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

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|------------------------|---|
| Proceeding | 92061215 |
| Party | Defendant Piano Factory Group |
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| Signature | /Adam Stephenson/ |
| Date | 07/14/2016 |
| Attachments | Petition to Disqualify Counsel.pdf(170408 bytes) Exhibit A Petition to Disqualify.pdf(644697 bytes) Exhibit B Petition to Disqualify.pdf(576328 bytes) Exhibit C Petition to Disqualify.pdf(1443950 bytes) |

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

Schiedmayer Celesta GmbH,

Cancellation No.: 92/061,215

Petitioner,

Reg. No. 3,340,759

v.

Mark: SCHIEDMAYER

Piano Factory Group, Inc.

Registration Date: November 20, 2007

Respondent.

**RESPONDENT’S PETITION TO DISQUALIFY PETITIONER’S COUNSEL
MICHAEL J. STRIKER OF STRIKER, STRIKER, AND STENBY**

Respondent Piano Factory Group, Inc. (“Respondent”) pursuant to TBMP 513.02 and 37 C.F.R. §11.19(c) hereby petitions the Director of the USPTO to disqualify Michael J. Striker and his firm Striker, Striker, and Stenby as representatives of Petitioner Schiedmayer Celesta GmbH (“Petitioner”) in the current cancellation proceeding. Mr. Striker will inevitably need to be called to testify as a witness on behalf of his client in this matter. The relevant supporting facts and legal argument follow. Pursuant to the procedure outlined in TBMP 513.02, Respondent requests that the Board **immediately issue an action** suspending further proceedings in this case, including further discovery, pending consideration of this petition.

FACTS

Respondent served its first set of Interrogatories and first Request for Production of Documents on counsel for Petitioner, Michael J. Striker, on February 3, 2016. The Board on the 2nd of February, however, had issued an order suspending further proceedings in this case pending the decision on Petitioner’s Motion to Amend the

Cancellation Petition. Respondent then re-served its first set of Interrogatories and first Request for Production of Documents on May 24, 2016, following the receipt of an amended Cancellation Petition from Petitioner on the 10th of May. On or about June 22nd, 2016, Respondent received Petitioner's responses to its first set of Interrogatories. Due to delays caused by recurring serious medical issues experienced by Respondent's client's representative, a Protective Order requested by Petitioner was not executed until June 28th, so Petitioner delayed providing its response to Respondent's Document Requests until the Protective Order was received. On July 5, 2016, Respondent received Petitioner's response to its first Request for Production of Documents.

On April 13, 1984, Schiedmayer Pianos, GmbH, filed a trademark application Serial No. 73475680 in class 015 for "Musical Instruments, in particular pianos, chimes, celestes, and keyboard instruments" for the mark SCHIEDMAYER and design. Christian Ibach signed the declaration on this application. The date of first use in commerce for the mark was 1960. The application was allowed, but was ultimately opposed by Steinway and Sons in an opposition proceeding No. 91073054 filed August 22, 1985. The opposition was terminated January 20, 1987 through Schiedmayer Pianos' abandoning its application. No decision on the merits by the Board was made in that case. The Board can take judicial notice of all other facts associated with that application relevant to this Petition.

On April 17, 2015, Petitioner's counsel, Michael J. Striker, filed an in-use trademark application Serial No. 86600864 for the standard character mark SCHIEDMAYER with the USPTO. The goods sought to be registered were in class 015, for "keyboard musical instruments." The date of first use was 1860. Petitioner's

counsel, Michael J. Striker signed the Declaration for the application as the “Authorized Attorney” for Petitioner. The Board can take judicial notice of all other facts associated with that application relevant to this Petition.

Petitioner’s answers to Questions 37-40 of Respondent’s first set of Interrogatories are included herewith as Exhibit A to this Petition.

Petitioner’s responses to Document Requests 23 and 24 from Respondent’s first set of Document Requests are included herewith as Exhibit B to this Petition.

