

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: November 5, 2020

Mailed: April 16, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Charles Bertini

v.

Apple, Inc.
—

Opposition No. 91229891
—

James Bertini, for Charles Bertini.

Joseph Petersen of Kilpatrick Townsend & Stockton LLP, for Apple, Inc.
—

Before Shaw, Kuczma and Hudis,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Apple, Inc. (“Applicant”) has applied to register the standard character mark

APPLE MUSIC for:

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, fairs for entertainment purposes, musical or film festivals for cultural or entertainment purposes, and exhibitions for entertainment purposes; production and distribution of radio programs, television programs, and sound recordings; entertainment services, namely, providing ongoing television, radio, audio programs, video programs, podcast, and webcast programs in the field of entertainment; providing audio and video

programming featuring entertainment, sports, music, information, and news by means of telecommunications networks; entertainment services, namely, providing streamed and downloadable audio and video content to users through a subscription service provided online via a communication network; provision of live entertainment and recorded entertainment, namely, musical performances; providing non-downloadable audio and video programming featuring entertainment, sports, music, informational, and current events news programming; providing websites and computer applications featuring entertainment information, sports information, music information, news in the fields of music and entertainment, and arts and culture information; providing websites and computer applications featuring information in the field of entertainment, music, sports, 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, fairs for entertainment purposes, music or 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, fairs for entertainment purposes, music or film festivals for entertainment purposes, and exhibitions for entertainment purposes; entertainment services, namely, providing reviews, entertainment surveys, and ratings, and providing interactive websites and computer applications for entertainment purposes for the posting and sharing of reviews, entertainment surveys, and ratings of users all relating to entertainment, art and cultural events, concerts, live musical performances, competitions in the field of entertainment, entertainment fairs, music or film festivals for cultural or entertainment purposes, and exhibitions for entertainment purposes; providing non-downloadable ringtones, pre-recorded music, video programs, and graphics for use on mobile communications devices via a global computer network and wireless networks; providing a website for the uploading, storing, sharing, viewing and posting of images, audio, videos, online journals, blogs, podcasts, and multimedia

content; publication of books, periodicals, newspapers, newsletters, manuals, blogs, journals, and articles, all in the fields of music and entertainment; providing websites featuring non-downloadable publications in the nature of books, periodicals, newspapers, newsletters, manuals, blogs, journals, and articles, all in the fields of music and entertainment; news reporting in the field of music and entertainment, in International Class 41.¹

Charles Bertini (“Opposer”) opposes registration of Applicant’s mark on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on his asserted common law rights in the mark APPLE JAZZ for services that are “the same as or substantially identical to services intended to be offered by Applicant under its alleged mark of APPLE MUSIC.”² Opposer pleaded ownership of a pending application for the mark APPLE JAZZ in standard characters for:

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

¹ Application Serial No. 86659444 was filed on June 11, 2015 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), claiming a bona fide intention to use the mark in commerce. Applicant claimed priority under Trademark Act Section 44(d), 15 U.S.C. § 1026(d), based on Jamaican Application No. 67176 filed on May 18, 2015. The term MUSIC is disclaimed.

² Notice of Opposition ¶ 6, 1 TTABVUE 5.

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, in International Class 41.³

In its Amended Answer, Applicant denied the salient allegations of the Notice of Opposition. Applicant pleaded the affirmative defenses of priority and ownership of

³ Notice of Opposition ¶ 10, 1 TTABVUE 9; 37 TTABVUE 46-51 (Ex. 132) Application Serial No. 87060640 was filed on June 5, 2016 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming a date of first use anywhere and in commerce at least as early as June 5, 1985. The term JAZZ is disclaimed.

three registrations comprising APPLE marks, (including two registrations which it purchased from an unrelated entity, Apple Corps, Ltd.) for arguably related goods and services (see below the discussion of the APPLE registrations accompanying Applicant's Notices of Reliance), and that Opposer's mark is "comprised of a descriptive term and a geographically descriptive term, and the claimed mark lacked distinctiveness as of Apple's priority date."⁴ The parties fully briefed the issues and appeared for oral argument. For the reasons discussed below, we dismiss the opposition.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the subject application. The parties filed a stipulation on May 29, 2019 regarding the authenticity of certain documents and the admissibility of certain discovery depositions.⁵ The parties also introduced the following evidence:

1. Trial Declaration of Opposer Charles Bertini ("Bertini Decl.") with exhibits relating to Opposer's use of his mark;⁶
2. Opposer's Notices of Reliance, including Applicant's discovery responses and objections, Internet documents, and USPTO official records;⁷

⁴ Amended Answer, 48 TTABVUE 19-23.

⁵ 53 TTABVUE.

⁶ 59-61 TTABVUE.

⁷ 62-66 TTABVUE.

3. Declaration of Jeffrey Vaughan Jones, Chief Executive Officer of Apple Corps Ltd. (“Jones Decl.”) with exhibits relating to Apple Corps’ use of the mark APPLE;⁸
4. Declaration of Thomas R. La Perle, Esq., Applicant’s Legal Department Senior Director (“La Perle Decl.”) with exhibits relating to Applicant’s use of APPLE marks and the purchase of Apple Corps’ rights in its APPLE marks;⁹
5. Applicant’s Notices of Reliance, including Opposer’s discovery responses, printed publications, USPTO official records, the deposition of Charles Bertini (“Bertini Dep.”), Internet documents, and status and title copies of the following three registrations owned by Applicant:
 - a. Registration No. 2034964, issued February 4, 1997 and renewed, for the mark APPLE in typed form for “Gramophone records featuring music; [and] audio compact discs featuring music” and claiming a date of first use of August 1968,
 - b. Registration No. 3317089, issued October 23, 2007 and renewed, based on Section 44(e), for the mark APPLE in standard characters for, inter alia, “Musical sound records”, and
 - c. Registration No. 4088195, issued January 17, 2012, for the mark APPLE in standard characters for, inter alia, “entertainment services, namely, providing prerecorded audio and audiovisual content . . . in the fields of music” and claiming a date of first use of March 1, 1981;¹⁰

⁸ 71 and 72 TTABVUE.

⁹ 83-85 TTABVUE.

¹⁰ 67-70 and 73-82 TTABVUE. Registration Nos. 2034964 and 3317089 issued to Apple Corps, Ltd., but were assigned to Applicant via a 2007 settlement agreement. *See* La Perle Decl. ¶ 48, 83 TTABVUE 19, Ex. 23 to La Perle Decl., 85 TTABVUE (confidential), and Ex. 24 to La Perle Decl., 83 TTABVUE 253-58; *see also* Assignment Abstracts of Title Information, 67 TTABVUE 17-18 and 22.

6. Opposer's Rebuttal Trial Declaration of Charles Bertini ("Bertini Rebuttal Decl."), including exhibits related to his use of the APPLE JAZZ mark;¹¹ and
7. Opposer's Rebuttal Notices of Reliance on Internet documents.¹²

II. Evidentiary Issues and Objections

The parties raise numerous evidentiary issues and objections to each other's evidence and briefs, including objections on the grounds of hearsay, relevance, timeliness, lack of probity, and lack of personal knowledge. We address the parties' arguments and objections as follows.

A. Applicant's Brief

In his Reply Brief, Opposer objects to the form of Applicant's brief, on the ground that Applicant uses extensive footnotes to avoid the page limit. Opposer argues that many of the brief's 141 footnotes "do not reference evidence, but rather additional facts, cases, case analysis and argumentation."¹³

Single-spaced footnotes containing substantial discussion may be viewed as a subterfuge to avoid the page limit. *Consorzio del Prosciutto di Parma v. Parma Sausage Prods. Inc.*, 23 USPQ2d 1894, 1896 n.3 (TTAB 1992). More importantly, arguments raised only in footnotes are waived. *Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280, 102 USPQ2d 1729, 1739 (Fed. Cir. 2012).

The vast majority of Applicant's footnotes comprise evidentiary citations and amplifications or clarifications of evidentiary points. The remaining footnotes do not

¹¹ 86 TTABVUE.

¹² 87 and 88 TTABVUE.

¹³ Opposer's Reply Br., p. 21, 92 TTABVUE 22.

contain substantial discussion; they merely provide additional material supporting propositions discussed in the body of the brief. We find Applicant's use of footnotes is not a subterfuge to avoid page limits. The objection is overruled and we have considered Applicant's trial brief, including the footnotes.

B. Applicant's 1981 and 1991 settlement agreements

In his brief, Opposer points out that Applicant failed to comply with the Board's order to produce Applicant's 1981 and 1991 settlement agreements with Apple Corps.¹⁴ Opposer alleges the agreements are relevant because "[a]ccording to publicly available information in online encyclopedia Wikipedia regarding the Agreement of 1981: 'Apple Computer agreed not to enter the music business'."¹⁵ Applicant does not address Opposer's contention but simply states that Apple Corps and Apple Computer "settled their differences in 2007, when Apple [Computer] acquired Apple Corps' trademark and service mark rights in the APPLE Mark dating back to August 1968."¹⁶

The Board ordered that "Applicant must produce the portion of the identified settlement agreements concerning trademarks [dated 1981 and 1991 between Applicant and Apple Corps] in response to [Opposer's] Requests for Production."¹⁷

The order further explained that:

In the event that Applicant fails or has failed to provide Opposer with full and complete responses to the discovery requests identified in the motion [including the 1981 and 1991 settlement agreements], . . . Applicant may, upon

¹⁴ Opposer's Br., p. 24 ¶ 69, 89 TTABVUE 24.

¹⁵ *Id.*

¹⁶ Applicant's Br., p. 20, 90 TTABVUE 22.

¹⁷ Board's Order, p. 7, 35 TTABVUE 7.

timely objection by Opposer, be barred from relying upon or later producing documents or facts at trial that were properly sought, but withheld from such discovery.¹⁸

As noted in the Board's order, settlement agreements that have avoided litigation may show limitations on party's rights in a mark. *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 197 (TTAB 1976). The 1981 and 1991 agreements between Applicant and Apple Corps could have shown limitations on Applicant's rights in its APPLE marks in the United States. However, inasmuch as Opposer did not object to Applicant's omissions, and Applicant does not seek to rely on them,¹⁹ we will not sanction Applicant or draw any adverse inferences from Applicant's failure to produce the settlement agreements. Nevertheless, in light of the clear intent of the Board's order, we view with great disfavor Applicant's failure to adhere to the Trademark Rules of Practice and comply with the order.

C. Hearsay objections to matter in documents

Applicant objects on the ground of hearsay to certain portions of Opposer's evidence consisting of newspapers articles and advertisements related to the APPLE JAZZ band and concerts. Applicant argues that "[t]o the extent that Opposer uses these to show the truth of the matter asserted . . . they are inadmissible hearsay."²⁰

¹⁸ *Id.* at 10 n.17, 35 TTABVUE 10.

¹⁹ In addition, as discussed below, we find that Applicant is unable to establish its own use of the mark APPLE for musical recordings or their production and distribution prior to Opposer's earliest priority date. In the alternative, Applicant relies on the trademark rights it purchased from Apple Corps.

²⁰ App. A to Applicant's Br., 90 TTABVUE 63.

Opposer objects to a number of Applicant's evidentiary submissions from various publications on the ground of hearsay as well.²¹

The Board considers website and Internet printouts and other materials introduced under a notice of reliance without supporting testimony only for what they show on their face rather than the truth of the matters asserted therein. *See Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). However, although printed publications cannot be used to prove the truth of the statements contained in them, Rule 803(16) of the Federal Rules of Evidence provides that a "statement in a document that is at least 20 years old and whose authenticity is established" is an exception to the hearsay rule. Newspapers and periodicals are self-authenticating. *See Fed. R. Evid. 902(6)*. In addition, inasmuch as witnesses for a party may have authenticated or testified to the provenance of such documents we also find that they meet the authenticity requirements of Fed. R. Evid. 901(b)(8). The objections are overruled as to documents that are over twenty years old. Either party may rely on printed publications more than twenty years old for the truth of the statements asserted therein, whether introduced through a notice of reliance on printed publications or through testimony. *See Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1086 n.20 (TTAB 2014). Printed publications less than twenty years old may not be relied on for the truth of the statements asserted therein.

