

2024-105

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE CHARLES BERTINI,

Petitioner.

On Petition for a Writ of Mandamus to the United States Patent and Trademark
Office, in Cancellation No. 92068213

**RESPONSE OF THE DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

FARHEENA Y. RASHEED
Acting Solicitor

ERICA JEUNG DICKEY
MARY BETH WALKER
Associate Solicitors

Office of the Solicitor
U.S. Patent and Trademark Office
Mail Stop 8, P.O. Box 1450
Alexandria, Virginia 22313-1450
(571) 272-9035

*Attorneys for the Director of the
United States Patent and Trademark Office*

November 28, 2023

Table of Contents

I. INTRODUCTION.....	1
II. STATEMENT.....	1
A. Statutory and Regulatory Background.....	1
B. Factual Background.....	2
III. ARGUMENT.....	5
A. Mandamus is an extraordinary form of relief.	5
B. Bertini does not have a clear and indisputable right to a final decision on his preferred timetable.	7
C. Attorney’s Fees	13
IV. CONCLUSION.....	14

Table of Authorities

	Page(s)
Cases	
<i>A Cmty. Voice, In re</i> , 878 F.3d 779 (9th Cir. 2017).....	8, 10, 11
<i>Allied Chem. Corp. v. Daiflon, Inc.</i> , 449 U.S. 33 (1980).....	6
<i>Bankers Life & Casualty Co. v. Holland</i> , 346 U.S. 379 (1953).....	6
<i>Barr Lab., Inc., In re</i> , 930 F.2d 72 (D.C. Cir. 1991).....	12
<i>Bluewater Network & Ocean Advocates, In re</i> , 234 F.3d 1305 (D.C. Cir. 2000).....	5-6
<i>Boston Beer Co. L.P., In re</i> , 198 F.3d 1370 (Fed. Cir. 1999)	11
<i>Cheney v. U.S. Dist. Court for the Dist. of Columbia</i> , 542 U.S. 367 (2004).....	5, 6
<i>Cutler v. Hayes</i> , 818 F.2d 879 (D.C. Cir. 1987).....	11
<i>Fahey, Ex parte</i> , 332 U.S. 258 (1947).....	5
<i>Jadhav, In re</i> , 795 F. App'x 846 (Fed. Cir. 2020)	7, 8
<i>Mallard v. U.S. Dist. Court for the S. Dist. of Iowa</i> , 490 U.S. 296 (1989).....	6
<i>Martin v. O'Rourke</i> , 891 F.3d 1338 (Fed. Cir. 2018)	<i>passim</i>

Mexichem Spec. Resins, Inc. v. EPA,
787 F.3d 544 (D.C. Cir. 2015).....10

Norton v. S. Utah Wilderness All.,
542 U.S. 55, 124 S.Ct. 2373, 159 L.Ed.2d 137 (2004)13

Roche Molecular Sys., Inc., In re,
516 F.3d 1003 (Fed. Cir. 2008)5

Sierra Club v. Gorsuch,
715 F.2d 653 (D.C. Cir. 1983).....11

Telecomms. Research & Action Ctr. v. FCC,
750 F.2d 70 (D.C. Cir. 1984).....6, 7, 10, 13

Statutes

15 U.S.C. §10517

15 U.S.C. §10647

15 U.S.C. § 10671, 8, 10

35 U.S.C. § 17

Regulations

37 C.F.R. § 2.117(a).....1, 4

Other Authorities

Fed. Cir. R. 47.713

Fed. Cir. R. 47.7(a)(3).....14

TBMP § 510.02(a)(2021).....4

I. INTRODUCTION

James Bertini petitions this Court for a writ of mandamus that would compel the Trademark Trial and Appeal Board (Board) of the U.S. Patent and Trademark Office (USPTO) to issue a decision in the underlying cancellation proceeding within two weeks of this Court's Order. The underlying proceeding has not been unreasonably delayed at all, much less delayed in a way that might give rise to a right to the extraordinary remedy of mandamus. Rather, Bertini complains about a routine application of the Board's regulations that contemplate a suspension of proceedings while a related matter is in litigation. In addition, now that the relevant litigation has ended, the proceedings have resumed. The petition should be denied.

II. STATEMENT

A. Statutory and Regulatory Background

The statutory provisions regarding inter partes proceedings before the Board are silent as to a time frame for issuing a final decision. Section 17 of the Lanham Act, 15 U.S.C. § 1067, provides:

In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.