In its most recently filed Second Amended Petition for Cancellation, Petitioner alleges Count I, False Association, and in paragraphs 9-16 make the associated allegations, including that “15. All of the factors alleged above also existed at the time of registration of the Trademark Registration sought to be cancelled herein.” A copy of the same is included as Exhibit C to this Petition.

At the present time, no order suspending proceedings has been issued by the Board.

ARGUMENT

Respondent notes that TBMP 513.02 states that “If a party to an inter partes proceeding before the Board believes that a practitioner representing another party to the proceeding should be disqualified (due, for example, to a conflict of interest, or because the practitioner should testify in the proceeding as a witness on behalf of his client), the party may file a petition to disqualify the practitioner.” Emphasis added.

Petitioner seeks to cancel Respondent’s mark in part on the basis of False Association/False Designation of Origin. To prove such a case, Petitioner has to present admissible evidence for each of the allegations made in paragraphs 9-16 of the Second

Amended Complaint. Accordingly, any information in this case corresponding with those allegations would be considered relevant evidence. Federal Rule of Evidence 401 (2015) states that “Evidence is relevant if: (a) it has any tendency to make a fact more or less probable than it would be without the evidence; and (b) the fact is of consequence in determining the action.”

Evidence regarding exactly when Petitioner and/or Petitioner’s predecessors-in-interest first began use of the mark SCHIEDMAYER in the United States for “keyboard musical instruments” would tend to make the allegations of paragraphs 10 and 15 more likely to be true. As they are elements of a claim of False Association, such facts are of consequence in determining this action. This is particularly so when the Petitioner has to prove that nearly 9 years ago, “All of the factors alleged above also existed at the time of registration of the Trademark Registration sought to be cancelled herein.” Timing of the use and the nature of the use by Petitioner and its predecessors in interest is critical to a False Association claim.

Accordingly, contrary to Petitioner’s counsel’s objection to Interrogatories 39 and 40, those facts in Michael J. Striker’s possession that would establish a first use date of **1860** for the mark SCHIEDMAYER for “keyboard instruments” in the United States are highly relevant evidence. These facts are particularly relevant in view of the 1984 filing for the mark SCHIEDMAYER by Schiedmayer Pianos that listed as date of first use of **1960**. There is conflicting publicly available evidence as to the date of first use, by 100 years, in view of Michael J. Striker’s declaration. Respondent is entitled to know what facts in Mr. Striker’s possession prove the real date of first use, and the nature of that use in interstate commerce.

However, Petitioner is refusing to provide documents that admittedly exist that contain these facts on the basis that the documents are “attorney-client protected documents.” (See Petitioner’s answers to Document Requests 23 and 24). The reason why these documents would be attorney-client protected is because Mr. Striker is both Petitioner’s counsel in this proceeding and also counsel before the USPTO in its pending U.S. Trademark application for the mark SCHIEDMAYER. Because Mr. Striker was not alive in 1860, the only documentary evidence he would have that could give him personal knowledge of a first use date of 1860 would have come through information from his client—the Petitioner. Because he and/or his client are refusing to waive the attorney-client privilege and provide the requested documents, Respondent cannot obtain any of the facts contained therein without deposing Mr. Striker to obtain those facts.

Since the facts in the documents are not privileged, just the documents themselves, Respondent is entitled to orally depose Michael J. Striker, counsel for Petitioner, to obtain those facts which he has declared under penalty of perjury are personally in his possession. By virtue of being subject to oral discovery deposition and, likely, examination during testimony depositions during this proceeding, Mr. Striker will have to testify in this proceeding as a witness on behalf of his client. This is particularly so since the only person indicated in Petitioner’s response to Interrogatory 38 other than Mr. Striker as having personal knowledge of the facts is Ellianne Schiedmayer, a national of Germany. If Respondent is permitted under the laws of Germany to depose her at all, it will only be by written questions under the procedure in TBMP §404.03(b).