D. Opposer's Objection to the Jones' declaration.

Opposer objects to much of Jeffrey Vaughan Jones' declaration testimony and the accompanying exhibits on the grounds of foundation and hearsay because Jones, who

²¹ App. A to Opposer's Br., 89 TTABVUE 53.

began working for Apple Corps (Applicant's predecessor-in-interest) in 2007, fails to state who gave him the relevant information or whether he has personal knowledge of the exhibits.²² Jones' declaration states:

Except where otherwise stated, all information provided within this declaration is either personally known to me, or is information which has been provided to me (especially in relation to matters prior to my appointment in May 2007) and all of which I believe to be true, and/or has been obtained by me from the books and records made in the usual and ordinary course of Apple Corps' business.²³

Apple Corps' claims of use of APPLE marks date back to 1968, more than fifty years ago. It is unreasonable to expect persons familiar with a businesses' history dating back to the late 1960s to remain employed after such a long period of time. In such cases—where testimony relies on institutional knowledge—the Board has stated that pursuant to Federal Rule of Evidence 803:

It is recognized that where a corporation has been in existence for a considerable period of time, there may not be an individual currently with the organization that could relate vital statistics of the business based upon personal knowledge and that therefore proper recourse may be made to historical documents and similar documents maintained by the corporation over the years, in the normal operation thereof or even to biographical matter, provided the material is made of record subject to the scrutiny and cross-examination of the adverse party.

Transamerica Fin. Corp. v. Trans-American Collections, Inc., 197 USPQ 43, n.6, (TTAB 1977). Opposer was free to cross-examine Jones regarding Apple Corps' books

²² *Id.*, 89 TTABVUE 58-62

²³ Jones Decl. ¶ 1, 71 TTABVUE 2.

and records if he was dissatisfied with Jones' declaration.²⁴ Opposer chose not to do so. Accordingly, we overrule the objection and have considered the Jones declaration.

E. Other objections

The remaining objections generally go to the weight or relevance, rather than the admissibility, of the evidence. Given the nature of the objections, coupled with their number, we see no compelling reason to discuss each objection. In assessing the remaining objections, we employ the same standards the Board has noted before:

[W]e simply accord the evidence whatever probative value it deserves, if any at all. . . . Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations, and this precludes the need to strike the testimony and evidence.

Hunt Control Sys. Inc. v. Koninklijke Philips Elec. N.V., 98 USPQ2d 1558, 1564 (TTAB 2011), *rev'd on other grounds*, Civ. No. 11-3684, 2017 WL 3719468 (D.N.J. Aug. 29, 2017). As necessary and appropriate, we will point out any limitations of the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. We have considered all of the testimony and evidence introduced into the record. In doing so, we have kept in mind the various objections raised by the parties and we have accorded whatever probative value the subject testimony and evidence merit.

²⁴ See Parties' Stipulation ¶ 6, 53 TTABVUE 3. *Cf. WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (opposer's objection to applicant's testimony declarations overruled where opposer had opportunity to cross-examine the witnesses but chose not to do so).

III. Entitlement to Statutory Cause of Action

We now refer to standing as entitlement to a statutory cause of action. *Peterson v. Awshucks SC, LLC*, 2020 BL 509515, at *5 n.34 (TTAB 2020); *Major League Soccer, LLC v. F.C. Int'l Milano S.p.A.*, 2020 USPQ2d 11488, at *5 n.18 (TTAB 2020). Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 of the Trademark Act remain equally applicable. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020). As the Court of Appeals for the Federal Circuit has observed, there is “no meaningful, substantive difference between the analytical frameworks” in the prior “standing” case law, under which an opposer must show a real interest in the proceeding and a reasonable basis for its belief in damage, *see Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), and the current “entitlement” case law, under which an opposer must show an interest falling within the zone of interests protected by statute and damage proximately caused by registration. *Corcamore*, 2020 USPQ2d 11277, at *4. Thus, “a party that demonstrates a real interest in [opposing registration of] . . . a trademark under [Trademark Act Section 13, 15 U.S.C. § 1063] has demonstrated an interest falling within the zone of interests protected by [the Trademark Act]. . . . Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of [§ 1063].” *Id.* at *7.

In his motion for summary judgment, which was partially granted by the Board, Opposer established his statutory entitlement to bring this opposition proceeding by

submitting a copy of his pleaded application for the mark APPLE JAZZ and an Office Action citing Applicant's pending application as a potential bar to registration of Opposer's mark based on likelihood of confusion.²⁵ Opposer has established his statutory entitlement to bring this opposition proceeding.²⁶ *See Fiat Grp. Autos. S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111, 1112 (TTAB 2010) ("The filing of opposer's application and the Office's action taken in regard to that application [a provisional refusal based on the involved application] provides opposer with a basis for pleading its . . . [entitlement to a statutory cause of action]").

IV. Grant of Partial Summary Judgment

In an order dated March 1, 2019, the Board granted Opposer's motion for summary judgment, in part, with respect to the issue of likelihood of confusion, and denied the motion, in part, with respect to the issue of priority of use.²⁷ The only remaining issues are priority and whether Opposer's mark is primarily merely geographically descriptive and lacks secondary meaning.

V. Priority

To prevail on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, based on a previously used mark, it is the Opposer's burden to prove both priority of use and likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir.

²⁵ 37 TTABVUE 46-51 (Exhibit 132), 150-53.

²⁶ 45 TTABVUE 5.

²⁷ 45 TTABVUE 16.

2000). As noted above, the Board granted Opposer's motion for summary judgment, in part, with respect to the issue of likelihood of confusion.

A party seeking to oppose registration of a mark under Section 2(d) must prove that it has proprietary rights in the term it relies upon to demonstrate likelihood of confusion as to source. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). A party may establish its own prior proprietary rights in a trademark through ownership of a registration, through actual use, or through use analogous to trademark use. *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996). Here, because Opposer has not pleaded or submitted a registration, he must rely on his asserted common law rights. In order for Opposer to prevail, the mark must be distinctive, inherently or otherwise, and Opposer must show priority of use. *Otto Roth*, 209 USPQ at 40; *see also, Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1721 (Fed. Cir. 2001).

Opposer asserts that he acquired common law rights in the mark APPLE JAZZ for the services identified in his application "long prior" to any date on which Applicant may rely for the applied-for mark.²⁸ Because the recited services in Opposer's pleaded application and Applicant's application both include "[a]rranging, organizing, conducting, and presenting concerts [and] live musical performances" and "production and distribution of . . . sound recordings," the parties' services are in part identical. We therefore focus our analysis on these services because they are most likely to establish priority for one party or the other. Neither Opposer nor Applicant need prove, and we need not find, priority as to each service listed in the respective

²⁸ Notice of Opposition ¶¶ 7 and 8, 1 TTABVUE 8.

recitations of services. It is sufficient to find priority as to any service encompassed by the application and registration. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff'd* 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

A. Opposer's mark and priority

Opposer is a jazz musician who began playing the trumpet professionally around 1971.²⁹ In 1984, he left his full-time music job and began freelancing as a musician.³⁰ Over the years, he has been employed in a number of roles, including, as a first trumpet, music director, and band leader.³¹ Opposer also currently teaches music at performing arts schools, and has taught music at a college in the past.³²

After organizing and leading a successful impromptu concert in 1984, Opposer performed his first concert under the name APPLE JAZZ at the Cortland New York Holiday Inn on June 13, 1985, as shown by the advertisement below.³³

²⁹ Bertini Dep., p. 9, 73 TTABVUE 21.

³⁰ *Id.*

³¹ *Id.* at 10, 73 TTABVUE 21.

³² *Id.* at 11-12, 73 TTABVUE 21.

³³ Opposer asserts his date of first use of the APPLE JAZZ mark is June 5, 1985, the date on which a newspaper article and an advertisement describing the upcoming first concert was published. *See* Ex. 1 to Bertini Dep., pp. 169 and 174, 73 TTABVUE 47-48 and 88. The use of a mark in the announcement of a future service, including an advance purchase of the service, does not constitute use as a service mark. *See Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301 (Fed. Cir. 2009) (holding that actual use of the mark in commerce in connection with an existing service is required and that mere preparations to use a mark sometime in the future does not constitute use in commerce); *In re Cedar Point, Inc.*, 220 USPQ 533 (TTAB 1983) (holding that advertising of an entertainment park, which was not yet open, was not a valid basis for registration). Accordingly, we find Opposer's earliest date of first use of the APPLE JAZZ mark is the date that Opposer's first concert was given,



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Opposer states that he chose the name APPLE JAZZ “because it was in Cortland County, and cortland apples are part of Cortland County, we decided to call it Apple Jazz.”³⁵ Each year since 1985, Opposer has offered APPLE JAZZ concerts in and around the Cortland, New York area. Between 1986 and 2014, nearly all of the concerts were billed as festivals, organized by Opposer, and generally held in a pavilion at the Dwyer Memorial Park in Cortland County.³⁶ In 2015, Opposer’s APPLE JAZZ band was hired to perform at the Syracuse Jazz Fest, and in 2016 and 2017, the APPLE JAZZ band was hired to perform at the Homer Center for the Arts in Homer, New York.³⁷ Revenues from the APPLE JAZZ festivals were modest, according to Opposer, “[s]ome years, it made money, and some years, it didn’t.”³⁸ The following representative exhibits, introduced by Opposer, show use of APPLE JAZZ to identify both Opposer’s band and concerts between 1986 and 2010.

namely June 13, 1985. The eight-day difference does not affect the outcome of the priority determination.

³⁴ Ex. 1 to Bertini Dep., 73 TTABVUE 88.

³⁵ Bertini Dep., p. 19, 73 TTABVUE 9.

³⁶ *Id.* at 27-28, 73 TTABVUE 11.

³⁷ *Id.* at 31-32, 73 TTABVUE 12.

³⁸ *Id.* at 59, 73 TTABVUE 19.

THE CORTLAND REPERTORY THEATRE
&
CHARLIE BERTINI
Present

Apple Jazz '86

Featuring
CHARLIE BERTINI
&
THE APPLE JAZZ BAND
DAVE HANLON - LARRY ARLOTTA
DICK CHAVE - JOHN KANE
DAVE GANNETT

SEPTEMBER 12, 1986 8 P.M.
at
THE PAVILION
DWYER MEMORIAL PARK
LITTLE YORK LAKE
Admission \$10.00

TICKETS AVAILABLE AT:
CRT Business Office - 37 Tompkins St. (607) 753-6161
The Candy Bar - Center City Mall
Master/Visa cards accepted

Bertini Funeral Home - N. Main St., Cortland
Allyson's Restaurant - S. Main St., Cortland
Steven's Diner - Rt. 291
The Lido Restaurant - 152 Port Watson, Cortland

**DWYER MEMORIAL PARK is located on Rt. 281N.,
Rt. 91 S. - Exit 13 - Rt. 291 S.**

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CORTLAND REPERTORY THEATRE
P.O. Box 783, Cortland, N.Y. 13045
Professional Summer Theatre Since 1972

1990 SEASON CALENDER

Mon.	Tues.	Wed.	Thur.	Fri.	Sat.	Sun.
		<i>Apple Jazz '90</i>		JUNE 8†		
		JUNE 13	14	15	16	17
		19	20	21	22*	23
		FOXFIRE	27	28	29	30
						JULY 1
			4	5	6	7
		ITALIAN AMERICAN RECONCILIATION	11	12	13	14
		17	18	19	20	21
		ARSENIC AND OLD LACE	25	26	27*	28
		JULY 30 FOLLIES	31	AUGUST 1	2	3
		1940's RADIO HOUR	8	9	10	11
		14	15	16	17*	18
						19

EVENING PERFORMANCES: 8:00 PM
* 2:00 PM MATINEE & EVENING PERFORMANCE

OUR LOCATION:

PERFORMANCES: Pavilion Theatre, Dwyer Memorial Park, North of Little York. Theatre Box Office Opens 1 1/2 hour prior to performance, and 4:00 P.M. Sunday.
MAIN BOX OFFICE: Love of Pete, 15 Main Street, Cortland. 9:30 - 5:30 Mon. - Sat.

