Apple Tacks on Win for its Trademark Portfolio at TTAB

***Charles Bertini v. Apple, Inc.*, Opposition No. 91229891 (TTAB April 16, 2021)**

By: Lisa Holubar & Daniel Zhang | April 26, 2021

The Trademark Trial and Appeal Board ("TTAB") recently dismissed musician Charles Bertini's opposition to Apple Inc.'s Trademark Application for "APPLE MUSIC." Bertini, applicant of the word mark "APPLE JAZZ," opposed on the grounds that his mark held priority and there was a likelihood of confusion between "APPLE JAZZ" and "APPLE MUSIC." In dismissing the opposition, the TTAB held that Apple Inc. could claim prior first use all the way back to 1968 by tacking its 2015 application onto the priority of its predecessor – The Beatle's media company Apple Corp. The TTAB found that the applied-for mark "APPLE MUSIC" was legally equivalent to Apple Corp.'s prior marks "APPLE," "APPLE FILMS," and "APPLE RECORDS." The TTAB had previously granted summary judgment that a likelihood of confusion existed between the marks.

Apple Inc. filed an application for its mark "APPLE MUSIC" on June 11, 2015 for a large array of music-related goods and services under an intent-to-use basis. The record later stated that "Apple Music" launched on June 8, 2015, which would be Apple's apparent date of first use. Bertini filed an application for his mark "APPLE JAZZ" for identical goods and services on June 5, 2016 on an actual use basis, claiming a first use date as early as 1985. Subsequently, Bertini filed an opposition with the TTAB on September 2, 2016, on the ground of priority of first use in 1985 and a likelihood of confusion between the marks "APPLE MUSIC" and "APPLE JAZZ." Nevertheless, Apple Inc. has The Beatles to thank for overcoming the seemingly easy-to-compare dates of first use.

In 1963, The Beatles set up a corporation to produce and distribute the iconic band's music. Though originally named The Beatles Ltd., The Beatles changed the name to Apple Corps Ltd. as of 1968. Apple Corp., during their time distributing The Beatles' music, which TTAB noted was considered "evergreen" and "available continuously every year after their original release," had continuously used the "APPLE" word mark in connection with music production and distribution and additional word marks like "APPLE RECORDS" and "APPLE MUSIC PUBLISHING." In 2007, Apple Inc. and Apple Corps settled an ongoing trademark dispute where Apple Inc. took ownership and control of every of Apple Corps' trademarks that included the word mark "APPLE," while Apple Corps became a licensee of these marks.

Because the TTAB found that "APPLE MUSIC" created the same continuing, commercial impression as Apple Corp.'s prior "APPLE" marks in light of shifting technology in the music industry, it permitted Apple to "tack" its application onto the first use by Apple Corp. in 1968, overcoming Bertini's priority date in 1985. Nevertheless, even the TTAB notes that the standard for tacking is very strict and tacking in general is permitted only in "rare instances."

This decision, though non-precedential, is important to note. It is not uncommon for entities looking to gain priority to purchase an earlier mark. Entities that do so must be sure their mark as used post acquisition meets the strict standard of creating the same continuing, commercial impression as the pre-acquisition use of the mark.