ESTTA Tracking number: **ESTTA1034847**

Filing date: **02/10/2020**

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

Proceeding	92068213
Party	Defendant Apple Inc.
Correspondence Address	JOSEPH PETERSEN KILPATRICK TOWNSEND & STOCKTON LLP 1080 MARSH ROAD MENLO PARK, CA 94025 UNITED STATES JPetersen@kilpatricktownsend.com, JGonder@kilpatricktownsend.com, Agarcia@kilpatricktownsend.com, tmadmin@kilpatricktownsend.com 650-614-6427
Submission	Opposition/Response to Motion
Filer's Name	Joseph Petersen
Filer's email	JPetersen@kilpatricktownsend.com, JGonder@kilpatricktownsend.com, Agarcia@kilpatricktownsend.com, tmadmin@kilpatricktownsend.com
Signature	/Joseph Petersen/
Date	02/10/2020
Attachments	Memorandum in Opposition to Bertini Motion for Summary Judgment in Cancellation_APPLE.pdf(1507200 bytes)

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

CHARLES BERTINI, Petitioner, v. APPLE INC., Respondent.	Cancellation No. 92068213 SM: APPLE (Reg. No. 4,088,195)

RESPONDENT APPLE INC.'S MEMORANDUM IN OPPOSITION
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT

On January 10, 2020, Petitioner Charles Bertini ("Petitioner") filed a motion for summary judgment, *see* 20 TTABVUE (the "Motion"), asking the Board to grant his Petition for Cancellation on the basis of abandonment, a claim which requires that Petitioner establish, as a matter of law, that Respondent Apple Inc. ("Apple"): (1) discontinued its use of the APPLE word mark in connection with the entertainment services at issue; and (2) that it did so with an intent not to resume such use.

More specifically, Petitioner contends that Apple abandoned its APPLE word mark in connection with entertainment services between November 2011 and mid-2015 because Petitioner allegedly failed to find media articles (including from Wikipedia) or announcements reflecting Apple's use of the APPLE word mark in connection with such services. In so arguing, Petitioner blithely ignores the voluminous documents Apple has painstakingly gathered and produced, which demonstrate Apple's continuous use of the mark in connection with the services at issue in this proceeding over the course of many years (including the time between November 2011 and

mid-2015). Thus, Petitioner cannot satisfy the first part of the statutory test for abandonment so the Board need not address the second part of that test. Nonetheless, even if there were any significant cessation in use (which is absolutely not the case) that same evidence and testimony would also unquestionably establish Apple's intent to resume use of its mark.

Petitioner's arguments would be baseless at trial, but they are frivolous for summary judgment. In resolving the Motion, the Board's role is to determine only whether there is sufficient evidence to decide the fact-specific issue of abandonment in Apple's favor after drawing all justifiable inferences in Apple's favor. At a minimum, the record demonstrates numerous genuine disputes of material fact. The Board therefore should deny the Motion and set the proceeding for trial.

I. INTRODUCTION AND PROCEDURAL BACKGROUND

This cancellation proceeding is part of Petitioner's quixotic campaign to register the mark APPLE JAZZ for a number of services in Class 41, despite Apple's longstanding rights in its APPLE word mark for a broad array of music and entertainment services dating back to the 1960s. Apple's extensive and prior rights derive in part from Apple's predecessor-in-interest's half-century-long use of the APPLE word mark in connection with music recordings by legendary musical acts, such as The Beatles, James Taylor, and many other famous musicians. The Office predictably (and properly) refused registration to the APPLE JAZZ mark because of Apple's prior rights, citing and maintaining six of Apple's registrations and applications. Petitioner then retaliated by: (1) opposing Apple's June 11, 2015, Application Ser. No. 86/659,444 to register APPLE MUSIC; and (2) filing this cancellation proceeding against *some* of the services covered

in one of the three APPLE registrations cited by the Examining Attorney in refusing registration to Petitioner's APPLE JAZZ mark.[1]

Apple filed three separate motions to dismiss Petitioner's defective initial Petition for Cancellation. *See* 5 TTABVUE; 7 TTABVUE; 14 TTABVUE. Petitioner amended his original Petition voluntarily in response to Apple's first motion to dismiss. *See* 5 TTABVUE; 6 TTABVUE. Thereafter, the Board ruled against Petitioner twice. *See* 11 TTABVUE; 18 TTABVUE. These rulings resulted in: (1) Petitioner's amendment of his pleading for a second time, *see* 12 TTABVUE; and (2) the Board's dismissal, with prejudice, of Petitioner's claim of fraud. *See* 18 TTABVUE. In one of its rulings against Petitioner, the Board admonished him "to review Rule 11 of the Federal Rules of Civil Procedure and ensure that he has a sound factual basis for alleging any grounds to refuse registration other than abandonment." 11 TTABVUE 16. Ultimately, only Petitioner's abandonment claim survived the pleadings stage, if barely. *See* 18 TTABVUE.

Discovery ensued. Apple produced volumes of documents evidencing its continued use of the APPLE word mark in connection with the Disputed Services. Indeed, Apple produced more than 2,000 pages of documents in discovery. Petitioner took no depositions and now has moved for summary judgment. Willfully ignoring the volumes of use evidence produced in this proceeding, Petitioner rests his motion on the theory that: (1) Petitioner's own sporadic, after-the-fact Internet searching purportedly found no evidence—between November 11, 2011 and

[1] Specifically, Petitioner challenges certain components of Apple's registration No. 4,088,195 for the APPLE word mark, which are collectively referred to herein as the "Disputed Services." The Disputed Services can be distilled into the following five categories: (1) providing information, podcasts, and webcasts in the field of entertainment; (2) publishing video, audio, and multimedia; (3) providing entertainment information, including personalized recommendations and reviews concerning digital content; (4) producing, and providing online, live musical performances; and (5) digital media rental services.

