

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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Schiedmayer Celesta GmbH,

Cancellation No.: 92/061,215

Petitioner,

Reg. No. 3,340,759

v.

Mark: SCHIEDMAYER

Piano Factory Group, Inc. and  
Sweet 16 Musical Properties, Inc.

Registration Date: November 20, 2007

Respondents.

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**BRIEF ON BEHALF OF RESPONDENT**

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**BRIEF ON BEHALF OF RESPONDENT**

**I. INTRODUCTION**

On November 20, 2007, the Respondents (referred to for simplicity's sake herein in the singular throughout) were rightfully issued U.S. Trademark Registration No. 3,340,759 for the word mark SCHIEDMAYER as used in association with pianos, namely, upright pianos, grand pianos, and digital pianos. The registration was obtained on an intent-to-use application originally filed August 24, 2002. On April 1, 2015, (approximately 7.5 years after the registration of the SCHIEDMAYER mark and over 12.5 years after the original filing of the application) Petitioner filed a Petition for Cancellation of the SCHIEDMAYER mark.

In seeking the cancellation of Respondent's registration, the Petitioner has asserted two particular grounds as put forth in the Plaintiff's Third Amended Petition for Cancellation dated January 3, 2017 (34 TTABVUE 8-11), and as reiterated in the Petitioner's Brief in Support of Petition to Cancel dated December 12, 2018 (75 TTABVUE 7). The grounds asserted by the Petitioner are:

1. **False Association**-The Petitioner alleges that there exists a “[f]alse suggestion of a connection between the Defendants’ goods and Plaintiff, by Defendants’ misappropriation of Petitioner’s name, persona and mark SCHIEDMAYER, pursuant to 15 USC § 1052(a).” (75 TTABVUE 12).
2. **Abandonment**-The Petitioner alleges that the Respondent has abandoned the SCHIEDMAYER mark as “any use of the mark SCHIEDMAYER by Defendants represents a palming off of Plaintiff’s goods and therefore does not constitute bona fide use of the trademark pursuant to TMEP Sec. 901.02, Sec. 45 of the Act.” (75 TTABVUE 12).

For reasons discussed in detail hereinafter, the Petitioner’s evidence and arguments are insufficient to sustain either of the two claims asserted.

Further, in the Respondent’s Answer to Petitioner’s Third Amended Petition for Cancellation, the Respondent raised the affirmative defense of Laches (35 TTABVUE 6). As previously established, and as explained herein, the Respondent has met the burden of establishing that at least the claim of False Association is barred by the doctrine of Laches.

Thus, there are two claims along with the affirmative defense of Laches that will be decided by the Board.

## **II. EVIDENTIARY RECORD**

Petitioner’s evidence in support of its Petition for Cancellation is as set forth in the Petitioner’s Final Brief (75 TTABVUE 11-12). The Respondent’s evidence relied upon in its defense is at least as follows:

- Declaration of Glenn Treibitz and the Exhibits appended thereto (66 TTABVUE 6)

- *The Pierce Piano Atlas*, 12<sup>th</sup> Edition, Larry E. Ashley (66 TTABVUE 15)
- *Piano an Encyclopedia*, 2<sup>nd</sup> Edition, Encyclopedia of Keyboard Instruments, Robert Palmieri, 2003 (66 TTABVUE 21)
- Online Statement made by Elianne Schiedmayer (66 TTABVUE 44)
- Defendant's Notice of Reliance and Exhibits appended thereto (65 TTABVUE)
- Declaration of Elianne Schiedmayer and Exhibits appended thereto (38 TTABVUE)
- Rebuttal Declaration of Elianne Schiedmayer (73 TTABVUE 2)
- Declaration of Russell Kassman (66 TTABVUE 4)
- Defendant's advertisements for SCHIEDMAYER branded pianos (66 TTABVUE 48-49)
- Deposition of Glenn Treibitz (42 TTABVUE 4)
- Cross-Examination Testimony Deposition of Glenn Treibitz (70 TTABVUE)

### III. FACTS

#### **History of Petitioner**

In order to evaluate the true history of and relationship of Petitioner to the manufacture of piano forte instruments (pianos), the Respondent has turned to authoritative texts on piano and piano manufacturer history, including, *The Pierce Piano Atlas* (66 TTABVUE 7) and the volume *Piano: An Encyclopedia* taken from *The Encyclopedia of Keyboard Instruments*. (66 TTABVUE 8).

According to the *Pierce Piano Atlas*, in 1969, Georg Schiedmayer, who also owned Schiedmayer & Soehne GmbH & Co., took over the company Schiedmayer Pianofortefabrik.



(66 TTABVUE 35). This company built pianos. (66 TTABVUE 29). In 1980, Georg Schiedmayer sold the piano line of the company to Rud Ibach & Sohn. (66 TTABVUE 29). Georg Schiedmayer was the last of his family to build pianos and changed his focus to building glockenspiels and celestas as of 1980. (66 TTABVUE 29). According to every authoritative piano text the Respondent has ever viewed, Georg Schiedmayer transferred rights to the Schiedmayer trademark for pianos in 1980 to the piano company Rud Ibach & Sohn at the same time he sold the piano line to Rud Ibach & Sohn. More specifically, according to the 12<sup>th</sup> edition of the *Pierce Piano Atlas*, it states that “George Schiedmayer sold this piano line to Rud. Ibach Sohn in 1980.” (66 TTABVUE 18) Further, according to the volume *Piano: An Encyclopedia* from *The Encyclopedia of Keyboard Instruments* series, it states “Georg Schiedmayer, who was the last of his family to build pianos, changed his focus to building celestas and glockenspiels and in 1980 sold the piano name, models, drawings, tools, and forms to the Rudolf Ibach Sohn firm. Schiedmayer is now a brand name of the Ibach company.” (66 TTABVUE 29). It further states that “[i]n the 1980s Ibach expanded by purchasing the venerable Schiedmayer piano division (est. in 1809) and the piano firm of Roth and Junius (est. in 1889), known for its affordable instruments for home and school. Both brand names are still in production under the auspices of Rudolf Ibach Sohn.” (66 TTABVUE 24).

