Bertini v. Apple Inc., 63 F.4th 1373 (Fed. Cir. 2023) (Moore, Taranto, Chen)

BY RICHARD A. CRUDO

In June 2015, Apple began using the mark APPLE MUSIC for its streaming services and filed a trademark application seeking to register the mark for production and distribution of sound recordings and arranging, organizing, conducting, and presenting live musical performances. Charles Bertini, a professional jazz musician, opposed Apple's registration, arguing that it would likely cause confusion with his common-law trademark APPLE JAZZ, which he had been using in connection with festivals and concerts since the mid-1980s.

The Trademark Trial & Appeal Board dismissed Bertini's opposition. Even though Bertini had been using his mark for thirty years before Apple filed its application, the Board held that Apple was entitled to an earlier priority date under the "tacking doctrine," which allows trademark owners to "tack" the date of an earlier mark's first use onto a subsequent use of a commonly owned mark if the marks are so similar that the consumers would regard them as essentially the same. The Board found that Apple could claim priority to August 1968 based on rights to the mark APPLE that it had purchased from an unaffiliated company Apple Corps (the Beatles' record company), even though that mark was limited to gramophone records only.

The Federal Circuit reversed. Reaffirming that the tacking doctrine is narrow in scope and the standard for invoking tacking is "strict," the court held that "[t]acking a mark for one good or service does not grant priority for every other good or service in [a] trademark application." Instead, "[a] trademark owner must show tacking is available for each good or service for which it claims priority on that ground." Thus, even if Apple could successfully claim priority to Apple Corps' 1968 use of the mark APPLE for gramophone records, that alone did not entitle Apple to a 1968 priority date for other services relating to live musical performances. Rather, Apple was required to separately establish tacking for those services.

The court held that "[t]acking a mark for one good or service does not grant priority for every other good or service in [a] trademark application." Instead, "[a] trademark owner must show tacking is available for each good or service for which it claims priority on that ground."

That, in turn, required Apple to show substantial identity between its APPLE MUSIC mark and Apple Corps' APPLE mark with respect to the particular goods and services that those marks identify. "Goods and services are substantially identical for purposes of tacking," the court held, "where the new goods or services are within the normal evolution of the previous line of goods or services." The court concluded that Apple could not make such a showing because "[n]othing in the record supports a finding that consumers would think Apple's live musical performances are within the normal product evolution of Apple Corps' gramophone records." Accordingly, the court held that Apple was not entitled to tack its use of APPLE MUSIC for live musical performances onto Apple Corps' 1968 use of APPLE for gramophone records. And, because Bertini used APPLE JAZZ for live musical performances nearly thirty years before Apple used its APPLE MUSIC mark, the court reversed the Board's dismissal of Bertini's opposition.

OTHER CASE:

- *In re Float'N'Grill LLC*, 72 F.4th 1347 (Fed. Cir. 2023) (Prost, Linn, Cunningham) (affirming Patent Office's rejection under 35 U.S.C. § 251 of reissue claims as impermissibly broader than the original patent, where the claims omitted structure that the specification described as essential to the invention).