June 1, 2015—that Apple used the APPLE word mark for the Disputed Services on the Apple website; (2) press releases purportedly did not reference the APPLE word mark for the Disputed Services; and (3) Wikipedia entries supposedly did not explicitly mention the Disputed Services in discussing the APPLE word mark.

Even if true—and the record demonstrates otherwise—all of this is completely beside the point. As demonstrated by the accompanying declaration of Apple's Senior Director, Thomas R. La Perle, Esq., (the "La Perle Declaration"), Apple has made myriad uses of its APPLE word mark, in *bona fide* and real-world commercial contexts, in connection with all of the Disputed Services between November 11, 2011, and June 1, 2015, and thereafter. Summary judgment is not warranted under these circumstances, and the Board should deny the Motion.

II. STATEMENT OF FACTS

Mr. La Perle's Declaration is extensive and detailed, and Apple respectfully urges the Board to review it, and its exhibits, in their entireties. Among other things, Mr. La Perle's Declaration establishes the following material facts:

1. Apple is one of the most renowned technology companies in the world. La Perle Decl. ¶ 9. Over its more than forty-year history, Apple has earned a reputation for developing innovative, consumer-focused technologies and services. *Id.* Indeed, even at Apple's inception, Apple delivered transformative offerings, beginning with products that ignited the personal computer revolution. *Id.* Since then, Apple has dramatically expanded its array of products and services, which have transformed many fields. *Id.*

2. The APPLE word marks and the Apple Logo (collectively, the "Apple Marks") are among the most famous and widely-recognized in the world. *Id.* ¶ 4.

3. Over the past nearly twenty years, Apple has transformed the way entertainment and information content (both audio and audio-visual content) are distributed in the United States and throughout the world. *Id.* ¶ 12.

Apple's iTunes Store Services

4. In the early 2000s, Apple introduced its revolutionary iPod media player and iTunes suite of technologies and services, including Apple's iTunes content distribution platform. *Id.* ¶ 13. These goods and services transformed music by overcoming the limitations of earlier media technologies, sparking the digital media revolution, and popularizing online downloading and streaming services, which are now ubiquitous. *Id.* These services are also now inextricably associated with Apple and the APPLE word mark. *Id.*

5. More specifically, on April 28, 2003, Apple launched its iTunes Music Store (now called the iTunes Store), which pioneered digital media services by publishing and distributing online an unrivaled and comprehensive catalog of music and audiobooks. *Id.* ¶ 14.

6. In 2003, Apple's iTunes Store popularized digital media with innovative services for content providers and consumers alike. *Id.* ¶ 15. Apple has since expanded these digital media services beyond music and audiobooks to publish and deliver a wealth of content—including exclusive and/or original media—such as podcasts,[2] movies, and TV shows, as well as educational materials, books, and news. *Id.*

7. Apple's iTunes Store has had unprecedented commercial success, making Apple the number one music provider in the world. *Id.* ¶ 18.

8. Apple's iTunes Store video services were likewise an immediate and continuing commercial success, and rapidly expanded to deliver consumers a wealth of content to watch. *Id.*

[2] In fact, the term "podcasting" derives from Apple's goods and services, because it is a portmanteau of "iPod" and "broadcast."

¶ 19. By January 9, 2007, Apple's iTunes Store was the "largest online video store in the world" and provided over "250 feature films" and "350 television shows," including "more than 100 movies from Paramount Pictures." *Id.* Even as early as that date, consumers had already downloaded over 50 million television episodes and 1.3 million feature-length films using Apple's iTunes services. *Id.*

9. At all relevant times, Apple has used the APPLE word mark in association with Apple's Apple iTunes services in a manner that also associates the APPLE word mark with a number of the Disputed Services. *Id.* ¶ 21. Although it is often difficult to locate specimens of use dating back in some instances almost a decade ago, Apple has painstakingly gathered and produced evidence of its use of the APPLE word mark in connection with certain of the iTunes Services that are covered by the Disputed Services descriptions. *Id.* Section V of Mr. La Perle's Declaration itemizes and discusses that evidence in more detail. *Id.*

Apple's Apple TV Services

10. Apple has long used its APPLE word mark with its other media distribution services to deliver the Disputed Services. *Id.* ¶ 22. One such distribution service is Apple TV, a service and associated device that work together to distribute content (e.g., movies, television shows, music, podcasts, Internet radio, and lyrics) and premium content (e.g., live musical performance videos, interviews, interactive galleries, and deleted scenes) to consumers' televisions and other video displays. *Id.*

11. Apple sources the content it distributes via Apple TV from such diverse content providers as Disney, the BBC, Hulu, Netflix, HBO, Sky News, ESPN, *The Wall Street Journal*, Vimeo, and professional sports leagues. *Id.* ¶ 23. By 2013, the Apple TV service had been providing consumers with a catalog of over 60,000 movies and 230,000 TV episodes, and Apple

was in fact delivering, daily, over 800,000 TV episodes and over 350,000 movies to consumers via Apple TV. *Id.* Through its Apple TV services, Apple publishes and delivers an additional wealth of materials, including those exclusive to and/or original to Apple. *Id.* Televisions therefore have become a part of the array of devices on which consumers can seamlessly enjoy media content delivered by Apple, including movie reviews, podcasts, and webcasts. *Id.*

12. At all relevant times, Apple has used its APPLE word mark in association with Apple's Apple TV services in a manner associating the APPLE word mark with the Disputed Services. *Id.* ¶ 24. Apple has painstakingly gathered and produced evidence of its use of the APPLE word mark in connection with the Apple TV-branded services most directly overlapping with the Disputed Services. *Id.* Section V of Mr. La Perle's Declaration itemizes and discusses that evidence in more detail. *Id.*

Apple's Apple Music Services

13. On June 8, 2015, Apple launched Apple Music, a watershed development in entertainment distribution for content providers and consumers alike. *Id.* ¶ 25. Apple Music seamlessly integrates iTunes—which provides consumers with a personal "jukebox" of music purchased from Apple—with expanded music and entertainment offerings. *Id.* These offerings include a subscription-based music streaming service that provides access to Apple's catalog of over 30 million songs. *Id.*

14. With the launch of Apple Music, Apple continued to expand its multimedia publishing and distribution services on behalf of artists and other content providers. *Id.* ¶ 26.

