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PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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General Contact Number: 571-272-8500

BUO

Mailed: December 21, 2016

Cancellation No. 92061215

Schiedmayer Celesta GMBH

v.

*Piano Factory Group; and
Sweet 16 Musical Properties, Inc.¹*

Before Zervas, Greenbaum, and Heasley,
Administrative Trademark Judges.

By the Board:

Now before the Board are:

- 1) Petitioner's motion for leave to amend the petition to cancel, filed May 10, 2016, 18 TTABVUE;
- 2) Petitioner's request for reconsideration of the Board's April 22, 2016 order, filed May 12, 2016, 19 TTABVUE;
- 3) Respondent's two motions to dismiss, filed May 31, 2016 and June 23, 2016, 21 TTABVUE, 23 TTABVUE (in response to Petitioner's third amended petition to cancel, filed June 13, 2016) 22 TTABVUE 9 *et seq.*;
- 4) Respondent's motion to disqualify Petitioner's Counsel, filed July 14, 2016, 24 TTABVUE; and
- 5) Petitioner's motion for summary judgment, filed July 22, 2016, 25 TTABVUE.

¹ Sweet 16 Musical Properties, Inc. is being joined as party-defendant in this proceeding *sua sponte* as discussed further below.

All of the motions are contested. The motion to dismiss, the petition to disqualify and the motion for summary judgment are all fully briefed.

Request for Reconsideration

Petitioner argues its allegation of fraud, stricken by the Board's April 22, 2016 order, "related to two separate aspects, first, the acquisition of the registration and second, the maintenance of the registration by Respondent." 19 TTABVue 2. Petitioner asserts that although it "does not object to the striking of paragraph 9 relating to fraud in the acquisition of the registration," "paragraphs 10 and 11 of the Claim to Fraud ... allege that Respondent falsely, fraudulently and with deliberate intent, filed a Declaration of Use under Sections 8 and 15." *Id.* at 3 and 4. The paragraphs in questions allege:

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.

In the Board's prior order, Petitioner's fraud claim was stricken because the "fraud claim appear[ed] to be facially implausible given the facts presented in the proposed amended petition to cancel." 17 TTABVUE 8.²

Generally, the premise underlying a request for reconsideration, modification or clarification under Trademark Rule 2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. Such a motion may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original

² Petitioner makes much of the notion that the Board's striking of its fraud claim was done *sua sponte*, presumably because it intended to add claims of abandonment and misrepresentation of source pursuant to its motion for leave to file an amended petition to cancel, and not to address the sufficiency of its existing fraud claim. However, the Board may at any time examine the sufficiency of the pleadings; it is not limited in doing so only upon motion of one of the parties.

motion. Rather, the motion should be limited to a demonstration that based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change. *See Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005).

Because Petitioner "does not object to the striking of paragraph 9 relating to fraud in the acquisition of the registration," we focus, as Petitioner does, on paragraphs 10 and 11 of the complaint. Petitioner's claim of fraud in the maintenance of the involved registration is based on the alleged false representation that, "[Respondent] 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." 13 TTABVUE 9, ¶ 10. An allegation that Respondent never had a relationship with Petitioner and had never offered any of *Petitioner's goods* for sale, is *circulus in probando*, and not an allegation of fraud. This does not amount to an allegation that Respondent has not offered for sale or sold "pianos, namely, upright pianos, grand pianos, and digital pianos" – the goods identified in Registration No. 3340759. Instead, Petitioner's allegation appears to be more of an attempt at a surrogate claim to its claim of false association, or a thinly-veiled attempt at raising a time-barred likelihood of confusion claim under Section 2(d). *See Trademark Act Section 14(3)*, 15 U.S.C. § 1064(3) (after the five year anniversary of the issuance of a registration, the grounds by which that registration may be cancelled are limited). This is further illustrated by Petitioner's allegation that "[p]urchasers and potential purchasers are being falsely and fraudulently led to believe that some relationship

exists between [Respondent] and the coveted and highly respected Schiedmayer keyboard instruments.” 13 TTABVUE 9, ¶ 11.