The trademark regulations give the Board the authority to suspend proceedings. Trademark Rule 2.117, 37 C.F.R. § 2.117(a), provides:

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.

B. Factual Background

Bertini's petition involves two inter partes proceedings before the Board. The first, Opposition No. 91229891 (the "'891 Proceeding"), was filed by Bertini in 2016. SAppx726-736. It concerned Apple, Inc.'s ("Apple") Application Serial No. 86659444 to register APPLE MUSIC for services in class 41, including live musical performances and related services. *Id.* The second, Cancellation No. 92068213 (the "'213 Proceeding"), filed by Bertini in 2018, concerns Apple's Registration No. 4088195 (the "'195 Registration") to register APPLE for services in class 41, including live musical performances and related services. SAppx93-274. In both proceedings, Bertini has alleged prior rights in the mark APPLE JAZZ and has pleaded ownership of Application Serial No. 87060640 (the "'640 Application") for the mark APPLE JAZZ. SAppx95-98, Sappx109, SAppx727-728, SAppx734.

At the core of each proceeding is a conflict between Apple's marks and Bertini's '640 application.¹ In the '213 Proceeding, Bertini identified the '891 Proceeding as a related proceeding and, throughout briefing, continued to refer to the '891 Proceeding. *See, e.g.*, Bertini's June 26, 2018 Response to Apple's Motion to Dismiss, SAppx276 (“[t]he Amended Petition for Cancellation ... was borne of the inability of the Registrant to produce proof of use ... during discovery in [a] related case Opposition No. 91229891.”); Bertini's December 18, 2018 Response to Apple's Motion to Dismiss, SAppx355-356 (describing discovery in the '891 Proceeding); Bertini's January 10, 2020 Motion for Summary Judgment, SAppx382 ('891 Proceeding filing identified as an undisputed material fact).

The Board issued a final decision in the '891 Proceeding on April 16, 2021. SAppx956-1007. Bertini appealed that decision to this Court, SAppx1008-1080, and a decision issued on April 4, 2023, SAppx1081-1092. Apple filed a petition for rehearing, SAppx1093-1131, which was denied on July 6, 2023, SAppx1133-34. The time for Apple to file a petition for writ of certiorari expired on October 4, 2023.

¹ The USPTO has issued a refusal to register Bertini's APPLE JAZZ mark based on a likelihood of confusion with Apple's registered marks covered by Registration No. 4088195 and Registration Nos. 2034964 and 3317089. SAppx65-92. Bertini has only petitioned to cancel Registration No. 4088195. SAppx93-274.

On February 9, 2022, during the pendency of the appeal of the '891 Proceeding, the Board suspended the '213 Proceeding citing Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a). SAppx721-722. The Board explained that suspension is “generally suitable when a ruling on the other proceeding will have a bearing on the issues before the Board.” *Id.* (citing Trademark Board Manual of Procedure (TBMP) (2021) § 510.02(a)). The Board further explained that because this Court’s opinion in appeal of the '891 Proceeding may have a bearing on the issues before the Board in the '213 Proceeding, the '213 Proceeding would be suspended pending final disposition of the appeal in the '891 Proceeding. SAppx722. That is, consistent with 37 C.F.R. § 2.117(a), the proceeding would remain suspended until 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 had expired, to include time for petitioning for rehearing or U.S. Supreme Court review. *Id.* (citing 37 C.F.R. § 2.117(a)).

Just over a month after Apple’s time for filing a petition for certiorari expired, the Board issued an order on a remaining motion pending in the '891 Proceeding, and thereafter terminated that proceeding. SAppx1135-1157. Four days later, the Board issued an order resuming the '213 Proceeding, explaining that because the '891 Proceeding had been terminated, “[t]he basis for suspension of this cancellation proceeding has been obviated.” SAppx723-725. It removed the

case from suspension and indicated that a final decision will issue “in due course.” SAppx725.

During the pendency of the appeal before this Court in the ’891 Proceeding, Bertini filed a request for reconsideration of the suspension order, Appx21-34, a demand letter to the Chief Judge to assign the case for decision, Appx47-50, a petition to the Director demanding a decision, SAppx1-64, a Freedom of Information Act request demanding documents related to the suspension of the Cancellation, *see* Appx82, and sought the assistance of two legislators. Pet. at 7, 9.

Bertini now seeks a writ of mandamus to compel the USPTO to issue a decision in the cancellation within two weeks of the order granting the writ. Pet. at 33-34.