15. Today, Apple provides content from entire digital libraries to its "on the go" customers. *Id.* ¶ 27. With the rise of cloud-based hosting, downloading, and streaming services, these consumers need not even worry about syncing their music players with their computers. *Id.*

Apple has spearheaded these innovations by developing new content distribution platforms and user-friendly, personalized services—all of which Apple offers under and in connection with the APPLE brand. *Id.*

16. At all relevant times, Apple has used the APPLE word mark in association with Apple's Apple Music services in a manner associating that mark with a number of the Disputed Services. *Id.* ¶ 28. Indeed, the dominant component of the APPLE MUSIC mark is, of course, APPLE. *Id.* Apple has painstakingly gathered and produced evidence of its use of the APPLE word mark in connection with certain of the APPLE MUSIC services that most overlap with the Disputed Services. *Id.* Section V of Mr. La Perle's Declaration itemizes and discusses that evidence in more detail. *Id.*

Apple's Apple News Service

17. In June 6, 2011, Apple yet again introduced a new suite of technologies and services. *Id.* ¶ 29. This time, it was for publishing and delivering news and magazines: Apple's Newsstand. *Id.* Like Apple's iTunes and Apple's podcasts offerings, Newsstand integrated media management and store functions, allowing content providers such as newspapers to publish and automatically deliver their materials to subscribers through a consumer-friendly interface. *Id.* On June 8, 2015, Apple released a successor to its Newsstand: Apple News. *Id.*

18. At all relevant times, Apple has used the APPLE word mark in association with Apple's Apple News services in a manner that also associates the APPLE word mark with a number of the Disputed Services, including, but by no means limited to, *digital media publishing*. *Id.* ¶ 30. Apple has painstakingly gathered and produced evidence of its use of the APPLE word mark in connection with certain of the Apple News services most directly overlapping with

the Disputed Services. *Id.* Section V of Mr. La Perle's Declaration itemizes and discusses that evidence in more detail. *Id.*

Apple's Apple Books Services

19. On January 27, 2010, Apple introduced, with its iconic iPad device, a new array of technologies and services for publishing, distributing, and reading books: Apple's iBooks. *Id.* ¶ 31. Like other Apple innovations, this was a significant development for content providers and consumers. *Id.* With the introduction of Apple's iBooks, Apple would begin to deliver a new assortment of content and associated services, including enhanced e-books that are exclusive to Apple. *Id.*

20. Moreover, Apple's services allow content providers to publish e-books that are uniquely enhanced with multimedia, such as animations, audio recordings, and interactive widgets. *Id.* ¶ 32. For example, celebrated author George R. R. Martin published, through Apple's iBooks services, a 20th anniversary enhanced edition of his best-selling book, *A Game of Thrones*. *Id.*

21. On June 12, 2018, Apple announced it would replace its iBooks service with a new suite of technologies and services: Apple Books. *Id.* ¶ 33. The transition from iBooks to Apple Books evinces Apple's continued interest in expanding use of the APPLE word mark with digital media publishing. *Id.* Illustrative examples of this service mark usage appear in Section V of Mr. La Perle's Declaration. *Id.*

Live Musical Entertainment

22. Apple's history, offerings, and brand have long been intertwined with music. *Id.* ¶ 34. As Apple's Chief Executive Officer Tim Cook remarked, "we [at Apple] love music . . .

We've had a long relationship with music at Apple and music has had a very rich history of change, some of which we [at Apple] played a part in." *Id.* at n.14.

23. Apple's enduring relationship with music has long extended to Apple's production and promotion of live musical performances. *Id.* ¶ 35. As a result, the APPLE word mark has long been strongly associated with the production of live musical performances. *Id.*

24. Apple strives to ensure that music, including live performances, is a regular part of the Apple Store—and indeed the Apple—experience. *Id.* ¶ 36.

25. Over the relevant period in the Cancellation, the Apple Store section of Apple's www.apple.com website has consistently featured the APPLE word mark in the advertising of live musical performances that Apple produces. *Id.* ¶ 37. Representative examples of Apple's advertising appear in Section V of Mr. La Perle's Declaration. *Id.*

26. Furthermore, Apple is renowned for its annual Apple Worldwide Developers Conference ("WWDC"), which is so popular that tickets are allocated by lottery and cost approximatley $1,600. *Id.* ¶ 38. Among other things, the Apple WWDC showcases new software and technologies for software developers and consistently delivers live musical performances from various well-known artists, such as Jack White and Khalid. *Id.*

27. In addition to Apple's live music performances at Apple's WWDC, Apple routinely hosts Apple Special Events for particularly important occasions, which also feature live musical concerts by various artists, such as U2, Elvis Costello, Bobby Short, Leon Bridges, Foster The People, Sia, Sara Bareilles, and countless others. *Id.* ¶ 40. Apple has painstakingly gathered and produced evidence of its use of the APPLE word mark in connection with the musical services that are covered by the Disputed Services descriptions. *Id.* Section V of Mr. La Perle's Declaration itemizes and discusses that evidence in more detail. *Id.*

28. In sum, at all relevant times, Apple has used its APPLE word mark with **all** of the Disputed Services and the APPLE word mark is closely associated with such services. *Id.* ¶ 41. The Board therefore should deny Petitioner's motion for summary judgment and dismiss his claims following trial and associated briefing.

III. ARGUMENT

A. Legal Standards

Petitioner's Motion has a high hurdle to clear. The following legal standards govern the Board's consideration of Petitioner's Motion, and therefore frame the genuine disputes of fact material to this proceeding.

