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Comparing Apple to Apple

On April 4, 2023, jazz musician Charles Bertini emerged victorious in his legal battle against tech giant Apple Inc. *Charles Bertini v. Apple Inc.* Case 21-2301, Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board No. 91229891. To provide some background, in 2015, Apple launched a streaming service and filed for federal trademark protection of its APPLE MUSIC mark in connection with "production and distribution of sound recordings and arranging, organizing, conducting, and presenting live musical performances." Bertini, with his brother serving as his attorney, opposed the application on the basis that APPLE MUSIC would cause confusion with his "Apple Jazz" brand, which he had used since 1985 in connection with festivals and concerts and eventually with distributing sound recordings under his record label. Although Bertini never registered APPLE JAZZ, he maintained common law trademark rights in the mark, which can defeat an application under Section 2(d) of the Lanham Act (15 U.S.C.A. § 1052(d)) in instances in which the trademarks could be confused.

TTAB Ruling

Initially, the Trademark Trial and Appeal Board (TTAB) found, and both parties agreed, that Bertini's APPLE JAZZ was distinct and had a priority date of June 13, 1985, in connection with "[a]rranging, organizing, conducting, and presenting concerts [and] live musical performances." Both parties also agreed that there was a likelihood of confusion between APPLE JAZZ and APPLE MUSIC. Thus, the only issue before the TTAB was deciding who was the senior user of the APPLE mark.

Apple argued that it was entitled to a priority date of August 1968, based on trademark rights it purchased from Apple Corps for the APPLE mark (Reg. No. 2034964). Apple argued that it was entitled to tack its 2015 use of APPLE MUSIC onto Apple Corps' 1968 use of APPLE, meaning Apple would be the senior user of the APPLE mark. The doctrine of tacking allows trademark owners to modify their marks over time without losing priority, provided that the old and new marks create the same, continuing commercial impression, but the standard for tacking is strict. The TTAB ultimately found that Apple Corps continuously used its APPLE mark on gramophone records, and other recording formats since August 1968 and that Apple was entitled to tack its 2015 use of APPLE MUSIC onto Apple Corps' 1968 use of APPLE. The TTAB dismissed Bertini's opposition.

Federal Circuit Reverses

Bertini appealed. The U.S. Court of Appeals for the Federal Circuit found that the TTAB misapplied the doctrine of tacking, that Bertini had priority of use for APPLE JAZZ as to live musical performances, and reversed the Trademark Trial and Appeal Board's dismissal of Bertini's opposition to Apple's application to register APPLE MUSIC. The Federal Circuit noted that this case raised "a question of first impression regarding the appropriate tacking standard in the registration context: whether a trademark applicant can establish priority for *every* good or service in its application merely because it has priority through tacking in a *single* good or service listed in its application." The Federal Circuit found that the TTAB errored in allowing Apple to claim absolute priority for all the services listed in its application based on a showing of priority for one service listed in the application.

The Federal Circuit concluded that the TTAB conflated the tacking standard with the standard for oppositions. "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," the panel said. "The reverse is not true."

Bertini and his brother were pleased with the Federal Circuit's decision and hope that "this decision will also help other small companies to protect their trademark rights." Apple hasn't yet decided whether to appeal the Federal Circuit's decision, but we will continue to monitor and provide an update in the event this matter proceeds to the Supreme Court.

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