Nonetheless, even if proven, Petitioner’s allegations do not amount to a claim of fraud inasmuch as Respondent’s maintenance documents aver that Respondent continues to use its mark on pianos and not on “Petitioner’s goods,” and specifically not celesta keyboards. Therefore, as stated in the prior order, the claim is facially implausible; and the Board’s order striking it was not in error.

Petitioner’s request for reconsideration is **DENIED and Petitioner’s claims of fraud remain stricken.**

Amended Pleading

Pursuant to Fed. R. Civ. P. 15(a)(1)(B), a party may amend its pleading once as a matter of course within 21 days after service of a motion under Rule 12(b). Accordingly, inasmuch as Petitioner’s third amended pleading filed in conjunction with its response to Respondent’s motion to dismiss under Fed. R. Civ. P. 12(b)(6) occurred within 21 days of Respondent’s motion, 22 TTABVUE 9 *et seq.*, the third amended petition to cancel is **ACCEPTED** and is now Petitioner’s operative pleading in this proceeding.³

Motion to Dismiss

In lieu of filing an answer to Petitioner’s third amended petition to cancel, Respondent filed a reply brief including a renewed motion to dismiss the amended

³ Petitioner’s second amended petition to cancel does not include the fraud claim stricken by the Board’s previous order.

petition on June 23, 2016. 23 TTABVUE. Respondent argues, “Petitioner’s Count I, False Designation of Origin, in its Second Amended Petition has not been changed from the originally filed Amended Petition,” and therefore, “is legally defective for precisely the same reasons argued in the previous Motion to Dismiss.” 23 TTABVUE 3. “Respondent renews its Motion to Dismiss Count I on the same grounds as previously made in its May 31st Motion,” but “Respondent does not now move to dismiss Count II in its amended form.” *Id.*

A. Background

By its amended pleading, Petitioner has removed the fraud claim, and now advances, *inter alia*, the following newly added or amended allegations with respect to its claim of false association (Count I):

- Schiedmayer Celesta GmbH is the successor in interest to the trademark SCHIEDMAYER dating to its origin in the year 1735. Schiedmayer Celesta GmbH is owned and operated by Elianne Schiedmayer, successor to the Schiedmayer name and trademark dating back to its origin in 1735.⁴
- 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.⁵
- Petitioner herewith states that Respondent’s mark sought to be cancelled herein is the same as Petitioner’s previously used name or identity.⁶

⁴ 22 TTABVUE 10, ¶ 1.

⁵ *Id.* at 12, ¶ 9.

⁶ *Id.*, ¶ 11.

- Petitioner further states that the mark SCHIEDMAYER would be recognized as such, in that it points uniquely and unmistakably to the Petitioner.⁷
- Petitioner is not connected with the goods allegedly sold or the activities performed by the Respondent under the mark SCHIEDMAYER.⁸
- 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.⁹
- All of the factors alleged above also existed at the time of registration of the Trademark Registration sought to be cancelled herein.¹⁰
- 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.¹¹

Respondent argues in respect to the false association claim, “[t]he fatal legal defect in Petitioner’s Amended Petition alleging False Association (really False Designation of Origin) is that there are not facts alleged that establish at least element 2 at the time of registration of the mark.” 21 TTABVUE 4. Specifically, Respondent avers, “there are no facts alleged in the [sic] Paragraph 1 or in Paragraphs 11 and 12 in Count I that would establish that Elianne Schiedmayer is the only person in the world with the last name of Schiedmayer.” *Id.* Further, Respondent states, “Petitioner must

⁷ *Id.*, ¶ 12.

⁸ *Id.*, ¶ 13.

⁹ *Id.* at 13, ¶ 14.

¹⁰ *Id.*, ¶ 15.

¹¹ *Id.*, ¶ 16.

allege facts that show, at the time of registration, ‘the mark in question pointed uniquely to the [Petitioner] as of the time the registration issued, not as of the time of the filing of the petition for cancellation.’” *Id.* at 5 (quoting Jeffery A. Handelman, Guide to TTAB Practice § 8.05[D] (2016)).