1. Petitioner Bears the Heavy Burden of Demonstrating the Absence of Any Genuine Dispute of Material Fact.

Summary judgment is inappropriate because Petitioner cannot show "there is no genuine dispute as to any material fact" such that he "is entitled to judgment as a matter of law." FED. R. CIV. P. 56(a); *see also Tolan v. Cotton*, 572 U.S. 650, 656–57 (2014) ("Summary judgment is appropriate only if . . . there is no genuine issue as to any material fact . . . In making that determination, a court must view the evidence in the light most favorable to the [non-movant]."). As the movant for summary judgment, Petitioner bears the burden of demonstrating "the absence of any genuine dispute of material fact," and this "burden is *greater than the evidentiary burden at trial*." TBMP § 528.01 (emphasis added) (citing cases). Unsurprisingly, given this "heavy burden on the movant," the Board grants summary judgment only "infrequently," *Express, LLC v. EXP613, LLC*, No. 9119491, 2013 WL 10925118, at *3 (TTAB July 16, 2013) (non-precedential), and it should not do so here.

As set forth below, the material fact of abandonment is genuinely disputed because "there is sufficient evidence for the fact finder to decide the question in favor of [Apple]," viewing the

evidence "in a light favorable to [Apple] and [drawing] all justifiable inferences . . . in its favor." *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 767 (Fed. Cir. 1993). Indeed, there does not even need to be a conflict in the evidence to deny Petitioner's Motion. Instead, there only need be an "[o]pposing factual inference," which "may arise from the same set of undisputed . . . facts" and which "the Board must draw" so long as such inferences are "reasonable." *Olde Tyme Foods v. Roundy's, Inc.*, 961 F.2d 200, 202 (Fed. Cir. 1992); *see e.g.*, *Galaxy Metal Gear, Inc. v. Direct Access Techs., Inc.*, No. 91184213, 2009 WL 9294896, at *4 (TTAB May 15, 2009) (non-precedential) (denying summary judgment after drawing all reasonable inferences in favor of the non-movant because "opposing factual inferences may arise from the same set of undisputed subsidiary facts").

2. Abandonment Is a Question of Fact, and Petitioner Bears the Heavy Burden of Establishing Abandonment as a Matter of Law.

Petitioner cannot demonstrate, much less as a matter of law, that Apple has abandoned its rights. Under Section 45 of the Lanham Act, 15 U.S.C. § 1127, a mark is abandoned only "[w]hen its use has been discontinued with [an] intent not to resume such use." Further, in relation to services, the Lanham Act provides that a mark is used in commerce when the mark is "used or displayed in the sale or advertising of services and the services are rendered in commerce." *Id*.

"As the Board has explained, '[b]ecause registrations are presumed valid under the law, the party seeking their cancellation bears the burden of proving a *prima facie* case of abandonment by a preponderance of the evidence.'" *TV Azteca S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1789 (TTAB 2018) (alteration in original) (emphasis added) (first quoting *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1532 (TTAB 2018); then citing *On-Line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1087 (Fed. Cir. 2000); and then citing

Exec. Coach Builders, Inc. v. SPV Coach Co., 123 USPQ2d 1175, 1180–81 (TTAB 2016)). However, at the summary judgment stage, Petitioner's burden to establish abandonment as a matter of law is even higher because "the standard of proof for summary judgment, the absence of a genuine dispute of any material fact, is more stringent than the preponderance of evidence standard for trial." *Mars, Inc. v. PAGS Inc.*, No. 91221462, 2017 WL 3670329, at *2 (TTAB Mar. 30, 2017).

In addition, "[a]bandonment . . . is a question of fact." *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 1390 (Fed. Cir. 2010). Therefore, even at the trial stage—let alone at summary judgment—any inference of abandonment must rest on proven fact. "The protection due the registrant is provided by requiring that the inference [of abandonment] have an adequate foundation in proven fact. Whenever an inference is based on pure speculation and 'there is no basis . . . to infer nonuse, a *prima facie* case of abandonment must fail.'" *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 1024 (Fed. Cir. 1989) (quoting *P. A. B. Produits et Appareils de Beaute v. Satinine Societa in Nome Collettivo di S.A. e. M. Usellini*, 570 F.2d 328, 332–33 (CCPA 1978)).

3. The Cases Cited in Petitioner's Motion Are Inapposite.

Despite these clear standards, and with only one exception, the cases Petitioner's Motion has cited are not ones in which a summary judgment of abandonment was granted. Consequently, all but one of Petitioner's cited abandonment cases are *procedurally* distinguishable from the present case. Indeed, *On-Line Careline*, 229 F.3d at 1087–88, cited at 20 TTABVUE 13, supports *Apple's* position far more than Petitioner's argument, because it held—as is true here—that a mark owner had *not* abandoned its registered mark through nonuse.

The one exception is *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575 (Fed. Cir. 1990), which is *substantively* distinguishable. There, the Federal Circuit affirmed a Board

finding of abandonment on summary judgment. However, that affirmance arose in circumstances where: (1) the Section 44 registrant did not dispute its failure to use its registered mark in the U.S.; and (2) the registrant did not produce sufficient record evidence showing the necessary intent to begin the mark's use. *Id*.

Here, in contrast, Petitioner has not met its high burden of proving, as a matter of law, the requisite nonuse of the APPLE word mark. In fact, quite the contrary: Apple has produced voluminous evidence of use, which Petitioner, ostrich-like, chooses to ignore. The Board therefore need not even reach the issue of Apple's intent to resume (or begin) use, which was the abandonment issue presented in *Imperial Tobacco*.

B. Petitioner's Argument Rests on Speculation, and on Inferences that the Board Is Not Permitted to Draw in Petitioner's Favor.

