

Bertini appealed to the U.S. Court of Appeals for the Federal Circuit (CAFC), which reversed the TTAB's decision and refused Apple's application. The parties agreed that there was a likelihood of confusion between the respective marks, so the only dispute concerned priority.

The CAFC stated that the standard for tacking an application to an earlier registration is strict, with the party seeking to tack bearing the burden to show that the old and new marks create the same, continuing commercial impression so that consumers would consider both as the same mark. This standard previously had been applied to cases in which the old and new marks had been used for the *same* goods or services. But this standard had never before been applied to marks for *different* goods or services. Put differently, the issue presented in this case was whether a trademark applicant can enjoy priority for *every* good or service listed in its application merely because it has priority through tacking for a *single* good or service listed in its application. The CAFC held that it cannot.

The CAFC said that, although an opposer can block a trademark application in full by proving priority of use and likelihood of confusion for *any* of the services listed in the application, the reverse is not true—the trademark applicant cannot establish priority for *all* of its listed services simply by proving priority for a *single* listed service.

In this case, the CAFC held that Apple's attempt to tack to the 1968 use of APPLE for "gramophone records" did not give Apple priority for "live musical performances" or any of the other services listed in its application because they were not "substantially identical." That is, the new goods or services were not within the normal evolution of the previous line of goods or services.

The CAFC decided that no reasonable person could conclude that the "live musical performances" listed in the Apple application were substantially identical to the "gramophone records" listed in the earlier registration. Therefore, Bertini had priority of his use of APPLE JAZZ for "live musical performances" notwithstanding Apple's earlier rights in APPLE for "gramophone records." Since likelihood of confusion had been agreed, Bertini's priority entitled him to prevail in his opposition in its entirety against Apple's application to register APPLE MUSIC mark for all of the services listed in Apple's application.

[Charles Bertini v. Apple Inc., No. 2:21-2301 \(Fed. Cir. April 4, 2023\).](#)

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Bill advises on domestic and international trademark matters at the highest level. His practice consists of counseling clients and handling domestic and international trademark and copyright matters including clearance, registration, proper use, licensing, contested administrative proceedings and infringement claims.