Accordingly, oral Examination of Mr. Striker is not merely duplicative. It would speed

the discovery process, avoid issues caused by language barriers, and enable Respondent to adequately prepare its defense in this case.

The Board must disqualify Mr. Striker as Petitioner's counsel so he can fully testify regarding all relevant facts personally in his possession that are relevant to Petitioner's case. Because others in Mr. Striker's firm likely also have similar attorney-client privileged information and may need to be deposed, the other members of his firm, Striker, Striker, and Stenby, should likewise be disqualified. Allowing Mr. Striker to invoke the attorney-client privilege and refuse to be deposed deprives Respondent of a valuable witness with relevant information. It permits Mr. Striker and Petitioner, as a result of Mr. Striker's dual representation, to "hide the ball" in the guise of the attorney-client privilege. It is fundamental rule of legal ethics that when an attorney discovers he is likely to be called as a witness in his client's proceeding that the attorney withdraw from further representation in the matter. Mr. Striker has not chosen to do that, even when confronted directly by the information in Interrogatory 39, and asked point blank how he could avoid being called as a witness as a result of his signing the Declaration.

Because Mr. Striker will not voluntarily withdraw, it falls to the Director of the USPTO, and by delegation, to the Board, to enforce the rules. Respondent is entitled to discover those facts Mr. Striker knows from preparing Petitioner's pending trademark application that are relevant to Petitioner's False Association claim. Mr. Striker cannot refuse to be deposed in this matter. His objections on the record to Respondent's direct questions have left Respondent no option but to depose him.

Petitioner will not be unduly prejudiced by Mr. Striker's removal from the case. There yet remains about 6 weeks of the discovery period, and Respondent is more than

willing, given the unfortunate circumstances, to stipulate to an extension of that period of discovery, subject to the approval of the Board. All outstanding Interrogatories and Requests for Production of Documents have already been responded to. All that remains is the taking of depositions. No experts have been retained by either party in this matter. Respondent did not know whether this Petition would be required until receipt of Petitioner's response to its document requests 9 days ago where Petitioner formally invoked the attorney-client privilege. Accordingly, this Petition has been filed as soon as it was practical as this issue needs resolution immediately before depositions are taken.

It will prejudice Petitioner's case far more if the Board waits to rule on this issue until Mr. Striker formally refuses to be deposed, and is then is later compelled to by the Board, requiring his disqualification at the last minute. Petitioner's new counsel would then potentially have little time remaining to complete remaining uncompleted discovery which would be far more prejudicial to Petitioner's case.

Stay of Proceedings Requested

TBMP § 513.02 states that "When a petition to disqualify is filed in connection with a proceeding pending before the Board, the Board **immediately issues** an action suspending proceedings in the case and advising the parties that no additional papers should be filed by the parties until further notice, pending consideration of the petition." Emphasis added.

Given the mandatory and imperative character of this instruction, Respondent respectfully requests that the Board issue an immediate stay of further proceedings in this case pending the resolution of this Petition.

In view of the foregoing, the Respondent respectfully requests that Michael J. Striker and his firm, Striker, Striker, and Stenby be disqualified as counsel for Petitioner. Respondent also respectfully requests immediate suspension of the proceedings in this case.

Dated: July 14, 2016

Respectfully submitted,
/s/ Adam R. Stephenson
Adam R. Stephenson, LTD.
40 W. Baseline Rd., Ste 101
Tempe, AZ 85283
Tel: 480.264.6075
Fax: 480.718.8336
Email: adam@patentproblempro.com
Attorney for Respondent, Piano Factory
Group, Inc.