The name of Schiedmayer Pianofortefabrik was changed to “Schiedmayer Pianos GmbH when George Schiedmayer sold this piano line to Rud. Ibach Sohn in 1980. Some Pianos were made under license by various manufacturers including Kemble, in England, and Kawai, in Japan for that company. The company, now named Schiedmayer Piano Co. was taken over by Musikhaus Thomann, Erlangen, Germany, in 2006.” (66 TTABVUE 35). It is noted that in 1984, Schiedmayer Pianos GmbH was the entity that applied for the only previously existing

SCHIEDMAYER trademark application. Petitioner confirmed this information in a statement voluntarily made during the pendency of these proceedings on the internet by Elianne Schiedmayer who owns and controls Petitioner, where she stated that “[i]n the 1990s, Ibach started a cooperation with KAWAI and began advertising pianos under the label Schiedmayer Pianofortefabrik GmbH and used a false ‘Schiedmayer S’ logo.” (66 TTABVUE 44). While Elianne Schiedmayer states that the logo is “false,” she provided no evidence to indicate as much. She further states “the company “Schiedmayer Pianos GmbH filed for bankruptcy in 2003. The name Schiedmayer Pianos GmbH was changed in the same year to Pianocenter Wuppertal GmbH. This company filed for bankruptcy in 2006.” (66 TTABVUE 44). She further corroborates the authoritative texts by stating that in 2006, Musikhaus Thomann e.K. utilized the remaining goods from the bankruptcy estate of the Pianocenter Wuppertal GmbH.” (66 TTABVUE 44).

In her statement, she admits that for over 30 years (between 1983 and 2014), other companies operated under the belief they had rights to the registered “Schiedmayer S” logo which included the printed name “Schiedmayer” thereon. (66 TTABVUE 44). Petitioner and Petitioner’s successors in interest stood by and let them use the name for pianos in the European market during this entire period.

“While Rud Ibach & Sohn were making pianos having the SCHIEDMAYER label [at least some of which were sold in the United States], Schiedmayer & Soehne GmbH & Co. continued to operate under the direction of George Schiedmayer and produced glockenspiels and celestas.” (66 TTABVUE 29). Elianne Schiedmayer took over Schiedmayer & Soehne GmbH & Co. after the death of her husband, Georg Schiedmayer, in 1992. (38 TTABVUE 7). Schiedmayer Pianos GmbH, owned by Rud Ibach & Sohn, and Schiedmayer & Soehne GmbH,

owned by Georg Schiedmayer and then his wife, Elianne Schiedmayer, were unrelated companies that coexisted until 2003. (66 TTABVUE 44). Elianne Schiedmayer also created the company Schiedmayer Celestabaus in 1995 and changed the name to Schiedmayer Celesta GmbH, which company is the actual Petitioner in this proceeding. (66 TTABVUE 35). During this proceeding, the Petitioner admitted and confirmed that it has never manufactured a piano. (65 TTABVUE 6).

**Respondent's acquisition of the registered SCHIEDMAYER trademark for pianos**

As stated in the Declaration of Glenn Treibitz, “[i]n approximately 2001 I had noticed that Kawai was no longer selling pianos branded as “Schiedmayer” in the United States.” (66 TTABVUE 9). Believing the mark was now abandoned for pianos, on August 24, 2002, the Respondent filed U.S. Trademark Application Serial No. 78/157552 for the mark SCHIEDMAYER to be used with pianos. The trademark application was subsequently rejected. In the rejection, the Examiner refused to register the trademark as “the applicant’s mark suggests a false connection with the pianos previously and currently manufactured under the trademark SCHIEDMAYER.” (Office Action, Sep. 12, 2003, p. 1). The Examining attorney claimed this violated 15 U.S.C. § 1052(a). (Office Action, Sep. 12, 2003, p. 1). To support this, the Examining Attorney included Attachment-1 to the 9/12/2003 Office Action which appears to be taken from Rud Ibach & Sohn’s website. The Attachment states, “Georg Schiedmayer was the last of his family, who built upright and grand pianos in this 1809 established firm. His interest changed and he started building “celeste” and “glockenspiel” and in 1980 he sold the traditional piano company to his friend Mr. Ibach.” (Office Action, Sep. 12, 2003, Attachment-1, p. 1). It further states “Ibach bought the name as well as the models, drawings, tools, forms and installations. This means even today Schiedmayer pianos are made continuously in the tradition

of the 1809 established company. Schiedmayer pianos had always been instruments of a higher product category. Schiedmayer est. 1809™ is a brand mark of IBACH.” (Office Action, Sep. 12, 2003, Attachment-1, p.1).

In response to this Office Action, the Applicant through its counsel explained that the Schiedmayer family’s piano business was sold in 1980 to IBACH. The Applicant further explained that “[t]he trademark SCHIEDMAYER was subsequently used by Schiedmayer Piano GmbH of Wuppertal, Germany, a subsidiary of Rud Ibach Sohn and was made under license by Kawai Piano of Japan. However, Kawai Piano ceased manufacture of SCHIEDMAYER a few years prior to 2002.” (Response to Office Action, Mar. 15, 2004, p. 2). The Applicant further explained that as far as Applicant could tell, Schiedmayer Piano GmbH had also ceased making SCHIEDMAYER branded pianos at that point. (Response to Office Action, Mar. 15, 2004, p. 2). The Applicant then explained how there could be no false association under section 2(a) of the Lanham act as Rud Ibach & Sohn had the rights to mark SCHIEDMAYER for pianos and they had ceased use of the mark with no apparent intent to resume use. The Examining attorney agreed with the Applicant and issued a Notice of Allowance on Sep. 14, 2004 (Notice of Allowance, Sep. 14, 2004). Following the filing of a statement of use, U.S. Trademark Application Serial No. 78157552 issued on November 7, 2007 as U.S. Trademark Registration No. 3,340,759. The mark was most recently renewed on Nov. 9, 2017, by Respondent Sweet 16 Musical Properties, Inc. (Notice-Acceptance-Renewal, Nov. 9, 2017).

