No. 24-105

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# United States Court of Appeals for the Federal Circuit

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IN RE CHARLES BERTINI,

*Petitioner*

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Reply to Responses of United States Patent and Trademark Office and Apple Inc., to Charles Bertini's Petition for Writ of Mandamus in Cancellation Case No. 92068213 for APPLE Registration No. 4088195

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**REPLY BY CHARLES BERTINI**

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# 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:

a. On December 18, 2020 Apple filed an application to register APPLE MUSIC in Class 41 for entertainment services, Serial No. 90394966. This is not the same application that was the subject of the Federal Circuit case in which the Federal Circuit reversed the Trademark Trial and Appeal Board's decision dismissing Bertini's Opposition to the registration of APPLE MUSIC, i.e. *it is a second application under the same name and in the same Class as the first application. See 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).

This application was suspended by the examining attorney due to a likelihood of confusion with Bertini's prior application to register APPLE JAZZ.

b. On September 13, 2020 Apple filed an application to register APPLE MUSIC 1 in Class 41 for entertainment services, Serial No. 90177287. This application was published for opposition, and on November 10, 2023 Bertini filed an Opposition.

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: December 4, 2023

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

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## INTRODUCTION

The essence of the Response by the USPTO is the following.

Even though the law requires the PTO to decide trademark disputes, the law does not specify when it must decide them, so Bertini's case can be undecided for any period of time the USPTO chooses, despite its long-established policy to decide cases in ten weeks.

## ARGUMENT IN REPLY

### I. The Suspension Fallacy

The PTO Response attempts to paint Bertini as unreasonable because he demands a final decision on his "preferred timetable," and asks the Court to deny Bertini's Petition because "now that the relevant litigation has ended, the proceedings have resumed." The Response neglects to mention that the proceedings have only been resumed *after/because Bertini filed the Petition*.

The Response states that the suspension is the result of "a routine application of the Board's regulations that contemplate a suspension of proceedings while a related matter is in litigation," but neither it or the Suspension Order justifies how the Cancellation case regarding *nonuse* in commerce of the APPLE '195 mark could be affected by the Opposition case where the issue was *priority* between APPLE JAZZ's date of first use in June 1985 and APPLE MUSIC's date of first use of June 2015. In its

Final Decision in the Opposition case the Board recognized that the issue was priority between APPLE JAZZ and APPLE MUSIC. Appx001-003 Neither the Suspension Order nor the Response refers to any statute, regulation or case where priority of two different marks can affect a third mark's use or non-use in commerce, requiring suspension of a cancellation case involving that third mark.

Moreover, the February 9, 2022 suspension based on the priority of a different mark contradicts the spirit of the Trademark Modernization Act ("TMA") which went into effect on December 18, 2021. The purpose of the TMA is to clear away unused trademarks. The Lanham Act at 15 U.S.C. §1066a allows any person to file a cancellation of any trademark not in use in commerce without any requirement to prove priority of use of any other mark. But in this Cancellation case, the TTAB won't even begin to review Bertini's claim that Apple has never used the Mark in commerce in Class 41.

Additionally, the Suspension Order was made one year after the trial was completed. When the file was marked "Submitted for Final Decision" on February 23, 2021 it surely didn't mean that it *wasn't* submitted for final decision. Appx017 This was not disputed in the Response.

At the time the Cancellation case was filed, the existence of the Opposition case came to the attention of the Board with its filing, and the

Board didn't determine that the Opposition case had a bearing on the Cancellation case. The Response didn't address how the Opposition case had a bearing on the Cancellation case. Neither did the Response address the reason that the Board allowed the Cancellation case be litigated through trial, only to suspend it one year after the trial was completed. Bertini alleged in the Petition that the TTAB required Bertini to litigate two separate cases when there were alternatives that would have preserved judicial resources and avoided exhausting Bertini and Counsel. The Solicitor did not dispute that characterization.

The Opposition case was decided in favor of Apple in five months as a result of the "routine application of the Board's regulations". (That decision was later reversed by this Court. *Bertini v. Apple Inc.,* 63 F.4th 1373; 2023 U.S. App. LEXIS 7935 (Fed. Cir. 2021). According to the Solicitor these regulations also mean that a refusal to decide the Cancellation case in nearly three years is "in due course". Therefore, according to the USPTO, "in due course" is undetermined and for an unlimited period of time. The PTO's application of the regulations in this manner, regulations that the PTO created and which Bertini is powerless to change, makes his case extraordinary.