Petitioner maintains, however, that it “is only required to give Respondent fair notice of the claim made, and Petitioner has clearly done so,” inasmuch as Petitioner has specifically alleged facts to support each of the elements of its false association claim. 22 TTABVUE 3-4. Petitioner also asserts that it has alleged “that these factors existed at the time of registration of the trademark registration sought to be cancelled herein.” *Id.* Petitioner concludes, “[t]he problem with Respondent’s assertion is that it represents nothing more than a defense against the allegations made in the Petition.” *Id.* at 5.

A motion to dismiss for failure to state a claim upon which relief may be granted is a test solely of the legal sufficiency of a complaint. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). In order to withstand such a motion, a complaint need only allege such facts as would, if proven, establish that the plaintiff is entitled to the relief sought; that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid statutory ground exists for cancelling the registration. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998). The complaint need only “state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007); *see also Ashcroft v. Iqbal*, 556 U.S. 662 (2009). Petitioner is not under a

burden to prove its case in its petition to cancel. *Enbridge, Inc. v. Excelerate Energy Ltd. P'ship*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009).

B. Standing

The Board has previously found that Petitioner has adequately pleaded its standing to bring this cancellation proceeding. 17 TTABVUE 7.

C. False Association

To state a claim of false suggestion of a connection or false association under Trademark Act Section 2(a), Petitioner must allege facts from which it may be inferred: (1) that Respondent's mark is, or is a close approximation of, Petitioner's name or identity, as previously used by it or identified with it; (2) that Respondent's mark would be recognized as such by purchasers of Respondent's goods, in that it points uniquely and unmistakably to Petitioner; (3) that Petitioner is not connected with the goods that are sold or will be sold by Respondent under its mark; and (4) that Petitioner's name or identity is of sufficient fame or reputation that when used by Respondent as a mark for its goods, a connection with Petitioner would be presumed. *See Bos. Athletic Ass'n v. Velocity, LLC*, 117 USPQ2d 1492, 1495 (TTAB 2015) (citing *Univ. of Notre Dame du Lac v. J.C. Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983)).

Contrary to Respondent's argument, there is no requirement that Petitioner allege that "Elianne Schiedmayer is the only person in the world with the last name of Schiedmayer;" this is not what it means to "point uniquely and unmistakably to Petitioner." Additionally, Respondent's argument regarding Petitioner's alleged

failure to sufficiently allege that the mark pointed uniquely and unmistakably to Petitioner as of the registration filing date, is belied by paragraph 15 of the amended petition.

Indeed, paragraphs 1 and 9-16 of the amended petition assert facts that if proven would entitle Petitioner to the relief it seeks under Trademark Act Section 2(a). Accordingly, Respondent's motion to dismiss the third amended petition to cancel for failure to state a claim upon which relief can be granted is **DENIED** as to Petitioner's amended claim of false suggestion of a connection or false association under Section 2(a).

Petition to Disqualify¹²

On July 14, 2016, Respondent filed a petition to disqualify Petitioner's counsel Michael J. Striker and his firm Striker, Striker, and Stenby from representing Petitioner in this matter.¹³ Respondent requests disqualification of Mr. Striker and his firm due to Respondent's belief that "Mr. Striker will inevitably need to be called to testify as a witness on behalf of his client in this matter," and "others in Mr. Striker's firm likely also have similar attorney-client privileged information and may need to be deposed." 24 TTABVUE 2 and 7. Respondent alleges, inasmuch as Mr. Striker personally signed an application on behalf of Petitioner for the mark

¹² 24 TTABVUE. Authority to decide petitions seeking disqualification of attorneys in cases before the Trademark Trial and Appeal Board has been delegated to the Chief Administrative Trademark Judge. TBMP § 513.02 (2016). Under the delegation, the authority to decide this petition was further delegated to this panel.

¹³ Petitions to disqualify are governed by Patent and Trademark Rule 11.19(c) ("Petitions to disqualify a practitioner in *ex parte* or *inter partes* cases in the Office . . . will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate").

SCHIEDMAYER, in standard character format, alleging a date of first use of 1860,¹⁴ a date that contradicts the date alleged in a previous application filed by Petitioner,¹⁵ “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.” 24 TTABVue 5. Respondent asserts that this information is critical to its false association claim inasmuch as:

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.

Id.

