

ESTTA Tracking number: **ESTTA151550**

Filing date: **07/17/2007**

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

Proceeding	91162715
Party	Defendant BURGETT, INC. BURGETT, INC. 4111 NORTH FREEWAY BOULEVARD SACRAMENTO, CA 95834
Correspondence Address	JOHN P. O'BANION O'BANION & RITCHEY LLP 400 CAPITOL MALL, SUITE 1550 SACRAMENTO, CA 95814-4498 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	Steven L. Smith
Filer's e-mail	sls@intellectual.com
Signature	/sls/
Date	07/17/2007
Attachments	Declaration In Opposition To Motion To Dismiss As Discovery Sanction.pdf (26 pages)(1246790 bytes)

PERSIS INTERNATIONAL, INC.)	Opposition No.:	91162715
)	Application No.:	76/214,968
Petitioner/Opposer)	Mark:	SOHMER
)	Owner:	Burgett, Inc.
)		
v.)		
)		
BURGETT, INC.,)		
)		
Respondent/Applicant.)		
)		

I, Steven Smith, state and declare as follows:

2. The law firm of O'Banion & Ritchey was retained by Burgett, Inc. as trademark counsel to maintain its rights in the SOHMER and other trademarks including filing for registration for updated trademarks for Mason & Hamlin marks that were obtained through the bankruptcy court in Massachusetts.

3. I was responsible for preparing the response to the order to compel interrogatory responses mailed May 16, 2007 by the Board. Language responding to Interrogatory No. 5 and No. 12(e) was prepared initially. The response to other interrogatories depends upon the response of these two interrogatories. Interrogatory 26 is essentially the same interrogatory as No. 12(e). Unfortunately, the wrong draft was finalized. The responses to interrogatories 6, 7 and 26 were not included in the final. The response was finalized outside of the office without the benefit of the order. I thought that I was serving a complete response when it was served within the time given by the Order of the Board. I am ultimately responsible for the error.

4. The filing of incomplete responses was unintentional and complete responses were served on the Opposer when the error was discovered. I apologize for any inconvenience or confusion this may have caused. The Applicant should not be penalized for an error of counsel.

5. Exhibit A is a true and correct copy of the complete interrogatory responses served by the Applicant.

6. The Opposer has submitted photographs of a piano that was sold by Burgett, Inc. on March 5, 2001 and shipped to Sacramento, California. Knowing that the Board is unfamiliar with the piano market, the Opposer has alleged that this piano was not a SOHMER piano and was a deception on the marketplace with the apparent hope that Board will make an uninformed decision. However, "stenciling" is an accepted practice in the industry and the Opposer only sells "stenciled" pianos.

7. “Stenciling” is a limited practice among a few piano resellers like Persis that purchase a few low end pianos that do not have any exterior indicia of source or make from a manufacturer overseas. The reseller then “stencils” his own name or mark on the piano. This practice can be very damaging to a trademark if widely used and there is an intention of maintaining or establishing a product line because there is no consistency in piano type, style or quality associated with the mark. The stenciled piano is also recognized by technicians and those who open the piano as being manufactured by the original overseas manufacturer.

8. An inspection of the piano that was claimed by the Opposer to be the “first sale” by Persis will reveal components and indicia of the DONG BEI PIANO COMPANY. This piano was one of several purchased by Ed Richards from Dong Bei Piano Company in China that does not have the Dong Bei brand names on the exterior of the piano. The Opposer then “stenciled” on a name on the exterior of the piano. The Opposer is believed to have applied names such as EVERETT, KIMBALL, SOHMER and others to the same make of piano.

9. Exhibit B is a true and correct copy of web pages from the Dong Bei Piano Company of China that sells pianos in the United States. These pianos are sold by Dong Bei under the names PRINCE, PRINCESS, EKSTROM, NORDISKA and others.

10. Exhibit C is a true and correct copy of a web page from Royale Piano Company. It is believed that the Opposer has stenciled Royale Piano Company pianos from Korea as well.

11. Piano repair and restoration technicians recognize the source of manufacture of the stenciled pianos from the structure and identifying plates and marks within the individual piano.