TICKET PRICES:
\$13. Center
\$11. Side (Matinees Lower)
For Group Rates Call CRT Office: (607) 753-6161

RESERVATIONS AND INFORMATION
607-756-2627

CRT performances are made possible, in part, with public funds from the New York State Council on the Arts, the Cortland County Legislature and the Natural Heritage Trust.

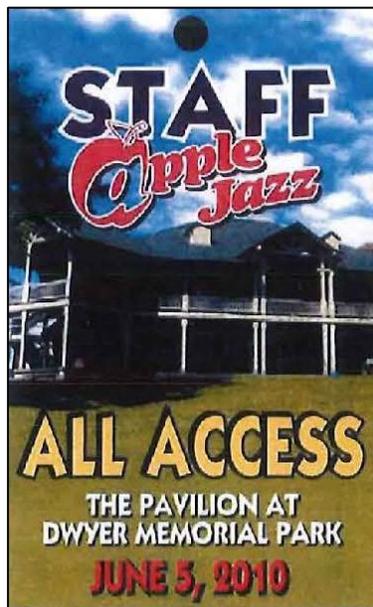
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39 Ex. 3 to Bertini Dep., 73 TTABVUE 141.

40 Ex. 15 to Bertini Dep., 73 TTABVUE 165.



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Eventually, Opposer branched out into other musical enterprises and formed APPLE JAZZ Records in the mid-1990s in order to issue and distribute recordings of his work as an independent musician, as well as the work of other musicians.⁴³

⁴¹ Ex. 29 to Bertini Dep., 73 TTABVUE 193.

⁴² Ex. 44 to Bertini Dep., 73 TTABVUE 223.

⁴³ Bertini Dep., pp. 44 and 47, 73 TTABVUE 15-16.

Opposer's music is available on Applicant's iTunes platform and other streaming music services.⁴⁴

Opposer has used APPLE JAZZ as a service mark to identify a variety of his musical enterprises, including a band, music festivals and concerts, and a musical recording production and distribution company.⁴⁵ As Opposer states in his deposition: "Apple Jazz is a brand."⁴⁶ Although Opposer's revenues from these events are modest, Opposer's use of the mark certainly is adequate to meet the definition of "use in commerce" under Section 45 of the Trademark Act, 15 U.S.C. § 1127. *See Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 18 USPQ2d 1292, 1295 (Fed. Cir. 1991) ("We . . . reject . . . [Opposer's] argument that a certain increased threshold level of interstate activity is required before . . . [protection of a mark] may be granted."). We therefore find Opposer was using APPLE JAZZ as a service mark in connection with "[a]rranging, organizing, conducting, and presenting concerts [and] live musical performances" at least as early as June 13, 1985.

B. Whether Opposer's mark is primarily merely geographically descriptive and lacks secondary meaning.

Applicant argues Opposer cannot establish priority because Opposer's APPLE JAZZ mark is primarily merely geographically descriptive and lacks secondary meaning.⁴⁷ Applicant claims Opposer's mark is primarily geographically descriptive because he performs jazz music in an area of New York known for producing apples.

⁴⁴ *Id.* at 114-15, 73 TTABVUE 33.

⁴⁵ *Id.* at 17, 26, and 33, 73 TTABVUE 9, 11, and 13.

⁴⁶ *Id.* at 46, 73 TTABVUE 13.

⁴⁷ Applicant's Br., p. 41, 90 TTABVUE 43.

That is, “APPLE’ is descriptive of ‘apple country’—the area in and around Cortland, New York”,⁴⁸ and the term JAZZ is generic for Opposer’s music. Thus, according to Applicant, Opposer’s “Apple Jazz’ is the geographically descriptive combination of ‘Apple’ and ‘Jazz[.]’”⁴⁹ To establish that Opposer’s mark is primarily merely geographically descriptive and lacking secondary meaning, Applicant relies on statements by Opposer and on other evidence it submitted.

Applicant first argues Opposer admits to the connection between his mark and the “apple country” of upstate New York. Applicant notes Opposer stated he selected APPLE JAZZ as his band’s name because “the jazz genre of music was being promoted in the apple country of Central New York State and Cortland, New York, home of the Cortland apple.”⁵⁰ Applicant also notes Opposer admitted to choosing the name APPLE JAZZ for his band because of a connection with the Cortland region: “I wanted a name for the band. I had to call it something. It could have been ‘Charlie Bertini and His Friends’ or whatever. But because it was in Cortland County, and cortland apples are part of Cortland County, we decided to call it Apple Jazz.”⁵¹

Applicant also submitted evidence that the Cortland County area of New York State, where Opposer has given most of his concerts, is known for the production of apples. The following examples are representative.

- The Cortland County Chamber of Commerce featured an apple image in its letterhead in a 1991 letter to Opposer:

⁴⁸ *Id.* at 45, 90 TTABVUE 47.

⁴⁹ *Id.* at 51, 90 TTABVUE 53.

⁵⁰ *Id.* at 45, 90 TTABVUE 47.

⁵¹ Bertini Dep., p. 19, 73 TTABVUE 9.



- A May 1993 newspaper article announcing one of Opposer’s concerts as one of several local “[e]vents built around seniors, **jazz**, **apples** and balloons[.]”⁵³
- Applicant identifies “[n]umerous businesses, programs, and festivals in the upstate New York region (which includes Cortland) [that] have adopted apple names and imagery to signal their location in ‘apple country.’”⁵⁴ These include: Red Apple Food Marts, the “Red Apple Program” offered by a business valuation company, the Ithaca New York Apple Harvest Festival, the Hilton New York Apple Fest, the LaFayette New York Apple Festival, the Warwick New York Apple Festival, and the Lioness Club of Central Square Apple Festival.⁵⁵

The elements for establishing that a mark is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), are:

- (1) The mark is the name of a place known generally to the public;
- (2) The goods for which applicant seeks registration originate in the geographic place identified in the mark; and

⁵² Ex. 1 to Bertini Rebuttal Decl., 86 TTABVUE 180.

⁵³ Ex. 27 to Bertini Decl., 59 TTABVUE 55 (emphasis by Applicant).

⁵⁴ Applicant’s Br., p. 46, 90 TTABVUE 48.

⁵⁵ Ex. A to Applicant’s 6th notice of reliance, 74 TTABVUE 22-42.

(3) Purchasers would be likely to believe that the goods originate in the geographic place identified in the mark.

See In re The Newbridge Cutlery Co., 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015).

We turn our attention first to the question of whether the primary significance of APPLE is that of a geographic location. In making this determination, we are mindful that a mark generally is not considered “primarily” geographic if it has a well-known meaning independent from its geographical meaning. *See In re Int’l Taste Inc.*, 53 USPQ2d 1604, 1605-06 (TTAB 2000) (HOLLYWOOD FRIES not primarily geographic because of other prominent, significant meaning of Hollywood referring to entertainment industry).

On this record, we find the term APPLE denotes the fruit, one type of which is produced in and around Cortland County, New York. Cortland County and the surrounding area are sometime referred to as “apple country” due to the volume of apples produced there. Thus, the phrase “apple country” has a geographic connotation for purposes of determining whether Opposer’s mark is primarily geographically descriptive. Nevertheless, evidence identifying “apple country” as the area in and around Cortland, New York is inapposite because Opposer’s mark is APPLE JAZZ, not APPLE COUNTRY JAZZ. The record therefore does not establish that APPLE—either alone or when combined with JAZZ—is primarily merely a geographic term. Simply put, APPLE does not share the same geographic connotation as the phrase “apple country” because removing the term “country” from the phrase “apple country” changes the meaning from a geographic place to the fruit.

Applicant also relies on section 1210.02(a) of the TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) (OCT. 2018), which states that “[a] geographic nickname (e.g., ‘Big Apple’ or ‘Motown’), or an abbreviation or other variant of the name of a geographic location, is treated the same as the actual name of the geographic location, if it is likely to be perceived as such by the purchasing public.” This argument is unpersuasive because, as noted above, Opposer’s mark does not contain the full nickname of the New York apple producing region, i.e., “apple country.” Thus, neither APPLE alone nor APPLE JAZZ can be considered to be a geographic nickname, abbreviation, or variant of the name of a geographic location to the purchasing public. We find, therefore, that Applicant has failed to establish that the primary significance of APPLE in Opposer’s mark APPLE JAZZ is a geographic location. *See In re Dixie Ins. Co.*, 223 USPQ 514 (TTAB 1984) (no evidence to support the conclusion that the primary significance of DIXIE is geographical).

In the absence of evidence that APPLE JAZZ is primarily merely geographically descriptive, we find Opposer has established that his APPLE JAZZ mark as a whole is inherently distinctive and not lacking in secondary meaning. Opposer may claim priority of use of the mark APPLE JAZZ for use in connection with “[a]rranging, organizing, conducting, and presenting concerts [and] live musical performances” at least as early as June 13, 1985.

C. Applicant’s mark and priority

1. Applicant’s use of APPLE marks

Since at least 1977, Applicant has used its APPLE word mark in connection with personal computers and mobile communication and media devices, as well as with a

variety of related software, services, and accessories.⁵⁶ Since the 1980s, Applicant also has used the mark APPLE in connection with an audio player and audio-recording functionalities on its computers and mobile devices.⁵⁷ Applicant's audio player and audio-recording functionalities, however, do not establish use of the APPLE mark in connection with the services identified in its application because they are insufficiently related.⁵⁸ Applicant's use of the APPLE mark in connection with other music-related goods and services, such as Applicant's iPod player and iTunes services, do not precede Opposer's 1985 priority date.

Nevertheless, the record shows that Applicant has used the mark APPLE MUSIC since at least June 8, 2015 when it launched the APPLE MUSIC streaming service for publishing and distributing music.⁵⁹ APPLE MUSIC provides consumers access to Applicant's music catalog comprising some 60 million songs.⁶⁰ Below is a screenshot from Applicant's website showing use of the APPLE MUSIC mark in connection with its streaming music service.⁶¹

⁵⁶ La Perle Decl. ¶¶ 8 and 9, 83 TTABVUE 8.