**Respondent’s use of the SCHIEDMAYER mark**

As has been explained by the Respondent, due to data losses resulting both from forced migration of record keeping software and due to losses suffered from computer system failure,

the entirety of the records that specifically identify SCHIEDMAYER branded piano sales cannot be produced. However, some documents have been. (66 TTABVUE 9). As further explained by Glenn Treibitz, Respondent's paper record keeping practices rendered locating any paper records, if they survived Respondent's haphazard document retention policy, virtually impossible, which is why no paper record copies were provided to Petitioner during discovery. See 70 TTABVUE 9-10, 17-19. Further complicating the ability to produce records of SCHIEDMAYER branded piano sales, the practice at Hollywood Piano was that when a SCHIEDMAYER branded piano was needed on the showroom floor, a quality piano from those in the warehouse, such as an unbranded piano manufactured by companies like American Sejung Corporation (ASC), had a SCHIEDMAYER brand nameplate placed on it. (66 TTABVUE 9). In the sales tracking system, however, the record for the unbranded piano was not always updated to reflect its SCHIEDMAYER brand once the physical branding was completed and the piano actually sold, resulting in an automatic undercounting of SCHIEDMAYER sales. (66 TTABVUE 9). A number of SCHIEDMAYER branded pianos were also placed into Hollywood Piano's piano rental pool. Accordingly, these following are the approximate sales and rental figures by year to the best of Respondent's information and belief (66 TTABVUE 10, 70 TTABVUE 22-23):

In the year 2007, approximately 3 pianos bearing the SCHIEDMAYER mark were sold.

In the year 2008, approximately 6 pianos bearing the SCHIEDMAYER mark were sold.

In the year 2009, approximately 3 pianos bearing the SCHIEDMAYER mark were sold.

In the year 2010, approximately 1 pianos bearing the SCHIEDMAYER mark were sold.

In the year 2012, approximately 2 pianos bearing the SCHIEDMAYER mark were sold.

In the year 2014, approximately 1 pianos with my SCHIEDMAYER mark were sold.

In the year 2015, approximately 1 pianos bearing the SCHIEDMAYER mark were sold.

In the year 2016, approximately 2 pianos with my SCHIEDMAYER mark were sold.

In the year 2017, approximately 10 pianos bearing the SCHIEDMAYER mark were sold and approximately 1 pianos bearing the SCHIEDMAYER mark was rented.

SCHIEDMAYER branded pianos have continued to be sold since 2017.

Thus, in total, approximately 29 SCHIEDMAYER pianos have been sold since the SCHIEDMAYER mark was registered and a few more pianos bearing the SCHIEDMAYER mark have been rented since registration of the mark. As each of the sold pianos sold for anywhere between \$1,999 & \$6,999, and each of the rented pianos rented for anywhere between \$49 and \$199 per month, there has been approximately \$137,000.00 in gross revenue from SCHIEDMAYER branded pianos. (66 TTABVUE 10).

**Petitioners use of the mark SCHIEDMAYER and trademark applications**

As admitted by the Petitioner, the Petitioner has never manufactured a piano. (65 TTABVUE 6). Petitioner is in the business of manufacturing celestas and glockenspiels. Since the registration date of the Respondent's trademark, the Petitioner has sold approximately 65 celestas in the United States. (38 TTABVUE 78-115). This is approximately only 36 more instruments than what has been sold by the Respondent over the same time period. Contrary to what is stated in the Petitioner's final brief, the Petitioner filed Trademark Application Serial

Nos. 79/166455 on April 2, 2015 and 86/600864 on April 17, 2015, both for the mark SCHIEDMAYER **after they filed the petition to cancel Respondent's registration on April 1, 2015.** (75 TTABVUE 35). While the Petitioner has gone on the record stating that "Petitioner first became aware of the existence of Respondent's trademark registration when it was cited against Petitioner in Petitioner's pending trademark application," **this is false** as the pending trademark applications were filed **after** the current petition to cancel the Respondent's mark. (65 TTABVUE 12). Indeed, while the Petitioner went on the record stating that they had never contacted Glenn Treibitz via telephone during the pendency of the application (65 TTABVUE 8), the Petitioner belatedly confessed via its agent Elianne Schiedmayer that she did in fact call Glenn Treibitz in the year 2002, the same year that the Respondent filed their trademark application. (73 TTABVUE 7). In her own words, "[i]n August of 2002 I telephoned a person whom I believed to be Glenn Treibitz in order to complain that my name had been improperly appropriated as a domain name and that I was entitled to it. I introduced myself as Elianne Schiedmayer, owner of Schiedmayer Celesta GmbH." (73 TTABVUE 7). This confession took place long after Petitioner had, under penalty of perjury, denied the existence of any such telephone call in its responses to interrogatories during discovery (65 TTABVUE 3, question 7).

#### **Difference between a piano and a celesta**

As admitted by the Petitioner, "[a] celesta is not the same musical instrument as a piano forte," (65 TTABVUE 9) and a celesta does not have a confusingly similar sound to the sound of a piano forte. (65 TTABVUE 10). The Respondent agrees and believes that there would not be any likelihood of confusion between a purchaser of a SCHIEDMAYER branded piano and a SCHIEDMAYER branded celesta given the visual differences and the unmistakable sound differences between the two instruments. The same principles would apply to glockenspiels

made by Petitioner. (66 TTABVUE 11). Further, according to Russell Kassman, the founder of R. Kassman Piano, who has sold both pianos and celestas, “In my experience, no customer of mine has indicated that they were confused thinking a celeste [celesta] is a piano forte.” (66 TTABVUE 4).

**Evidence of actual consumer confusion between the purchase of a SCHIEDMAYER branded piano and a SCHIEDMAYER branded celesta**

Russell Kassman, who has sold both Schiedmayer branded pianos and Schiedmayer branded celestas has stated “[d]uring the time I sold Schiedmayer branded pianos and the SCHIEDMAYER branded celestes, I am unaware of any customer expressing any confusion about whether an association existed between the manufacture of SCHIEDMAYER branded pianos and the manufacturer of SCHIEDMAYER branded celestas.” (66 TTABVUE 4-5).

Since the Respondent adopted the SCHIEDMAYER mark for pianos, they have never been approached or contacted by any individual who informed them that he or she believed there was an association or relationship between the celestas sold by Schiedmayer Celesta (the Petitioner) and SCHIEDMAYER branded pianos. (66 TTABVUE 12). Likewise, the Petitioner has also admitted that there has never been an incident where a consumer contacted Petitioner thinking Respondent’s pianos were related to Petitioner’s celestas. (65 TTABVUE 13).



#### **IV. ARGUMENTS**

##### **a. THE PETITIONER’S ARGUMENTS IN THEIR FINAL BRIEF FAIL TO MIRROR THE PLEADINGS MADE IN THE AMENDED PLEADINGS**

As is well established, the Petitioner must prove the grounds for cancellation actually plead in its complaint. These grounds are the only grounds that Petitioner can use or argue during the briefing phase of a cancellation petition because further amendments to the cancellation petition can only be made by moving to amend the pleadings as set forth in Fed. R. Civ. P. 15(b) and 37 C.F.R. § 2.115. “A plaintiff may not rely on an unpleaded claim. The plaintiff’s pleading must be amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter.” TBMP § 314 (June 2018).

