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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Charles Bertini		
Entity	Individual	Citizenship	UNITED STATES
Address	10825 Wheaton Ct Orlando, FL 32821 UNITED STATES		

Attorney information	James Bertini 423 Kalamath st Denver, CO 80204 UNITED STATES Email: jamesbertini@yahoo.com Phone: 3035723122

Registration Subject to Cancellation

Registration No.	4088195	Registration date	01/17/2012
International Registration No.	NONE	International Registration Date	NONE
Registrant	Apple Inc. One Apple Park Way Cupertino, CA 95014 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 1981/03/01 First Use In Commerce: 1981/03/01
All goods and services in the class are subject to cancellation, namely: Education and training services, namely, arranging and conducting personal training, classes, workshops, conferences and seminars in the field of computers, computer software, online services, information technology, website design, and consumer electronics; arranging professional workshop and training courses; computer education training services; trainingin the use and operation of computers, computer software and consumer electronics; online journals, namely, blogs featuring general interest topics covering a wide variety of topics and subject matter; providing on-line publications in thenature of magazines, newsletter and journals in the field of computers, computer software and consumer electronics; providing information, podcasts and webcasts in the field of entertainment via the Internet concerning movies, music, videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events; digital video, audio and multimedia publishing services; providing entertainment information regarding movies, music, videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events; providing information, reviews and personalized recommendations of movies, music, videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events in the field of entertainment; entertainment services, namely, production of live musical performances; entertainment services, namely, providing live musicalperformances online via a global computer network; rental of digital entertainment content in the nature of movies, music,

videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events, by means of communications networks, namely, provision of non-downloadable audio and audiovisual programs via an online video-on-demand service; providing a database of digital entertainment content in the nature of movies, music, videos, television, sports, news, history, science, politics, comedy,children's entertainment, animation, culture, and current events via electroniccommunication networks; entertainment services, namely, providing prerecorded audio and audiovisual content, information and commentary in the fields of music,concerts, videos, movies, television, books, news, sports, games and cultural events all via a global computer network

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Related Proceedings	Opposition No. 91229891

Attachments	Petition to Cancel.pdf(32168 bytes)

Signature	/james bertini/
Name	James Bertini
Date	03/19/2018

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

CHARLES BERTINI	)	
	)	
Petitioner,	)	Cancellation No. _____
v.	)	Registration No. 4088195
	)	Date of Issue: January 17, 2012
APPLE INC.	)	Mark: APPLE
	)	
Respondent.	)	
_____ ___	)	

PETITION FOR CANCELLATION

Charles Bertini, a Florida sole proprietor believes that he is and will be damaged by Registration No. 4088195 for the mark APPLE, and hereby petitions to cancel this Registration. As grounds therefore, it is alleged that:

1. Petitioner has been, and is, engaged in

Arranging, organizing, conducting, and presenting concerts, live musical performances, entertainment special events in the nature of musical and cultural events, arts and cultural events, theatrical entertainment in the nature of live theatrical performances, competitions in the field of entertainment, contests for entertainment purposes, musical and film festivals for cultural or entertainment purposes, and exhibitions for entertainment purposes; production and distribution of television programs and sound recordings; provision of live entertainment, namely, live musical performances, and temporary use of online non-downloadable recorded entertainment featuring musical performances; providing websites featuring entertainment information, music information, news in the fields of music and entertainment, and arts and culture

information; providing websites featuring information in the field of entertainment, music, news in the fields of music and entertainment, and arts and culture; entertainment services, namely, providing information, schedules in the nature of concert schedules, reviews and personalized recommendations of entertainment in the nature of music, arts and cultural events, concerts, live musical and cultural performances, competitions in the field of entertainment, music and film festivals for cultural or entertainment purposes, and exhibitions for entertainment purposes; ticket reservation and booking services for entertainment, arts and cultural events, concerts, live musical performances, competitions in the field of entertainment, music or film festivals for entertainment purposes, and exhibitions for entertainment purposes; entertainment services, namely, providing reviews, and providing interactive websites for the posting and sharing of reviews, all relating to entertainment, art and cultural events, concerts, live musical performances, competitions in the field of entertainment, music and film festivals for cultural or entertainment purposes; providing a website for the uploading, storing, sharing, viewing and posting of images, audio, videos, online journals, blogs, and multimedia content in the fields of music; publication of newsletters, blogs, journals, and articles, all in the fields of music and entertainment; providing websites featuring non-downloadable publications in the nature of newsletters, blogs, journals, and articles, all in the fields of music and entertainment; arranging, producing in the nature of, recording, mixing, editing and sound engineering, researching musical compositions, publishers, artists, recordings, and licensing for music production services; arranging and conducting educational competitions for students in the field of business; arranging and conducting educational competitions for students in the field of entertainment.

2. Since at least as early as June 5, 1985 and continuing to date, Petitioner has made continuous use or the mark APPLE JAZZ in commerce to identify and distinguish his services.