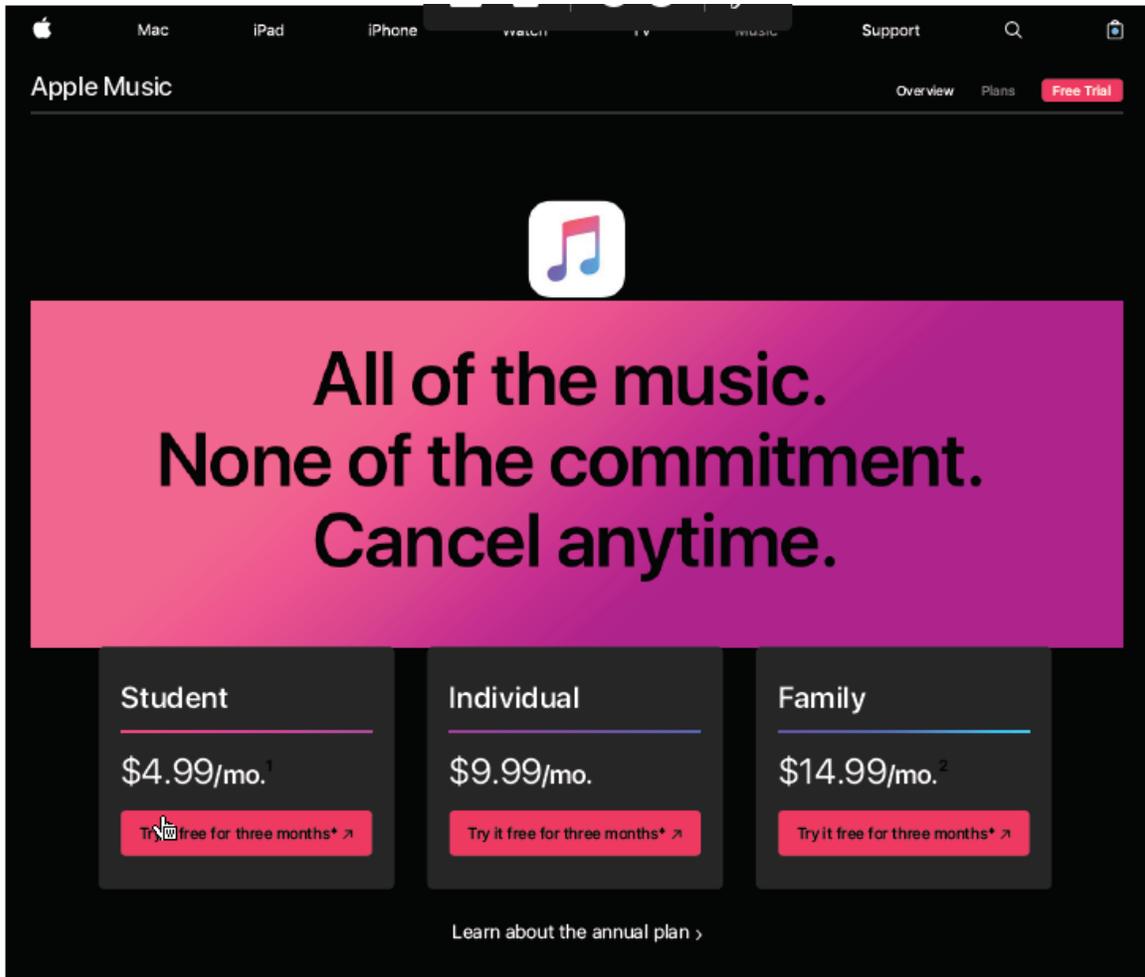
⁵⁷ *Id.* at ¶ 34, 83 TTABVUE 14.

⁵⁸ Although Applicant's Registration No. 4088195 recites a variety of entertainment services, including "entertainment services, namely, production of live musical performances," and claims a date of first use as early as March 1, 1981, Applicant was unable to establish its use of the mark for any of these services prior to Opposer's 1985 priority date. *See* TMEP section 903.08: "If more than one item of goods or services is specified in a particular class, the date of first use anywhere and date of first use in commerce do not have to pertain to every item in the class."

⁵⁹ La Perle Decl. ¶ 19, 83 TTABVUE 4.

⁶⁰ *Id.*

⁶¹ Ex. 8 to La Perle Decl. ¶ 24, 83 TTABVUE 9 and 201. Opposer objects to this exhibit on the ground that "Internet evidence may not be used to demonstrate the truth of what has been printed" and because it does not include the date and website URL. 89 TTABVUE 56. The objection is overruled inasmuch as La Perle testified to its authenticity and provided the URL and date of image capture. *See* La Perle Decl. ¶ 24, 83 TTABVUE 9.



Applicant also alleges that it has priority because it acquired trademark rights in the mark APPLE from the Beatles’ record company, Apple Corps, used in connection with sound and video recordings “dating back to 1968.”⁶² According to Applicant, “Apple and Apple Corps have produced and distributed sound recordings and films under the APPLE mark since long prior to Opposer’s June 5, 1985, claimed date of first use.”⁶³ Applicant argues that it may rely on these purchased rights to establish priority: “Apple is entitled to tack its rights to those of Apple Corps, Apple enjoys absolute priority of rights as between the parties . . . , including with respect to

⁶² La Perle Decl. ¶ 47, 83 TTABVUE 19.

⁶³ Applicant’s Br., p. 9, 90 TTABVUE 11.

services recited in the Application that are closely related to the production and distribution of sound recordings.”⁶⁴ We therefore look to Apple Corps’ use of the mark APPLE.

2. Apple Corps’ use of APPLE on sound and video recordings

In 1963, the musical group The Beatles set up a United Kingdom corporation to produce and distribute the group’s music.⁶⁵ The original name of the corporation was The Beatles Limited, but the name was changed to Apple Corps Limited, effective February 9, 1968.⁶⁶ The Beatles—John Lennon, Paul McCartney, George Harrison, and Ringo Starr—as well as several other well-known musicians, have had their sound and video recordings produced and distributed under the Apple Corps record label and APPLE mark. These other musicians include such well-known recording artists as James Taylor, Mary Hopkin, Badfinger, and Billy Preston.⁶⁷

Apple Corps’ Chief Executive Officer, Jeffrey Vaughan Jones, testified that “[s]ince 1968, Apple Corps has continuously used the APPLE word mark in connection with the production and/or distribution of sound recordings and film in the United States.”⁶⁸ Indeed, Jones testified that “The Beatles recordings are ‘evergreen,’ meaning versions of The Beatles recordings have been available continuously every year after their original release.”⁶⁹ Beatles albums bearing the

⁶⁴ *Id.*

⁶⁵ Jones Decl. ¶ 3, 71 TTABVUE 3.

⁶⁶ *Id.*

⁶⁷ *Id.* at ¶ 8, 71 TTABVUE 4.

⁶⁸ *Id.* at ¶ 18, 71 TTABVUE 8.

⁶⁹ *Id.* at ¶ 21, 71 TTABVUE 9.

APPLE mark, including albums released on compact disc, continue to be sold up to the present day including both re-releases and new compilations.⁷⁰

The Jones declaration includes a number of examples establishing that Apple Corps has used the word marks APPLE (as well as APPLE RECORDS, APPLE MUSIC PUBLISHING, APPLE FILMS, and marks comprising apple designs) on sound and video recordings since August 1968.⁷¹ Representative examples of sound recordings showing use of the APPLE mark, released between 1968 and 1975, are shown below.

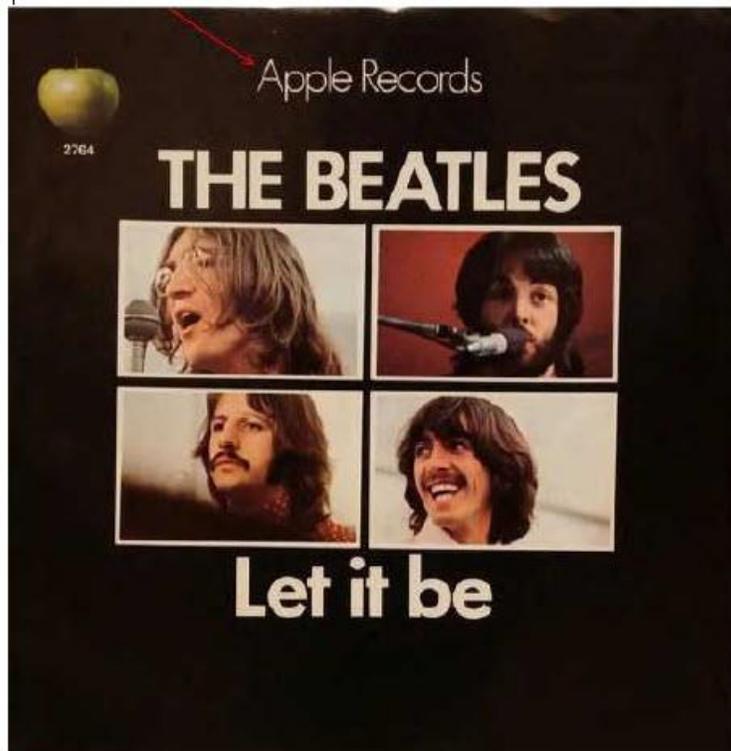


72

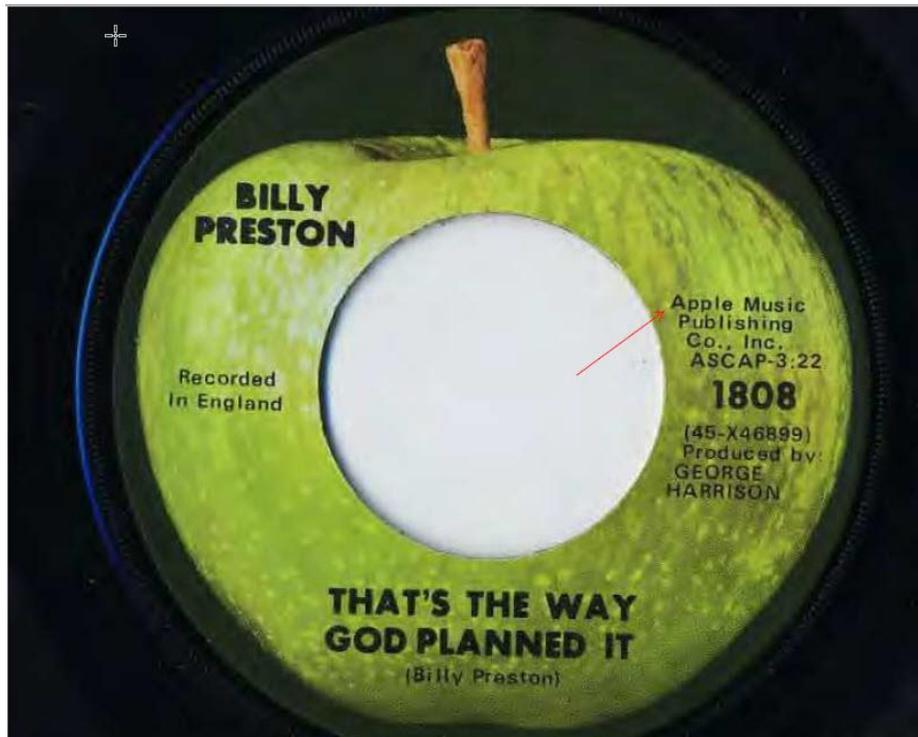
⁷⁰ *Id.* at ¶ 25, 71 TTABVUE 14.

⁷¹ *Id.* at ¶ 22, 71 TTABVUE 9-10 and 45.

⁷² Ex. 10 to Jones Decl. ¶ 34, 71 TTABVUE 22 and 174.



