

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

Schiedmayer Celesta GmbH,)
)
 Petitioner,)
)
 v)
)
 Piano Factory Group, Inc. and)
 Sweet 16 Musical Properties, Inc.)
)
 Respondents.)
 _____)

Cancellation No. 92/061,215
Reg. No.: 3,340,759
Mark: SCHIEDMAYER
Registration Date: 11/20/2007

**PETITIONER'S MOTION TO STRIKE RESPONDENT'S
AMENDED NOTICE TO TAKE CROSS-EXAMINATION ON WRITTEN QUESTIONS**

Petitioner herewith moves for an Order striking Respondent's Amended Notice to Take a Deposition on Written Questions in Germany of Elianne Schiedmayer before a German notary. (Respondent's Notice incorrectly refers to 'Cross-Examination' whereas in fact 'Direct Examination' is correct.)

Permission for the filing of this Motion was granted by Interlocutory Attorney Benjamin Okeke on September 11, 2017.

The basis for this Motion is because the taking of a deposition in Germany, whether by written questions or otherwise, is governed by The Hague Convention on Taking of Evidence Abroad, as well as certain specific and clear requirements of German law which exclude the taking of any testimony before a German notary.

The following quotation, taken from a publication of the Consulate General of the United States of which a copy is attached hereto, is instructive:

“Bilateral agreements between Germany and the United States require that the German Ministry of Justice pre-approve all requests for depositions. Depositions taken without the prior approval of the German Ministry of Justice and/or without the involvement of the United States Mission to Germany, are unauthorized and may lead to criminal penalties against the participants...A Consular Officer will administer the oath to the witness.”

–Consulate General of the United States/Frankfurt, Germany, last update October 2016.

Whether the deposition is written or oral is entirely irrelevant. A deposition is a deposition and must be conducted before a U.S. Consulate in Frankfurt, Germany upon payment of a fee of \$1,283.00.

Only a U.S. Consul or Vice Consul, in Frankfurt Germany, may conduct a Deposition on Written Questions and administer the Oath. See: Attached 'Depositions at the U.S. Consulate General' It would be improper and illegal under German law for any such Deposition to be conducted by a German Notary, as proposed by Respondent.

Additionally, a room reservation must be made at the Consulate requiring the payment of a fee, as well as the retention of an authorized translator and an authorized transcriber.

See also TBMP § 404.03(b) Person Residing in a Foreign Country – Party

wherein the following is stated:

“Similarly, if a testimonial deposition is taken in a foreign country, it must be taken by deposition on written questions...It should be noted however that some countries prohibit the taking of testimony within their boundaries for use in any other country, including the United States, even though the witness is willing; or may permit the taking of testimony only if certain procedures are followed. A party which wishes to take a deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of Legal Affairs, Department of State, in order to determine whether the taking of a deposition will be permitted by the foreign country, and if so, what procedures must be followed.”

Clearly, Respondent has not educated itself as to the specific requirements of German law prohibiting depositions unless taken pursuant to the provisions of The Hague Convention and certain stringent and particular requirements of German law which are not being followed here. Again, it is strongly noted that the failure to comply with such requirements under German Law may result in criminal prosecution against all parties involved.

See also TBMP § 404.03(c)(2) relating to The Hague Convention and Letter Rogatory Procedures. This section relates generally to the issuance of a Letter Rogatory by the Board, which procedure has not been followed here.

“Some countries also tightly restrict where the depositions may be taken. In many countries, including...Germany...depositions even of willing witnesses, generally may be taken only at a U.S. Consulate. It may,

therefore, be illegal to take voluntary depositions at a hotel or a law firm's borrowed conference room."

--*ADA Section of Litigation, Key Steps to Successful Foreign Depositions-Litigation News.*

Additionally, it is clear that any oath may not be administered by a German notary:

Since the depositions must take place at the U.S. Consulate General before a U.S. Consular Officer, the oath must be administered by a U.S. Consul. The court reporter cannot administer the oath even if both parties stipulate.

--*Discovery and Depositions in Germany updated 2017. Planet Depos.*

Indeed, if the witness is considered an unwilling witness, the witness must be examined by a German Judge in a courtroom:

"For example, voluntary depositions must be taken at the U.S. Consulate in Frankfurt, but an unwilling witness must be examined by a German Judge in the courtroom. In Germany, only non-parties testify as witnesses and the scope of questioning is very narrow."

--*Anna Engelhard-Barfield, Taking Depositions for use in International Commercial Litigation: German Requirements.*

Finally, it is noted that the provisions of the Supreme Court Decision *Societe Nationale Industrielle Areospace v U.S. District Court*, 42 U.S. 522 (1987) do not apply. This Decision generally indicates that The Hague Convention on Taking Evidence Abroad, is not the exclusive method for taking of testimony. However, as indicated above, the country of Germany has added numerous national laws in addition to The Hague Convention, requiring stringent compliance, failure to comply with will result in criminal prosecution.

Also, the country of Germany has indicated that full compliance with The Hague Convention on Taking Evidence Abroad is required by the German law. See Germany's response to the 2008 Hague Conference questionnaire on the practical operation of The Hague Evidence Convention.

SUMMARY

In view of all of the above, it is overwhelmingly clear that a deposition on written questions before a German notary is not only legally improper but could result in criminal prosecution under German law.

If the Respondent seriously wishes to take a deposition on written questions of Elianne Schiedmayer, then the Respondent should comply with all of the requirements of The Hague Convention and local German law as described above. Respondent must also assume all expenses relating to participation by the U.S. Consulate in Frankfurt, Germany, as well as conference room expenses, translator expenses and court reporter expenses as well.