12. During discovery, the Opposer Persis has identified approximately twenty sales since their alleged date of used in 2001 to the present originating from two different manufacturers. It is believed that Ed Richards/Persis has applied the KIMBALL mark to the same piano styles as they claim to have applied the SOHMER mark.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Date: July 17, 2007.

Steven L. Smith
Steven L. Smith, Esq.
400 Capitol Mall, Suite 1550
Sacramento, CA 95814
Attorney for Applicant

EXHIBIT A

(Discovery Responses Of The Applicant)

PERSIS INTERNATIONAL, INC.)	Opposition No.:	91162715
)	Application No.:	76/214,968
Petitioner/Opposer)	Mark:	SOHMER
)	Owner:	Burgett, Inc.
)		
v.)		
)		
BURGETT, INC.,)		
)		
Respondent/Applicant.)		
)		

The following interrogatories are responded to under a narrow definition of “you” or “Applicant” to exclude the use of the predecessors in interest and associated companies and licensees, which inures to the benefit of the Applicant as a matter of law. The responses are made without waiving the right to claim the benefits of use by related companies.

RESPONSES AND OBJECTIONS

5) *Please describe the circumstances under which you claimed first use of the SOHMER mark.*

RESPONSE TO INTERROGATORY NO. 5:

The "circumstances" under which the Applicant claims "first use" of the SOHMER trademark was by its predecessor in interest Hugo Sohmer. The first use of the mark SOHMER for pianos in commerce was April 1, 1872. The SOHMER mark was applied to pianos and associated manufacturing and replacement part services from that time to the present through a number of business entities. The mark was applied to both upright and grand piano styles. Through the substantially continuous and exclusive use of the mark by Hugo Sohmer, Sohmer & Company and Mason & Hamlin and licensee's from the date of first use in 1872 until the present, the mark SOHMER has become well known and famous within the piano manufacturing industry.

On October 3, 1911, Sohmer & Company filed an application for registration of the mark SOHMER that developed into registration No. 85,691 in March 5, 1912 on the Principal Register. This registration had three 20-yr renewals by the Sohmer & Company but was not renewed in 1992 even though it was still in use and the registration was cancelled December 7, 1992.

On June 2, 1917, Sohmer & Company filed a trademark application for the mark SHOMER & CO. for use on pianos. The mark was registered on October 23, 1917 and given registration No. 119,130. Likewise, this registration had three 20-year renewals and was active through July 27, 1998.

On May 5, 1920 Sohmer & Company filed a trademark application for the mark SOHMER in a shield design. The registration from this application was granted on November 23, 1920 and has registration No. 137,464. This registration was renewed three times and was active at the date of filing of the above captioned application.

In 1989, Sohmer & Company changed its name to Sohmer Corporation. On March 30, 1992, Sohmer Corporation filed an application for the mark SOHMER for musical instruments, namely pianos. Registration on the principal Register was granted on August 10, 1993 and given No. 1,786,687. This registration was cancelled on December 29, 2000.

In 1994, Sohmer Corporation was merged or otherwise acquired by Mason & Hamlin Co., a manufacturer of pianos under its own and other marks. In 1996, the Mason & Hamlin Co. filed for Chapter 11 Bankruptcy. Applicant purchased most of the assets and goodwill of Mason & Hamlin Co. including the trademark rights to the mark SOHMER through the Bankruptcy Court.

By order of the Court, there was a judicial determination of the existence of trademark rights and goodwill associated with the SOHMER trademarks and that all rights, title, interest and goodwill in the SOHMER marks were transferred to the Applicant. Therefore, by judicial decree, the Applicant may claim the benefit of the "first use" of Hugo Sohmer as well as the rights generated from use along with the goodwill associated with such use. The date of "first use" for purposes of trademark priority is April 1, 1872.

By motion to compel, Interrogatory 5 has been changed to "*What was the date the mark was first used by Burgett, Inc. (exclusive of predecessors and licensees)?*" The SOHMER marks were in use by Mason & Hamlin before and during the bankruptcy proceedings. The Mason & Hamlin distributors had inventory for sale through this time and after the assets were acquired in 1996. The last known offer for sale of a new SOHMER piano by a Burgett/Mason & Hamlin distributor was in 2002 in New York. (advertisement previously produced). After acquisition by Burgett, the existing use of the SOHMER mark continued under existing signs and telephone listings etc. as parts, inventory and information were liquidated. Burgett/Mason & Hamlin continues to receive inquiries and provide repair and part information to the marketplace for SOHMER pianos. (previously provided). Other uses of the SOHMER mark by Burgett/Mason & Hamlin at that time included news releases and articles

notifying the public and guilds of the acquisition of the SOHMER marks and of the plans to design new piano lines.