##### **Abandonment**

In the case at hand, the Petitioner filed a third amended complaint on January 3, 2017. In that complaint, the Petitioner argued that Respondent’s registration should be cancelled for abandonment. (34 TTABVUE 10). The Petitioner argued that the Respondent abandoned their trademark as they never used their trademark. (34 TTABVUE 10). Contrary to this pleading, in the Petitioner’s final brief they readily admit that the Respondent has in fact used the SCHIEDMAYER mark by putting it on pianos, but that it should still be abandoned because such use does not constitute a “bona fide use in commerce” as they contend the use was illegal. (75 TTABVUE 32). Because the Petitioner plead that the mark be cancelled because it was abandoned due to non-use by Respondent but is now arguing that it is abandoned due to illegal use by Respondent, the Petitioner’s arguments regarding abandonment are objected to as they go beyond the scope of the matter asserted in the third amended complaint and, accordingly, should be disregarded by the Board in their entirety.

### **Palming Off**

Though the issue of “palming off” and intent were never raised in the amended pleadings filed Jan. 3, 2017, in its final brief the Petitioner argues that the Respondent is “palming off” of the SCHIEDMAYER name. (75 TTABVUE 33). The Petitioner argues that while they have not pleaded “palming off,” they are arguing it in the final brief in order to show intent, which intent can be used to show the Respondent is falsely associated with the Petitioner and that the Respondent abandoned their mark because they illegally used it by palming off of the Schiedmayer name. (75 TTABVUE 10-11).

The doctrine of palming off requires proof of fraud. *Venetianaire Corp. of America v. A & P Import Co.*, 302 F. Supp. 156, 161, 163 U.S.P.Q. 412 (S.D. N.Y. 1969), order aff'd, 429 F.2d 1079, 167 U.S.P.Q. 481 (2d Cir. 1970) (“The doctrine of palming off, ... requires proof of fraud.”) Therefore, **if there is no fraud, there is no palming off**.

In the amended pleading filed by the Petitioner on January 7, 2016, the Petitioner alleged fraud. (13 TTABVUE 8). More specifically, the Petitioner alleged that the Respondent fraudulently filed its trademark application, that the Respondent fraudulently filed its declaration of use, and that the Respondent fraudulently maintained its trademark application, all in view of knowing that the Petitioner actually had rights to and owned the SCHIEDMAYER mark. (13 TTABVUE 8-10). In response to this amended pleading, the interlocutory attorney decided that “[t]he proposed fraud claim appears to be facially implausible given the facts presented in the proposed amended petition to cancel. Accordingly, the proposed amended fraud claim is **STRICKEN** from the petition to cancel, and will be given no further consideration.” (17 TTABVUE 8).

However, the Petitioner is yet again trying to allege fraud by disguising it as “palming off.” The issue of fraud is not plead in the third amendment complaint. Palming off is an unpleaded claim that was formally stricken from this proceeding. Accordingly, the Petitioner’s arguments regarding palming off are beyond the scope of the matter asserted in the third amended complaint and, accordingly, should be disregarded by the Board in their entirety. They truly are a backdoor approach to resurrecting an issue already formally stricken from the case.

In conclusion, because the Petitioner’s arguments made in their final brief are beyond the scope of the claims currently presented in the third amended pleadings dated Jan. 3, 2017, the Petitioner’s arguments regarding abandonment and palming off should be disregarded.

#### **b. FALSE ASSOCIATION**

The Petitioner has failed to establish a claim of false association under 15 U.S.C. § 1052(a).

A registration may be denied when the mark “consists of or comprises ... matter which may ... falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols ...” 15 U.S.C. § 1052(a). A four-factor test is used to determine whether a mark should be refused registration under 15 U.S.C. § 1052(a). The Petitioner must 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. *In re Pedersen*, 109 USPQ2d 1185, 1188-89 (TTAB 2013); *Bd. of Trs. of Univ. of Ala. v. Pitts*, 107 USPQ2d 2001, 2025 (TTAB 2013); *In re Jackson International Trading Co.*, 103 USPQ2d, 1417, 1419 (TTAB 2012).

At least because the Respondent's mark does not point uniquely and unmistakably to the plaintiff, **and** because no connection with the plaintiff would be presumed when the Respondent's mark is used on its goods and services, there is no false association between the Respondent's mark and the Petitioner.

- **The defendant's mark is the same as, or a close approximation of, the plaintiff's previously used name or identity.**

The Respondent concedes that their registration is for SCHIEDMAYER and the Petitioner's name is Schiedmayer Celesta; however, the goods produced under the two marks are not identical, contrary to what the Petitioner asserts. (75 TTABVUE 24). While the Petitioner's alleged predecessors in interest may have manufactured pianos pre-1980, the record is clear that Petitioner has never produced a piano in approximately 40 years.

- **The mark does not point uniquely and unmistakably to the plaintiff.**

In order for the second factor of the four part test to be satisfied, the mark must point only to Petitioner and not possibly to anyone else.

In the *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc*, case relied on by the Petitioner, the defendant's registration of trademark NOTRE DAME and design for cheese was opposed by the appellant, a well-known University. 703 F.2d 1372,

217 U.S.P.Q. 505 (Fed. Cir. 1983). The appellant argued that there would be a false association between the defendant's mark and the appellant. In dismissing case, the Federal Circuit reasoned "Notre Dame' is not a name solely associated with the University. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. **Thus, it cannot be said that the only "person" which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity.**" 703 F.2d 1372, 217 U.S.P.Q. 505 (Fed. Cir. 1983), emphasis added.

Just as the multiple entities had rights to use "Notre Dame" in *The University of Notre Dame*, so have multiple people and entities had rights to use the name SCHIEDMAYER associated with their respective keyboard instruments. As the record clearly establishes, as of 1980, Rud Ibach & Sohn had rights to the mark SCHIEDMAYER and used the mark on their pianos. Stemming from Rud Ibach & Sohn's, rights, Kawai, Schiedmayer Piano GmbH, Pianocenter Wuppertal GmbH, and Musikhaus Thomann e.k. also had rights to the name Schiedmayer as used with keyboard instruments. Further, Respondent legally acquired its rights through the use of the mark for pianos in interstate commerce following the abandonment of the mark in the United States by all those previous users. Respondent's rights were memorialized in the registration of the SCHIEDMAYER mark for pianos.