It was necessary for Bertini to mention the Mark during the Opposition litigation because Apple pleaded it as an Affirmative Defense, but Apple didn't use this defense in its Trial Brief, which was necessarily filed after Bertini's Trial Brief. However, in this mandamus request, Bertini alleged that the TTAB disconnected the Mark from the Opposition case, because in the Final Decision the Board stated "Applicant was unable to establish its use of the mark for any of these services prior to Opposer's 1985 priority date." This means that at least from the date of this April 16, 2021 Final Decision, the Opposition and Cancellation cases have no bearing on each other. This was not disputed in the Response, and the fact that Bertini mentioned the Mark in the Opposition litigation does not mean that the marks are connected or have bearing on each other. Therefore, suspension after April 16, 2021 was unreasonable and improper, and it strongly demonstrates that the TTAB didn't want to decide the Cancellation case.

## II. The USPTO Doesn't Deny that Bertini Has No Adequate Means of Relief

The Response doesn't refute Bertini's position that he has no "adequate means to obtain the relief" desired. It disputes that his right to relief is "clear and indisputable" by claiming that there is no statutory timeline for the USPTO to decide his case and thus he can never complain.

It also disputes that "the writ is appropriate under the circumstances." It does this by using a 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. The Response analyzes the first two of six factors regarding the time to make a decision, and concludes that there is no time requirement on the PTO and thus in essence it never has to decide a case.

The Response uses cases that support Bertini, stating: "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)." In fact, any "rule of reason" would not possibly support (a) a one-year failure to act after trial, (b) an improper and unsupported suspension, (c) a failure to decide a motion challenging that suspension for nearly two years, and (d) a failure to decide a Petition to the Director after it is due.

The *Martin* case further articulates the rule of reason: "The 'rule of reason' analysis must, of course, look at the particular agency action for which unreasonable delay is alleged. It is reasonable that more complex and substantive agency actions take longer than purely ministerial ones." *Martin v. O'Rourke*, 891 F.3d 1338, 1345 (Fed. Cir. 2018). In this case, the agency

action is not complex. In the Response it is not shown that this case is complex. It is a routine decision on a case at the TTAB normally decided within ten weeks and where the only issue is whether a registrant did or did not use the Mark in commerce in Class 41.

The Response further states that the third and fifth factor weigh against Bertini because his health is not harmed, although issuance of a writ of mandamus is not limited to health matters.

Referring to the fourth factor, the Response states "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." *There are no Board panel members assigned to this case, an explanation provided by Bertini's lawyer in a Declaration.* The Response continues: "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." Bertini's case has *already* been moved to the back of the queue where it is stalled, and all new cases that come in after it are decided ahead of it, i.e. within ten weeks.

Twice the Response cites a nonprecedential case to support its position, *In re Jadhav*, 795 F. App'x 846 (Fed. Cir. 2020). In that case, the

Petitioner sought mandamus directing the Merit Systems Protection Board to take immediate action instead of having to wait 180 days. The Court declined to order mandamus "under these circumstances" but stated: "However, the court will not rule out the possibility that the delay here could become egregious in the future, which could merit a reconsideration of the issue." The nearly three-year delay in this case is surely egregious.

Again the Response quotes *In re A Cmty. Voice*, 878 F.3d 779, 784 but neglects to include the entire sentence, which is "Of course, an agency cannot unreasonably delay that which it is not required to do, so the first step before applying the TRAC factors is necessarily to determine whether the agency is required to act, that is whether it is under a duty to act." The PTO admits in its Response that it is under a duty to act.

## III. The Response Doesn't Dispute That TTAB Policy is to Decide Cases and Motions in Ten Weeks

The Response doesn't dispute that TTAB policy is to decide cases and motions in ten weeks. It doesn't challenge any of the evidence Bertini supplied, e.g. a TTAB FAQ, regular public statements by Chief Rogers, his interview with the media explaining his power to assign Administrative Law Judges ("ALJs") to cases.

The Response did not address the TTAB's failure to decide Bertini's Motion for Reconsideration of the Suspension Order which he filed in February 2022.

## IV. Nothing Prevents the USPTO or the TTAB From Deciding the Case *Now*

On May 4, 2023 Bertini asked the Director of the PTO to decide the case since the TTAB has not done so. The Petition's Office stated that it would review the case two months from mid-August, i.e. mid-October, and explained that they are experiencing a backlog. Appx056 Upon receipt of Bertini's Petition for Writ of Mandamus on November 1, 2023, the Solicitor's Office realized that (a) the TTAB wasn't eager to decide Bertini's case, (b) the Petition's Office agreed to review the case in mid-October, and (c) the Petition's Office was backed up. At that point, the Solicitor could have pitched in and offered to write the decision for the Director. *This would have resolved the entire matter.* But this did not happen. The filing of the mandamus Petition did not (a) prompt the TTAB to decide the case it marked "Submitted for Final Decision" on February 23, 2021, and that its Suspension Order stated it would decide after the appeal, (b) convince the Petition's Office to decide the case it promised to decide, (c) convince the Solicitor to lend a hand, or (d) announce a date by which it would decide the case. Instead, the institutional decision was to waste more government time

and further prevent Bertini from having his day in court by arranging for the Solicitor to file a Response attaching more than a thousand pages of appendices (even though many of these were not cited in the Response).[1]

None of this was necessary, and it is further proof that the USPTO is not sincere and has never been sincere about deciding this case. It supports Bertini's position *a fortiori* that this is an extraordinary situation that cannot be resolved without the intervention of this Court.

