCH 4, 2022

Had Apple branded that service as APPLE, any contention by Bertini that he has priority in the APPLE mark would be frivolous. Bertini's modest use of the APPLE JAZZ mark in connection with an annual (and discontinued) jazz festival in upstate New York would have made him nothing more than an infringer of Apple's rights in its famous APPLE marks. The sole question in this appeal, and one the Board properly answered below, is whether Apple forfeited its priority position by appending the word "MUSIC" to its APPLE mark, thereby exposing itself to Bertini's opportunistic and quixotic campaign, now in its sixth year, to disrupt and delay registration of Apple's APPLE MUSIC mark for a variety of entertainment-related services in Class 41.¹⁶

The Board properly found that Apple did not forfeit its priority position by adding the generic term "MUSIC" to its famous APPLE mark.

¹⁶ The endgame of Bertini's campaign is unclear. After Bertini filed his own trademark application to register APPLE JAZZ, the USPTO refused and maintained its refusal of registration under Section 2(d), citing not only the Application at issue in this appeal and Apple's Registration No. 4,088,195 referenced above (which Bertini is attempting to cancel in part under Cancellation No. 92068213), but also three of Apple's registrations that Bertini has *not* challenged—i.e., Registration Nos. 2,034,964, 3,317,089 and 5,330,141. Appx02139-02142. Accordingly, regardless of the outcome in this proceeding, Bertini faces insurmountable obstacles to claiming superior trademark rights to Apple.