Just as there was no false association in *The University of Notre Dame*, neither is there false association in the case at hand. Indeed, for at least 30 years, the Petitioner watched numerous other entities use the SCHIEDMAYER mark for pianos in the United States and Europe and did nothing about it. While the Petitioner alleges that Schiedmayer represents "uniquely and only the creation of keyboard musical instruments by the Plaintiff" ( 75

TTABVUE 24) and that “Defendants have not cited any other use of the trademark Schiedmayer and none exists” (75 TTABVUE 25), it is apparent that the Petitioner is intentionally turning a blind eye towards not just the Respondent’s evidence, but also reality. The evidence provided by Respondent clearly establishes that the uniqueness of the Schiedmayer name died the moment Rud Ibach & Sohn claimed they owned the brand SCHIEDMAYER as used with pianos in the United States. Accordingly, the mark SCHIEDMAYER, beginning nearly 40 years ago, did not uniquely point to the Petitioner because of the ownership claim made by at least Rud Ibach & Sohn.

The difficulty for Petitioner to prove this point is further underlined by the fact that the SCHIEDMAYER mark is the surname of the founders of Petitioner. A mark that is primarily merely a surname is not registerable absent a showing “of long and exclusive use that changes its significance to the public from that of a surname to that of a mark for particular goods or services.” TMEP § 1211, 15 U.S.C. § 1052(e)(4). Marks that are merely a surname therefore have a higher burden of proof needed to show the marks uniquely identify Petitioner at any given point in time in situations such as this, where Petitioner admittedly does not make the good (pianos) that is the subject of the registration. Petitioner’s mere assertion in its Brief that SCHIEDMAYER clearly points the purchasing public of pianos to it, after 39 years of use of the mark by others for pianos does not meet this high evidentiary standard.

- **The plaintiff is not connected with the goods sold or the activities performed by the defendant under the mark.**

The Respondent agrees that they are in no way connected with the goods sold or the activities performed by Petitioner.

- **The plaintiff's name or identity is not 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.**

In determining whether the fourth factor is met, the Petitioner's name must have sufficient fame or reputation **and** its use on or in connection with particular goods or services must point consumers of the goods or services uniquely to a particular person or institution. *In re Julie White*, 73 U.S.P.Q.2d 1713, 2004 WL 2202268 (TTAB 2004). Sufficient fame and reputation must be determined at the time of registration. *Hornby v. TJJ Cos. Inc.*, 87 USPQ2d 1411, 1426 (TTAB 2008).

#### **Sufficient Fame and Reputation**

As has been made clear, the Petitioner manufactures celestas and glockenspiels. They have never manufactured any kind of a piano and have no intent to manufacture a piano. While they may have some level of fame or reputation with celestas and glockenspiels, Petitioner cannot have any kind of fame or reputation with pianos when the Petitioner's predecessors quit making pianos nearly 40 years ago and allowed others (making no attempt to stop them) to sell pianos under the SCHIEDMAYER mark. The Petitioner cannot have sufficient fame or reputation in the piano industry when other companies, such as Rud Ibach & Sohn and Kawai, were manufacturing SCHIEDMAYER pianos.

While the Petitioner has attempted to provide evidence that they have sufficient fame and reputation, it is important to realize that they need sufficient fame and reputation **at the time of registration**. Thus, arguments such as a Schiedmayer piano winning a Bronze award in Philadelphia in 1976, a Schiedmayer piano winning a silver award in 1897 at Chicago's World Fair, and a grand prix award given to a Schiedmayer piano in 1904 are totally and

completely irrelevant. The relevant time for this inquiry is 2007, and 2007 alone. As of 2007, the Petitioner's predecessors had sold the piano line and the Schiedmayer label for pianos to Rud Ibach & Sohn. (75 TTABVUE 26-27) and had not made a piano to be sold in the United States for 27 years. As of 2007, every authoritative text that the Respondent is aware of indicates that the Petitioner had no current connection to the name SCHIEDMAYER as it pertained to pianos.

The Petitioner further argues that a 2017 Google search brings up many hits related to the Petitioner and asks the board to "take judicial notice of the common-sense conclusion that if such vast celebrity of the Schiedmayer name on the internet existed in the year 2017, that logically it would have also existed prior to November 20, 2007, which is the registration date of the Defendants Schiedmayer registration." (75 TTABVUE 28-29). This so called "common-sense conclusion" is entirely lacking common sense. First, the Petitioner has failed to appreciate just how far the internet has progressed in the last ten years, and even more so in the last three years. The online landscape today not at all representative of what it was in 2007—this includes Google search results. This statement fails entirely to indicate when Petitioner first launched its website or if it even had one in 2007.

Second, it seems the Petitioner has only recently focused on expanding her company. Indeed, the Petitioner sat by idly while others used the SCHIEDMAYER mark from approximately 1980-2014 (including the Respondent). Petitioner never sought a U.S. trademark for the mark SCHIEDMAYER until 2015. If anything, there recent surge of activity is an indication of an effort to make up for a lack of activity ten years ago. Present activity and activity dating back to 2015 is irrelevant to determining the fame of a mark registered 2007.



Finally, the Examining Attorney's office action is an excellent indicator of what kind of internet material actually existed at the time of registration. Indeed, the Office Action for the instant registration dated September 12, 2003, shows what the Examining Attorney found when they searched the internet for Schiedmayer Pianos--the website of Rud Ibach & Sohn. If the Examining Attorney back in 2003 was only able to find information on Schiedmayer pianos on the website of Rud Ibach & Sohn, then it is likely that the Petitioner's reputation is proportional to their online presence, probably non-existent at the time of registration. Petitioner's invitation for the Board to completely speculate about what internet evidence existed in 2007 based on what can be found in 2017 is not the Petitioner presenting evidence. At best, it is wholly technologically misguided attorney argument.

### **Goods and Services**

Not only must the Petitioner's name have sufficient fame and reputation, but use of the name on **the Respondent's goods and services** must point a consumer **to the Petitioner**. Again, to reiterate, the Petitioner makes celestas and glockenspiels. The Respondent sells pianos. Petitioner admits that a Piano is not a celesta. The Petitioner gave up rights to the Schiedmayer brand as it relates to pianos nearly 40 years ago. Thus, if anything, if a consumer would be led to believe that if a SCHIEDMAYER branded piano in 2007 came from anyone besides the Respondent, the most likely evidence that existed then on the internet would inform them that the piano was made by Rud Ibach & Sohn. Every other authoritative text also indicated that Rud Ibach & Sohn acquired rights to the Schiedmayer piano label in 1980. **None of the evidence presented would ever point the consumer to Petitioner as the source of a piano**. Because use of the Respondent's mark is tied to pianos, and Petitioner has never made a piano and sold/lost its rights to the Schiedmayer name for

pianos in 1980, use of the Respondent's mark on their pianos could not point a consumer to the Petitioner.