However, Respondent argues that Petitioner is refusing to produce documents responsive to requests on this topic under a claim of attorney-client privilege “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.” *Id.* at 6. Respondent concludes that consequently, without Petitioner agreeing to waive the attorney-client privilege and produce requested documents, the only way for Respondent to obtain the relevant facts is to depose Mr. Striker, particularly in

¹⁴ Application Serial No. 86600864, filed April 17, 2015, for “keyboard musical instruments,” in International Class 15, under Trademark Act Section 1(a), alleging Petitioner’s use of the mark in commerce as of 1860.

¹⁵ Application Serial No. 73475680, filed April 16, 1984, for “musical instruments, namely pianos, chimes, celestes, and keyboards,” in International Class 15, under Section 1(a), alleging Petitioner’s use of the mark in commerce as of 1960. The application was abandoned following an opposition proceeding.

light of Petitioner's response to Respondent's Interrogatory No. 38, which identified only Ellianne Schiedmayer, a national of Germany, as a person having "personal knowledge of the facts surrounding the filing of the '864 application." *Id.*

Petitioner contends that the petition to disqualify should be denied because, *inter alia*, "[Mr.] Striker has no independent knowledge whatsoever of any facts relating to this proceeding. Any such facts are within the knowledge of Elliane Schiedmayer, President of the Petitioner." 27 TTABVUE 4. Petitioner concludes, "[n]ot only is Striker not a necessary witness; Striker is not an appropriate witness." *Id.* at 8.

Section 11.307(a) of the **USPTO RULES OF PROFESSIONAL CONDUCT**, 37 CFR § 11.307(a), discusses when a practitioner for a party who may become a witness in a USPTO proceeding should be disqualified:

- a) A practitioner shall not act as advocate at a proceeding before a tribunal in which the practitioner is likely to be a necessary witness unless:
 - 1) The testimony relates to an uncontested issue;
 - 2) The testimony relates to the nature and value of legal services rendered in the case; or
 - 3) Disqualification of the practitioner would work substantial hardship on the client.

Thus, in determining whether disqualification is required, the first consideration is whether the attorney is a necessary witness, and the second is, if necessary, does that attorney meet a listed exception.

An attorney will be considered a necessary witness where no other person is available to testify in his or her place. *Northbrook Digital, LLC v. Vendio Servs., Inc.*, 625 F.Supp. 2d 728, 765 (D. Minn. 2008). A necessary witness is one who offers evidence that is not available from another source. *See Horaist v. Doctor's Hosp. of Opelousas*, 255 F.3d 261, 267 (5th Cir. 2001); *Telectronics Proprietary, Ltd. v.*

Medtronic, Inc., 836 F.2d 1332, 5 USPQ2d 1424, 1428 (Fed. Cir. 1988) (citing *SMI Indus. Canada Ltd. v. Caelter Indus. Inc.*, 586 F.Supp. 808, 223 USPQ 742, 748 (N.D.N.Y. 1984) (an attorney as witness is one “who has crucial information in his possession that must be divulged”)). An attorney is “likely to be a necessary witness where the proposed testimony is relevant, material, not merely cumulative, and unobtainable elsewhere.” *Carta v. Lumbermens Mut. Cas. Ins. Co.*, 419 F.Supp.2d 23, 29 (D. Mass. 2006) (quoting *Merrill Lynch Bus. Fin. Svcs., Inc. v. Nudell*, 239 F.Supp.2d 1170, 1173 (D. Colo. 2003)); and *Horaist*, 255 F.3d at 266. See also *Religious Tech. Center v. F.A.C.T.Net, Inc.*, 945 F.Supp. 1470, 1474 (D. Colo. 1996) (quoting *World Youth Day, Inc. v. Famous Artists Merch. Exch.*, 866 F.Supp. 1297, 1302 (D. Colo. 1994) (“A lawyer is a ‘necessary’ witness if his or her testimony is relevant, material and unobtainable elsewhere.”)). Without a showing by the petitioning party that the attorney has information only he or she may attest to, that person will not be deemed a necessary witness. See *Macheca Transp. Co. v. Phila. Indem. Ins. Co.*, 463 F.3d 827, 833 (8th Cir. 2006).