III. ARGUMENT

A. Mandamus is an extraordinary form of relief.

“The remedy of mandamus is available only in extraordinary situations to correct a clear abuse of discretion or usurpation of judicial power.” *In re Roche Molecular Sys., Inc.*, 516 F.3d 1003, 1004 (Fed. Cir. 2008); *see also, e.g., Cheney v. U.S. Dist. Court for the Dist. of Columbia*, 542 U.S. 367, 380 (2004) (holding that the writ of mandamus is a “‘drastic and extraordinary’ remedy ‘reserved for really extraordinary causes’”) (quoting *Ex parte Fahey*, 332 U.S. 258, 259-60 (1947)); *In re Bluewater Network & Ocean Advocates*, 234 F.3d 1305, 1315 (D.C.

Cir. 2000) (“[C]onsideration of any and all mandamus actions starts from the premise that issuance of the writ is an extraordinary remedy, reserved only for the most transparent violations of a clear duty to act.”). This is not such a situation.

To be entitled to the “extraordinary” remedy of mandamus, a petitioner must establish that: (1) there are no alternative means of obtaining the relief desired; and (2) the right to the relief is “clear and indisputable.” *Allied Chem. Corp. v. Daiflon, Inc.*, 449 U.S. 33, 35 (1980). Even if the petitioner can meet these two requirements, the court must also “be satisfied that the writ is appropriate under the circumstances.” *Cheney*, 542 U.S. at 381. “[P]etitioners must show that they lack adequate alternative means to obtain the relief they seek . . . and carry ‘the burden of showing that [their] right to issuance of the writ is clear and indisputable.’” *Mallard v. U.S. Dist. Court for the S. Dist. of Iowa*, 490 U.S. 296, 309 (1989) (quoting *Bankers Life & Casualty Co. v. Holland*, 346 U.S. 379, 384 (1953), internal quotations omitted).

When, as here, a petitioner asserts that the writ is appropriate due to the Board’s unreasonable delay in issuing a final decision, the central question is whether “the agency’s delay is so egregious as to warrant mandamus.” *Martin v. O’Rourke*, 891 F.3d 1338, 1344 (Fed. Cir. 2018) (quoting *Telecomms. Research & Action Ctr. v. FCC*, 750 F.2d 70, 79 (D.C. Cir. 1984)). This Court instructs lower courts to apply the standard set forth in *Telecomms. Research & Action Ctr. v.*

FCC (“*TRAC*”), 750 F.2d 70, 80 (D.C. Cir. 1984), to evaluate mandamus petitions based on alleged unreasonable delay. *Martin*, 891 F.3d at 1349. Under the *TRAC* standard, a court will consider the following six factors to determine whether agency delay is unreasonable:

(1) the time agencies take to make decisions must be governed by a “rule of reason”; (2) where Congress has provided a timetable or other indication of the speed with which it expects the agency to proceed in the enabling statute, that statutory scheme may supply content for this rule of reason; (3) delays that might be reasonable in the sphere of economic regulation are less tolerable when human health and welfare are at stake; (4) the court should consider the effect of expediting delayed action on agency activities of a higher or competing priority; (5) the court should also take into account the nature and extent of the interests prejudiced by delay; and (6) the court need not “find any impropriety lurking behind agency lassitude in order to hold that agency action is ‘unreasonably delayed.’”

TRAC, 750 F.2d at 80.

B. Bertini does not have a clear and indisputable right to a final decision on his preferred timetable.

When analyzing mandamus petitions of this kind, this Court has looked to relevant statutory provisions for language requiring a decision within a certain period. *See In re Jadhav*, 795 F. App’x 846, 848 (Fed. Cir. 2020). Bertini does not and cannot identify any statutory requirement to decide an inter partes proceeding within any period of time. He cites to the statutory provisions regarding the registration of trademarks, but even those provisions have no timetable for a decision. Pet. at 15-16, citing 15 U.S.C. §§ 1051, 1064, 35 U.S.C. § 1. Moreover,

those statutory provisions are not relevant to the underlying proceeding because they relate to the determination of registrability of a mark identified in an application, rather than a determination of the rights in a registration, the subject matter of a cancellation proceeding. The Lanham Act does not provide a specific timeline or timeframe for issuing final decisions for cancellation proceedings. Section 1067 only specifies that “[i]n every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.” 15 U.S.C. § 1067.