CERTIFICATE OF SERVICE

It is hereby certified that one (1) copy of the foregoing RESPONDENT'S PETITION TO DISQUALIFY PETITIONER'S COUNSEL MICHAEL J. STRIKER OF STRIKER, STRIKER, AND STENBY is being sent via first class U.S. Mail to Petitioner Schiedmayer Celesta GmbH's attorney of record as follows:

Michael J. Striker
Striker, Striker & Stenby
103 East Neck Road
Huntington, NY 11743
striker@strikerlaw.com

Dated: July 14, 2015

/s/ Adam Stephenson

Exhibit A

34. If the answer to Interrogatory No. 31 is in the affirmative, please explain what actions over the next 30 years Petitioner took to protect the SCHIEDMAYER mark from being subjected to false designation of origin by any part, including Ibach.

Response to Interrogatory No. 34: No answer required.

35. Please explain why Petitioner did not file for a U.S. trademark application for the SCHIEDMAYER mark for keyboard instruments of any kind following the abandonment of the mark by Ibach around 2001-2002.

Response to Interrogatory No. 35: Objected to as irrelevant.

36. Does Petitioner believe that Ibach abandoned use of the SCHIEDMAYER trademark for piano fortes sometime between 2000-2002?

Response to Interrogatory No. 36: Ibach became insolvent and ceased manufacture of pianos.

37. If the answer to Interrogatory No. 36 is negative, then please describe the basis that authorized Petitioner to file its application for the mark SCHIEDMAYER on April 17, 2015, Application Serial No. 86/600,864 (the '864 application).

Response to Interrogatory No. 37: No answer required.

38. Please identify the names, addresses, and telephone numbers of all persons in addition to Ellianne Schiedmayer that have personal knowledge of the facts surrounding the filing of the '864 application.

Response to Interrogatory No. 38: The person who has the most knowledge of the facts surrounding the filing of '864 application is Ellianne Schiedmayer.

39. On April 17, 2015, Michael J. Striker, counsel for Petitioner, made the following declaration by signing the '864 application on behalf of Petitioner:

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark or use on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own

knowledge are true and all statements made on information and belief are believed to be true.

Please describe how Petitioner believes that Michael J. Striker will not be called as a witness in this proceeding, given that Mr. Striker's declaration on the '864 application represented to the USPTO that Petitioner's date of first use of the SCHIEDMAYER trademark for "keyboard musical instruments" was "at least as early as 00/00/1860."

Response to Interrogatory No. 39: Objected to as irrelevant. The '864 application is not involved in respect to the subject cancellation proceeding.

40. Given that it is reasonable to assume that counsel for Petitioner, Michael J. Striker, was not alive in 1860, please disclose all of the personally known facts in Michael J. Striker's possession that formed a basis for him to declare, under penalty of fine or imprisonment on April 17, 2015, that the date of first use of the SCHIEDMAYER mark in the United States was in 1860.

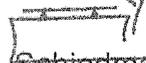
Response to Interrogatory No. 40: Objected to. See answer to Interrogatory No. 39.

41. Please explain why Petitioner, via the declaration of its counsel Michael J. Striker, believes its date of first use of the SCHIEDMAYER mark in the United States was in 1860 rather than 1960 as made in the application for the SCHIEDMAYER logo mark by Christian Ibach on April 2, 1984.

Response to Interrogatory No. 41: Petitioner has no idea why Christian Ibach indicated April 2, 1984 as use of the trademark SCHIEDMAYER.

1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated:



SCHIEDMAYER
Celesta GmbH
Schäferhauser Str. 10/2
73240 Wendlingen/Stgt.
Schiebmayer Celesta GmbH
Tel.: 0 71 24 3 07 93 40 Fax: 0 71 24 5 07 93 41

As to objections:


Michael J. Striker

Exhibit B

DOCUMENT REQUEST NO. 22:

Produce all documents that support good cause for Petitioner to file its application for the mark SCHIEDMAYER on April 17, 2015, Application Serial No. 86600864 (the '864 application).

RESPONSE: No documents available.

DOCUMENT REQUEST NO. 23:

Produce all documents that support Michael J. Striker's declaration, under penalty of fine or imprisonment on April 17, 2015, that the date of first use of the SCHIEDMAYER mark in the United States was in 1860.

