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

Proceeding	92061215
Party	Plaintiff Schiedmayer Celesta GMBH
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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

**REQUEST FOR RECONSIDERATION OF THE *SUA SPONTE* STRIKING
OF PETITIONER'S CLAIM OF FRAUD**

May 12, 2016

Pursuant to Section 518 of the TBMP, Petitioner herewith requests reconsideration of that portion of the Decision of April 22, 2016 striking, *sua sponte*, Petitioner's claim of fraud by Respondent in the maintenance of the registration sought to be cancelled herein.

It is noted that Petitioner's claim of fraud related to both fraud in the acquisition of the subject registration and also fraud in the *maintenance* of the subject registration.

In other words, Petitioner's allegation of fraud related to two separate aspects, first, the acquisition of the registration and second, the maintenance of the

registration by Respondent. The two claims both relate to Fraud but are exclusive from one another.

In the Decision of April 22, 2016, Petitioner's entire claim to fraud was stricken, *sua sponte*, for the following reasons:

"However, any averred failure to disclose to the Office the alleged rights of a third party to an applied for mark in an application for registration or maintenance document does not constitute fraud. (Citing authorities)

Therefore, any knowledge Respondent may have had regarding Petitioner's use of the Schiedmayer marks does not constitute fraud."

However, Petitioner did not base its claim of fraud in the *maintenance* of the registration upon any knowledge or imputed knowledge by Respondent of Petitioner's use of its trademark.

Attached hereto as Exhibit A is a copy of Petitioner's claim of fraud in the acquisition and maintenance of the subject registration.

Petitioner does not object to the striking of paragraph 9 relating to fraud in the acquisition of the registration.

However, Petitioner clearly alleged fraud in the *maintenance* of the subject registration in paragraphs 10 and 11 thereof.

In paragraphs 10 and 11 of the Claim to Fraud, Petitioner alleges that Respondent falsely, fraudulently and with deliberate intent, filed a Declaration of Use under Sections 8 and 15 which falsely and fraudulently and intentionally represented to the Office that it had continued to use the trademark SCHIEDMAYER and had done so continuously for the five years next preceding the filing of the Declaration of Use for pianos, including upright pianos, grand pianos, and digital pianos. Thus, Petitioner clearly alleged that Respondent had falsely, fraudulently and intentionally misrepresented to the Office compliance with both sections 8 and 15 of the Act.

While the Claim to Fraud also alleges lack of sales, it is noted that paragraph 10, as paraphrased above, specifically alleges lack of *use*, which covers both sales and transport in commerce.

The allegations of fraud set forth in paragraphs 10 and 11 clearly meet the test enunciated at *In Re Bose*, 580 F. 3d 1240 (Fed. Cir. 2009).

More specifically, Petitioner has alleged that Respondent made a fraudulent representation to the USPTO and that representation is material to the continued registerability of the mark. It appears in any event obvious that the representation is material since without the filing of a Declaration of Use, the registration would become abandoned.

Petitioner further alleged that Respondent had knowledge of the fraudulent representation, because Petitioner specifically alleged that the making of a fraudulent claim was deliberate and intentional. Finally, it is clear that the representation was made with intent to deceive the U.S. Patent & Trademark Office. This element is further subsumed in the allegation by Petitioner that Respondent falsely, fraudulently and with deliberate intent caused to be filed a Declaration of Use and *intentionally falsely and fraudulently* represented to the USPTO that it continued to use the trademark. An intentional fraud is an intent to deceive.

SUMMARY

The intentional, false and fraudulent filing of a Declaration of Use under both Sections 8 and 15 when in fact no such use has ever taken place, let alone five years of consecutive use, represents a legitimate basis for a claim of Fraud in the Maintenance of the Registration.

This claim has been clearly made in Paragraphs 10 and 11 of the Petition for Cancellation and has nothing to do with any knowledge by Respondent of Petitioner's mark, imputed or otherwise.

It has long been the stated policy of the TTAB that it is in the best interests of justice that a claim for relief be fully adjudicated and not stricken down in its infancy.

The drastic act of *sua sponte* depriving a litigant from pursuing a legitimate claim should be withdrawn.

For the reasons set forth above, reconsideration of the striking of Petitioner's Claim of Fraud in the maintenance of the subject registration is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. Striker', with a long horizontal flourish extending to the right.