Rather than grapple with the "voluminous documents" (Petitioner's phrase, at 20 TTABVUE 19) that Apple has produced, which show use of the APPLE word mark in connection with the Disputed Services in a real-world commercial context, Petitioner attempts to obtain summary judgment by figuratively waving his hands and pointing to various places where he thinks the APPLE word mark *should* appear, but allegedly doesn't, *e.g.*, Wikipedia, the www.apple.com website, and press releases. For instance, Petitioner contends that "[Apple] didn't offer any APPLE services to the public during November 11, 2011 – June 1, 2015, otherwise the public *would know* about such services." 20 TTABVUE 16 (emphasis added). Similarly, Petitioner asserts that the Disputed Services "*would [have] be[en] listed* on [Apple's] website and in Wikipedia as is information about other products and services." *Id.* (emphasis added).

Each facet of this position is logically, factually, and legally flawed. First, nothing in the Lanham Act requires that services be "announced" or "listed . . . in Wikipedia," 20 TTABVUE 16, for a mark to be "use[d] in commerce" in connection with the requisite services. *See* 15

U.S.C. § 1127. The Lanham Act instead requires simply that the mark be "used or displayed in the sale or advertising of services and [that] the services are rendered in commerce." *Id*. Mr. La Perle's Declaration amply establishes that, during the relevant time period, the APPLE word mark has been displayed in the sale or advertising of the Disputed Services, and that the Disputed Services have been rendered in commerce. Petitioner seemingly wants to require more of Apple, but has no basis in trademark law for doing so.

Second, Petitioner's allegations about what the public "would know" about Apple's services are rank speculation, supported by no record evidence whatsoever. As outlined in Section III.A.2. above, such speculation and inference against Apple would be baseless even at trial, and is particularly unavailing on summary judgment.

Third, the Registration does not contain any limitation on where the Disputed Services may be offered *other than*, in some instances, "online," "via the Internet," or "via a global computer network" or "communications networks." Thus, Apple's use of its APPLE word mark in connection with Disputed Services rendered through avenues other than its *www.apple.com* website—such as through iTunes or Apple TV—is clearly sufficient to maintain the Registration's Disputed Services.

Fourth, the supposed absence of content on Wikipedia about the APPLE word mark being used in connection with the Disputed Services is irrelevant, given that Wikipedia's content consists of unverified, user-generated, and incomplete summaries of Apple's activities and, in any event, is not intended—and certainly cannot be used—as a vehicle for cataloging all of Apple's uses of the APPLE work mark in commerce.

Fifth, even Petitioner's own evidence reflects use of the APPLE word mark in connection with the Disputed Services between November 11, 2011,[3] and three years thereafter. *See* Declaration of Irina Bertini ("Irina Declaration") at Ex. 53. By way of illustrative examples:

- June 24, 2013: Apple Worldwide Developers Conference to Kick Off June 10 in San Francisco.[4]
- June 19, 2013: HBO GO and WatchESPN come to Apple TV.
- February 19, 2014: Apple Announces iTunes Festival Coming to SXSW—Five Amazing Nights, Five Amazing Shows.
- April 3, 2014: Apple Worldwide Developers Conference to Kick Off June 2 at Moscone West in San Francisco.
- April 14, 2015: Apple's Worldwide Developers Conference Kicks Off June 8 at San Francisco's Moscone West.

Id. at Ex. 53.[5]

Finally, and perhaps most significantly, Petitioner's argument is also belied by the substantial record evidence and documents produced by Apple.[6] Mr. La Perle's Declaration also sets

[3] Because the application that matured into the Registration was originally filed on an intent-to-use basis under Section 1(b), 15 U.S.C. § 1051(b), any purported abandonment cannot, as a matter of law, be assessed until on or after the November 11, 2011 filing of the SOU. *See Consol. Cigar Corp. v. Rodriguez*, 65 USPQ2d 1153, 1155 (TTAB 2002) (holding that for an application based on Trademark Act Section 1(b), "petitioner cannot assert a three-year period of nonuse that began prior to respondent's filing of its statement of use").

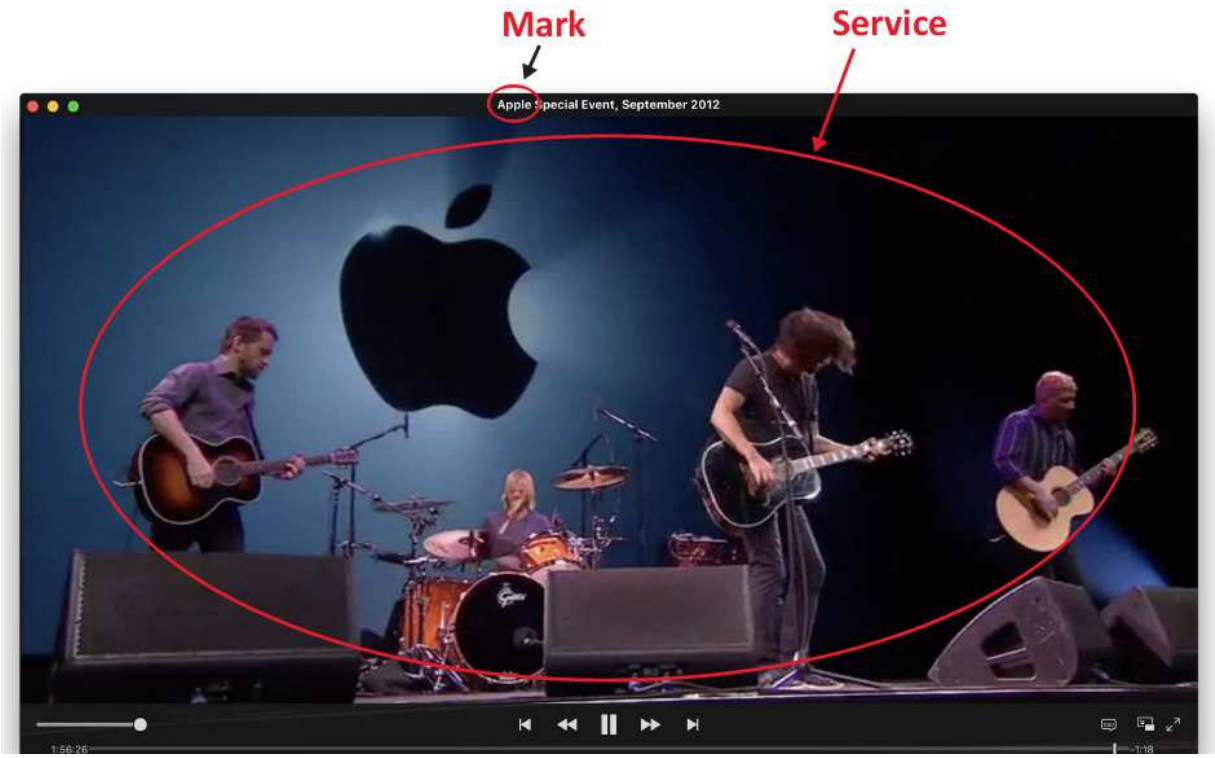
[4] The significance of Apple's Worldwide Developers Conference, and the entertainment services Apple offers in association with it, are discussed in the La Perle Declaration ¶¶ 38-39.