## V. If, after the Petition for Writ of Mandamus Was Filed, the PTO Decided to Become Sincere About Deciding the Case, it Could Have Set a Timetable For Doing So

The TTAB lifted its suspension on November 13, 2023, apparently in response to Bertini's filing of the Petition for a Writ of Mandamus, and stated that the Cancellation case will be decided "in due course". But as explained above "in due course" in the USTO is undetermined and for an unlimited period of time. It could have easily stated that the decision will be made in, say, 30 days, at which point the Solicitor would have requested Counsel's agreement to an extension of time to file a Response for 40 days, which Counsel would have given and which the Court would likely have granted.

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[1] According to Fed. Cir. Rule 30(a)(1)(B) "Parts of the record must not be included in the appendix unless they are cited in the briefs."

Then, after the case was decided this mandamus request would become moot, saving the time of the Solicitor, Apple, Bertini and preserving judicial resources. Instead, the Board stated that it would be decided "in due course", a phrase also relied on in the Response, even after Bertini explained that this phrase is meaningless because Judge Rogers stated that Bertini's Motion for Reconsideration of the Suspension Order would be decided "in due course", way back in July 2022. The fact that the Judge made this statement was undisputed in the Response.

## VI. According to the Response, the USPTO Never Has to Decide the Case

The Response states "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." This is a remarkable statement. It effectively repudiates the PTO's statutory obligation to decide cases. It is yet additional proof that this situation is extraordinary, because the United States government has taken the position that there is no time limit by which it must decide a contested legal case in its administrative court.

Regarding the last sentence in the Suspension Order which mentions settlement, the Solicitor disputes Bertini's interpretation of the meaning of the sentence, and explains "The Board's order stated only that if settlement

did not occur, the Board would issue a final decision." But the Response does not state *how long* the Board will wait for this possible settlement to occur. Since Bertini explained that neither he nor Apple informed the Board that they are engaged in settlement discussions and that neither asked for a delay – which the Solicitor did not dispute – the only way this sentence can be interpreted is that it is yet another expression of the principle that the PTO doesn't ever have to decide this case.

Referring to the Petition's Office email that it would review the case two months from mid-August, i.e. mid-October (Appx056), the Response states "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." This is followed with the statement that the PTO cannot be held to "adhere to certain statistics regarding pendency." But this email is not citing a statistic: it is a statement by the Petition's Office *regarding this particular case*. In any event, at this time 3.5 months have elapsed since that two-month promise was made and yet the Petitions Office has not acted.

## VII. Even When the PTO Does Indicate a Time Frame to Decide This Case, it Reneges

A. The case was marked "Submitted for Final Decision" on February 23, 2021, and TTAB policy is to decide cases in ten weeks.

B. The Suspension Order of February 2022 stated that the TTAB would decide the case after the appeal is decided. The appeal was decided on April 4, 2023, and according to the Solicitor the time for filing a petition to the U.S. Supreme Court expired on October 4, 2023.

C. Judge Rogers stated in July 2022 that the Motion for Reconsideration would be decided in due course.

D. The 2022 and 2023 letters to the legislators stated that the case will be decided after Bertini's appeal of priority is determined, which occurred on April 4, 2023.[2]

E. The Petition's Office stated that the case will be reviewed by that Office two months from mid-August, i.e. mid-October.

## VIII. The PTO and Apple Wrongly Claim That This Case is Not Extraordinary Because Other Marks Block Bertini's Registration

Both the PTO Response and the Apple response state that this

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[2] The Response by the PTO did not deny that TTAB officials conspired to deceive Congresswoman Val Demings.

mandamus request is not extraordinary because Bertini cannot register his trademark anyway due to other marks which block his registration. Bertini disagrees that those marks will prevent registration, but this is not the correct place to have a discussion about that.

**CONCLUSION**

Since suspension cannot be justified, the delay in deciding this case should be considered to have begun on February 23, 2021. The law doesn't establish any timeframe to decide the case and the USPTO has demonstrated its strong position not to decide it, so without this Court's intervention it may never issue a decision.

The PTO doesn't dispute that Bertini has no adequate means of relief. Bertini's right to mandamus is clear and indisputable, and the writ is appropriate under the circumstances. This situation is extraordinary.

December 4, 2023

/s/ James Bertini

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**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 2,838 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: December 4, 2023

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