RESPONSE: No documents available other than attorney-client protected documents.

DOCUMENT REQUEST NO. 24:

Produce all documents relating to and/or that provide good cause why Petitioner, via the declaration of its counsel Michael J. Striker, believes its date of first use of the SCHIEDMAYER mark in the United States was in 1860 rather than 1960 as made in the application for the SCHIEDMAYER logo mark by Christian Ibach on April 2, 1984.

RESPONSE: No documents available other than attorney-client protected documents.

DOCUMENT REQUEST NO. 28:

Produce all documents in Petitioner's possession that relate to or describe the circumstances surrounding the filing of the SCHIEDMAYER logo trademark filing in 1984 by SCHIEDMAYER PIANO, GmbH.

RESPONSE: No documents available.

I hereby declare that all statements made herein of my own knowledge are true and that all statements on information and belief are believed to be true; and further that those statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


SCHIEDMAYER
Celesta GmbH
Schäferhauser Str. 10/2
73240 Wendlingen/Stgt.
Tel.: 0 70 24/5 01 98 40 • Fax: 0 70 24/5 01 98 41

Dated: 02/02/2016


Schiedmayer Celesta GmbH
By: Elianne Schiedmayer

As to objections:


Michael J. Striker

Exhibit C

is a piano keyboard instrument having four or five octaves and in which a plate is struck rather than a wire to create sound.

6. Schiedmayer keyboard musical instruments represent the highest degree of quality and reputation. Schiedmayer keyboard musical instruments have been sold and are used by numerous symphonies and orchestras 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 and its predecessors in interest 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, Pittsburgh Orchestra, Paul Simon Arkansas Symphony Orchestra, Cincinnati Symphony and Pops Orchestra.

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

COUNT I – FALSE ASSOCIATION

Petitioner herewith repeats and realleges paragraphs 1-8 above as fully as set forth herein. Petitioner further states that it is a 'person' within the meaning of Sec. 2 (a) of the Act, Lanham Act Sec. 45, 15 U.S.C. Sec. 1127.

9. Long prior to any use or registration by Piano Factory, the trademark SCHIEDMAYER has been known throughout the world as being associated with the finest musical keyboard instruments ever produced.

10. Petitioner and through its predecessors in interest, owns the exclusive reputation for the mark SCHIEDMAYER.

11. Petitioner herewith states that Respondent's mark sought to be cancelled herein is the same as Petitioner's previously used name or identity.

12. Petitioner further states that the mark SCHIEDMAYER would be recognized as such, in that it points uniquely and unmistakably to the Petitioner.

13. Petitioner is not connected with the goods allegedly sold or the activities performed by the Respondent under the mark SCHIEDMAYER.

14. Petitioner's trademark SCHIEDMAYER is of sufficient fame and reputation that if and when Respondent's mark is used on its goods or services, a connection with Petitioner will be presumed.

15. All of the factors alleged above also existed at the time of registration of the Trademark Registration sought to be cancelled herein.

16. In view of the false association set forth above, Petitioner is being damaged because its right to exclusive use and registration of a mark which points uniquely to the Petitioner is being put in jeopardy, due to the registration of the mark sought to be cancelled herein.

COUNT II – ABANDONMENT

Petitioner herewith repeats and realleges paragraphs 1-8 above as fully as set forth herein.

17. Upon information and belief, Piano Factory has not used the trademark SCHIEDMAYER upon any of the goods set forth in the trademark registration sought to be cancelled herein, within at least the past 10 years.

18. Upon information and belief, Piano Factory has not sold or offered for sale or transported in commerce any of the products set forth in the trademark registration sought to be cancelled herein, for at least the past 10 years.

19. Piano Factory has abandoned the trademark SCHIEDMAYER and in view thereof the subject trademark registration should be cancelled in all respects.