

**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 MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM

Respondent Piano Factory Group, Inc. (“Respondent”) hereby submits its motion to dismiss Schiedmayer Celesta GmbH (“Petitioner”) Amended Petition for Cancellation filed May 10, 2016.

FACTS

Petitioner filed its Amended Petition for Cancellation May 10, 2016, in response to the Board’s order dated April 22, 2016, dismissing Petitioner’s Motion to Amend the Cancellation Petition. In the Board’s order, the Board had dismissed Petitioner’s fraud claim with prejudice, and dismissed Petitioner’s proposed Abandonment and False Association claims without prejudice. On May 12, 2016, Respondent filed a Request for Reconsideration with the Board requesting that the Board reconsider its dismissal with prejudice of Petitioner’s fraud claims.

Respondent was served with a copy of the Amended Petition via first class U.S. mail, which accordingly gives Respondent 20 days (until May 31, 2016, counting federal holidays), in which to answer the Amended Petition. Before filing an answer to the

Amended Petition, Respondent is timely filing this Motion to Dismiss for Failure to State a Claim.

In the Amended complaint, paragraph 1 alleges that “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.”
Emphasis added.

Count I of the Amended Complaint, paragraphs 9-16 contain Petitioner’s specific allegations regarding False Association. Count II of the Amended Complaint, paragraphs 17-21 contain Petitioner’s specific allegations regarding Abandonment.

ARGUMENT

The Amended Petition Fails to Allege Facts to show False Designation of Origin:

As the Board knows, to show False Designation of Origin, the Petitioner must plead facts that prove:

1. That the defendant's mark is the same as, or a close approximation of, the plaintiff's previously used name or identity;
2. That the mark would be recognized as such, in that it points uniquely and unmistakably to the plaintiff;
3. That the plaintiff is not connected with the goods sold or the activities performed by the defendant under the mark; and
4. That the plaintiff's name or identity is of sufficient fame or reputation that, when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed. Jeffery A. Handelman, *Guide to TTAB Practice* § 8.05[E] (2016)

As indicated in the Board's order, p. 9, footnote 11, to be legally sufficient, Petitioner's Amended Petition "must allege facts from which it may be inferred (1) that Respondent's mark points uniquely to Petitioner as an entity—*i.e.*, that Respondent's mark is Petitioner's identity or "persona;" (2) that purchasers would assume that goods sold under Respondent's mark are connected with Petitioner; and (3) either (a) that Petitioner was the prior user of Respondent's mark, or the equivalent thereof, as a designation of its identity or "persona", or (b) that there was an association of the mark with Petitioner prior in time to Respondent's use." (Citations omitted).

The 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. Because of this, the Amended Petition fails to establish that "Respondent's mark points uniquely to Petitioner as an entity..." (Board Order, April 22, 2016, fn 11).

Paragraph 1 of the Amended Petition recites that Petitioner is Schiedmayer Celesta GmbH owned and operated by Elianne Schiedmayer. It is apparent that the mark SCHIEDMAYER is identical to the last name of the owner of Petitioner and that the business name of Petitioner also includes the surname of its current owner. It is common practice for businesses to incorporate the last name of the owner of the company. However, there are no facts alleged in the 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. There are very likely any number of other individuals in the United States who have the surname Schiedmayer, including her other family members.

Where the mark is a surname, the Petitioner must do more than merely allege that the mark is the same as the surname and then conclude that automatically, the mark has fame sufficient to point unmistakably to Petitioner. A surname is not inherently distinctive, even when rare [see TMEP § 1211.01(a)(v)], and so Petitioner faces a much higher bar to plead facts sufficient to show unique and unmistakable association with Petitioner where a mark is identical to the surname of the owner of Petitioner. All Petitioner has done in paragraphs 9, 10, and 11 is generally allege that the mark SCHIEDMAYER has great fame, that Petitioner owns it, and that Respondent's mark is the same as Petitioner's previously used identity. Petitioner fails to plead any facts in the Petition that establish any secondary meaning that Petitioner has in the mark SCHIEDMAYER other than it happens to be the surname of the owner of Petitioner.

Furthermore, the Petitioner must 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.” Jeffery A. Handelman, *Guide to TTAB Practice* § 8.05[D] (2016). Because the time of registration was nearly 9 years ago, it is legally critical for Petitioner to specifically allege in the Petition that, 9 years ago, the mark SCHIEDMAYER pointed uniquely to Petitioner. All the Amended Petition contains is Petitioner's general allegation that Petitioner “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.” (Paragraph 9). This provides no information about how the mark SCHIEDMAYER pointed uniquely to Petitioner at the date of registration. The Board does not even know how long “long prior” might be.

The foregoing show that Petitioner’s Amended Petition merely recites the elements of a claim for False Designation of Origin—it fails to “allege well-pleaded factual matter and [is no] more than ‘[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements.’” TBMP § 503.02, citing *Ashcroft v. Iqbal* 556 U.S. 662, 678 (2009). In view of the foregoing, it is clear that the allegations made in Count I of the Amended Petition are fatally legally defective and fail to state a claim upon which relief can be granted.

The Amended Petition Fails to Allege Facts to Show Abandonment:

While in Paragraph 17, Petitioner alleges that Respondent has not used the trademark SCHEDMAYER upon any of the goods, Petitioner then alleges in Paragraph 18 inexplicably that “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.” This allegation fails completely to discuss facts involving the mark. To sufficiently plead abandonment, Petitioner must plead that Piano Factory has not sold or offered for sale or transported in commerce any of the products bearing the mark SCHIEDMAYER. This failure renders the claim of abandonment fatally legally defective and fails to state a claim upon which a relief can be granted.

In view of the foregoing, the Respondent respectfully requests that Petitioner's Amended Petition for Cancellation be dismissed for failure to state a claim upon which relief can be granted.

Dated: May 28, 2016

Respectfully submitted,

/s/ Adam R. Stephenson
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CERTIFICATE OF SERVICE

It is hereby certified that one (1) copy of the foregoing RESPONDENT’S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM is being sent via first class U.S. Mail to Petitioner Schiedmayer Celesta GmbH’s attorney of record as follows:

Michael J. Striker
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Dated: May 28, 2016

_ /s/ Adam Stephenson_____