[5] Petitioner may attempt to argue that these examples reflect only "trade name" usage of the word "Apple." *See* Second Amended Petition for Cancellation, 12 TTABVUE ¶ 67. However, it is well established that a name can function both as a trade name and a trademark, and the evidence makes plain that this is the case here. *See In re Univar Corp.*, 20 USPQ2d 1865, 1866 (TTAB 1991) (holding that "a name may function as both a trade name and as a trademark and/or a service mark," which is an issue "of fact" that "is determined from the manner in which the name is used and the probable impact thereof upon purchasers and prospective customers"); *see also* 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 9:15 (5th ed. 2019).

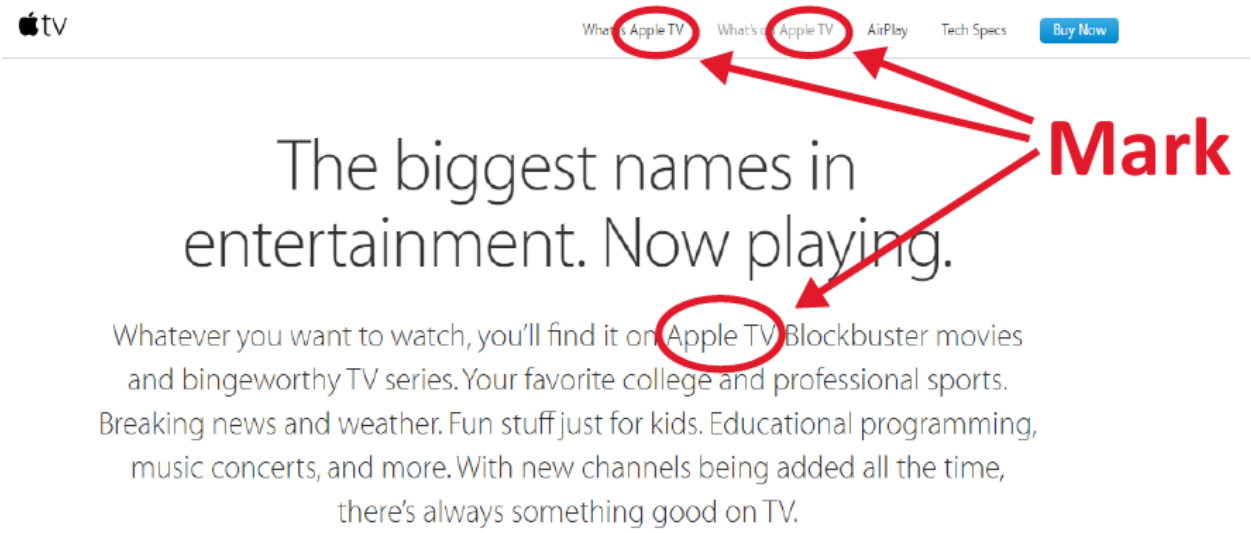
[6] For example, contrary to Petitioner's repeated assertions, Apple has produced copies of tickets for concerts and festivals. *See*, *e.g.*, La Perle Declaration at 161 (¶ 47) (Bates No. AAPL000854).

out, in great detail and with annotated visual examples, how Apple has, in fact, used the APPLE word mark continuously since at least November 11, 2011, in connection with all of the Disputed Services. *See* Section V of the La Perle Declaration ¶¶ 42-49. A few illustrative (and not exhaustive) examples follow:

La Perle Declaration at 209 (¶ 49) (Apple's Apple TV Advertising (November 11, 2011) – Bates No. AAPL001628-29).



La Perle Declaration at 137 (¶ 47) (Still from video of Apple Special Event (2012) – Bates No. AAPL000328).



La Perle Declaration at 58 & 63 (¶ 45) (Apple's Apple TV Advertising (April 7, 2015) – Bates Nos. AAPL000105-10).

La Perle Declaration at 98 (¶ 46) (Apple's Apple Music Advertising (July 1, 2015) – Bates No. AAPL000112).

This evidence establishes Apple's use of the APPLE word mark shown in the Registration in connection with the Disputed Services during the relevant time period, and thus at a minimum establishes a genuine dispute of material fact precluding summary judgment.

D. The Fact that Apple *Sometimes* Combines APPLE with a Generic Term, or Co-Brands Its APPLE Services with Other Marks Apple Owns, Is Irrelevant.

