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

Proceeding	91229891
Party	Plaintiff Charles Bertini
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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 REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

Opposer Charles Bertini files this Reply in Support of Motion for Summary Judgment ("Motion" Dkt. 36-38) and opposing the Response ("Response" Dkt. 40-42) by Applicant.

The Response raises new affirmative defenses, is supported by a surprise witness not identified in the Initial Disclosures, introduces previously undisclosed documents, and references some of Opposer's deposition testimony without supplying copies of the transcript. Importantly, the Response does not dispute 62 of the Motion's 64 Undisputed Facts ("UF"). Some of the new affirmative defenses are not clearly labeled, or are deceptively labeled as disputed facts. Opposer objects to these new affirmative defenses.

Applicant has not complied with this Board's August 16, 2018 Order to Compel at Dkt. 35. I did receive some response from Applicant to the Order: a package was dropped outside my home-office near the street by UPS two days after the Order's deadline when I was away rather than sent by email due to the "highly confidential nature of the documents," according to an email from attorney Jason Gonder who did not require a signature for delivery. The Order states at P8 "Applicant must produce the portion of the identified settlement agreements concerning trademarks in response to Requests for Production Nos. 4, 5 and 6." However, no documents produced were responsive to Nos. 4 or 5 and there was no privilege log. See James Bertini Reply Declaration ("James **Reply** Decl.") ¶3, Ex. 154. According to Wikipedia, as a condition of

settlement of a lawsuit in 1981 Apple Computer agreed not to enter the music business. Irina Bertini Reply Declaration ("Irina **Reply** Decl.")¶ 9, Ex. 152. This supports Opposer's position that Applicant didn't provide entertainment services in Class 41 at least prior to June 5, 1985, and Opposer asks that the Board decide this issue in Opposer's favor.

Applicant's claim to be a famous company in recent years (P12) and reference to "the Apple family of marks" (P1) are not relevant to the use of mark APPLE in Class 41 on or before June 5, 1985. On and before June 5, 1985 Applicant was using the trade name Apple Computer, Inc. (UF 24) and it was known for its Macintosh computers and related software. UF 24, Ex. 126. It is undisputed that no application for standard character mark APPLE in Class 9 and Class 41 was ever filed at the USPTO by the Applicant or by Apple Corps prior to June 5, 1985, the date of first use by Opposer. UF 15, 42, 43 and 44. As it is shown in the Motion and below neither Apple Corps nor Applicant used mark APPLE in Class 9 or Class 41 at least during years 1982-1986. Apple's family of marks in Classes 9 and 41 simply didn't exist on the date of June 5, 1985. There is nothing in the Lanham Act supporting the idea that an unregistered, abandoned one-word, foreign mark can reserve rights for all combinations of that word in all classes in the future. The law at 15 U.S.C. § 1127 prohibits reserving rights in marks without use in commerce.

The USPTO already ruled that combinations using the word "apple" are not conflicting with the single word APPLE marks including in Class 41. The PTO registered marks APPLEJAXX and APPLE JAM in Class 41 (UF 9, 10) when Reg. Nos. 2,034,964 and 3,317,089 existed in Class 9 (UF 44, 45, 53). The USPTO found that mark BLACK APPLE in Class 41 (Ser. No. 76447732) doesn't conflict with any mark (Reg. No. 2,034,964 existed on this date). The Priority Action for BLACK APPLE issued on March 11, 2003 states: "The examining attorney … has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d)." Irina **Reply** Decl. ¶ 2 Ex. 150. APPLE JAM was not found to be conflicting with any mark when Registrations 2,034,964 and 3,317,089 existed in Class 9 and the Application for Reg. No. 4088195 was pending. UF 10, 15, 44 and 53. It is clear that the

combination of word "apple" with other words doesn't create the same commercial impression as single word "apple" used as a trademark, otherwise the above marks would not be registered.