In sum, for purposes of priority, the date of first use claimed by the Applicant in its statement of use is April 1, 1872. The earliest date that the Applicant could have used the registrations acquired in bankruptcy is approximately December 1996 when it acquired the assets of Mason & Hamlin and liquidated the residual assets of Sohmer & Company etc. The date of "first use" by the Burgett occurred when the assets of were conveyed to Burgett in 1996 pursuant to the orders of the bankruptcy court. The "circumstances of that use" include, but are not limited to, use of the mark on piano sales; signage; piano parts; offers for the sale of piano parts etc.; public announcements and promotion of the mark and contract negotiations relating to the production and distribution of goods sold under the mark.

6) *Describe the circumstances under which you claimed first use in commerce in the United States of the SOHMER trademark.*

RESPONSE TO INTERROGATORY NO. 6:

This interrogatory is objected to as being vague and ambiguous with respect to the phrase "you claimed first use of the SOHMER mark" and to the term "circumstances." Reserving these objections:

As indicated in response to Interrogatory 5, the Applicant claims the date of first use as April 1, 1872. This is the date that was claimed in the statement of use filed by the Applicant in the underlying application. The circumstances surrounding the first use of the mark by Hugo Sohmer are unknown but the use of the mark by Hugo Sohmer and the Sohmer Corporation for over a century is evident from the number of pianos bearing the Sohmer trademark throughout the world. The Applicant claims the benefit of the goodwill and registrations of the Sohmer Corporation acquired by Mason & Hamlin and Applicant through the Bankruptcy specifically identifying and granting those rights to the Applicant. The use of predecessors and licensees of the Applicant inures to the benefit of the Applicant as a matter of law. (See e.g. Crown Fabrics Corp. v. American Viscose

Corp., 145 F. 2d 246 (CCPA 1944) or General Mills, Inc. v. DCA Food Indus., Inc., 149 USPQ 225 (TTAB 1966).

As interpreted by the Board in the order to compel, the term “you” means Burgett, Inc. exclusive of the predecessors in interest or the licensees of the Applicant. The interrogatory has been interpreted to mean the date of first use by Burgett, Inc. in commerce. The date of “first use” by the Applicant occurred when the assets of Mason & Hamlin were conveyed to Burgett in 1996 pursuant to the orders of the bankruptcy court. Mason & Hamlin was an existing business when it was acquired by the Applicant in Bankruptcy. The buildings and assets that were acquired had signs using the SOHMER mark that continue to be present today. The business had telephone listings using the SOHMER mark. The business had piano parts and inventory that bore the SOHMER mark. In addition, the mark was used by the Applicant in public announcements and communications with Mason & Hamlin/Burgett distributors as well as with piano technicians and the technician guilds. Technical repair and design information and residual parts and inventory were available to the public from that date. The Applicant believes that it was approximately December 1996 when full control of the assets of Mason & Hamlin/Sohmer was obtained out of bankruptcy. Ownership of the Sohmer trademark and the acquisition of the company by the Applicant was widely known in the general public, the music industry and particularly the piano technician service industry. Although the SOHMER mark is under license, the Applicant continues to field inquiries from the public as well as technicians.

The date of first use and the date of first use in commerce are believed to be the same for both the use of the predecessors in interest as well as with the dates of use by the Applicant.

7) *Identify all documents, purchase orders, invoices, labels or any written materials upon which Applicant will rely to establish the dates identified in Interrogatories 5 and 6.*

RESPONSE TO INTERROGATORY NO. 7:

This interrogatory is objected to as being unduly burdensome and seeking information that is not reasonably calculated to lead to the production of admissible evidence. The Applicants claim of first use is the date of first use of Sohmer Corporation, the predecessor in interest of Mason & Hamlin and Applicant. One document indicating the date of first use is the filing history of Registration No. 85,691. Subsequent registrations by SOHMER Corporation are a matter of public record at the USPTO and are equally available to the Opposer. These registrations and renewals are some evidence of the use of the mark for more than a century. The Applicant has previously produced documents from the Bankruptcy Court showing the transfer of all right, title and interest to the Applicant. The Applicant has already produced photographs of signs, invoices, advertisements by distributors, news articles and releases etc to show use of the mark.