Petitioner did not even try to address Apple's actual evidence of its use of the mark in his moving brief. Petitioner therefore may attempt to introduce new arguments in reply that he did not make in his moving brief. For example, Petitioner may try to argue on reply that use of the APPLE word mark in conjunction with a generic term—such as APPLE MUSIC, APPLE TV, APPLE NEWS, APPLE STORE, and the like—does not, as a matter of law, reflect use of the APPLE word mark shown in the Registration. Any such argument would be without merit.

It is beyond dispute that the Apple Marks are among the most famous and widely-recognized in the world. La Perle Declaration ¶ 4; *see also* 20 TTABVUE 2 (Apple "is one of the largest technology companies") and 14 ("All of [Apple's] products and services are well known to the public because [Apple] is one of the largest companies in the world"). It is therefore similarly beyond dispute that consumers rely upon the presence of the APPLE mark—as opposed to the generic terms "music," "TV," "news," or "store"—to identify and distinguish the source of the services, and to equate, for instance, APPLE MUSIC with APPLE.

Indeed, the Board and other tribunals *routinely* reject arguments that use of a mark in connection with other non-distinct matter impairs a party's trademark rights in the dominant

component of the mark. Such authority, which arises in a number of contexts, such as in tacking and abandonment cases,[7] includes the following:

- *Am. Sec. Bank v. Am. Sec. & Tr. Co.*, 571 F.2d 564, 567 (CCPA 1978), held that the marks "AMERICAN SECURITY BANK" and "AMERICAN SECURITY" were the legal equivalents for tacking purposes because "the word 'bank' is purely descriptive and adds nothing to the origin-indicating significance of AMERICAN SECURITY" such that "the marks [were] legal equivalents."
- *In re Raychem Corp.*, 12 USPQ2d 1399, 1399-1400 (TTAB 1989), reversed a specimen refusal, holding that a specimen containing "TR06AI-TINEL-LOCK-RING 07/22/87" supported registration for "TINEL-LOCK" because the alpha-numeric "part number" and "generic designation" of "Ring" were not essential to the commercial impression of the mark and played no integral role in distinguishing applicant's goods. *Id.*
- *Nat'l Bakers Servs., Inc. v. Hain Pure Food Co.*, 207 USPQ 701 (TTAB 1980), dismissed an opposition because the applicant's prior-registered mark HOLLYWOOD HEALTH FOODS was the legal equivalent of its applied-for HOLLYWOOD mark. Specifically, the Board concluded: "[i]t is our view that purchasers and prospective purchasers of applicant's mayonnaise would perceive both marks

[7] The same standards govern tacking for establishing priority and defeating abandonment claims. *See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S. L. U.*, 797 F.3d 1363, 1369 (Fed. Cir. 2015) ("We hold that the same legal standard applies in both [tacking and abandonment] contexts. Accordingly, when a trademark owner uses a modified version of its registered trademark, it may avoid abandonment of the original mark" where "'the modified version 'create[s] the same, continuous commercial impression.'").

as HOLLYWOOD and would not be deterred from this perception by the descriptive words 'health foods.'" *Id*. at 707.[8]

The same logic applied in these decisions also applies here. Based on the evidence in the record, it is clear that APPLE is the most significant part of the Apple Marks, and that generic terms such as "music" do not interfere with consumer perception that the mark associated with such services is the APPLE mark. At minimum, this fact-intensive issue is inappropriately resolved at the summary judgment stage. *See Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1166-67 (9th Cir. 2013) (issues of whether "Hana" was the most significant part of the defendant's mark and whether relevant consumers likely would overlook the accompanying descriptive terms were issues for the fact-finder at trial), *aff'd*, 574 U.S. 418 (2015).

Petitioner also appears to argue, and may argue in reply, that because Apple has long offered various entertainment services under its ITUNES and ITUNES STORE marks, it could not, as a matter of law, have used the APPLE word mark in connection with such services. *See* 20

[8] *See also Granny's Submarine Sandwiches, Inc. v. Granny's Kitchen, Inc.*, 199 USPQ 564, 566 (TTAB 1978) (holding that "[t]he addition to, or subtraction from, a trademark or service mark of a word purely descriptive of the goods or services distinguished by the mark does not affect the origin-indicating function of the mark" and dismissing a cancellation claim where the petitioner argued that a specimen showing GRANNY'S KITCHEN did not support respondent's registration of GRANNY'S); *Yard-Man, Inc. v. Getz Exterminators, Inc.*, 157 USPQ 100, 106 (TTAB 1968) (rejecting abandonment claim as "not well founded" where the opposer registered the mark YARD-MAN but used the mark in conjunction with Sears' CRAFTSMEN mark and the word SILENT); *Highline Capital Mgt., LLC v. High Line Venture Partners, L.P.*, No. 15-CV-660(VEC), 2015 WL 10847688, at *3 (S.D.N.Y. Oct. 1, 2015) (dismissing abandonment claim against investment management firm, reasoning that because the words "'Capital'" and "'Management'" were "'purely descriptive,'" they did not "'affect the origin-indicating function of the [firm's HIGHLINE] mark,'" such that the claimant failed to plausibly allege that the use of these words following the firm's mark did not constitute use of the mark in commerce); *see also Plus Prods. v. Pharmavite Pharm. Corp.*, 221 USPQ 256, 259 (TTAB 1984) (rejecting abandonment counterclaim where the "word 'Plus' [was] the dominant part of opposer's trade name" and "also formed the basic common element of opposer's trademarks, either . . . by itself or in combination with other terms to form marks such as 'PROTEIN PLUS' and 'YEAST PLUS'").

TTABVUE 4-6 (¶¶ 7-9, 11-13). That position too would be meritless. The fact that Apple's iTunes services have been an overwhelming commercial success, revolutionizing digital media, has no bearing whatsoever on whether Apple used the APPLE word mark in the U.S. in connection with the entertainment services covered by the Registration. Any business may use multiple marks to identify and distinguish the source of its services. Apple too has used multiple marks to identify and distinguish the source of its services, including many of the Disputed Services.