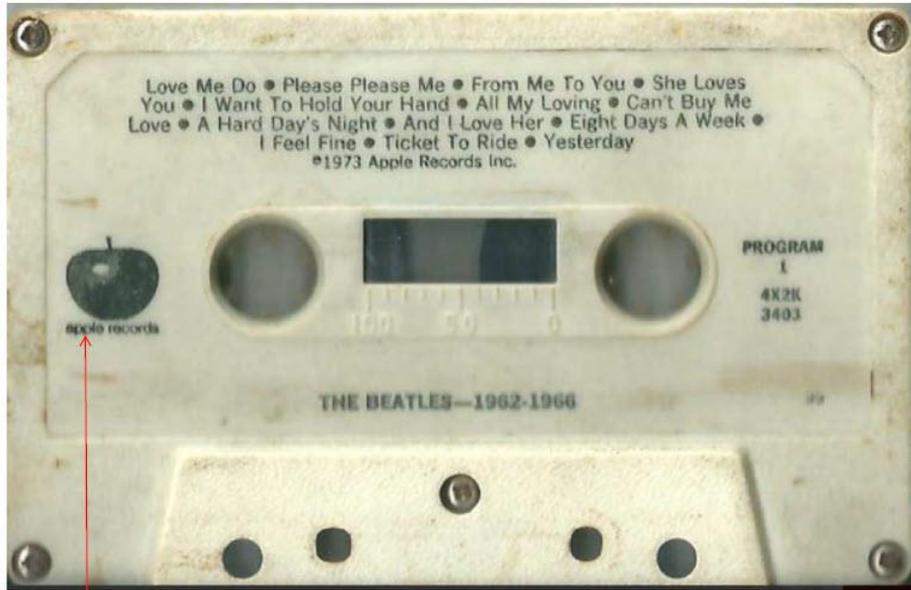
73



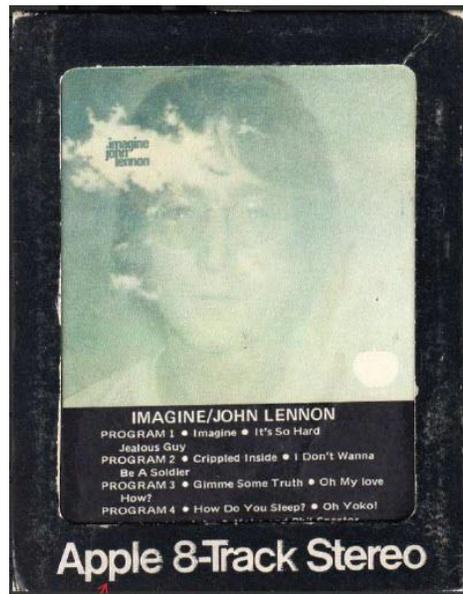
74

⁷³ Ex. 3 to Jones Decl. ¶ 23, 71 TTABVUE 11 and 54.

⁷⁴ Ex. 10 to Jones Decl. ¶ 34, 71 TTABVUE 22 and 140.



75



76

As shown above, the APPLE mark was used on a variety of formats, including vinyl records, cassette tapes, and 8-Track cartridges. New releases of APPLE recordings halted for a time in 1975 but “substantial quantities of those sound recordings issued under the Apple Corps label and bearing the APPLE word mark

⁷⁵ The wording “apple records” appears below the image of an apple. Ex. 3 to Jones Decl. ¶ 23, 71 TTABVue 11 and 59.

⁷⁶ Ex. 10 to Jones Decl. ¶ 34, 71 TTABVue 22 and 175.

continued to be sold around the world (including the United States) throughout the 1970s and 1980s.”⁷⁷ For example, according to Jones, George Harrison’s *All Things Must Pass* album, shown below, was first released in 1970 but was available on cassette tapes up to at least December 31, 1985.⁷⁸



⁷⁷ Jones Decl. ¶ 35, 71 TTABVUE 26.

⁷⁸ The wording “apple” appears below the image of an apple. *Id.* at ¶¶ 34 and 37, 71 TTABVUE 22 and 26.

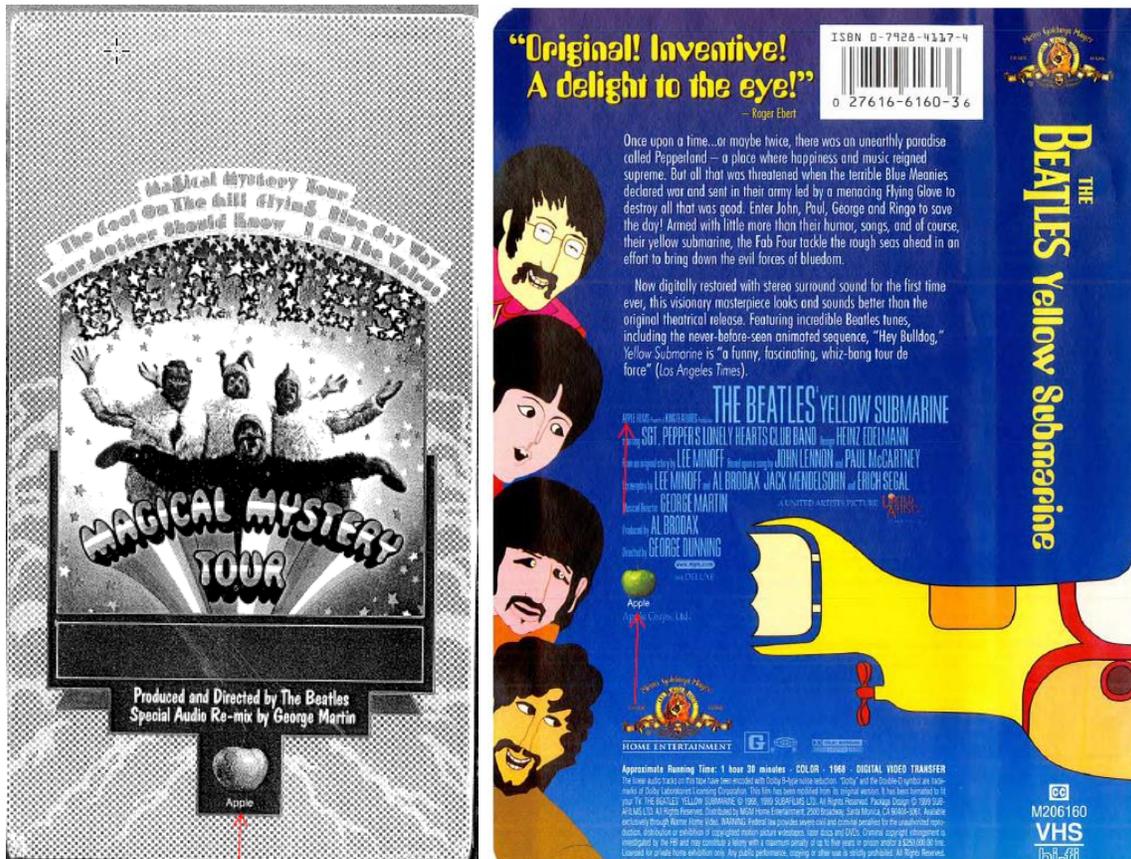
In addition, the album *Shaved Fish*, shown below, by John Lennon and The Plastic Ono Band was re-released in 1983 under the APPLE mark and thus was available in the 1980s as well.⁷⁹



Apple Corps also was involved in the production and distribution of several films featuring music by The Beatles. The films have been shown in theaters and on television in the United States since the 1960s. Several of the films were released on VHS when the format became available, and all or most of them are now sold on DVD

⁷⁹ The wording “apple records” appears below the image of an apple. *Id.* at ¶ 39, 71 TTABVUE 28.

in the United States under the APPLE word mark.⁸⁰ For example, *Magical Mystery Tour* was released in VHS format in the United States in or around 1988 and *Yellow Submarine*, was released in VHS format in the United States in or around 1999:⁸¹



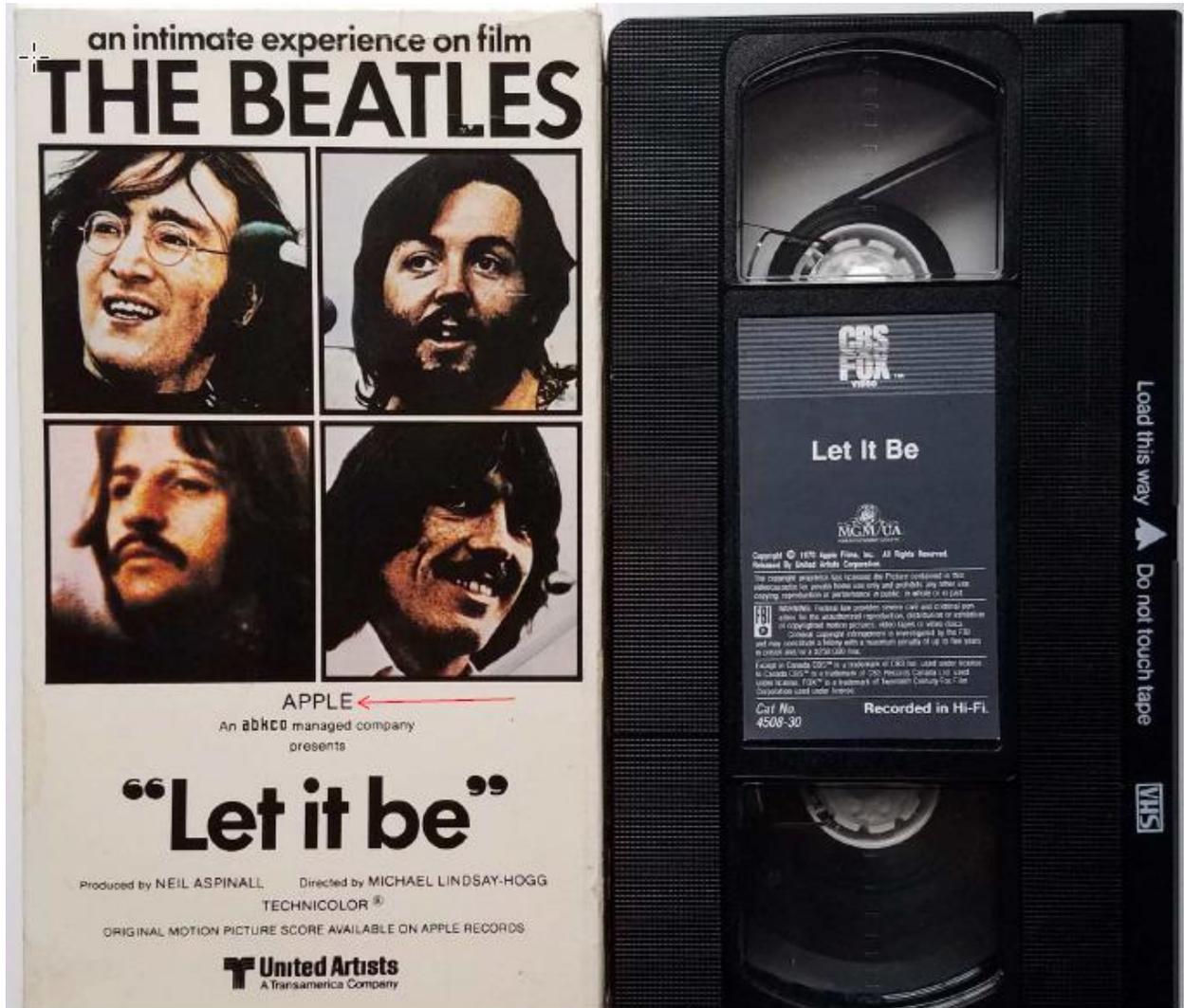
Jones testified that, in 1970, Apple Corps released a documentary film titled *Let It Be* in the United States. The film documented The Beatles rehearsing and recording songs for their album *Let It Be*. In 1981, the film was released in the United States in VHS and Betamax formats, and on VideoDisc.⁸² The *Let It Be* recordings

⁸⁰ *Id.* at ¶ 41, 71 TTABVUE 29.

⁸¹ The packaging for the *Magical Mystery Tour* video includes the wording “Apple” below the image of an apple. The packaging for the *Yellow Submarine* video includes both the wording “Apple” below the image of an apple and “APPLE FILMS.” Jones Decl. ¶ 41 and Ex. 11, 71 TTABVUE 29 and 242-46.

⁸² Jones Decl. ¶ 42, 71 TTABVUE 30-31.

were being sold as late as September 30, 1984 as evidenced by Applicant's confidential royalty reports covering the periods June 30, 1984 and September 30, 1984.⁸³ The APPLE word mark appears on the covers of the VHS and VideoDisc packaging, shown below.⁸⁴



⁸³ *Id.* at ¶ 42 and Ex. 13 (confidential), 71 TTABVUE 30-31 and 72 TTABVUE.