In conclusion, the evidence of record applied to the four-factor test for false association proves there could be no false association between the Respondent's mark and the Petitioner when the goods are pianos. Thus, there can be no grounds for cancellation on the basis of false association.

- **The Respondent has never intended to be falsely associated with the Petitioner**

While a showing of intent may be used to indicate false association, the Petitioner has failed to establish intent. In order for an intent of false association to be established, the Respondent must have knowledge of the Petitioner, but knowledge alone is insufficient to establish a showing of intent.

First, the evidence proves that at the time of filing the trademark application, the Respondent did **not** know of the Petitioner. The first interaction with the Petitioner came from the phone call from Elianne Schiedmayer **after** the Respondent had obtained the Schiedmayer.com domain name and filed the trademark application that matured into the registration at issue. While Glenn Treibitz had at least seen a SCHIEDMAYER branded celesta at Kasimoff-Bluthner Piano Co., this occurred in August of 2005, about 4 years **after the trademark application was filed**. (41 TTABVUE 6). The Respondent obtained the domain name for Schiedmayer.com, filed the application for the SCHIEDMAYER mark, and chose to adopt the SCHIEDMAYER mark all before the Respondent ever knew of Petitioner. This evidence strongly indicates that false association was never the Respondent's intent as it was unaware of the Petitioner when the mark

SCHIEDMAYER was first considered for adoption for use on pianos and applied for on the Principal Register.

Second, referring back to the *The University of Notre Dame*, the petitioner argued that the registrant intended to falsely associate their product with the petitioner. 703 F.2d 1372, 217 U.S.P.Q. 505 (Fed. Cir. 1983). In response, the registrant argued that they selected the name while viewing the Cathedral of Notre Dame. *Id.* at 510. While the Board treated the registrant as knowing of the petitioner, they found that the knowledge of the petitioner's existence was insufficient, standing alone, to draw an "inference of intent to trade on the University's goodwill." *Id.*

In contrast to the facts in *Notre Dame*, the Respondent at hand only may have known of the Petitioner's existence **after** they filed the trademark application. By the time Respondent may have known, it had already selected the name based upon their information that indicated Rud Ibach & Sohn, through its contract manufacturer Kawai had abandoned the mark. (65 TTABVUE 9). Thus, just as the Federal Circuit found that there was no intent in *The University of Notre Dame*, it should likewise be found that the Respondent did not intend to falsely associate itself or its products with the Petitioner.

- **In determining whether a claim under 15 U.S.C. § 1052(a) exists, 15 U.S.C. § 1052(d) should be considered.**

A likelihood of confusion analysis is relevant when determining whether or not there has been false association. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 56 C.C.P.A. 946, 407 F.2d 881, 888–889, 160 U.S.P.Q. 715 (1969) (To prove falsely suggest a connection "there would have to exist, at the very least, the same likelihood of confusion with appellant's 'MAGIC'

marks, under section 2(d) ...”); *Frederick Gash, Inc. v. Mayo Clinic*, 59 C.C.P.A. 1071, 461 F.2d 1395, 1397, 174 U.S.P.Q. 151 (1972) (“The inquiry under [§ 2(a)] is similar to that under § 2(d), 15 U.S.C. § 1052(d), which is likelihood of confusion of the marks as applied to the respective goods and/or services.”).

It is clear from its Brief that the Petitioner is arguing false association under 2(a) of the Lanham Act while ignoring 2(d) of the Lanham Act. This is likely the case as the Petitioner knows that there is can be no likelihood of confusion where the Petitioner has never made a piano, the piano and celesta are two instruments not confused by consumers, the Petitioner’s predecessors expressly abandoned any rights to the SCHIEDMAYER mark for pianos in 1980, and others have been selling SCHIEDMAYER branded pianos since 1980. Because of this, the Petitioner is relying on *The University of Notre Dame*, which “is a tentative and ambiguous foray into incorporating some of the concepts of the right of publicity into Lanham Act § 2(a).” McCarthy, J. Thomas, *McCarthy on Trademarks and Unfair Competition*, Fifth Edition, § 19:76 (Nov. 2018). Indeed, a common-sense approach in the present case clearly indicates that false association cannot be completely divorced from a likelihood of confusion. When the Petitioner’s predecessors sold (or otherwise expressly abandoned) their trademark rights to SCHIEDMAYER in conjunction with pianos in 1980, there is no question that they then lost rights to a claim under section 15 U.S.C. § 1052(d). However, by saying that they still had rights to the mark under 15 U.S.C. § 1052(a) is stating that the Petitioner can enforce a trademark against another user even after selling the mark to the other user. This clearly flies in the face of the contracted for result of the sale of the rights if not basic fairness.

In any event, even if *The University of Notre Dame* is applied in the instant case, the claim of false association still fails. Indeed, just like the false association claim failed in *The University of*

*Notre Dame*, because the University was not uniquely identified by the respondent's use of the mark because there have been many parties who have made pianos under the brand of SCHIEDMAYER, use of the SCHIEDMAYER mark on pianos does not uniquely identify the instant Petitioner as the source.

- **Conclusion**

In sum, the Petitioner's claim under 15 U.S.C. § 1052(a) fails as the Petitioner's evidence fails to establish any intent of the Respondent to falsely associate with the Petitioner. Petitioner entirely failed to consider a likelihood of confusion of the Respondent's mark and the Petitioner's abandoned mark. Petitioner's evidence also fails to satisfy the four factors for a showing of false association as set forth in *In re Pedersen*.

#### **V. THE RESPONDENT HAS NOT ABANDONED THE SCHIEDMAYER MARK**

The Respondent maintains that the question of Abandonment need not be considered as the Petitioner's arguments in their final brief do not mirror those of the Petitioner's amended complaint; however, even if the abandonment argument is considered, it still fails as the Respondent has not abandoned the mark.

To avoid abandonment, a registrant must have bona fide use of their mark in commerce. TMEP § 901.01; 15 U.S.C. § 1127. Absent proof of illegality, a registrant's use of the mark will be considered legal.