Thus, the Lanham Act is silent to any timetable. The absence of any statutory deadline makes clear that Bertini has no clear and indisputable right to relief. *See In re Jadhav*, 795 F. App’x at 848 (where statute only specified that a final order be rendered “as soon as practicable after the commencement of any proceeding,” statute did not create a “clear right” to a decision) *citing In re A Cmty. Voice*, 878 F.3d 779, 784 (9th Cir. 2017) (explaining that ““an agency cannot unreasonably delay that which it is not required to do”).

Bertini seemingly argues that the delay in issuing a petition decision is unreasonable because the USPTO represented that the current petition pendency suggested that review would occur in two months. Pet. at 10. However, the failure

to adhere to certain statistics regarding pendency does not make the delay unreasonable. *Martin*, 891 F.3d at 1346, n.10 (statistics regarding delay are merely speculative and do not serve as an appropriate basis for mandamus). Average pendency does not dictate when any particular petition will be decided, and here there is a case-specific reason, contemplated by governing regulations, that the underlying proceeding has exceeded the average.

The Board did not abuse its discretion in suspending the '213 Proceeding while the related '891 Proceeding was before this Court on appeal. Both Apple and Bertini referred to Apple's '195 Registration in the '891 Proceeding briefing. *See, e.g.*, Bertini's Trial Brief, SAppx744, SAppx754, SAppx759, Apple's Trial Brief, SAppx814, SAppx826, Bertini's Reply Brief, SAppx927, SAppx936. And Bertini discussed the '891 Proceeding in numerous filings in the '213 Proceeding. *See, e.g.*, Bertini's June 26, 2018 Response to Apple's Motion to Dismiss, SAppx276; Bertini's December 18, 2018 Response to Apple's Motion to Dismiss, SAppx355-356; Bertini's January 10, 2020 Motion for Summary Judgment, SAppx382. Moreover, having made a finding regarding the use of the APPLE mark at issue in the '213 Proceeding in the '891 Proceeding decision, the Board reasonably determined that any opinion from this Court regarding the '891 Proceeding could impact the '213 Proceeding.

Bertini complains that the Board was “withhold[ing] a decision until and unless [the] case is settled.” Pet. at 25. The Board’s order stated only that if settlement did *not* occur, the Board would issue a final decision. SAppx722. Bertini’s reading of the language in the order makes little sense. If the parties were to settle, there would be no need for the Board to issue a decision.

Application of the *TRAC* factors makes clear that Bertini is not entitled to relief. The first factor, “the time agencies take to make decisions must be governed by a ‘rule of reason,’” is considered the most important factor. *Martin*, 891 F.3d at 1345 (citing *In re A Cmty. Voice*, 878 F.3d at 786). This Court explained that the second *TRAC* factor relates to the first factor, as “a timetable or other indication of the speed with which [Congress] expects the agency to proceed” may “supply content” for the rule of reason. *Id.* (quoting *TRAC*, 750 F.2d at 80). Here, the statute is silent as to any timetable for a cancellation decision. *See* 15 U.S.C. § 1067. Under the second factor, where Congress has provided a timetable or other indication of the speed with which it expects the agency to proceed in the enabling statute, that statutory scheme may supply content for the first factor’s rule of reason.

Where Congress does not provide a timeframe for issuing decisions, an agency’s actions and timing are given due deference, such that the first and second factors weigh in the USPTO’s favor. *See Mexichem Spec. Resins, Inc. v. EPA*, 787

F.3d 544, 555 (D.C. Cir. 2015). And, an administrative agency is entitled to considerable deference in controlling its own docket, including whether to suspend proceedings and setting timetables for completing proceedings. *In re Boston Beer*, 198 F.3d at 1373; *Cutler v. Hayes*, 818 F.2d 879, 896 (D.C. Cir. 1987) (citing *Sierra Club v. Gorsuch*, 715 F.2d 653, 658 (D.C. Cir. 1983)).

The third and fifth factors, which analyze the “impact on human health and welfare and economic harm,” and “the nature and extent of the interests prejudiced by the delay,” likewise weigh against a finding of unreasonable delay. To the extent that there has been any delay, it has impacted only Bertini’s commercial interests, rather than human health and welfare, which does not weigh in Bertini’s favor. *See Cutler*, 818 F.2d at 898 (delay that is “less tolerable when human lives are at stake” may “be altogether reasonable in the sphere of economic regulation.”); *Martin*, 891 F.3d at 1346 (reviewing third and fifth factor together) citing *In re A Cmty. Voice*, 878 F.3d at 787. Although Bertini asserts that cancelling the registration at issue is in the public interest because Apple relies on its APPLE MUSIC registration in opposition proceedings, seeking to cancel a registration to prevent its enforcement is not an impact on human health and welfare, no matter how Bertini characterizes Apple’s enforcement efforts. Asserting only an impact to his commercial interests, Bertini cannot demonstrate that these factors weigh in his favor.

