

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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wbc

Mailed: August 16, 2017

Cancellation No. 92061215

Schiedmayer Celesta GMBH

v.

Piano Factory Group

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes up for consideration of Respondent's motion to strike Exhibits C and F attached to the declaration of Elianne Schiedmayer submitted by Petitioner during its trial period. 38 TTABVUE; 43 TTABVUE. Additionally, Respondent has filed a notice to take testimonial cross-examination of Ms. Schiedmayer on written questions. 44 TTABVUE. Petitioner has filed a motion to strike the notice. 46 TTABVUE. The motions are fully briefed.¹

Petitioner's Notice of Reliance – Schiedmayer Declaration, Exhs. C and F

¹ The Board's December 21, 2016 order prohibited the parties from filing any further unconsented motions in this proceeding "without first seeking leave of the Board to do so. **Any future motions not on consent filed without evidence of such leave are automatically denied and will be given no consideration.**" 33 TTABVUE 22. Although evidence of such leave was not indicated in either of the parties' motions, the Board is aware that leave was granted by Interlocutory Attorney, Benjamin Okeke. Although the Board could nonetheless deny the motions because neither party filed their motions with "evidence of such leave," the Board will consider the motions. The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments made therein. The parties' arguments will not be summarized herein except as necessary to explain the Board's decision.

It has long been the case that a party is not required, in advance of trial, to disclose each document or other exhibit it plans to introduce. *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1788 (TTAB 2001). This did not change with the Board's adoption of disclosures. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007) ("Pretrial disclosures are governed by Federal Rule 26(a)(3), but the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial under Rule 26(a)(3)(C)."). As noted, Exhs. C and F are not required to be disclosed prior to introduction at trial because they are exhibits to testimony.

Any exhibits which are in a foreign language, however, should be translated into English because Board proceedings are conducted in English. TBMP § 104 (June 2017). "If a party intends to rely upon any submissions that are in a language other than English, the party should also file a translation of the submissions." *Id.*; see *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1508 n.221 (TTAB 2017); *Johnson & Johnson v. Obschestvo s ogranitchennoy; otvetstvennosti "WDS"*, 95 USPQ2d 1567, 1570 n.3 (TTAB 2010); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998). Petitioner has translated its Exhs. C and F, appearing originally in German, into English.

Petitioner relies on the testimony of its Chief Executive Officer and owner, Ms. Elianne Schiedmayer submitted via declaration. 38 TTABVUE. Respondent does not argue that Ms. Schiedmayer was not properly disclosed in pretrial disclosures, that the translations used by Petitioner are inaccurate, or that the translations were not provided during discovery; only that a translation of two documents found in Exhs. C and F, for which Ms. Schiedmayer includes in her testimony, are not admissible because the translator, Ms. Dana Scruggs, was not disclosed in pretrial disclosures. Respondent further argues that a translator is an expert witness and that therefore, Exhibits C and F should be stricken from the record. 43 TTABVUE 2-3.

Respondent does not point to any, and the Board is unaware of any, caselaw which treats a translator as an expert witness.² A translator used merely to translate a document, as opposed to a testimonial witness, does not testify based on her personal knowledge of the facts of the case, but is more akin to authentication.³ In other words, the use of a translator for Exhs. C and F was

² Indeed, Respondent belies its assertion that a translator is an expert witness asserting only that “a translator is *likely* considered an expert witness” (emphasis added). 43 TTABVUE 3.

³ “To satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Federal Rule of Evidence 901(a). Under the Board’s rules and practice, except for documents deemed to be self-authenticating, “[t]estimony affidavits, declarations and depositions are the means by which a party may introduce into the record not only the testimony of its witnesses, *but also those documents and other exhibits that may not be made of record by notice of reliance*” (emphasis added). TBMP § 703.01(a). Indeed, the Board, permits use of website evidence to show a translation of a word or term. *See, e.g., In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 n.3 (TTAB 2008); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 (TTAB 2006).

merely a vehicle to provide an English translation, the documents were otherwise introduced via Ms. Schiedmayer's testimonial declaration. *Cf. Luxco, Inc.*, 121 USPQ2d at 1508 n.221 ("affidavit is simply the vehicle for introducing the relevant law of Mexico"); *Obschestvo s ogranitchennoy; otvetstvennostiu "WDS"*, 95 USPQ2d at 1570 n.3 (noting that if a party intends to rely at trial on business records in a foreign language, it must provide a translation).

In short, Respondent has not persuaded the Board that a translator should be treated as an expert witness or that portions of Ms. Scheidmayer's testimony – Exhs. C and F – should be stricken from the record for using a translator to submit those documents in English, as required by Board rules. In view thereof, the motion to strike Exhs. C and F based on the use of a translator is **denied**.⁴ To the extent Respondent argues that the translations were not properly certified and should thus, be stricken, the Board also denies the motion to strike. *See Luxco, Inc.*, 121 USPQ2d at 1508 n.221 ("While the manual references a 'certified' translation, there is no rule or case that requires the translation be certified; that is simply a suggested better practice."); TBMP § 104.