As interpreted by the Board in the order to compel, the term "you" means Burgett, Inc. exclusive of the predecessors in interest or the licensees of the Applicant. Accordingly, the interrogatory is interpreted as requesting the identification of documents showing the first use by Burgett, Inc. and ignoring use by Mason & Hamlin, Sohmer Corporation and Samick etc. that inures to the benefit of the Applicant.

Reserving these objections, the Applicant has identified and previously produced the following documents:

- Telephone listings using the SOHMER mark;
- Photographs of signs publicly displayed on the buildings owned by the Applicant;
- Photographs of repair and replacement parts bearing the SOHMER mark.

- Photographs of design and production drawings that can be used in the special manufacture of replacement parts for SOHMER pianos.
- Advertisement of one distributor of the Applicant offering a new SOHMER piano for sale in 2002.
- Magazine and newspaper articles describing the acquisition of Mason & Hamlin by Burgett.
- E-mail inquires from the public.
- Communications from technicians.
- Contract with the Opposer for the acquisition of the rights to and the existing SOHMER registration and associated communications.
- Bankruptcy order identifying goodwill and rights in the SOHMER and transferring those rights to the Applicant.
- Correspondence documenting early attempts by the Applicant to obtain manufacturing using similar designs to the traditional SOHMER pianos.
- U.S. Government Report pages identifying the Applicant as the owner of the SOHMER mark.
- Invoice showing sale of one piano by Burgett (rather than Mason & Hamlin) under the mark SOHMER.

As indicated in the response to Interrogatory 12(e) and 26, most of the documents that were in existence regarding the sale of pianos and piano parts and information were either destroyed after a few years or did not exist. The transition period from bankruptcy and the elimination of inventory had inconsistent record keeping that is typical in these types of acquisitions.

12) *Identify each product or service where Applicant has at any time used the name SOHMER and for each, identify:*

e. State the total dollar volume of sales or income generated from each product or service for each year from the date on which each were first sold, rented, or rendered to the present.

RESPONSE TO INTERROGATORY NO. 12(e):

The SOHMER mark has been used on pianos, piano parts, special manufacture and repair services, information distribution and education services the like have been available by the Applicant and its related companies. The Applicant can only speculate at the "total dollar volume of sales" of "products or services" under the SOHMER marks by the Applicant or its predecessors and licensees because more than a decade has passed, accounting documents have been destroyed or never existed, or are not in the possession or control of the Applicant.

The registrations and assets relating to the SOHMER marks were acquired out of bankruptcy as part of the assets of Mason & Hamlin. Many of the Sohmer & Company assets including parts and plans and forms etc. had been transported from a factory location to a warehouse location near the Mason & Hamlin plant in Haverhill. There was no general inventory available or created during this transition period. Parts and piano sales and shipments were also not strictly accounted for according to trademark. Pianos and piano parts sold under Knabbe, Falcone, Sohmer and Mason & Hamlin etc. were sold to make way for new machinery and designs. Assets were not distinguished by trademark name. Accounting records at the time did not distinguish sales by trademark name and it is therefore impossible to provide a definitive "total dollar volume" based on a particular piano or part type. Furthermore, the accounting records are not kept for more than five years as was the common practice at the time since there was no business or accounting reason to keep such records. Therefore, it is not possible to provide a definitive "total dollar volume" due to the disposal of very outdated records that would be roughly ten years old. Accordingly, the Applicant can only speculate about the "dollar volume" as that phrase is understood.

If the sales by predecessors, distributors and licensees of Burgett, Inc. are *ignored*, the speculative dollar value of the sales of pianos, parts and repair information services obtained by Burgett/Mason & Hamlin from 1996 to 2006 are set forth below. After 2001, the Applicant could not manufacture and sell pianos under the SOHMER mark because of an exclusive license but continues to provide parts and repair and design information services etc to the present time.