An application for registration must include a verified statement signed by a person properly authorized to sign on behalf of the applicant under § 2.193(e)(1). Trademark Rule 2.33; TMEP § 804 (Oct. 2016). Trademark Rule 2.193(e)(1), 37 CFR § 2.193(e)(1) provides, in relevant part, as follows:

... an application for registration, amendment to an application for registration, allegation of use under §2.76 or §2.88, request for extension of time to file a statement of use under §2.89, or an affidavit under section 8, 12(c), 15, or 71 of the Act must ... be signed by the owner or a person properly authorized to sign on behalf of the owner.

The Rule identifies a person properly authorized to verify the facts on behalf of the owner as:

- (i) A person with legal authority to bind the owner (*e.g.*, a corporate officer or general partner of a partnership);
- (ii) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or
- (iii) An attorney as defined in § 11.1 of this chapter who has an actual written or verbal power of attorney or an implied power of attorney from the owner.

Additionally, in all cancellation proceedings “[t]he petition for cancellation need not be verified, but must be signed by the petitioner or the petitioner’s attorney”

Trademark Rule 2.111(b); TBMP § 309.01 (2016).

The USPTO clearly permits an attorney to sign the verification (*e.g.*, a declaration) in support of an application, and other specified filings, on behalf of the applicant. Indeed, it is common for attorneys to do so. The mere signing of the declaration does not make an attorney a “necessary witness.”

Although it is true that Mr. Striker signed the declaration included with the application on behalf of his client, this by itself does not create a circumstance where Mr. Striker alone would need to testify to the contents of that application. Indeed, as Respondent notes, Ellianne Schiedmayer, Petitioner’s president, is an available source of information, albeit obtaining the information from her as a foreign national would be a more cumbersome endeavor. Nonetheless, in light of this, Respondent has failed to establish that Mr. Striker is the sole source of the information that Respondent seeks. Mr. Striker was merely a permitted signatory. Evidence and

information as to the contents of those submissions can be found elsewhere. Thus, Mr. Striker is not a necessary witness.¹⁶

Accordingly, the petition to disqualify Michael J. Striker and his firm Striker, Striker, and Stenby from representing Petitioner in this matter is **DENIED**.¹⁷

Motion for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus allowing such cases to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes exist. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471

¹⁶ In passing, a policy of disqualifying an attorney for signing a declaration on behalf of his client, especially where it is permitted by the Trademark Rules of Practice, without anything more, would have an undesired consequence of rendering many attorneys practicing before the Board eligible for disqualification.

¹⁷ The parties are reminded of their duty to conduct themselves with decorum and courtesy during this proceeding. Trademark Rule 2.192; *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009). Both parties should refrain from lobbing personal attacks and provocative allegations during this proceeding. The Board's jurisdiction is limited to a determination of the registrability of marks, and therefore the parties' arguments should be limited to issues related to the resolution of that question.

(Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

If the evidence produced in support of the summary judgment motion does not meet the moving party's burden summary judgment will be denied, particularly where the non-moving party introduces evidence that demonstrates the existence of at least one genuine dispute as to a material fact that requires resolution at trial.

In support of its motion, Petitioner introduced the declaration of Olga Fuchs, Petitioner's counsel's Office Manager,¹⁸ who authenticated the following exhibit:

- a printout from the website of the Secretary of State of California, showing "Business Search Results" from a search for the term "Piano Factory Group, Inc."¹⁹

Additionally, Petitioner attached the following exhibits independently of the Fuchs declaration:²⁰

- a purported printout from the website of the "State of California Franchise Tax Board;"²¹ and
- a copy of an email from Melissa Marsh (an unidentified attorney) sent to the Striker law firm regarding the "Suspended Status of Piano Factory Group, Inc."²²

Petitioner did not submit any additional evidence.

¹⁸ 25 TTABVUE 13.

¹⁹ 25 TTABVUE 11.

²⁰ Although certain types of evidence may be considered on summary judgment even when not filed in connection with a declaration or affidavit, the exhibits submitted by Petitioner do not meet the self-authenticating requirements of Trademark Rule 2.122(e), and therefore will not be considered in connection with the motion for summary judgment. *See* Fed. R. Civ. P. 56(c); Trademark Rule 2.122(e); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1369-70 (TTAB 1998); TBMP §§ 528.05(a)(1)-(e).

