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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

**PETITIONER’S REPLY MEMORANDUM IN SUPPORT OF
MOTION FOR SUMMARY JUDGEMENT**

September 6, 2016

Petitioner, Schiedmayer Celesta GmbH, hereby replies to Respondent’s response to Petitioner’s Motion for Summary Judgment as follows:

Respondent asserts that on or about August 17, 2006, all of the assets of Respondent, Piano Factory Group, Inc., were assigned for the benefit of creditors to Equitable Transitions, Inc. Said assignment would have included an assignment-in-gross of the trademark registration at issue herein.

On the same date, all of the assets of Piano Factory Group, Inc., held by Equitable Transitions, Inc., and presumably including the trademark registration at issue herein, were sold through a bill of sale to Sweet 16 Musical Properties, Inc.

Accordingly, based upon the admission of the Respondent in its Response to Petitioner's Motion for Summary Judgement, as of August 17, 2006, the subject registration, No. 3,340,759, was no longer owned by Piano Factory Group, Inc., but was owned on that date forward by a different judicial entity, to wit: Sweet 16 Musical Properties, Inc.

On April 18., 2014, on a date when, by Respondent's own admission, the subject registration was owned by Sweet 16 Musical Properties, Inc., a Declaration of Use was filed with respect to the subject registration in the name of Piano Factory Group, a corporation of California. A copy of the first page of the Declaration of Use is attached as Exhibit "A".

ARGUMENT

It will thus be seen, that by Respondent's own admission, a Declaration of Use for the subject registration was filed by Piano Factory Group, a corporation, at a time when Piano Factory Group, a corporation, was no longer the owner of the subject registration and had not been the owner of the subject registration for several years.

Indeed, by Respondent's own admission, Piano Factory Group, a corporation, had divested itself of the registration completely, several years before the Declaration of Use was filed. In view thereof, the Declaration of Use was filed on behalf of an insolvent corporation no longer permitted to conduct business of any kind since at

least September 2, 2008, the date when it was suspended as a corporation by the State of California.

As stated at TMEP § 1604.07(a):

“The affidavit or declaration of use or excusable non-use, must be filed by the *owner of the registration*. Filing by the owner is a minimum requirement that must be met before the expiration of the deadlines set forth in § 8(a) of the Act.”

Section 15 US Code § 1058 clearly provides that it is the owner of the registration that must file in the United States Patent and Trademark Office, affidavits that meet the requirements of Subsection B.

Section TMEP 1201.02(c) Correcting Errors in How the Applicant is Identified, states the following under the subsection “Non-Correctable Errors”:

“If an application is filed in the name of entity A when the mark was assigned to entity B before the application filing date, the application is void as filed because the applicant was not the owner of the mark at the time of filing.”

The identical mandate applies to the filing of a Declaration of Use.

At *In Re: Trademark Application of Sanford Acquisition Company*, Registration No. 1,672,989, issued July 21, 1992, a copy of which is attached as Exhibit

“B”, the facts related to a Declaration of Use, which, as here, was not filed in the name of the owner of the registration.

The decision indicated that an error of this nature can be corrected only where the party who filed the papers is the owner of the mark and the misidentification does not name a different legal entity.

This tracks exactly the situation found herein in which a juristic entity, Piano Factory Group, a corporation, signed the Declaration although it did not own the registration and did not exist at the time of signing.

Also, this is clearly not a DBA, doing business as situation as opined by Respondent.

The Declaration of Use was clearly not filed in the name of a DBA because the Declaration states on the face of it, Piano Factory Group, a *corporation of California*.

Accordingly, the Declaration was filed by a different juristic entity and is void ab initio.

In view of all of the above, it is believed clear that there is no genuine issue of material fact relating to the undisputed fact that the subject registration was

maintained by the filing of a Declaration of Use by a corporation which was had previously divested itself of the registration and additionally was a void, suspended, corporation, having no power in any event to execute a Declaration of Use.

It is believed that the fact that the trademark registration sought to be cancelled in this proceeding is incontestable should have no bearing upon this Motion.

The requirement that a Declaration of Use be signed and filed by the owner of the registration is a statutory requirement as set forth at 15 U.S. Code Sec. 1058. A clear violation of a statutory requirement for the maintenance of a registration must result in the cancelling of the registration.

At the very least, if cancellation is not found proper, it should be held that the registration – having not been maintained in accordance with Statute -, is unenforceable in all respects.