Indeed, Petitioner's argument is reminiscent of the one rejected in *E. Gluck Corp. v. Rothenhaus*, 585 F. Supp. 2d 505, 513–14 (S.D.N.Y. 2008), *abrogated on other grounds by Salinger v. Colting*, 607 F.3d 68 (2d Cir. 2010). In that case, the defendant asserted the plaintiff had abandoned its "NOW" mark in favor of "'Armitron Now'" such that "the NOW mark [was] not incontestable." *Id*. at 512. The plaintiff contended in response that it had properly used a house mark and product mark on some of its products and that doing so did not compromise the protectability of either of the marks. *Id.* at 514. The district court agreed and rejected defendant's abandonment argument. *Id*.; *see also Gen. Foods Corp. v. Ito Yokado Co.*, 219 USPQ 822, 824 (TTAB 1983) (rejecting applicant's counterclaim of abandonment and noting that "[n]othing in the Trademark Act precludes an owner from using more than one trademark on a product and each may be separately registered and separately protected" and further observing that "in today's marketing environment, on products such as those herein involved, the practice of using multiple marks on a product is probably more the rule than the exception"); *BeautyBank, Inc. v. Harvey Prince, LLP*, No. 10 CIV. 00955 (AJN), 2013 WL 11327097, at *9 (S.D.N.Y. Mar. 29, 2013) (rejecting claim that plaintiff abandoned its rights in FLIRT by using FLIRT! BIG FLIRT! on packaging and observing that "FLIRT is apparently being used as a house mark, whereas BIG

FLIRT is being used as a product mark" and that "use of house and product marks together does not constitute abandonment of each one individually").

Apple has opposed Petitioner's Motion with voluminous evidence of Apple's use of its APPLE word mark in connection with the Disputed Services. Such evidence amply supports dismissal of Petitioner's abandonment claim following trial and, therefore, *ipso facto* constitutes a sufficient showing to warrant denial of Petitioner's Motion.

E. If the Board Reaches the Second Prong of the Abandonment Test, Apple Has Nonetheless Raised Disputed Issues of Material Fact About Its Intent to Resume Use of the APPLE Word Mark.

If, despite the foregoing, the Board determines it is necessary to assess Apple's intent to resume use of the APPLE word mark in connection with the Disputed Services, Apple's 2015 launch of its Apple Music service, La Perle Declaration ¶ 25, at minimum creates a genuine dispute of material fact about such intent. For instance, in *Crash Dummy Movie*, the Federal Circuit held that substantial evidence supported the Board's finding, at trial, of a mark owner's intent to resume use of the disputed mark, and held that "[t]he Board may consider evidence and testimony . . . that occurred before or after the three-year statutory period to infer [an] intent to resume use during the three-year period." 601 F.3d at 1391. The evidence adduced here is at least as great as that presented in *Crash Test Dummy Movie*, and, at minimum, creates a disputed issue of fact about Apple's intent to resume use.

F. Petitioner Is Neither Entitled to Further Discovery Nor to a Second Summary Judgment Motion.

Petitioner's motion concludes with a request that, if the Motion is denied, he receive leave to file a second summary judgment motion "after outstanding discovery has been completed." Apple respectfully submits it has complied with all of its discovery obligations, that discovery is now complete, and that if Petitioner believed Apple's discovery conduct was deficient in

some respect, he should have pursued meet-and-confer obligations and filed a motion to compel. Seeking to backdoor such additional relief now is inappropriate and the Board therefore should deny Petitioner's alternative request for relief and schedule this matter for trial.

IV. CONCLUSION

For the foregoing reasons, Apple respectfully asks the Board to deny Petitioner's Motion for Summary Judgment and the alternative relief requested therein.

Dated: February 10, 2020

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON LLP

By: */Joseph Petersen/*

Joseph Petersen
Jason M. Gonder
1080 Marsh Road
Menlo Park, California 94025
Telephone: (650) 614-6427
Facsimile: (650) 644-0570
jpetersen@kilpatricktownsend.com
jgonder@kilpatricktownsend.com

J. David Mayberry
Theodore H. Davis, Jr.
The Grace Building
114 Avenue of the Americas
New York, NY 10036
Telephone: (212) 775-8830
Facsimile: (202) 585-0038
dmayberry@kilpatricktownsend.com
tdavis@kilpatricktownsend.com

William M. Bryner
1001 W. Fourth Street
Winston-Salem, NC 27101
Telephone: (336) 607-7482
Facsimile: (336) 734-2656
bbryner@kilpatricktownsend.com

Attorneys for Respondent Apple Inc.

CERTIFICATE OF TRANSMITTAL

I certify that a copy of the **RESPONDENT APPLE INC.'S MEMORANDUM IN OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT, DECLARATION OF THOMAS R. LA PERLE, ESQ., ANNEXURES A – F and EXHIBITS 1 - 11** were filed electronically with the Trademark Trial and Appeal Board via ESTTA on February 10, 2020.

/Kris Teilhaber/

Kris Teilhaber
Kilpatrick Townsend & Stockton LLP

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

CHARLES BERTINI, Petitioner, v. APPLE INC., Respondent.	Cancellation No. 92068213 SM: APPLE (Reg. No. 4,088,195)

CERTIFICATE OF SERVICE

I hereby certify that on February 10, 2020, a true and correct copy of the foregoing **RESPONDENT APPLE INC.'S MEMORANDUM IN OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT, DECLARATION OF THOMAS R. LA PERLE, ESQ., ANNEXURES A – F and EXHIBITS 1 - 11** were served on Petitioner's Attorney of Record by electronic mail as follows:

James Bertini, Esquire
423 Kalamath Street
Denver, Colorado 80204
jamesbertini@yahoo.com

/Kris Teilhaber/
Kris Teilhaber
Kilpatrick Townsend & Stockton LLP