Moreover, even Bertini's claim of commercial harm is specious. Bertini mistakenly asserts that Apple's '195 Registration "is the only remaining obstacle to Bertini's registration of APPLE JAZZ." Pet. at 6. But the USPTO issued a refusal to register Bertini's APPLE JAZZ mark based on a likelihood of confusion with Apple's registered marks covered by Registration No. 4088195 and Registration Nos. 2034964 and 3317089. *See, e.g.*, SAppx65-92. Bertini only petitioned to cancel Registration No. 4088195. SAppx93-274. The refusal to register Bertini's APPLE JAZZ mark based on Registration Nos. 2034964 and 3317089 remain unaffected by the outcome of the '213 Proceeding.

Under the fourth factor, "the effect of expediting delayed action on agency activities of a higher or competing priority," Bertini fails as well. The Board panel members assigned to the underlying proceeding have other cases in their dockets and to order them to issue a decision within two weeks would take their attention away from other proceedings and any decisions they may be drafting. A judicial order requiring a decision for the Cancellation would simply move others awaiting a decision further back in the queue, resulting in no net gain. *See In re Barr Lab., Inc.*, 930 F.2d 72, 75 (D.C. Cir. 1991) (rejecting mandamus petition to advance an FDA application because "a judicial order putting [petitioner] at the head of the queue simply moves all others back one space and produces no net gain").

Although Bertini does not specifically address the final *TRAC* factor, “the court need not find any impropriety lurking behind agency lassitude in order to hold that agency action is ‘unreasonably delayed,’” he alleges that the delay is due to Board impropriety. Pet. at 22-30. As discussed above, the Board’s application of regulations governing suspension was entirely proper.

Finally, Bertini’s due process and Administrative Procedure Act (APA) claims likewise fail because the standards for both claims are essentially identical to the standard applied under the Mandamus Act. *Norton v. S. Utah Wilderness All.*, 542 U.S. 55, 63–64 (2004) (APA and Mandamus Act unreasonable delay standards the same); *Martin*, 891 F.3d at 1348 (“a claim that a plaintiff has been denied due process because of delayed agency action is essentially no different than an unreasonable delay claim; indeed, if there is any difference at all, it is that an unreasonable delay claim would likely be triggered *prior to* a delay becoming so prolonged that it qualifies as a constitutional deprivation of property.”) (emphasis in original).

C. Attorney’s Fees

Bertini includes in his petition a request for attorneys’ fees. Because Bertini’s petition is without merit, he is not entitled to fees. In addition, this request does not comply with the requirements of Fed. Cir. R. 47.7, and includes no accounting of the fees requested. The Director will respond to a procedurally

compliant request for attorneys' fees if so directed by the Court. *See* Fed. Cir. R. 47.7(a)(3).

IV. CONCLUSION

For the foregoing reasons, the petition for a writ of mandamus should be denied.

Dated: November 28, 2023

Respectfully submitted,

/s/ Erica Jeung Dickey
FARHEENA Y. RASHEED
Acting Solicitor

ERICA JEUNG DICKEY
MARY BETH WALKER
Associate Solicitors

Office of the Solicitor
U.S. Patent and Trademark Office
Mail Stop 8, P.O. Box 1450
Alexandria, Virginia 22313-1450
(571) 272-9035

*Attorneys for the Director of the United
States Patent and Trademark Office*

CERTIFICATE OF COMPLIANCE

I certify pursuant to Fed. R. App. Proc. 32(a)(7) that the foregoing **Response of the Director of the United States Patent and Trademark Office** complies with the type-volume limitation required by the Court's rule. The total number of words in the foregoing brief, excluding the table of contents and the table of authorities, is 3163 as calculated using the Word® software program.

/s/ Erica Jeung Dickey
Erica Jeung Dickey
Associate Solicitor
Office of the Solicitor
U.S. Patent and Trademark Office
Mail Stop 8, P.O. Box 1450
Alexandria, Virginia 22313-1450
(571) 272-9035