⁸⁴ Ex. 12 to Jones Decl. ¶ 42, 71 TTABVUE 250-56.

Time: 1-hour 20 minutes color

75476 01411

SONGS FEATURED:
 Don't Let Me Down
 Maxwell's Silver Hammer
 Two of Us
 I've Got a Feeling
 Oh Darling
 One After 909
 Jazz Piano Song
 Across the Universe
 I Dig a Pony
 Suzy Parker
 I Me Mine

For You Blue
 Besame Mucho
 Octopus's Garden
 You Really Got a Hold on Me
 The Long and Winding Road
 Shake, Rattle and Roll
 Kansas City
 Miss Ann
 Lawdy Miss Clawdy
 Dig It
 Let It Be
 Get Back

THE BEATLES
 APPLE
 "Let it be"
 Produced by NEIL ASPINALL
 Directed by MICHAEL LINDSAW-HOGG
 TECHNICOLOR
 United Artists
 G GENERAL AUDIENCES
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Everybody had a good time... Everybody let their hair down... Everybody saw the sunrise... Those ones from I Got a Feeling, sung by John, search the sooty road from A Hard Day's Night to Let It Be... the Beatles that stand tall for... The Beatles, from a howling solo to a bitter-sweet goodbye... Let It Be... John and Yoko... dressed in white, walking across the floor of the studio to George's I Me Mine... John and Paul, coming together like teenage Quary Men on "Two of Us" — "You and I have memories longer than the road that stretches out ahead"... The Beatles were breaking up... The Beatles were boys becoming men... January 1969... Paul was pushing for a solo, saying that the group needed to reconnect with their audience... but the other Beatles weren't buying... A compromise was struck... The new album would be recorded as if the Beatles had never split — simply, John, Paul, George, and Ringo, with George Martin producing... A film crew would track the action, with Ringo as the boys' touchstone... base with Shoney Robinson's You Really Got a Hold on Me... and began to piece together the album that would become "Let It Be"... Before that record was released, however, the Beatles would record... Abbey Road... officially break up... begin to release solo albums... and meet Phil Spector at Sound Recorders to construct a... soundtrack... about from a mountain of accumulated tapes... The disc, however, is the literal soundtrack of Let It Be... and for a song like The Long and Winding Road... which Spector arranged in strings and vocals... the 10-minute is a revelation... Let It Be restores the song's simple soul... with Billy Preston's organ swaddling Paul's voice... and the coolest Beatles caught in all his earnest charm... One squint as Paul sings of George and Ringo far from playing their parts correctly... as if the Beatles might was of a who that could be whopped into shape... But you can't blame Paul... because he... was asking the Beatles coming to an end... Suddenly, the Pop Four brought girlfriends to the studio with names like Linda and Yoko... Suddenly, they were grown-ups... So what did the Beatles do when their whole world shifted from optimism to gloom? They went up to the roof and waved as goodbye with a live performance... There are the smiles that linger forever... Kids start over the most excited in their eyes... heads turned towards the sky... A console whirrs on the floor of Abbey Road... to inquire about the racket on the roof... And the wind flies through John's hair as he pokes out the wind to Get Back... and... along with his three comrades... sends himself back to where he once belonged... The Beatles — John, Paul, George, and Ringo... They passed the audition... — JIMMY KANE

Manufactured and distributed by RCA Records/Victor Music Group, a division of RCA Corporation, New York, N.Y.

Selected from a collection of RCA Corporation
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 © 1993 RCA Corporation

APPLE001911

Apple Corps released the video recording *The Beatles Anthology* in the mid-1990s as an eight-part VHS video cassette box set, and in April 2003 Apple Corps released

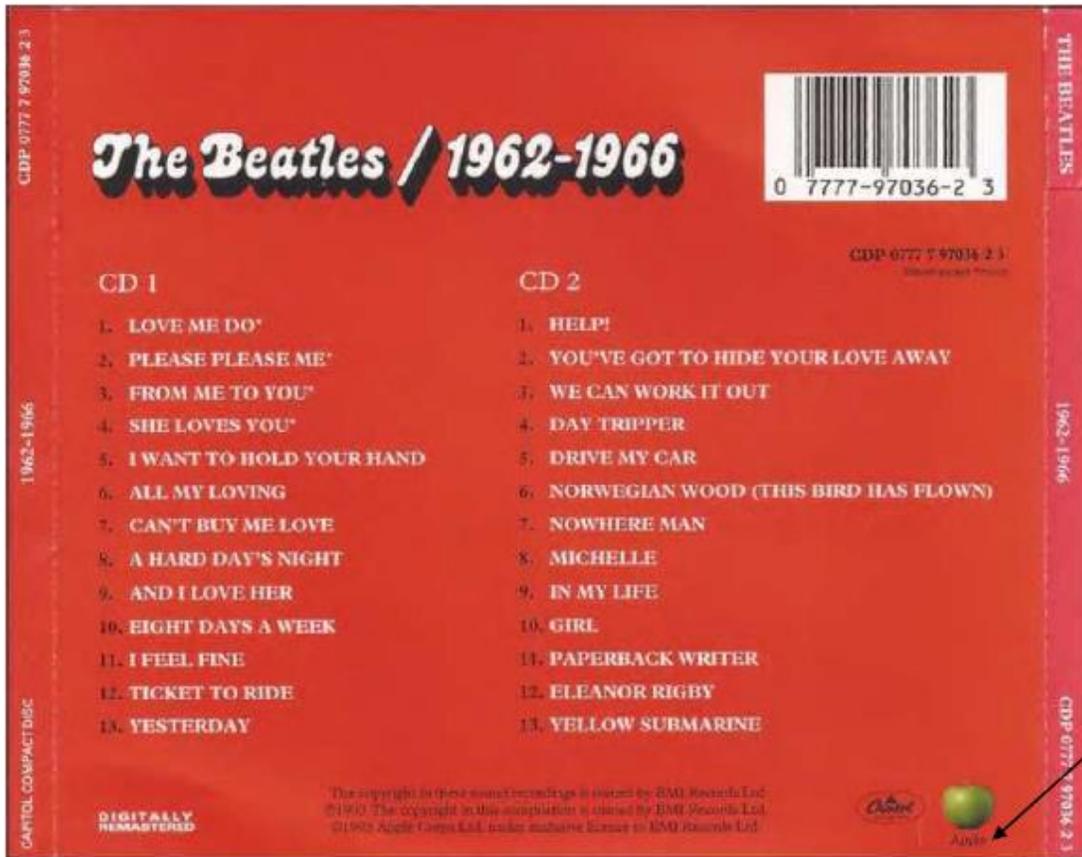
it as a five-disc DVD set.⁸⁵ The VHS cassette box set and the five-disc DVD set bearing the APPLE word mark are shown below:



The sale of music and videos bearing the APPLE mark continued into the 1990s, with many of the previously released albums being released on compact disc. Jones testified: “[f]or example, in 1993, CD versions of *The Beatles 1962-1966* and *The*

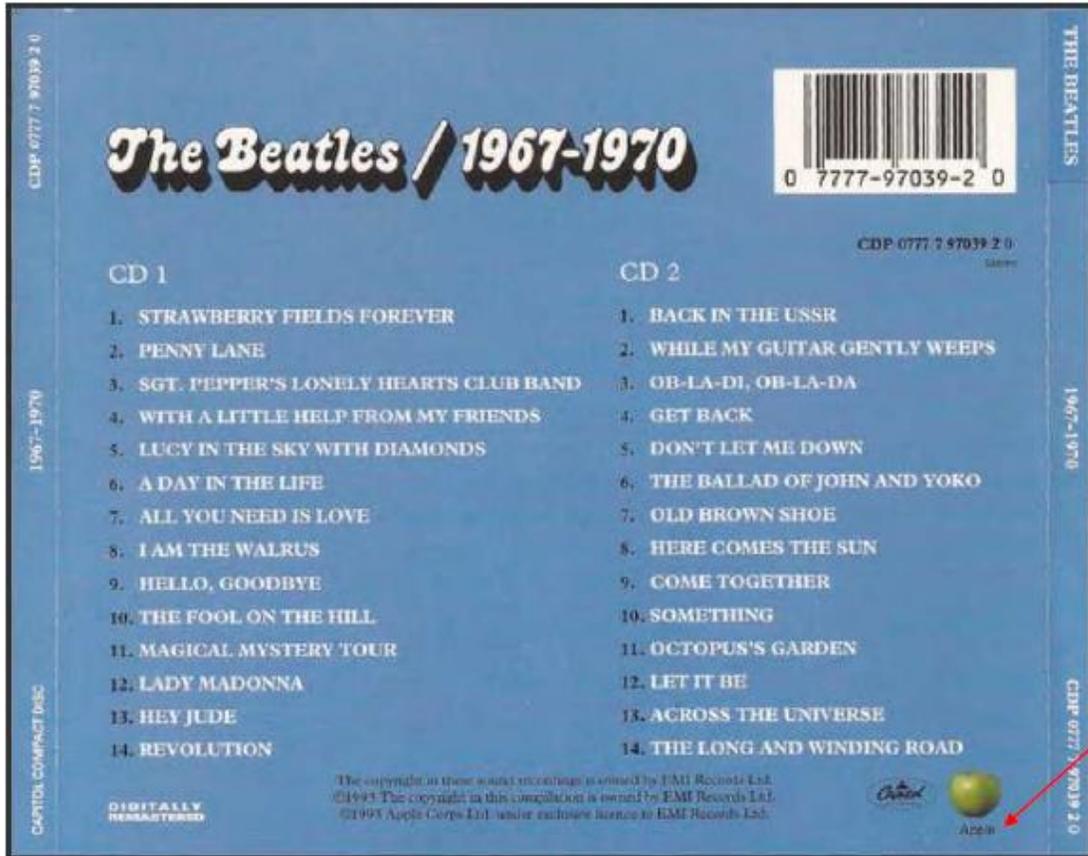
⁸⁵ On the VHS and DVD packaging, the wording “Apple” appears below the image of an apple. Jones Decl. ¶ 44 and Ex. 14, 71 TTABVue 31 and 258-66.

