

ESTTA Tracking number: **ESTTA683743**

Filing date: **07/15/2015**

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

Proceeding	92061215
Party	Plaintiff SCHIEDMAYER CELESTA GMBH
Correspondence Address	MICHAEL J STRIKER STRIKER STRIKER & STENBY 103 EAST NECK ROAD HUNTINGTON, NY 11743 UNITED STATES striker@strikerlaw.com
Submission	Motion for Default Judgment
Filer's Name	Michael J. Striker
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Signature	/Michael J. Striker/
Date	07/15/2015
Attachments	schiedmayer.pdf(712213 bytes )

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL & APPEAL BOARD**

Schiedmayer Celesta GmbH,            )  
  )  
                          Petitioner,        )  
  )  
v    )  
  )  
Piano Factory Group, Inc.,            )  
  )  
                          Respondent.      )  
\_\_\_\_\_                                      )

Cancellation No. 92/061,215  
Reg. No. 3,340,759  
Mark: SCHIEDMAYER  
Registration Date: 11/20/2007

**PETITIONER'S ADDENDUM TO MEMORANDUM IN REPLY TO RESPONDENT'S  
OPPOSITION TO MOTION TO STRIKE ANSWER  
AND FOR DEFAULT JUDGMENT**

Petitioner, Schiedmayer Celesta GmbH, herewith requests that the following addendum to its Memorandum in Reply be considered.

It is requested that this addendum be considered because the information contained herein was not available at the time Petitioner's Memorandum in Reply was filed.

Reference is made to the Office Action issued on July 14, 2015 with respect to Applicant's Trademark Application No. 86/600,864, of which a copy is attached.

In the Office Action, registration to the Applicant (Petitioner), has been refused in view of Section 2(d), Likelihood of Confusion, in view of Respondent's Registration No. 3,340,759.

In the Office Action it is indicated that the marks are similar and the goods are similar.

It is thus patently clear that Respondent's required "meritorious defense" is entirely frivolous, particularly in view of the fact that it is the official position of the Trademark Office that the respective goods involved are sufficiently similar to establish likelihood of confusion.

It is noted parenthetically that a surname refusal has also been issued. However, this is not any type of meritorious defense since the Petitioner herein can easily file a legitimate claim to distinctiveness.

It is further requested that the Affidavit filed on July 14, 2015 of Glenn Treibitz be given no consideration. The unexplained, dilatory filing of an Affidavit, weeks after it would have been due should be given no consideration. No reason is given for the filing of an Affidavit a month after its due date.

In any event the Affidavit says only that between May 17, 2015 and May 27, 2015, Glenn Treibitz was looking for counsel. The problem is that Respondent received the Petition for Cancellation on April 7, 2015. Totally unexplained is what efforts, if any, were made to secure counsel from April 7, 2015 to May 17, 2015, a period of some 40 days.

In addition the Affidavit is conclusionary, without setting forth any facts as to what efforts were made and when to secure counsel. It is also unbelievable.

Counsel for the Respondent Adam Stephenson is the same person who is attorney of record in the trademark registration sought to be cancelled herein. It is simply beyond belief that Respondent could not contact its own attorney within the required term. At the very least, the Treibitz Affidavit should have explained how it was necessary to take some 50 days to contact his own attorney. It does not and it should be given no consideration.

Respectfully submitted,



Michael J. Striker  
Attorney for Petitioner  
Reg. No.: 27233  
103 East Neck Road  
Huntington, New York 11743

## CERTIFICATE OF SERVICE

It is hereby certified that the attached Addendum to Memorandum in Reply was served upon counsel for Respondent via First Class Mail, postage prepaid, at the following address:

Adam R. Stephenson, Ltd.  
40 W. Baseline Road, Suite 101  
Tempe, AZ 85283

This 15<sup>th</sup> day of July, 2015.