In view of all of the above, favorable consideration of the Motion for Summary Judgment is respectfully requested.

Respectfully submitted,

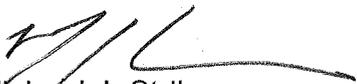

Michael J. Striker
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Huntington, New York 11743

EXHIBIT A

PTO Form 1583 (Rev 5/2006)
OMB No. 0651-0055 (Exp 07/31/2018)

Combined Declaration of Use and Incontestability under Sections 8 & 15

To the Commissioner for Trademarks:

REGISTRATION NUMBER: 3340759

REGISTRATION DATE: 11/20/2007

MARK: SCHIEDMAYER

The owner, Piano Factory Group, a corporation of California, having an address of
323 S. Front St., #106
Burbank, California 91502-1918
United States

is filing a Combined Declaration of Use and Incontestability under Sections 8 & 15.

For International Class 015, the mark is in use in commerce on or in connection with **all** of the goods/**all** of the services, or to indicate membership in the collective membership organization, listed in the existing registration for this specific class: Pianos, namely, upright pianos, grand pianos, and digital pianos; **and** the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with **all** goods/**all** services, or to indicate membership in the collective membership organization, listed in the existing registration for this class. Also, no final decision adverse to the owner's claim of ownership of such mark for those goods/services, or to indicate membership in the collective membership organization, exists, or to the owner's right to register the same or to keep the same on the register; and, no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exists.

The owner is submitting one(or more) specimen(s) for this class showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) Mark on product.

Original PDF file:

[SPN0-1747962133-174402098 . Product1.pdf](#)

Converted PDF file(s) (1 page)

[Specimen File1](#)

Original PDF file:

[SPN0-1747962133-174402098 . Product2.pdf](#)

Converted PDF file(s) (1 page)

[Specimen File1](#)

The registrant's current Attorney Information: Adam R. Stephenson of Adam R. Stephenson, LTD.
40 W. Baseline Rd., Ste. 101
Tempe, Arizona (AZ) 85283
United States

The docket/reference number is PFG004.

EXHIBIT B

«seal»

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

98-652

Re: Trademark Application of :
Sanford Acquisition Company :
Registration No. 1,672,989 :
Issued: July 21, 1992 : On Petition
For: SPD AND DESIGN :
Petition Filed: August 31, 1998 :

Sanford Acquisition Company has petitioned the Commissioner to accept a combined Section 8 and 15 declaration filed in connection with the above identified registration. 37 C.F.R. §§2.146(a)(3), 2.146(a)(5) and 2.148 provide authority for the requested review. The petition is denied.

FACTS

The above registration issued on January 21, 1992. Pursuant to Section 8 of the Trademark Act, 15 U.S.C. §1058, Registrant was required to file an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the registration date, i.e., between January 21, 1997 and January 21, 1998. On January 21, 1998, Dana Corporation filed a combined declaration under Sections 8 and 15 of the Act.

In an Office Action dated March 10, 1998, the Affidavit-Renewal Examiner withheld acceptance of the combined declaration pending receipt of evidence showing ownership in the present claimant such as recordation of an assignment, merger or change of name with the Assignment Branch of the Patent and Trademark Office. The records of the Assignment Branch of the Patent and Trademark Office showed title to the registration to be vested in Sanford Acquisition Company, Michigan Corporation, rather than Dana Corporation, Virginia Corporation. Petitioner was advised that in the absence of a proper response filed within six months of the mailing date of the action, a cancellation order would be issued.

On April 10, 1998, Petitioner filed a second combined declaration in the name of Sanford Acquisition Company. In a letter dated July 21, 1998, Post Registration Examiner notified Petitioner that the registration was cancelled for failure to comply with the statutory requirements for filing Section 8 and 15 Affidavits. The Post Registration Examiner's letter indicated that the registration would be canceled because the affidavit was filed after the sixth year following the date of registration. This petition followed.

Petitioner asserts that the January 21, 1998 affidavit was inadvertently misfiled in the name of Dana Corporation, the parent corporation of registrant, Sanford Acquisition Company. Petitioner

requests the Commissioner to review the action of the Post Registration Examiner and accept the amended Affidavit filed April 10, 1998.