1996: Several thousand dollars

1997: Several thousand dollars

1998: Several hundred dollars

1999: Several hundred dollars

2000: Several hundred dollars

2001: Several hundred dollars

2002: Several hundred dollars

2003: Several hundred dollars

2004: Several hundred dollars

2005: Several hundred dollars

2006: Several hundred dollars

If the sales of the distributors and licensees of Mason & Hamlin/Burgett, Inc. are included in the analysis, the "total dollar volume" of pianos sold under the SOHMER trademarks during this time period are near a "*million dollars*."

Thousands of pianos have been sold under the SOHMER trademark that inures to the benefit of the Applicant. (previously produced by Applicant under protective order).

26) *For the period beginning immediately after Burgett, Inc.'s April 1996 bankruptcy purchase of the Mason & Hamlin Companies assets to the present, identify the revenue received each year by Burgett, Inc. (excluding its predecessors, licensees, distributors, affiliates and retailers) from the sale of products under the SOHMER mark. Exclude all revenue received from the licensing agreement with Samick, which Burgett, Inc. identified in its response to Interrogatory No. 17.*

This interrogatory is objected to as being unduly burdensome and duplicative in that it asks the same question as Interrogatory 12(e) responded to herein. The Applicant incorporates the response to Interrogatory 12(e) as though set forth in full.

As indicated, the Applicant did not differentiate its accounting between parts and inventory sold during the transition time by brand. In the absence of specific documents, the Applicant can only speculate or estimate the funds that were generated during any given time period.

If the sales by predecessors, distributors and licensees of Burgett, Inc. are *ignored*, the speculative dollar value of the sales of pianos, parts and repair information services obtained by Burgett/Mason & Hamlin from 1996 to 2006 are set forth below. After 2001, the Applicant could not manufacture and sell pianos under the SOHMER mark because of an exclusive license but continues to provide parts and repair and design information services etc to the present time.

1996: Several thousand dollars

1997: Several thousand dollars

1998: Several hundred dollars

1999: Several hundred dollars

2000: Several hundred dollars

2001: Several hundred dollars

2002: Several hundred dollars

2003: Several hundred dollars

2004: Several hundred dollars

2005: Several hundred dollars

2006: Several hundred dollars

Since the new lines of SOHMER pianos have been in production and marketed by the licensee and most of the old inventory of parts depleted, the Applicant values the distribution of technical information concerning the traditional SOHMER pianos distributed by Applicant to be a few hundred dollars per year.

Dated: July 12, 2007

O'BANION & RITCHEY LLP

By: Steven L. Smith

Steven L. Smith, Esq. Reg. No. 44,343

O'BANION & RITCHEY LLP

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(916) 498-1010

Attorneys for Applicant

Burgett, Inc.

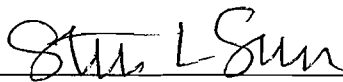
CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed APPLICANT'S AMENDED RESPONSES TO OPPOSER'S INTERROGATORIES 5-7, 12(e) and 26, was served upon the following this day, July 12, 2007, as follows:

VIA FIRST CLASS MAIL, POSTAGE PREPAID

John F. Eichler
John F. Eichler & Associates
1559 S. Hull Avenue
Westchester, IL 60154

Attorneys for
PERSIS INTERNATIONAL, INC.



Steven L. Smith

EXHIBIT B

(Web Pages From Dong Bei Piano Manufacturers Stenciled by Opposer)