Michael J. Striker
Attorney for Petitioner
Reg. No.: 27233
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EXHIBIT A

been sold to and are used by numerous symphonies and orchestra throughout the United States, by way of the following examples:

Boston Symphony, Washington National Symphony, San Francisco Symphony, New York Philharmonic Orchestra, Florida Philharmonic Orchestra, St. Louis Symphony Orchestra, Chicago Symphony Orchestra, Memphis Orchestra, Philadelphia Orchestra and several others.

7. Schiedmayer currently and long prior to any use or registration by Piano Factory, offers for sale and has sold within the United States, Schiedmayer marked keyboard instruments. Among recent purchasers are the following:

Chicago Symphony Orchestra, Detroit Symphony Orchestra, New York Philharmonic, Cleveland Orchestra, New York University, Pittsburg Orchestra, Paul Simon, Arkansas Symphony Orchestra, Cincinnati Symphony and Pops Orchestra.

8. Piano Factory has never had any relationship whatsoever with Schiedmayer.

COUNT I - FRAUD

9. On August 24, 2002, Piano Factory falsely, fraudulently and intentionally represented to the United States Patent Office that it was the owner of the trademark SCHIEDMAYER for pianos, namely, digital pianos, upright pianos and grand pianos. Piano Factory falsely, fraudulently and with deliberate intent never informed the

United States Patent and Trademark Examiner that in fact Schiedmayer was actively involved in the manufacture and sale of celesta keyboard musical instruments.

10. On or about November 20, 2013, Piano Factory falsely, fraudulently and with deliberate intent caused to be filed a Declaration of Use under Sections 8 and 15 which falsely, fraudulently and intentionally represented to the United States Patent and Trademark Office that it had continued to use the trademark SCHIEDMAYER and had done so continuously for the five years next preceding the filing of the Declaration of Use, for pianos, including upright pianos, grand pianos and digital pianos. Said representations were intentionally false and fraudulent in as much as Piano Factory never had any relationship with the Schiedmayer product and has not offered for sale or sold a Schiedmayer product continuously within the five years next preceding the filing of the Declaration of Use. The filing of said Declaration of Use was intentionally false and fraudulent because in fact no continuous sales by Piano Factory of Schiedmayer pianos of any type had taken place within the said five-year time span.

11. The deliberately intentionally false and fraudulent maintaining of the trademark SCHIEDMAYER by the Piano Factory is damaging to Schiedmayer. Schiedmayer has filed a U.S. Trademark Application for the mark SCHIEDMAYER which has been refused in view of the registration sought to be cancelled herein. Purchasers and potential purchasers are being falsely and fraudulently led to believe that some relationship exists between Piano Factory and the coveted and highly respected Schiedmayer keyboard instruments. Schiedmayer is further being damaged

in view of the fact that the trademark SCHIEDMAYER is the rightful property of Schiedmayer and Piano Factory has wrongfully appropriated its rightful property. A celesta is a keyboard musical instrument similar to and likely to be confused with a piano. Consumers and potential consumers are likely to believe that a piano and a celesta keyboard musical instrument emanate from the same source.

COUNT II - FALSE ASSOCIATION

12. As correctly stated by Examiner Darlene D. Johnson during the prosecution of U.S. Trademark Application Serial No. 78/157,552, which is the trademark application leading to the registration which Schiedmayer seeks to cancel herein:

"The examining attorney refuses registration because the mark consists of or comprises matter which may falsely suggest a connection with Schiedmayer. Mr. Schiedmayer was a famous maker of pianos. Additionally, pianos are currently being made under the method previously used by Schiedmayer and carry his name and the SCHIEDMAYER trademark; as such applicant's mark suggests a false connection with the pianos previously and currently manufactured under the trademark SCHIEDMAYER."

13. In response thereto, Piano Factory represented that the Schiedmayer Piano Company was no longer in business. Piano Factory never informed the Examiner of the existence of Schiedmayer Celesta GmbH, the Petitioner herein, which had long before manufactured and sold piano keyboard instruments in the United States. Any consumer or potential consumer seeing a Schiedmayer piano product in

CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the attached document was served upon counsel for the Respondent at his address of record, this 11th day of May 2016 by first class mail:

Adam R. Stephenson, LTD
40 Baseline Rd. Ste 101
Tempe, AZ 85283

A handwritten signature in black ink, appearing to read 'M Striker', written over a horizontal line.

Michael Striker