Beatles 1967-1970, known as the ‘Red’ and ‘Blue’ albums, respectively, were released for the first time in the United States.”⁸⁶ The compact disc cases are shown below.⁸⁷



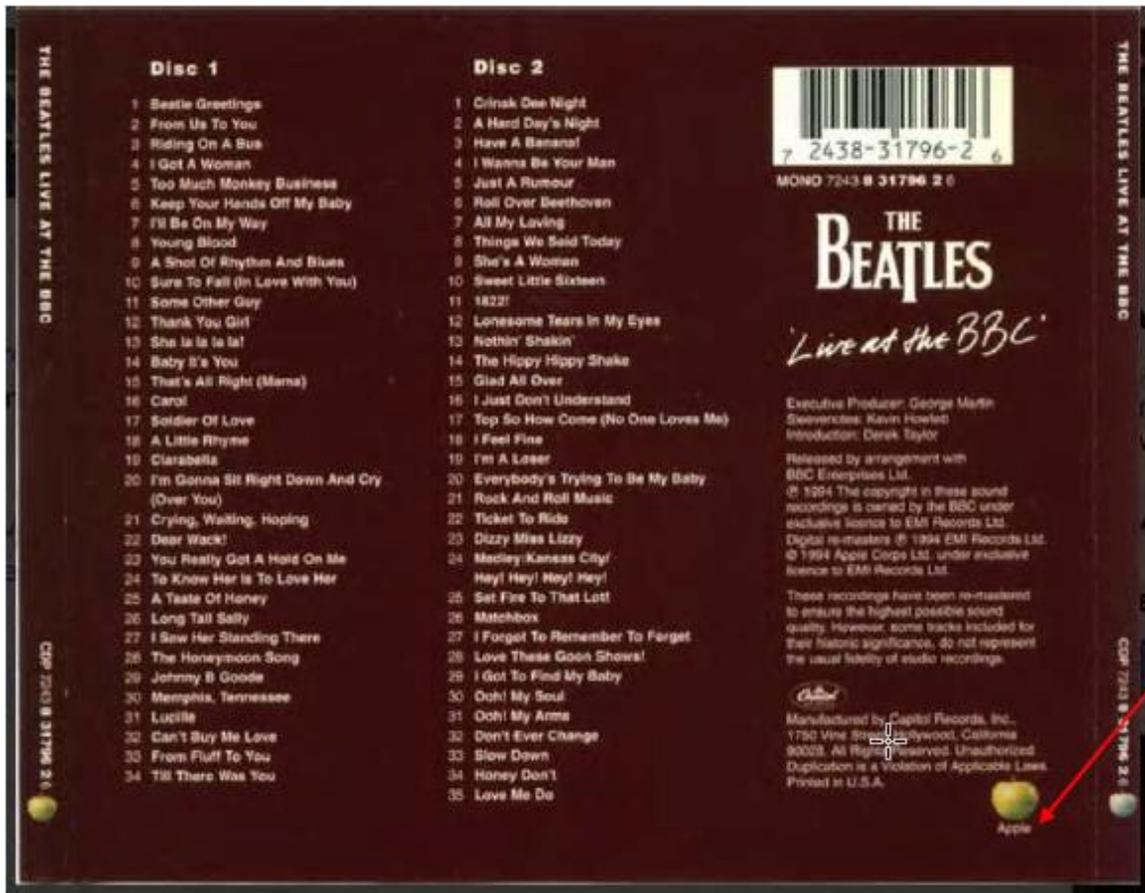
⁸⁶ *Id.* at ¶ 25, 71 TTABVUE 14-16.

⁸⁷ The wording “Apple” appears below the image of an apple. Ex. 4 to Jones Decl. ¶ 25, 71 TTABVUE 61-67.



In 1994, a new album using archive material, *The Beatles: Live at the BBC*, was released in the United States. This release featured the APPLE word mark on the compact disc packaging, as depicted below:⁸⁸

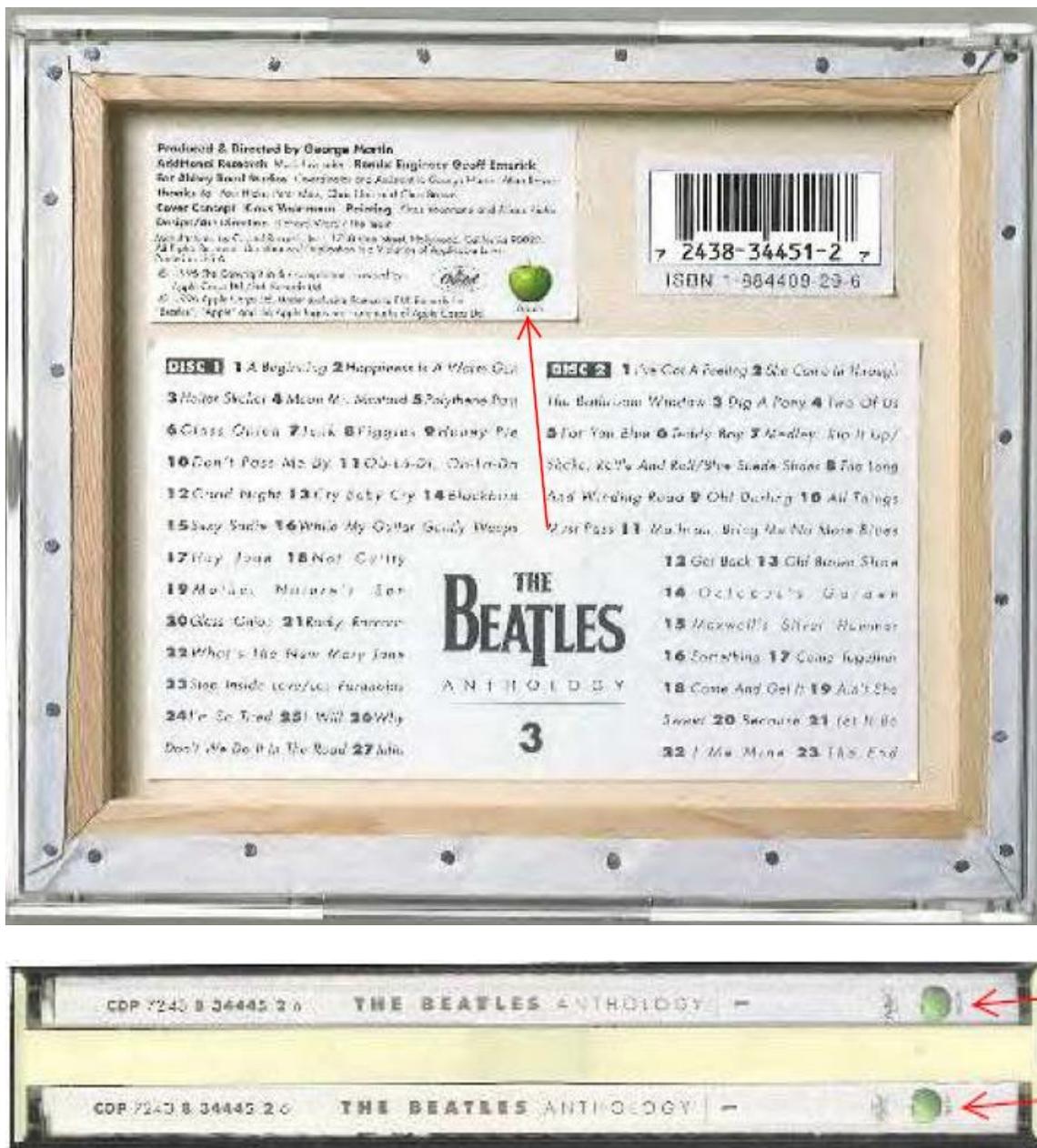
⁸⁸ The wording “Apple” appears below the image of an apple. Jones Decl. ¶ 25, 71 TTABVue 16-17.



In 1995 and 1996, Apple Corps released three new compilation albums called *The Beatles Anthology Parts I, II, and III*.⁸⁹ The albums were released under the APPLE mark.⁹⁰

⁸⁹ Jones Decl. ¶ 28, 71 TTABVUE 20.

⁹⁰ The wording “Apple” appears below the image of an apple. Ex. 6, to Jones Decl. ¶ 28, 71 TTABVUE 75-89.



In November 2000, Apple Corps released another new Beatles compilation album titled “1” which featured Beatles songs that had reached number one on the United

Kingdom or United States music charts upon their initial releases between 1963 and 1970.⁹¹ The album was released under the APPLE mark as shown below:⁹²



The film *Help!* was released in DVD format as a double disc in the United States in or around 2007:⁹³

⁹¹ Jones Decl. ¶ 29, 71 TTABVUE 21.

⁹² The wording “Apple” appears below the image of an apple. Ex. 7 to Jones Decl. ¶ 29, 71 TTABVUE 90-94.

⁹³ *Id.* at ¶ 41, 71 TTABVUE 29 and 247-50.



In September 2009, Apple Corps reissued the entire original Beatles catalog, featuring the APPLE word mark, in a digitally remastered form on compact disc in the United States.⁹⁴

Apple Corps, acting through licensees, also operates the Official Beatles Store ecommerce websites directed at users in North America, Europe, Japan, and Brazil. Jones testified that the website, launched in 2006, offers for sale various goods

⁹⁴ *Id.* at ¶ 30, 71 TTABVUE 21.

bearing the APPLE mark, including compact discs containing Beatles recordings and films.⁹⁵

In 1997, Apple Corps registered the mark APPLE in typed form for “Gramophone records featuring music; [pre-recorded audio tape cassettes featuring music;] audio compact discs featuring music [; pre-recorded video tape cassettes featuring music] [; video laser discs featuring music],” claiming a date of first use of August 1968.⁹⁶ In 2007 Apple Corps registered the mark APPLE in standard characters for, inter alia, “musical sound recordings.”⁹⁷

We find Applicant’s testimony and evidence establish Apple Corps’ continuous use of the mark APPLE, for use in connection with musical sound recording and films featuring music, since 1968.

Opposer nevertheless argues that Apple Corps ceased use of the mark in 1976 and did not resume use until after Opposer’s first use of his mark.⁹⁸ Opposer primarily relies on a Wikipedia page about Apple Records discography which states: “After EMI’s contract with the Beatles ended in 1976, the Apple label was finally wound up. The label was reactivated in the 1990s.”⁹⁹ The Wikipedia page is admissible for the limited purpose of demonstrating what has been printed, but not for the truth of what has been printed. *Safer*, 94 USPQ2d at 1039. The Wikipedia page thus falls far short

⁹⁵ *Id.* at ¶ 32, 71 TTABVUE 22.

⁹⁶ Registration No. 2034964, issued February 4, 1997 and renewed. The goods in brackets were deleted from the registration upon renewal but are listed here for historical context.

⁹⁷ Registration No. 3317089, based on Section 44(e), issued October 23, 2007 and renewed.

⁹⁸ Opposer’s Br., p. 43, 89 TTABVUE 44.

⁹⁹ *Id.* at 42, 89 TTABVUE 43.

of establishing that Apple Corps ceased use of the mark between 1976 and the 1990s. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (search results are only probative of what they show on their face, not for the truth of the matters contained therein), *aff'd*, 565 F. App. 900 (Fed. Cir. 2014) (mem.).

Opposer also argues that Applicant has not established its priority because “Apple Corps Ltd. has no documents showing that Apple Corps Ltd or its company in the U.S., Apple Records, Inc., manufactured goods in the U.S. under [the] standard character mark APPLE during period January 1, 1983 - December 31, 1985.”¹⁰⁰ This argument is unpersuasive. Jones testified that Capitol Records, under license from Apple Corps, manufactured and distributed many of Apple Corps’ recordings bearing the APPLE mark in the United States until at least 1989.¹⁰¹

In fact, between 1979 and 1989, Apple Corps was involved in suit against Capital Records and EMI over royalty payments.¹⁰² A 1969 agreement between Apple Corps and EMI “granted Apple the sole and exclusive right to manufacture, distribute, advertise and sell Beatles’ recordings.” *Apple Records, Inc., Apple Corps Ltd., George Harrison, Richard Starkey and Yoko Ono Lennon, v. Capitol Records, Inc. and E.M.I. Records Ltd.*, 137 A.D.2d 50, 52, 529 N.Y.S.2d 279, 280 (N.Y. App. Div. 1988).¹⁰³ A second agreement between Apple Corps and Capitol covered manufacturing and

¹⁰⁰ Opposer’s Br., p. 42, 89 TTABVUE 43.

¹⁰¹ Jones Decl. ¶¶ 19 and 26, 71 TTABVUE 9 and 19-20.

¹⁰² *Id.* at ¶ 26, 71 TTABVUE 20.

¹⁰³ According to the opinion, former Beatles’ member Paul McCartney chose not to participate in this action.

distribution of records by Capitol. *Id.* In the action, Apple Corps et al. sought to recoup royalties diverted by Capital and EMI up through the mid-1980s, and to terminate their rights to manufacture and distribute Beatles' recordings. *Id.* The parties settled the suit in November 1989.¹⁰⁴ Clearly, between 1979 and 1989 Apple Corps had not abandoned its interest in producing and distributing music.