⁴ Unlike federal practice, where live trials are conducted before the court, Respondent has ample time to prepare its cross-examination, if any, of a witness authenticating documents and other exhibits related to third party use.

In view of the Board's order denying the motion to strike, Respondent's argument in its reply brief that the Board should accept the translations of Exh. C only from the version included in Exh. 1 of Petitioner's response to the motion to strike is moot.

Respondent further argues that Exh. C is not properly authenticated as an official record under Fed. R. Evid. 902(3) because it “was not accompanied with a final certification” as an additional grounds to strike this exhibit from the record. 43 TTABVUE 2, 4. In response, Petitioner, although arguing that Exh. C has been properly authenticated, includes with its response an apostille for this exhibit. Respondent, in its reply thereto, notes that “Petitioner appears to have cured the defect in the originally submitted Exhibit.” 48 TTABVUE 4. In view thereof, the motion to strike for lack of authentication is **denied** as moot.⁵

Cross-examination on Written Questions

Respondent filed its notice to cross-examine Petitioner’s witness, Ms. Schiedmayer. 44 TTABVUE. In response thereto, Petitioner seeks to strike this notice arguing that Respondent has not properly identified the name or descriptive title of the officer before whom the deposition will be taken pursuant to Trademark Rule 2.124(a) and that Ms. Schiedmayer was in the U.S. during “the month of July.” 46 TTABVUE 3.

Testimony taken in a foreign country must be taken: by deposition on written questions, unless the Board, on motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take

⁵ Additionally, the Board notes that official records may be made of record by appropriate identification and introduction during the taking of testimony. *See* TBMP § 704.07 and cases cited therein. The Schiedmayer declaration introduces and identifies Exh. C as “an official government document providing that I inherited all of the assets of my husband.” 38 TTABVUE.

and bear the expense of cross-examination by written questions of that witness. *See* Trademark Rule 2.123(a)(2). A deposition on written questions, like a deposition on oral examination, may be taken before the persons described in Fed. R. Civ. P. 28.⁶ A party desiring to take cross-examination, by written questions, of an affiant or declarant must serve on each adverse party notice of the cross-examination within twenty days from date of service of the affidavit or declaration. *See* Trademark Rules 2.124(b)(3) and 2.124(d)(1). The notice must state the name or descriptive title of the officer before whom the deposition will be taken, and must include a copy of the written questions to be propounded at cross-examination. *See* Trademark Rules 2.124(c) and 2.124(d)(1).

If a party serves notice of the taking of a testimony deposition on written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory which is under the control and jurisdiction of the United States), any adverse party may, within 20 days from the date of service of the notice, file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination. *See* Trademark

⁶ Fed. R. Civ. P. 28. Persons Before Whom Depositions May Be Taken...

(b) In a Foreign Country.

(1) In General. A deposition may be taken in a foreign country:

- (A) under an applicable treaty or convention;
- (B) under a letter of request, whether or not captioned a “letter rogatory”;
- (C) on notice, before a person authorized to administer oaths either by federal law or by the law in the place of examination; or
- (D) before a person commissioned by the court to administer any necessary oath and take testimony.

Rule 2.123(a)(2); *Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), corrected at 19 USPQ2d 1479 (TTAB 1990).

What constitutes good cause to take an oral deposition is determined on a case-by-case basis. See *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980).

As to Petitioner's objection to Respondent's notice arguing that Respondent should take oral cross-examination of Ms. Schiedmayer because she was in the U.S. during the month of July, inasmuch as that time period has lapsed, the basis for the objection is moot. To the extent the objection was intended as a motion for oral cross-examination, the motion is **denied** as moot.

Turning to Petitioner's objection that Respondent's notice is procedurally insufficient because it does not identify by name or descriptive title of the officer before whom the cross-examination will take place, the Board notes that Respondent does not dispute this assertion.⁷ Respondent asserts that it "amends its original notice to request that the written questions be answered ... before a German notary – if possible, the same Germany notary that certified Exhibit 1 to Petitioner's Response to Respondent Motion to Strike."⁸ 49 TTABVUE 2-3. Respondent, however, did not submit a new or revised notice. Accordingly, Petitioner's motion to strike the notice to take cross-

⁷ Respondent notes that it is "not familiar with German officials" and had "hope[d] ... an agreement as to the particular type of official" used would be reached by the parties. 49 TTABVUE 2.

⁸ Petitioner objects to the use of the same notary arguing the "German Notar ... acts for the city of Stuttgart" and because of his position, "he cannot act as a deponent in an independent matter." 50 TTABVUE 3.

examination on written questions is hereby **granted**. Notwithstanding the foregoing, Respondent is allowed until **August 30, 2017** to file with the Board an amended notice to cross-examine Ms. Schiedmayer on written questions which complies with the rules.

Proceedings are otherwise suspended. If Respondent files with the Board a proper and timely notice to take cross-examination upon written questions, the parties should notify the Board, by email or phone, within ten days so that proceedings may be further suspended for the noticed cross-examination. *Cf.* Trademark Rule 2.124(d)(2). The Board will thereafter (or if Respondent does not file an amended notice by the deadline noted), reset remaining trial dates, as appropriate.