²¹ *Id.* at 17.

²² *Id.* at 15.

A. State of California's Franchise Tax Board and the Secretary of State of California

The basis for Petitioner's motion is that Respondent has not complied with certain regulations of the State of California's Franchise Tax Board and the Secretary of State of California, and therefore cannot lawfully conduct business in the State of California. Consequently, Petitioner alleges, Respondent cannot lawfully make use of its mark or participate in a legal proceeding involving the mark, including the present proceeding. This allegation was not asserted in the amended petition to cancel. Generally, a party may not obtain summary judgment on a claim or defense that has not been pleaded. *See* Fed. R. Civ. P. 56(a); *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1528 n.3 (TTAB 2008). However, if the parties, in briefing a summary judgment motion, have treated an unpleaded claim on its merits, and the nonmoving party has not objected to the motion on the ground that it is based on an unpleaded claim, the Board may deem the pleadings to have been effectively amended, by agreement of the parties, to allege the matter. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (pleading deemed amended where nonmoving party did not object to motion as seeking judgment on unpleaded claim), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997).

Although this claim was not initially pleaded or added by any of Petitioner's amendments to its petition, Respondent has treated the claim on its merits without objection, and therefore it will be considered. For purposes of determining the

summary judgment motion only, the Board will deem the petition to cancel to be further amended to advance the new allegations and those allegations to be denied by Respondent.

Here, Petitioner asserts, "... Respondent, Piano Factory Group, Inc. is a suspended corporation, having been suspended since 2008 by the Franchise Tax Board of the Office of the Secretary of State of the State of California. Therefore, the filing of a Declaration of use in April 2014 must be considered as a nullity." 25 TTABVUE 2. Petitioner further alleges, "... the entity has been suspended by the Franchise Tax Board of the State of California due to its failure to file needed returns and pay taxes." *Id.* at 5. Petitioner concludes without legal support or citation, "[a] suspended corporation, being a juristic nullity, also cannot do business of any kind and cannot maintain a Trademark Registration," *id.* at 2, "and cannot defend this Petition for Cancellation." *Id.* at 7. The website printout attached as evidence to Petitioner's motion, the only exhibit that may be considered,²³ simply shows that Piano Factory Group, Inc.'s status is that of "FTB Suspended."

²³ On August 1, 2016, Petitioner filed an addendum to its motion including an exhibit that was not supported by an affidavit or declaration. However, specific provision is made in the Trademark Rules of Practice for the filing of a brief in support of a motion, a brief in opposition to a motion, and a reply brief in further support of the motion. No further papers will be considered regarding the motion. *See* Trademark Rule 2.127(a); *Pioneer Kabushiki Kaisha v. Hitachi High Techs.*, 74 USPQ2d 1672, 1677 (TTAB 2005).

Further, as previously noted, only certain types of material may be filed in support of a motion for summary judgment absent a supporting declaration, and those materials must meet the self-authenticating requirements of Trademark Rule 2.122(e).

Respondent contends, “the Board is not bound by the laws of [the] State of California when deciding whether Respondent has the ability to defend itself and its property in this federal legal proceeding,” but that in any event:

the legal Respondent in this matter has, at all times, been Sweet 16 Musical Properties, Inc. (Sweet 16) doing business as (DBA) under the fictitious name PIANO FACTORY GROUP. The suspended Piano Factory Group, Inc. currently on the records of the California Secretary of State is simply a left over, undissolved corporation that holds no assets, including the registration at issue in this case.

31 TTABVUE 2-3 and 3-4.

The gravamen of Petitioner’s allegations is whether a suspended corporation can continue to hold property, including intellectual property. Respondent contends however, “Petitioner’s arguments make no legal sense ... essentially suggest[ing] that a suspended corporation loses all its property at the time of suspension and that property then sits in legal limbo permanently thereafter.” 31 TTABVUE 3. In any event, Respondent argues that this point is moot inasmuch as the assets of Piano Factory Group, including the registration at issue, were assigned to another legal entity before the suspension.