Technology




→ GRAND PIANOS

→ UPRIGHT PIANOS

Products

→ GRAND PIANOS

→ UPRIGHT PIANOS

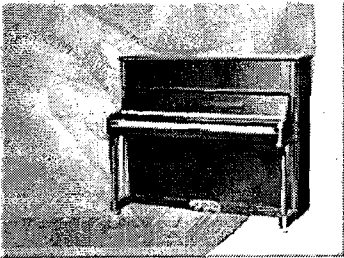




DONG BEI PIANO

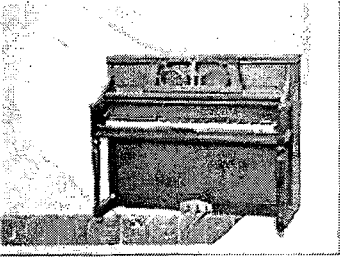
Upright Pianos—Nordiska Series

www.dongbeipiano.com

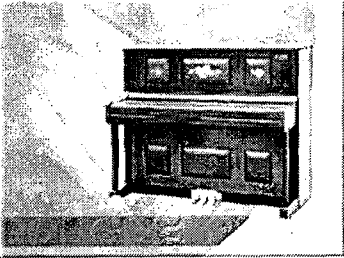
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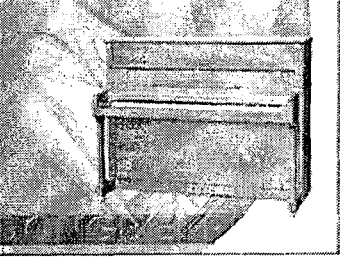
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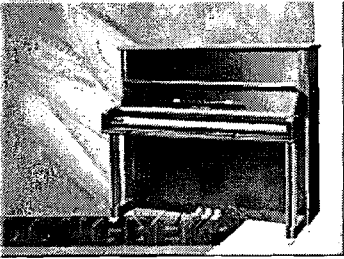
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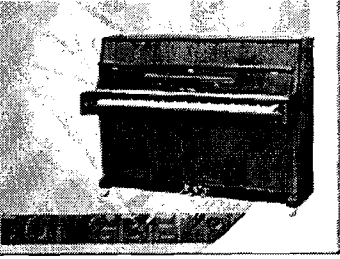
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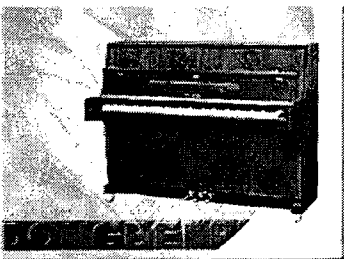
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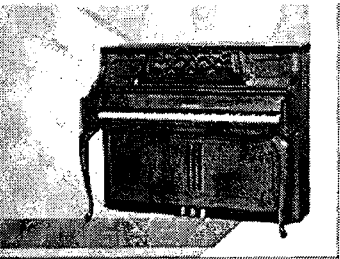
126CA




109G



109G



115MC



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➤ UPRIGHT PIANOS

Products

➤ GRAND PIANOS


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www.dongbeipiano.com

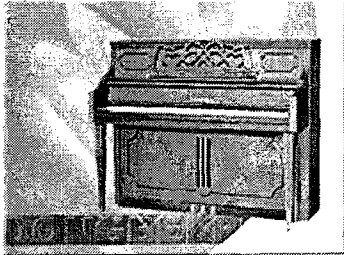
DONG BEI PIANO

Upright Pianos---Nordiska Series

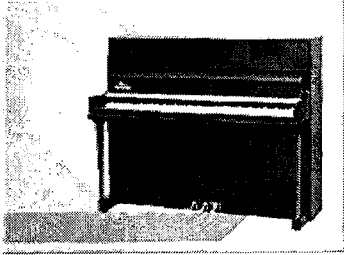
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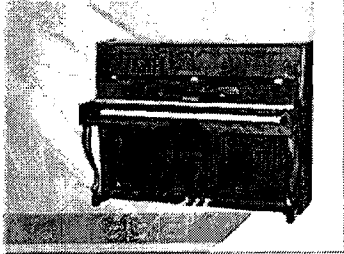
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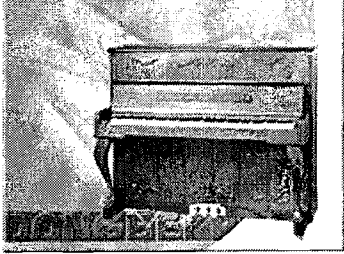
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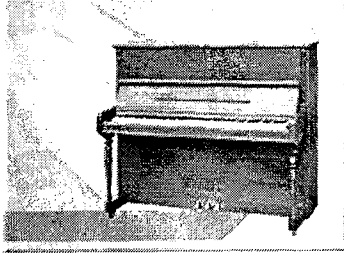
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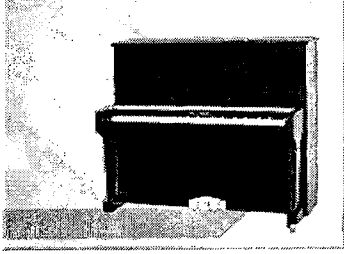
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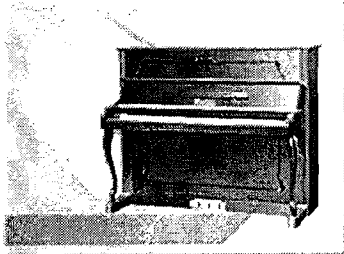
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120CG