New Affirmative Defenses Raised in the Response

In its Answer at PP3, 4, Applicant's only affirmative defenses are APPLE marks Reg. Nos. 2,034,964, 3,317,089 and 4,088,195. But in the Response Applicant raises unpleaded affirmative defenses as disputed facts: (a) APPLE JAZZ is descriptive and therefore it is not a protectable mark, PP22, 23; (b) Opposer lacks proprietary rights in his common law mark, PP20, 21; (c) tacking of APPLE MUSIC to unregistered foreign common law mark APPLE, P14; (d) date of first use by Opposer, P5. The Fed. R. Civ. P. 8(c) and 12(b) require affirmative defenses to be pleaded in an Answer. A defendant may not rely on unpleaded affirmative defenses. *See* Fed. R. Civ. P. 56 (a) and (b); TBMP 311.02(c); *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715, 1717 n.5 (TTAB 1991) (defense that opposer lacks proprietary rights in its common law mark raised for first time in final brief was neither pleaded nor tried); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) (defense of tacking must be pleaded to put opposer on notice of new matter that applicant is placing at issue). Opposer objects to these new defenses. To the best of its ability to identify all of the new defenses spread throughout of the Response, Opposer will address them in this Reply.

APPLE JAZZ is a Protectable Mark

There are five classifications of trademarks: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. *See Taco Cabana Int'l, Inc. v. Two Peso, Inc.*, 505 U.S. 763, 768 (1992). The Tenth Circuit has defined these terms as follows: "…An arbitrary mark has a common meaning unrelated to the product for which it has been assigned." *See, Heartsprings, Inc. v. Heartsprings, Inc.*, 143 F.3d 550, 555 (10th Cir. 1998). Moreover, two dictionary words which might be generic on their own and incapable of protection, when combined, can function as a protectable mark. *See Hunt Masters, Inc. v. Landry's Seafood Restaurant, Inc.*, 240 F.3d 251, 254 (4th Cir. 2001). The common meaning for the word "apple" is a fruit and for "jazz" is a

music genre. None of these words separately or both together describe or are related to services provided by the Opposer. UF3, Ex. 132. APPLE JAZZ is an arbitrary mark for *all services* provided by the Opposer since it is a unique unitary mark. Motion P12. The Examining Attorney in the Office Action didn't identify APPLE JAZZ as descriptive mark, **therefore APPLE JAZZ mark already passed the test to be a protectable mark** since the application to register Opposer's mark in the Principal Register was refused only under Section 2(d). James Bertini Decl. ¶3, Ex. 130. In any event during more than 30 years of use Opposer's mark is naturally distinctive since a reservoir of goodwill has been developed in the APPLE JAZZ mark among a number of dedicated customers, fans, musicians and contractors of APPLE JAZZ. Charles Bertini Decl. ¶10, all Exs. to the Motion.

In an effort to prove that APPLE JAZZ is not a protectable mark, the Response at P23 states that the word "apple" is commonly used in Central New York State to refer to harvest festivals and cultural events. Ex. H. **It is not shown in any exhibit that mark APPLE JAZZ was used for such events.** On P12 of the Motion Opposer clearly demonstrated that his mark is a unitary mark. On Opposer's registered logo the words are presented as one word AppleJazz (Declaration of Charles Bertini for Reply ¶9, ("Charles **Reply** Decl."), Ex. 59) showing that the elements of a mark are **so integrated and merged together that they cannot be regarded as separable.** Therefore, "apple" events are irrelevant since the APPLE JAZZ mark is not used to identify any of these events.

Opposer Has Exclusive Rights in His Mark APPLE JAZZ

Opposer coined the mark APPLE JAZZ and he has been using his mark for decades; no one has claimed ownership of this mark or sent him a cease and desist letter. UF 2, 4. APPLE JAZZ is not only used as a name for the band but also used for a number of services offered under this mark and provided by Opposer. Charles Bertini Decl. 2, 8, Ex. 124. A verified statement of ownership of the mark was included to the Response to Office Action (James Bertini Decl. ¶5, Ex. 68) and it is part of USPTO records. Opposer disclosed and presented as exhibits multiple

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