In the Petitioner's Final Brief, it is argued that the Respondent abandoned the SCHIEDMAYER mark not because Respondent did not use it, but because such use was illegal. Respondent's evidence shows it has sold or rented approximately \$137,000.00 worth of SCHIEDMAYER branded pianos; thus the Petitioner is not arguing that the Respondent

has not ever used the mark in commerce. Rather, the Petitioner seems to be taking the approach that the mark was used illegally through the Respondent “palming off” its goods on the public to the detriment of Petitioner, or through Respondent’s alleged false association with the Petitioner. As previously explained, this is just a rehashing of the fraud claim Petitioner was previously barred from pursuing in this case because fraud must be shown to show palming off. Petitioner’s arguments regarding illegality of Respondent’s use is erroneous for multiple reasons.

First, regarding the false association, as it has been established herein that there is no false association, the claim of abandonment cannot possibly survive based on the mark being illegally used under 15 U.S.C. 1052(a).

Second, regarding the issue of “palming off,” the Respondent is not palming off its goods on the public as being Petitioner’s goods. It is black letter law that it is not illegal to adopt an abandoned mark previously used by others. Likewise it is not illegal to apply a trademark name to an unbranded, contract manufactured “no-name piano” and sell that piano under that brand. Numerous piano manufacturers including Rud Ibach & Sohn use this technique as they contracted Kawai to build pianos in Japan that were then sold by Ibach as SCHIEDMAYER pianos.

In selecting the mark, the Respondent realized that the mark SCHIEDMAYER for pianos was abandoned by Rud Ibach & Sohn (and all other affiliates) nearly 20 years ago. As history has clearly established, Rud Ibach & Sohn acquired the rights to the SCHIEDMAYER mark for pianos in 1980. There is nothing illegal about adopting a mark which has been previously abandoned by multiple other entities. Further, there is not a shred of evidence in the record that the Respondent was trying to “palm off” their goods as goods

as coming from the Petitioner. Petitioner has not pointed any such evidence, despite Petitioner's arguments that "the evidence is overwhelming that the Defendants herein simply engaged in palming off of no-name cheap pianos by applying thereon a Schiedmayer trademark and representing it to be an authentic Schiedmayer product." (75 TTABVUE 33). While it is evident that the Respondent's practice of purchasing pianos, branding them, and reselling them is repugnant in the eyes of the Petitioner, Petitioner's dislike of the practice does not make it illegal. Indeed, rebranding pianos is a very common practice in the piano industry—common enough that Petitioner specifically asked Mr. Treibitz his opinion on the practice based on documents published on the internet by other parties during his testimonial cross examination (70 TTABVUE). At no time has the Respondent tried to misrepresent to the public that their pianos are German made.

Respondent acknowledges that the Petitioner claims the pianos are offered for sale as "German made products, with reference to German strings, German pin blocks, German keys, and the like." (75 TTABVUE 33). To support this, the Petitioner relies on two advertisements from the Respondent which shows SCHIEDMAYER pianos being advertised and stating that the pianos include German components (such as German strings). (75 TTABVUE 42, 44). The pianos shown in the advertisements did include German strings, a German design, and/or a German pin block. This sales practice is in no way deceptive as these pianos really did include those specific parts manufactured in Germany or designed in Germany. Indeed, if the Respondent really wanted to deceive the public, they would have just put "German Made" on the pianos. However that is not the case—only those components of the piano that were made/designed in Germany were advertised as such. The Petitioner's argument is analogous to stating that if a car includes Italian leather on the seats,

a purchaser would just baldly assume the entire car was made in Italy and was Italian. This is absurd. No rational consumer would not believe they are purchasing a piano made in Germany when it is only advertised as having German strings.

The Petitioner tries to use the deposition of the Glenn Treibitz as proof that the Respondent was engaged in “palming off.” (75 TTABVUE 30). While Glenn Treibitz did state that he knew the brand SCHIEDMAYER had a history, this is in no way evidence that Mr. Treibitz 1) knew of the existence of Petitioner (which the evidence presented already proves he did not at the time of adoption) or 2) intended to fraudulently “palming off” pianos on the public by trading of the Petitioner’s good will. The history the Respondent knew was that Kawai had recently abandoned the mark and no longer made pianos under the SCHIEDMAYER name—making it now available for adoption by Respondent.

The irony of the abandonment claim made by the Petitioner is that **if anyone has abandoned the SCHIEDMAYER mark for use with pianos, it has been the Petitioner’s predecessors.** The facts clearly show that the right to use the brand SCHIEDMAYER was transferred in 1980. While the Petitioner may argue that the rights were never transferred, practically speaking, they absolutely were as evidenced by Rud Ibach & Sohn’s use of the mark for pianos. The rights were also acquired through use in interstate commerce as evidenced by Schiedmayer Pianos, GmbH’s application for the SCHIEDMAYER logo trademark in 1984 for pianos and celestes (65 TTABVUE 155-163). Finally, the ONLY party who apparently took any action to protect its rights *vis a vis* the SCHEDMAYER mark was Steinway & Sons in their opposition to the 1984 application (65 TTABVUE 116-122)—the Petitioner and its predecessors failed entirely to take any action to enforce their supposed rights. While the Petitioner may disagree whether such use was consented to by Petitioner,



mere non-consent does not save trademark rights. Real, actual, and affirmative action to stop the use is required to preserve trademark rights. The record is clear that Rud Ibach & Sohn, along with others, produced SCHIEDMAYER branded pianos starting in 1980. In turn, the public understands that neither the Petitioner or the Petitioner's predecessors have made SCHIEDMAYER pianos since 1980, as the SCHIEDMAYER brand for pianos was owned by/used by others. The Respondent cannot be engaged in "palming off" the Petitioner's good will or products when the Petitioner's predecessors stood by and watched that goodwill expire nearly 40 years ago.

Accordingly, the Respondent has not engaged in illegal use of the mark. It has used the mark just as Rud Ibach & Sohn, Kawai, and all the other companies have done while Petitioner and Petitioner's successors in interest have stood idly by. Accordingly, Respondent has used the lawfully in interstate commerce and cannot have been considered as abandoning the mark. Petitioner's arguments regarding abandonment, therefore, are unavailing, and should be rejected.