3. APPLE JAZZ began operation as a jazz band with the location for its annual APPLE JAZZ concerts held in the City of Cortland, New York. New York State is the second largest apple-producing state and home of the Cortland apple. The word “apple” in the Petitioner’s mark refers to the fruit, and APPLE JAZZ was selected as the service mark since the jazz genre of music was being promoted in apple country.

4. A reservoir of goodwill in the APPLE JAZZ service mark exists in a number of dedicated customers, fans, musicians and contractors of APPLE JAZZ which has been developed during more than three decades.

5. On June 5, 2016, Petitioner filed an application to register the mark APPLE JAZZ to identify the above services (Serial No. 87060640).

6. In an official Trademark Office Action dated September 17, 2016, Petitioner’s application to register APPLE JAZZ for the above services in class 041 (Serial No. 87060640) was refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), because it was deemed to be likely to cause confusion between Petitioner’s mark and U.S. Trademark Registration No. 4088195 for APPLE (the “Mark”).

7. The Registrant of the Mark is Apple Inc., a California corporation (the “Respondent”).

8. On March 22, 2008 the Respondent had filed an application to register the Mark for “*Education and training services, namely, arranging and conducting personal training, classes, workshops, conferences and seminars in the field of computers,*

computer software, online services, information technology, website design, and consumer electronics; arranging professional workshop and training courses; computer education training services; training in the use and operation of computers, computer software and consumer electronics; online journals, namely, blogs featuring general interest topics covering a wide variety of topics and subject matter; providing on-line publications in the nature of magazines, newsletter and journals in the field of computers, computer software and consumer electronics; providing information, podcasts and webcasts in the field of entertainment via the Internet concerning movies, music, videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events; digital video, audio and multimedia publishing services; providing entertainment information regarding movies, music, videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events; providing information, reviews and personalized recommendations of movies, music, videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events in the field of entertainment; entertainment services, namely, production of live musical performances; entertainment services, namely, providing live musical performances online via a global computer network; rental of digital entertainment content in the nature of movies, music, videos, television, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, and current events, by means of communications networks, namely, provision of non-downloadable audio and audiovisual programs via an online video-on-demand service; providing a database of digital entertainment content in the nature of movies, music, videos, television, sports,

news, history, science, politics, comedy, children's entertainment, animation, culture, and current events via electronic communication networks; entertainment services, namely, providing prerecorded audio and audiovisual content, information and commentary in the fields of music, concerts, videos, movies, television, books, news, sports, games and cultural events all via a global computer network."

9. The basis for the application for the Mark was 1(b) and 44(d).

10. The foreign filing date of the Mark is September 28, 2007.

11. After several suspensions of the application a Notice of Allowance was issued on May 11, 2010.

12. After several extensions of time to file a Statement of Use ("SOU"), Respondent filed yet another request for extension of time to file an SOU on November 11, 2011.

13. Also on the same day of November 11, 2011 Respondent filed an SOU and a Declaration.

14. The sole specimen submitted with the SOU was a screenshot of a website without an indication on the specimen of the date or time that the screenshot was made.

15. This specimen did not contain any indication on it of the webpage or website it represents.

16. It was stated in the SOU: "The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) A page from Applicant's website showing use of the applied for mark APPLE in use for education and training services course offerings."

17. It was stated in the SOU: “The mark is in use in commerce on or in connection with all goods or services listed in the application or Notice of Allowance or as subsequently modified for this specific class”

18. It was stated in the Declaration filed simultaneously with the SOU: “Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.”

19. Based on the SOU, the sole specimen and the Declaration, Registration No. 4088195 was issued on January 17, 2012 indicating a priority date September 28, 2007.

20. When the Petitioner began offerings its services in the music and entertainment industry in Class 041 under mark APPLE JAZZ at least as early as June 5, 1985, Apple Inc. was a company named Apple Computer, Inc. known as a computer and software company.

21. In 1985 Apple Computer, Inc. didn’t have or use any trademark in Class 041 for the services listed in the APPLE JAZZ application or in the Certificate of Registration No. 4088195.

FRAUDULENT PROCUREMENT

22. All previous allegations are repeated.

23. The Respondent in its SOU knowingly and intentionally made specific false, material representations of fact in connection with its application to register the mark, with the intent to deceive the USPTO and to obtain a registration to which the Respondent is otherwise not entitled.

24. The statement in the SOU that “The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) A page from Applicant's website showing use of the applied for mark APPLE in use for education and training services course offerings” was false as explained below.

25. This SOU statement was false because on the date of SOU, the www.apple.com website didn’t offer any online seminars in connection with word mark APPLE as is shown on the specimen.

