

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

The Federal Circuit released a precedential opinion in Charles Bertini v. Apple Inc., 63 F.4th 1373

(Fed. Cir. 2023) on April 4, 2023. The opinion addresses the scope and applicability of the Tacking

Doctrine as it relates to trademark rights. The case appeals a final decision of the Trademark Trial

and Appeal Board (the "TTAB") dismissing Charles Bertini's opposition to Apple Inc.'s application to register the mark APPLE MUSIC. The Federal Circuit reversed, holding that Apple

Inc. could not tack its use of APPLE MUSIC for live musical performances onto Apple Corps'

1968 use of APPLE for gramophone records. Thus, Charles Bertini had the earlier priority date

(1985) compared to Apple Inc.'s priority date (2015). The Federal Circuit required that, for tacking

to apply, the new goods and services must be "substantially identical" to the previous goods and

services. The Court noted that "[t]his inquiry depends, at least in part, on whether consumers would

generally expect the new goods or services to emanate from the same source as the previous

goods." Here, the Court found that Apple Inc. could not show that live musical performances are

substantially identical to gramophone records (the goods and services of Apple Corps' 1968

APPLE trademark). In conclusion, for a trademark owner to claim priority to an earlier-filed

trademark application, the two trademarks' goods and services must be substantially identical.

If you have any questions, or if we can help you with any of your Intellectual Property needs,

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