ANALYSIS

Section 8 of the Trademark Act, 15 U.S.C. §1058, provides, in part:

[T]he registration of any mark under the provisions of this Act shall be cancelled by the Commissioner at the end of six years following its date, unless ***within one year next preceding the expiration of such six years the registrant shall file*** in the Patent and Trademark Office an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and attaching to the affidavit a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark....

The statute specifically requires that the affidavit be filed by the "registrant," prior to the expiration of the sixth year after the date of registration. The term "registrant" includes both the original registrant, and a person who has acquired ownership through proper transfer of title. Section 45 of the Trademark Act, 15 U.S.C. §1127; TMEP §1603.05. Where an assignee seeks to file a Section 8 affidavit, the assignee must establish its ownership of the mark. Ownership is established by submitting documentary evidence of a chain of title from the original owner to the assignee, or by specifying the reel and frame number where such evidence is recorded in the Patent and Trademark Office. 37 C.F.R. §3.73(b); TMEP §§502 and 1603.05(a). *In re Galton Company Limited Partnership*, 37 USPQ2d 1539 (Comm'r Pats. 1995).

Office practice permits applicants and registrants to correct a mistake in the manner or form in which the applicant's/registrator's name is set out in the application for registration and in subsequent filing of affidavits of use. TMEP §§802.07, 1201.02(c) and 1603.05(b). A request to correct a mistake in the applicant's or registrant's name is permissible where: (1) there is ambiguity as to who the owner of the mark is or there is a mistake in the identification of the applicant's/registrator's name or entity type; (2) the party who filed the papers is the owner of the mark; and (3) the misidentification does not name a different existing legal entity. *See Accu Personnel Inc. V. Accustaff Inc.*, 38 USPQ2d 1443 (TTAB 1996); *In re Colombo Inc.*, 33 USPQ2d 1530 (Comm'r Pats. 1994); *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm'r Pats. 1990).

When held to the standard, Petitioner's affidavit fails with respect to the second and third requirements. In this case, the Affidavit/Renewal Examiner properly withheld acceptance of the affidavit since the affidavit was filed by a party that did not own the mark, and the affidavit clearly identified the name of a different existing legal entity.

The Section 8 and 15 affidavit was submitted in the name of Dana Corporation. The assignment Branch records of the Office show title of the mark to be vested in Sanford Acquisition Company. Petitioner has not provided any evidence of a transfer of title to the present claimant, Dana Corporation nor recorded appropriate documents with the Assignment Branch of the

Office, that establish a complete chain of title from Sanford to Dana. Trademark Rule 3.73; TMEP §1603.05(a).

When a Section 8 affidavit is timely filed by the owner of the registration, but the records of the Patent and Trademark Office show title in another party, the party who filed the affidavit may submit evidence of its ownership of the registration even if the sixth year following the date of registration has expired. TMEP §1603.11. However, if the party who filed the affidavit was not the owner of the registration at the time the affidavit was filed, a substitute affidavit in the name of the true owner cannot be filed unless there is time remaining in the statutory filing period. *In re Precious Diamonds, Inc.*, 635 F.2d 845, 208 USPQ 410 (C.C.P.A. 1980); *In re Weider*, 212 USPQ 947 (Comm'r Pats. 1981).

DECISION

37 C.F.R. §§2.146 and 2.148 permit the Commissioner to waive any provision of the Rules which is not a provision of the statute, where an extraordinary situation exists, justice requires and no other party is injured thereby. However, the Commissioner has no authority to waive a requirement of the statute. Here, Petitioner has declared that the name listed on the affidavit was an inadvertent clerical error and subsequently filed a corrected affidavit listing the correct owner of record. However, the amended affidavit submitted April 10, 1998, was filed after the sixth year following the date of registration. Because the requirement that the registrant file the affidavit between the fifth and sixth year after the date of registration is statutory, it cannot be waived.

The petition is denied. The registration will be cancelled in due course.

Robert M. Anderson
Deputy Assistant Commissioner
for Trademarks

RMA:NLO:SMW

Date:

Attorney for Petitioner:

Frank B. McDonald, Esq.
Sanford Acquisition Company
P.O. Box 1000
Toledo, Ohio 43697

CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the attached Petitioner's Reply Memorandum was served upon counsel for the Respondent at his address of record via first class mail, postage prepaid:

Adam R. Stephenson LTD
40 West Baseline Road Ste. 101
Tempe, Arizona
85283

This 6th day of September, 20216



Michael Striker