26. This SOU statement was specific.

27. This false SOU statement was made knowingly and intentionally by the Respondent.

28. This SOU statement was material as explained below.

29. This SOU statement was made in connection with Respondent’s application to register the Mark.

30. This SOU statement was made with the intent to obtain a registration to which Registrant was otherwise not entitled.

31. This SOU statement was made with the intent to deceive the USPTO.

32. Without this SOU statement and specimen, registration could not be obtained.

33. The USPTO was deceived, and it issued a registration.

34. This caused damage to the USPTO and Petitioner.

35. The Respondent in its SOU knowingly and intentionally made a ***second*** specific false, material representation of fact in connection with its application to register the

Mark, with the intent to deceive the USPTO and to obtain a registration to which it is otherwise not entitled.

36. This second SOU statement was: “The mark is in use in commerce on or in connection with all goods or services listed in the application”.

37. This second SOU statement was false because no services listed in the application or SOU were offered by the Respondent on its website in connection with the word Mark APPLE on the date of the SOU.

38. This statement was specific.

39. This false statement was made knowingly and intentionally by the Respondent.

40. This statement was material as explained below.

41. This statement was made in connection with Respondent’s application to register the Mark.

42. This statement was made with the intent to obtain a registration to which Registrant was otherwise not entitled.

43. This statement was made with the intent to deceive the USPTO.

44. Without this statement, registration could not be obtained.

45. The USPTO was deceived, and it issued a registration.

46. This caused damage to the USPTO and Petitioner.

47. The Respondent in its SOU Declaration knowingly and intentionally made a ***third*** specific false, material representation of fact in connection with its application to register the Mark, with the intent to deceive the USPTO and to obtain a registration to which it is otherwise not entitled.

48. This statement was: “Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.”

49. This statement was false because no services listed in the application or SOU were offered by the Respondent on its website in connection with the word Mark APPLE on the date of the SOU.

50. This statement was specific.

51. This false statement was made knowingly and intentionally by the Respondent.

52. This statement was material as explained below.

53. This statement was made in connection with Respondent’s application to register the Mark.

54. This statement was made with the intent to obtain a registration to which Registrant was otherwise not entitled.

55. This statement was made with the intent to deceive the USPTO.

56. Without this statement, registration could not be obtained.

57. The USPTO was deceived, and it issued a registration.

58. This caused damage to the USPTO and Petitioner.

59. Accordingly, Registration No. 4088195 was obtained fraudulently and according to 15 U.S.C. § 1064 it should be canceled in its entirety.

ABANDONMENT

60. Petitioner incorporates by reference the allegations contained in all previous paragraphs.

61. Respondent has not used the Mark in commerce in connection with education and training services for the period at least from November 11, 2011 to date.

62. The notice “Seminars & Events listings and registration site is no longer available” appeared on the Respondent’s website at least as in 2013 and this notice continued to be carried on the website through at least March 9, 2018.

63. Respondent is presumed to have abandoned any trademark rights it may have in the Mark in connection with “education and training services”.

64. Therefore according to 15 U.S.C. § 1064(3) the Mark must be cancelled in part regarding education and training services.

PRIORITY OF USE

65. On information and belief, Respondent does not have any basis for claiming rights in the Mark prior to Petitioner's first use in commerce of the APPLE JAZZ.

66. Petitioner's date of first use in commerce of the APPLE JAZZ mark at least as early as June 5, 1985, predates by more than 20 years the September 28, 2007 priority date for the Mark obtained by the Respondent based on its foreign registration filing date in the European Community.

67. Thus, Petitioner has priority of use of the APPLE JAZZ mark based on its earlier use in commerce.

68. Petitioner has established a valid right acquired under the law by use of his mark continuing from a date prior to the date of registration of the Mark and according to 15 U.S.C. § 1065 the Mark is contestable and it must be cancelled according to 15 U.S.C. § 1064.

LIKELIHOOD OF CONFUSION

69. According to the USPTO with regard to the application of APPLE JAZZ, the Mark is similar to APPLE JAZZ, and is likely, when applied to Respondent's services, to cause confusion, mistake or deception among consumers within the meaning of 15 U.S.C. § 1052(d).

70. According to the USPTO with regard to the application of APPLE JAZZ, Respondent's services are related to, and would be sold, advertised and directed at the same marketing and trade channels, and to the same consumers, as Petitioner's services, or are in the natural scope of expansion of Petitioner's services.

71. Respondent can easily dominate Petitioner in any online search using its well-established position as a computer/electronics/software producer.

72. Petitioner has been damaged by the Mark's registration because Petitioner's APPLE JAZZ Application was refused based on a finding of likelihood of confusion with the Mark's registration.

73. Further, Petitioner will be damaged in that such registration would support and assist in the infringing use of the mark, and will give colorable exclusive statutory rights to the Respondent in violation and derogation of the prior and superior common law trademark rights of Petitioner.

WHEREFORE, Petitioner requests that this Petition for Cancellation be sustained and that Registration No. 4088195 be cancelled.

Dated: March 19, 2018

Respectfully submitted
By: /James Bertini/
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