

**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
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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_____