Respondent introduced evidence in connection with its response brief in opposition to the motion for summary judgment supported by the declaration of Glenn Treibitz, who “controls” Sweet 16 Musical Properties, Inc. This evidence shows that on August 17, 2006, all rights and interest in the company Piano Factory Group, Inc. were

transferred to Sweet 16 Musical Properties. 31 TTABVUE 16.²⁴ Respondent also attached evidence showing Sweet 16 Musical Properties' status as "Active" with the Secretary of State. 31 TTABVUE 18. When a mark that is the subject of a registration has been assigned, together with the registration, in accordance with Trademark Act Section 10, 15 U.S.C. § 1060, any action with respect to the registration which may or must be taken by the registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded with the USPTO or that proof of the assignment has been submitted in the Board proceeding record.

The evidence of record²⁵ tends to indicate at least a genuine dispute of material fact exists as to whether Respondent is able to defend this cancellation or maintain a trademark registration. Based upon the record at present, Petitioner has failed to meet its burden to show that no genuine disputes of material fact remain as to its unpleaded claim that Respondent cannot legally defend itself in this proceeding.²⁶

²⁴ An assignment was recorded by the USPTO on August 27, 2016, at reel/frame 5866/0016.

²⁵ The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

²⁶ The fact that we have identified only certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes that remain for trial.

Accordingly, Petitioner's motion for summary judgment is **DENIED** with respect to the previously unpleaded allegations made in its motion for summary judgment.²⁷

Join/Substitute Party

In light of the information provided by Respondent in its opposition to Petitioner's motion for summary judgment, we find that Sweet 16 Musical Properties, Inc. should be joined *sua sponte* as party defendant to this proceeding. When there has been an assignment of a mark that is the subject of, or relied upon in, an *inter partes* proceeding before the Board, the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board's own initiative. TBMP § 512.01. *See, e.g., NSM Res. Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1031 (TTAB 2014) (citing *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 n.1 (TTAB 2008)).

Where the mark(s) assigned, together with the corresponding application or registration, is the subject of an opposition or cancellation proceeding before the Board, the assignee may be joined as a party defendant once a copy of the assignment has been filed with the Board. *See* TBMP § 512.01. When the assignment is recorded in the Assignment Services Division of the USPTO, the assignee may be substituted as a party if the assignment occurred prior to the commencement of the proceeding, *Cf. Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1434 n.1 (TTAB 2007), or the assignor is no longer in existence, or if the plaintiff raises no objections to

²⁷ If Petitioner wishes to pursue its claim beyond this motion for summary judgment, Petitioner must, within **TEN DAYS** of the issuance of this order, file a motion to amend its petition to cancel to properly plead such a claim.

substitution, or if the discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery. *See, e.g.*, 37 CFR § 2.113(c); 37 CFR § 2.113(d), 37 CFR § 3.71(d) and 37 CFR § 3.73(b); Fed. R. Civ. P. 17 and 25; *Drive Trademark Holdings*, 83 USPQ2d at 1434 n.2.

Under the present circumstances, substitution would be inappropriate and discovery would be better served by the retention of Respondent as a party defendant in this matter. Therefore, Sweet 16 Musical Properties, Inc. will be **JOINED** as a party-defendant with Respondent, Piano Factory Group.²⁸

Future Motions

In light of the parties' rampant motion practice and the lapse in decorum in the tenor of those motions, no further motions should be filed 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.**²⁹

Schedule

The proceeding is **RESUMED**. The remaining discovery, disclosure and trial dates are reset as follows:

Expert Disclosures Due	2/12/2017
Discovery Closes	3/10/2017
Plaintiff's Pretrial Disclosures	4/24/2017
Plaintiff's 30-day Trial Period Ends	6/8/2017

²⁸ The Board's records have been updated accordingly to reflect the joinder.

²⁹ The parties should seek leave by contacting the assigned Board interlocutory attorney by telephone at 571-270-1524.

Consent motions for extension or suspension of the proceeding are exempt from this requirement.

Defendant's Pretrial Disclosures	6/23/2017
Defendant's 30-day Trial Period Ends	8/7/2017
Plaintiff's Rebuttal Disclosures	8/22/2017
Plaintiff's 15-day Rebuttal Period Ends	9/21/2017

In each instance, a copy of the transcript of any testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of taking of that testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.