Moreover, whether Applicant manufactured goods in the United States is not the test for determining priority. Instead, the issue is whether Applicant's testimony and evidence, as a whole, establishes priority. The United States Court of Appeals for the Federal Circuit has been clear as to how the Board should consider the evidentiary record regarding claims of priority:

[W]hether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use. The TTAB . . . [should not] dissect[] the evidence to the point . . . [of] refus[ing] to recognize, or . . . overlook, the clear interrelationships existing between the several pieces of evidence submitted.

West Fla. Seafood, Inc. v. Jet Rests., Inc., 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994). The Board, moreover, has also recognized that “[o]ral testimony, if sufficiently probative, is normally satisfactory to establish priority of use . . . , and the testimony of a single witness may be adequate to establish priority.” *DeVivo v. Ortiz*, 2020 USPQ2d 10153, *3 (TTAB 2020).

¹⁰⁴ Jones Decl. ¶ 26, 71 TTABVUE 20.

Sales of Apple Corps products ebbed and flowed over the years as musical tastes changed and musical formats evolved. Applicant's evidence regarding its use of the APPLE mark lacks extensive documentary support as to sales figures, particularly as to the period between the late 1970s and the early 1980s. Applicant relies primarily on the testimony of Jones, the Chief Executive Officer of Apple Corps since 2007, which details Apple Corps' use of the mark and provides images of recordings and films bearing the mark. Jones' testimony is not accompanied by the type or quantity of documentary evidence that one would expect to be readily available to show the use of a mark that Applicant claims was used in connection with the "production and distribution of some of the *most famous sound recordings ever created*["¹⁰⁵ Oral testimony is, of course, always "strengthened by corroborative documentary evidence," *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1184 (TTAB 2017), but "[w]hile it is certainly preferable for a party's testimony to be supported by corroborating documents, the lack of documentary evidence is not fatal." *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1931 (TTAB 2011). The critical portions of Jones' testimony are clear, and are neither contradicted by Opposer nor "indefinite and internally inconsistent." *Cf. Exec. Coach Builders*, 123 USPQ2d at 1182-85 (rejecting testimony of applicant's principal regarding alleged prior use because it was both indefinite and inconsistent on a number of topics). The record provides no sufficient reason for us to disregard or discount Jones' testimony on the Apple Corps' use of the mark going back to 1968. His testimony establishes, at a minimum, that Applicant used the APPLE mark on

¹⁰⁵ *Id.* at ¶ 4, 71 TTABVUE 3.

sound recordings and films featuring music at least as early as 1968, prior to Opposer's priority date, and that Applicant has not abandoned the mark.

3. Applicant's purchase of the Apple Corps marks

In 2007, Applicant acquired all of Apple Corps' trademark and service mark rights in its APPLE marks, including Registration Nos. 2034964 and 3317089.¹⁰⁶ The 2007 agreement between Applicant and Apple Corps assigned to Applicant all Apple Corps' APPLE marks, which were defined as "any Trademarks of [Apple] Corps or any Apple Corps Group Company that utilize or feature the word 'apple' in any form . . . and/or any symbols, designations, signs, logos, depictions or representations of an apple, in whole or in part[.]"¹⁰⁷ Applicant then granted back to Apple Corps a license to continue using the marks, which use inures to Applicant's benefit.¹⁰⁸ Applicant seeks to gain priority over Opposer by tacking rights Applicant obtained from Apple Corps in the APPLE mark to Applicant's APPLE MUSIC mark.

4. Whether Applicant Can Gain Priority by Tacking

"[T]acking' is a defense that must be pleaded to put opposer on notice of new matter that applicant is placing at issue (i.e., a mark previously used by applicant that is the legal equivalent of applicant's opposed mark, and that provides the basis for applicant to claim prior use)." *H.D. Lee Co., Inc. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008). Applicant pleaded, as an affirmative defense, priority and ownership of the two registrations comprising APPLE marks purchased from Apple

¹⁰⁶ *Id.* at ¶¶ 47 and 48, 71 TTABVUE 19.

¹⁰⁷ Confidential 2007 Settlement Agreement, clause 1.1, 85 TTABVUE 6.

¹⁰⁸ Jones Decl. ¶ 48, 71 TTABVUE 19.

Corps, Registration Nos. 2034964 and 3317089, and use of the APPLE mark since August 1968. We find Applicant properly pleaded the defense of tacking.

The fact that Applicant seeks to establish priority via assignment of rights from Apple Corps does not diminish the showing of priority. *See Lone Star Steakhouse & Saloon v. Alpha of Va.*, 43 F.3d 922, 33 USPQ2d 1481, 1487 (4th Cir. 1995) (while defendant had seniority over plaintiff's own use, plaintiff obtained an assignment of rights from a third user who was senior to defendant; hence, plaintiff became the senior user).

The Supreme Court described tacking succinctly in *Hana Financial*:

Recognizing that trademark users ought to be permitted to make certain modifications to their marks over time without losing priority, lower courts have provided that, in limited circumstances, a party may clothe a new mark with the priority position of an older mark. This doctrine is called "tacking," and lower courts have found tacking to be available when the original and revised marks are "legal equivalents" in that they create the same, continuing commercial impression.

Hana Fin., Inc. v. Hana Bank, 135 S. Ct. 907, 113 USPQ2d 1365, 1366 (2015) quoted in *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1132 (Fed. Cir. 2015).

As stated by the Supreme Court, two marks are "legal equivalents" if they "create the same, continuing commercial impression so that consumers consider both as the same mark." *Hana Fin.*, 113 USPQ2d at 1367. (citation and internal quotation marks omitted); *see also Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1224 (CCPA 1976) ("The law permits a user who changes the form of its mark to retain the benefit of its use of the earlier form, without abandonment, if the new and old forms create

the same, continuing commercial impression.”). “Tacking is occasionally permitted where the two marks, though differing slightly in their literal meaning or grammatical presentation, nevertheless possess the same connotation in context.” *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1869 (Fed. Cir. 1991).

The standard for tacking is very strict and tacking in general is permitted only in “rare instances.” *Van Dyne-Crotty*, 17 USPQ2d at 1869; *Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1635 (TTAB 2007). “[T]he standard of legal equivalence used in reviewing efforts to ‘tack’ the prior use of one mark onto that of another is higher than that used in evaluating two competing marks. . . . [E]ven if the two marks are confusingly similar, they still may not be legal equivalents.” *Van Dyne-Crotty*, 17 USPQ2d at 1868.

The addition of even one word can make a significant difference in commercial impression. *See Am. Paging Inc. v. Am. Mobilphone Inc.*, 13 USPQ2d 2036, 2039 (TTAB 1989) *aff’d mem.*, 923 F.2d 869, 17 USPQ2d 1726 (Fed. Cir. 1990) (even where both marks “are dominated by the word AMERICAN and the same star and double bar design,” AMERICAN MOBILPHONE and design and AMERICAN MOBILPHONE PAGING and design found to be “legally different”). In *American Paging*, the Board noted that the registrant provided both telephone and paging services, therefore the addition of PAGING provided more information to prospective consumers: “Customers who simply saw the mark AMERICAN MOBILPHONE and design and who simply utilized registrant’s mobile phone services, would not know

they were dealing with a company that also rendered paging services. *Am. Paging*, 13 USPQ2d at 2039.

But, the addition of a single word does not make a significant difference in all cases. In *Am. Sec. Bank v. Am. Sec. & Trust Co.*, 571 F.2d 564, 197 USPQ 65 (CCPA 1978) the United States Court of Customs and Patent Appeals held that “American Security” and “American Security Bank” were legal equivalents. The Court reasoned that “[w]hile AMERICAN SECURITY BANK is a distinguishable, three-word mark, the word ‘bank’ is purely descriptive and adds nothing to the origin-indicating significance of AMERICAN SECURITY. Customers using the services would know they were dealing with a bank.” *Id.* at 67. Similarly, in *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, (TTAB 2010), the Board held CAPITAL CITY BANK and CAPITAL CITY BANK GROUP to be essentially the same mark because they “engender the same continuing commercial impression.” *Id.* at 1656.

We find the facts in the present case are more similar to those in *American Security Bank* and *Citigroup* than to those in *American Paging*. The addition of the term MUSIC does not create a different commercial impression because it is generic when used in connection with sound recordings and the production and distribution of sound recordings. Consumers would know they were dealing with a music company, particularly because Applicant’s licensee, Apple Corps, has used variations of the APPLE mark, with APPLE as the dominant element, to identify its musical recordings, which inures to Applicant’s benefit, and because Applicant uses APPLE MUSIC to identify its service of publishing and distributing sound recordings.¹⁰⁹

¹⁰⁹ La Perle Decl. ¶ 19, 83 TTABVUE 4.

Moreover, Apple Corps' long use of other generic terms with APPLE, i.e., APPLE RECORDS, APPLE MUSIC PUBLISHING, APPLE FILMS, and the representation of an apple, suggests that consumers already are accustomed to seeing slight variations in Apple Corps' APPLE mark. Given the progression of musical formats from vinyl records, to 8-track cartridges, to cassettes tapes, to compact discs, and now to streaming services, it would not be unexpected for a company to update their mark to incorporate more modern and inclusive terminology by adopting the term MUSIC in place of terms such as RECORDS or FILMS. Modernization of a mark which retains the commercial impression of the previous version does not result in any abandonment or loss of priority in the mark. *See Jack Wolfskin*, 116 USPQ2d at 1134 (modernized version of mark creates the same continuing commercial impression as the registered mark); *In re Flex-O-Glass, Inc.*, 194 USPQ 203, 205 (TTAB 1977) (slight "modernization" of design mark does not prevent tacking on for priority).

We find that when used in connection with sound recordings and the production and distribution of sound recordings, the marks APPLE and APPLE MUSIC are "legal equivalents" because they both create the "same, continuing commercial impression so that consumers consider both as the same mark." *Hana Fin.*, 135 S. Ct. at 910.

Tacking also requires that the goods or services marketed under the earlier mark must be "the same or similar" as the goods or services marketed under the later mark. *See, e.g., In re Baroid Drilling Fluids Inc. v. Sun Drilling Prods.*, 24 USPQ2d 1048, 1051 (TTAB 1992); *Big Blue Prods. Inc. v. Int'l Bus. Machs. Corp.*, 19 USPQ2d 1072, 1075 (TTAB 1991). Here, we find the sound recordings identified in Applicant's

registrations to be “the same or similar” for purposes of tacking as the production and distribution of sound recordings identified in Applicant’s application. *Baroid*, 24 USPQ2d at 1052. That is, sound recordings are inseparable from the production and distribution of sound recordings. As Jones testified:

Apple Corps has been involved in the production and distribution of some of the *most famous sound recordings ever created* Apple Corps and/or affiliates and licensees produced and distributed sound recordings under its Apple Corps record label and APPLE word mark for The Beatles and other famous recording artists, and such sound recordings were (and many continue to be) distributed in the United States and worldwide.¹¹⁰

Accordingly, we find Applicant may claim priority as to the mark APPLE for production and distribution of sound recordings as early as August 1968.

VI. Conclusion

Opposer has established that he owns an inherently distinctive mark, APPLE JAZZ, which he uses in connection with “arranging, organizing, conducting, and presenting concerts and live musical performances.” Opposer’s earliest date of use of his APPLE JAZZ mark is June 13, 1985. Applicant, by tacking the use of the mark APPLE by Apple Corps, has established use of the mark APPLE MUSIC for the “production and distribution of sound recordings” as early as August 1968.

In view of Applicant’s earlier priority date, Opposer has not established the necessary element of priority required to prevail.

VII. Decision

The opposition is dismissed.

¹¹⁰ Jones Decl. ¶ 4, 71 TTABVUE 3-4.