## **VI. LACHES**

The claim of false association under 15 U.S.C. § 1052(a) should be dismissed as it is barred by the doctrine of laches. While a successful assertion of the defense of laches requires unreasonable delay in filing suit as well as prejudice to the Respondent due to the delay, other factors should be considered when determining whether the defense of Laches applies, including: "the strength and value of the Petitioner's trademark rights; Petitioner's diligence in enforcing its mark; the harm to Petitioner if relief is denied; whether Respondent acted in good faith ignorance of Petitioner's rights; competition between Petitioner and Respondent; and the harm suffered by

the Respondent because of the Petitioner's delay." *Clamp Mfg. Co. v. Enco Mfg. Co.*, 870 F.2d 512, 515 (9th Cir. 1989).

### **Unreasonable Delay**

While the Petitioner concedes "that a considerable period of time transpired between the constructive notice of the trademark SCHIEDMAYER in the Defendant's trademark application, and the filing of this petition for cancellation," the Petitioner argues that "the Petition for Cancellation was instituted promptly after the Plaintiff first found out about the existence of the Registration, in connection with the filing of its own trademark applications." (75 TTABVue 35). This is patently false in view of the evidence. The Petitioner filed its own trademark applications **after** filing this Petition for Cancellation. Thus, Petitioner clearly knew of Respondent's registration **before** ever filing for their own trademark. Further, in the year 2002, shortly after the Respondent had obtained the domain name for [schiedmayer.com](http://schiedmayer.com) and had filed its trademark application for the mark SCHIEDMAYER, Elianne Schiedmayer admittedly called and spoke with Glenn Treibitz on the telephone. While the Respondent understands that the date of laches is calculated from the date of registration, it is unreasonable to think that the Petitioner was clueless to the possibility that an application for registration might exist when she had spoken with the Respondent inquiring into his use of the brand SCHIEDMAYER. At the very least Petitioner should have known that a trademark application may have been filed and been put to inquiry as to whether one existed following the conversation with Mr. Treibitz regarding his intentions with the mark. Accordingly, the Petitioner unreasonably delayed in bringing forth this action.

### **Prejudice as a Result of the Delay**

“Prejudice, however, may be as simple as the development of goodwill built around a mark during petitioner’s delay.” *Christian Broadcasting Network Inc. v. ABS-CBN International*, 84 USPQ2d, 1560, 1573 (TTAB 2007). As explained herein, between the registration of the Respondent’s trademark and the instigation of this cancellation proceeding, the Respondent sold and rented SCHIEDMAYER branded pianos continuously for seven years. Respondent relied on the absence of any opposition being filed, the absence of any communication from Petitioner, and the absence of any evidence of actual confusion to induce it to continue to invest in the mark. Because Petitioner has waited for seven years to notify Respondent of its alleged rights in the mark, the damage to Petitioner now is far greater than it would be if Petitioner had brought the action within three years of the registration date. The delay resulted inevitably in creating prejudice to Respondent, which increased every year Petitioner delayed filing this action.

### **Strength and Value of Petitioner’s Trademark Rights**

As has been established herein, the Petitioner does not have rights in the trademark SCHIEDMAYER in conjunction with pianos as they were expressly abandoned in 1980 by its predecessors in interest. Neither Petitioner nor its predecessors in interest sold any pianos in the United States after that time.

### **Petitioner’s Diligence in Enforcing its Mark**

The Petitioner (and its predecessors in interest) have not only sat idly by while the Respondent engages in the sale of SCHIEDMAYER pianos, but for approximately 34 years prior to the Petitioner filing this petition to cancel, the Petitioner had failed to assert any kind of trademark rights against **anyone** using the brand SCHIEDMAYER with pianos.

### **Harm to the Petitioner if Relief is Denied**

There will be no harm to the Petitioner if relief is denied as the Petitioner's celestas and glockenspiels and the products of other companies selling SCHIEDMAYER branded pianos have coexisted for the past 40 years. There has been no evidence of harm to the Petitioner due to the coexistence thus far, and as pianos are celestas are different instruments not confused by consumers, there would not be harm to the Petitioner if relief is denied.

### **Whether Respondent has acted in Good Faith Ignorance of Petitioner's Rights**

Not only has the Respondent acted in good faith ignorance of the petitioner's rights, the evidence proves that Respondent has confirmed that the Petitioner has no rights to the name SCHIEDMAYER for pianos as has been established herein.

### **Competition between Petitioner and Respondent**

As has been established herein and within the record evidence, the Petitioner manufactures and sells celestas and glockenspiels while the Respondent sells pianos. A celesta and a piano are two separate instruments. The sounds are not confusingly similar as admitted by Petitioner. (65 TTABVUE 4-5). Any purchaser of a piano or celesta (or a glockenspiel) would not be confused between them because of the distinct sound difference between the instruments as established in the evidence of record. Thus, the Respondent is not actually in competition with the Petitioner.

Accordingly, as the Petitioner has made inexcusable delay in instigating this action and the Respondent has been harmed by this delay, in combination with the fact that the Petitioner does not have rights in the mark SCHIEDMAYER in conjunction with pianos, and that the Petitioner never enforced the SCHIEDMAYER mark in conjunction with pianos between 1980-2014, the Petitioner will not be harmed by the current SCHIEDMAYER registration. Since the

Respondent and Petitioner are further not in competition, the defense of laches should be applied and the claim under 15 U.S.C. § 1052(a) should be barred.

## VII. SUMMARY

The Respondent legally obtained U.S. Trademark Registration No. 3340759 for the mark SCHIEDMAYER to be used with pianos. In obtaining the registration, the United States Patent and Trademark office considered the issue of false association and conclusively decided that there would be no false association with the Petitioner. This action is and has been at all times a frivolous attempt to needlessly resurrect losing issues that were long ago resolved and laid to rest.

No doubt, the Petitioner, including Elianne Schiedmayer, is passionate about the history of the Schiedmayer family and its current status in the keyboard instrument industry. However, passion does not give those who feel it the ability to re-write history. What matters in trademark law is what one actually does with a mark—it is not what one feels entitled to possess based on family heritage. Petitioner must live with the actions of itself and its predecessors—it must live with the result of what it abandoned and gave up decades ago.

In view of the foregoing, it is respectfully requested that this cancellation proceeding be dismissed.

Dated: January 14, 2019

Respectfully submitted,  
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## CERTIFICATE OF SERVICE

It is hereby certified that one (1) copy of the foregoing RESPONDENT'S FINAL BRIEF is being sent via email to Petitioner Schiedmayer Celesta GmbH's attorney of record as follows:

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Dated: January 14, 2019

/s/ Adam Stephenson