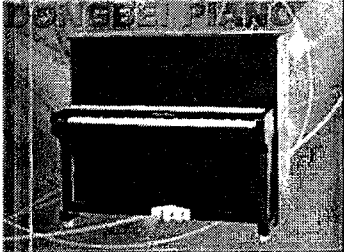


120CS



126CA





Technology

→ GRAND PIANOS

→ UPRIGHT PIANOS

Products

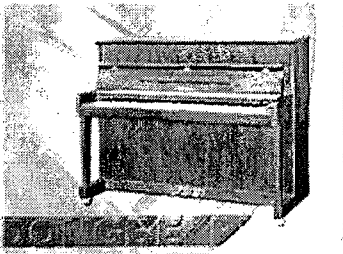
→ GRAND PIANOS

→ UPRIGHT PIANOS

www.dongbeipiano.com

DONG BEI PIANO

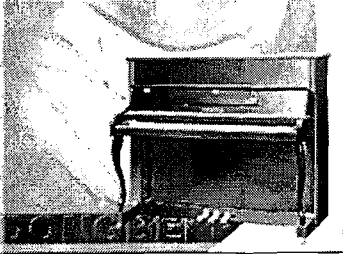
Upright Pianos—Prince Series



110WH



115WHG



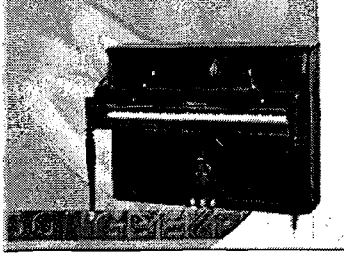
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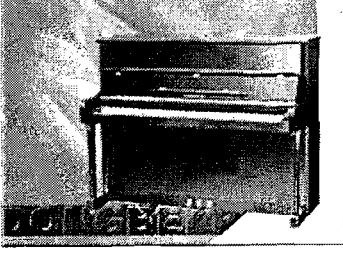
126WH



113WH



114MH



121WHG

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Technology

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Products

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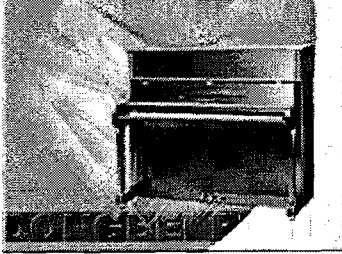
www.dongbeipiano.com

DONG BEI PIANO

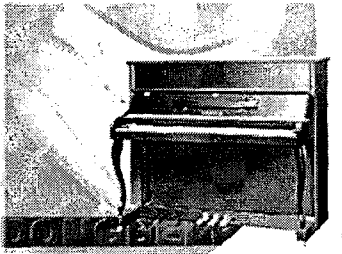
Upright Pianos--Prince Series



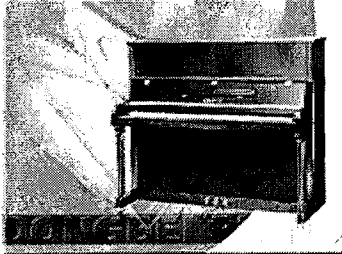
110WH



115WHG




115WSG



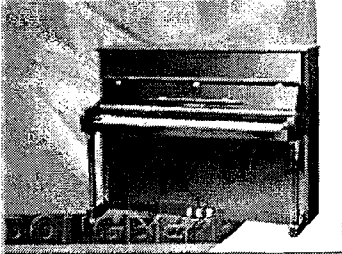
126WH



113WH



114MH



121WHG

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DONG BEI PIANO

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EXHIBIT C

(Web Pages From Royale Piano Manufacturers Stenciled by Opposer)

ROYALE CLASSIC

ROYALE CLASS has developed new advanced pianos based on the World Class Concept. The World Class Concept Provides pianos perfected to meet the requirements of traditional European stlye in terms of Sound, Touch and Stability.



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