  
\_\_\_\_\_  
MICHAEL J. STRIKER

**To:** Schiedmayer Celesta GmbH ([striker@strikerlaw.com](mailto:striker@strikerlaw.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 86600864 - SCHIEDMAYER - 5442  
**Sent:** 7/14/2015 2:42:40 PM  
**Sent As:** ECOM120@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)  
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[Attachment - 5](#)  
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[Attachment - 11](#)  
[Attachment - 12](#)  
[Attachment - 13](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 86600864

**MARK:** SCHIEDMAYER

**\*86600864\***

**CORRESPONDENT ADDRESS:**

MICHAEL J. STRIKER  
Striker Striker & Stenby  
103 E Neck Rd  
Huntington, NY 11743-1567

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<http://www.uspto.gov/trademarks/teas/response>

[VIEW YOUR APPLICATION FILE](#)

**APPLICANT:** Schiedmayer Celesta GmbH

**CORRESPONDENT'S REFERENCE/DOCKET NO :**

5442

**CORRESPONDENT E-MAIL ADDRESS:**

[striker@strikerlaw.com](mailto:striker@strikerlaw.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE: 7/14/2015**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

### Summary of Issues

- Section 2(d) Refusal – Likelihood of Confusion
- Section 2(e)(4) Refusal – Primarily Merely a Surname

### Section 2(d) Refusal – Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3340759 (“SCHIEDMAYER”). Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

### Similarity of the Marks

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(v).

In the present case, applicant's mark is “SCHIEDMAYER” and registrant's mark is “SCHIEDMAYER”. Thus, the marks are identical in terms of appearance and sound. In addition, the connotation and commercial impression of the marks do not differ when considered in connection with applicant's and registrant's respective goods and services.

Therefore, the marks are confusingly similar.

Similarity of the Goods

Applicant's goods are "Keyboard musical instruments."

Registrant's goods are "Pianos, namely, upright pianos, grand pianos, and digital pianos."

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i).

The respective goods need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

With respect to applicant's and registrant's goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified goods and/or services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording — specifically, keyboard musical instruments — to describe the goods and this wording is presumed to encompass all goods of the type described, including those in registrant's more narrow identification, which specifies that these instruments are various types of pianos.

Based on the analysis above, applicant's and registrant's goods are related.

Accordingly, applicant's mark so resembles registrant's mark that consumers are likely to be confused, and registration must be refused under Section 2(d).

Applicant should note the following additional ground for refusal.

## Section 2(e)(4) Refusal – Primarily Merely a Surname

Applicant has applied to register the mark “SCHIEDMAYER” for use in connection with “Keyboard musical instruments.”

Registration is refused because the applied-for mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); *see* TMEP §1211. The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); *see* TMEP §§1211, 1211.01.

The following five factors are used to determine whether a mark is primarily merely a surname:

- (1) Whether the surname is rare;
- (2) Whether anyone connected with applicant uses the term as a surname;
- (3) Whether the term has any recognized meaning other than as a surname;
- (4) Whether the term has the structure and pronunciation of a surname; and
- (5) Whether the term is sufficiently stylized to remove its primary significance from that of a surname.

*See In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995); TMEP §1211.01.

Although “SCHIEDMAYER” appears to be a relatively rare surname, *see* attached Switchboard screen capture, a rare surname may be unregistrable under Trademark Act Section 2(e)(4) if its primary significance to purchasers is that of a surname. *E.g.*, *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Giger*, 78 USPQ2d 1405 (TTAB 2006); *see* TMEP §1211.01(a)(v). There is no minimum number of telephone directory listings needed to prove that a mark is primarily merely a surname. *See* TMEP §1211.02(b)(i); *see, e.g.*, *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986).

Moreover, a term that is the surname of an individual applicant or that of an officer, owner, or principal of applicant’s business is probative evidence of the term’s surname significance. TMEP §1211.02(b)(iv); *see, e.g.*, *In re Etablissements Darty et Fils*, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985) (holding DARTY primarily merely a surname where “Darty” was the surname of applicant’s corporate president); *In re Cazes*, 21 USPQ2d 1796, 1796-97 (TTAB 1991) (holding BRASSERIE LIPP primarily merely a surname where “Lipp” was the surname of the restaurant’s founder and the term “brasserie” (translated as “brewery”) was found merely descriptive and disclaimed). In this case, “SCHIEDMAYER” is the surname of applicant’s current Executive Partner and the surname of applicant’s founding family. *See* attached screen capture from Schiedmayer Celesta.

Evidence that a word has no meaning or significance other than as a surname also is relevant to determining whether the word would be perceived as primarily merely a surname. *See In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986); TMEP §1211.02(b)(vi). The attached evidence from the Merriam-Webster dictionary and the Columbia Gazetteer of the World shows that the word does not appear in the dictionary or the gazetteer. Thus, this word appears to have no meaning or significance other than as a surname.

The fact that a term looks and sounds like a surname may also contribute to a finding that the primary significance of the term is that of a surname. *In re Giger*, 78 USPQ2d 1405, 1409 (TTAB 2006); *In re Gregory*, 70 USPQ2d 1792, 1796 (TTAB 2004); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988); *In re Petrin Corp.*, 231 USPQ 902, 904 (TTAB 1986); see TMEP §1211.01(a)(vi). Here, the term “SCHIEDMAYER” is phonetically and structurally similar to several surnames. See attached Switchboard screen capture.

A mark deemed primarily merely a surname may be registered on the Principal Register under Trademark Act Section 2(f) by satisfying one of the following:

(1) Submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“The mark has become distinctive of the goods and/or services through the applicant’s substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.”** 37 C.F.R. §2.41(a)(2); TMEP §1212.05(d); see 37 C.F.R. §2.193(e)(1); or

(2) Submit actual evidence of acquired distinctiveness. 37 C.F.R. §2.41(a)(3); TMEP §1212.06. Such evidence may include the following: examples of advertising and promotional materials that specifically promote the applied-for mark as a trademark and/or service mark in the United States; dollar figures for advertising devoted to such promotion; dealer and consumer statements of recognition of the applied-for mark as a trademark and/or service mark; and any other evidence that establishes recognition of the applied-for mark as a source-identifier for the goods and/or services. See *In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp. of Am.*, 201 USPQ 957 (TTAB 1979); TMEP §§1212.06 *et seq.*

Trademark Act Section 2(f), 15 U.S.C. §1052(f); see 37 C.F.R. §2.41; TMEP §§1211, 1212.

Please note that to establish acquired distinctiveness by extrinsic evidence or long-term use, applicant may rely only on use in commerce that may be regulated by the United States Congress. See 15 U.S.C. §§1052(f), 1127. Use solely in a foreign country or between two foreign countries is not evidence of acquired distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741, 1746-47 (TTAB 1999); TMEP §§1010, 1212.08.

Although applicant’s mark has been refused registration, applicant may respond to the refusals by submitting evidence and arguments in support of registration.

### Response Guidelines

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. See TMEP §§705.02, 709.06.

**TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE:** Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$50 per international class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone without incurring this additional fee.

/Danielle E. Johnson/  
Examining Attorney  
Law Office 120  
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**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

Print: Jul 13, 2015

78157552

**DESIGN MARK**

**Serial Number**

78157552

**Status**

CANCELLATION PENDING

**Word Mark**

SCHIEDMAYER

**Standard Character Mark**

No

**Registration Number**

3340759

**Date Registered**

2007/11/20

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(1) TYPED DRAWING

**Owner**

Piano Factory Group CORPORATION CALIFORNIA 323 S. Front St., #106  
Burbank CALIFORNIA 915021918

**Goods/Services**

Class Status -- ACTIVE. IC 015. US 002 021 036. G & S: Pianos,  
namely, upright pianos, grand pianos, and digital pianos. First Use:  
2003/11/10. First Use In Commerce: 2003/11/10.

**Filing Date**

2002/08/24

**Examining Attorney**

BELENKER, ESTHER

**Attorney of Record**

Adam R. Stephenson