Finally, it is requested that all proceedings be suspended pending the determination of this Motion, including with particularity Petitioner's term for the filing of Cross-Questions, and Objections to Respondents questions.

Respectfully submitted,



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DEPOSITIONS at the U.S. CONSULATE GENERAL FRANKFURT AM MAIN, GERMANY

(Last update: October 2016)

General Information about Depositions in Frankfurt

Bilateral agreements between Germany and the United States require that the German Ministry of Justice pre-approve all requests for depositions. Depositions taken without the prior approval of the German Ministry of Justice and/or without the involvement of the United States Mission to Germany are unauthorized and may lead to criminal penalties against the participants. Due to both staffing and space constraints at all of our other diplomatic and consular facilities, all depositions in Germany must take place at the U.S. Consulate General in Frankfurt. We thank all deposition participants for their cooperation in abiding by these requirements.

CIVIL CASES ONLY: Under the provisions of bilateral agreement(s), U.S. Consular Officers in Germany have the right to administer depositions only in civil cases. Depositions related to criminal cases are accomplished via letters rogatory. For instructions on the use of the letters rogatory to obtain testimony in criminal cases, please contact the Department of State, Bureau of Consular Affairs, Office of Overseas Citizens Services. From the U.S. & Canada 1-888-407-4747 and from Overseas +1 202-501-4444 or <http://travel.state.gov/content/travel/english/legal-considerations/judicial.html>

Getting the Process Started

Notice of Deposition or Court Commission: To have a deposition taken before a Consular Officer at the U.S. Consulate General in Frankfurt, a copy of the notice of deposition or, alternatively, a commission issued by the U.S. court, stating that the testimony of the witness(es) is to be taken before any Consul or Vice Consul of the United States in Frankfurt, Germany, must be provided to the Consulate. The Consulate's address is:

U.S. Consulate General
Special Consular Services
Giessener Str. 30
60435 Frankfurt am Main
Germany

Tel: 069-7535-2518, 2514 or 2519
011-49-69-7535-2518, 2514 or 2519 (from the United States)
Fax: 069-7535-2252 (within Germany)
011-49-69-7535-2252 (from the United States).
E-mail: germanyacs@state.gov

Required Information: Please ensure that the notice contains the case name and related docket number; the location of the U.S. court where the case will be adjudicated; full name(s) of all witnesses, their nationality(ies), complete German home address(es) and phone number(s), the function and the relationship between the parties and the witness(es) and the nature of their testimony.

The notice must also include a brief description of the case with special focus on the appropriate standards of the U.S. procedural and substantive laws. Please also provide a proposed date for the deposition. You may submit the request by mail or by fax to the Special Consular Services unit. The required \$1,283 scheduling fee per daily appointment (a payment form included at the end of this document) must be submitted in original (in duplicate) before the Consulate will initiate a request to the German government for permission to conduct the deposition.

Deposition Fees and Scheduling: While the Consulate will make every effort to accommodate requests for a specific time and date for depositions, workload and staff limitations may affect the availability of personnel and space. In order to facilitate planning of space and staffing, we ask that you provide as much detail as possible about the number of participants, the proposed length of the deposition, and any court dates that may bear relevance to your scheduling in your initial request.

In accordance with 22 CFR 22.1, all depositions require an initial \$1,283 scheduling fee per witness and daily appointment. This fee must be received before the Consulate can take action on a deposition request. The initial scheduling fee will not be deposited until an agreement is reached between you and the Consulate on a mutually-acceptable date/time.

**THE NOTICE OF DEPOSITION AND A MANDATORY
SCHEDULING FEE, MUST BE RECEIVED BY THE CONSULATE
AT LEAST SIX WEEKS IN ADVANCE
OF THE DEPOSITION.**

Once a deposition request is made and the fee is paid, the Consulate will ask the U.S. Embassy in Berlin to approach the German Ministry of Justice to request approval for the deposition. At this point, the fee is non-refundable. The six weeks lead time is non-negotiable as the German government requires several weeks to process deposition requests. In addition, please note that regulations require the payment of the non-refundable scheduling fee each time you or any other party make a request to reschedule the deposition (this would include any scheduling conflicts which arise with stenographers, interpreters, court reporters, witnesses, etc.) In the event that the Consulate needs to reschedule the deposition, we will do our best to settle upon a date that works for you.

Oaths: Fees and Required Identification: A Consular Officer will administer the oath to the witness(es), and, if required, to a stenographer, videographer and an interpreter on the morning of the deposition.

Please note: Each individual taking an oath must present valid, government-issued photo id.

In accordance with the Code of Federal Regulations, Title 22, a consular fee of \$309/hour will be assessed for the first hour of the deposition during which the administration of the oaths occurs. If the Consular Officer needs to attend the deposition beyond the administration of oaths, an additional \$309/hour will be charged. Providing the seal and certification of depositions (closing certificate) will be \$ 415. This fees are payable on the day of completion of the deposition. Please send us the original signed credit card form in duplicate.

Logistical Information

- **Hours of Operation:** Depositions may take place Monday through Friday from 9 am to 4:00 pm, subject to availability and by prior arrangement only. The consulate is closed on German and American holidays and on the last Thursday of every month.
- **Deposition Room:** The deposition room is a separate room within the consulate building which can only be accessed with an escort. For security reasons, a member of the consular staff must be present in the deposition room during the entire deposition.
- **Amenities:** The deposition room seats 15 people. Electrical power is available, with standard German-style 220 volt outlets. If you require adapters or power transformers, you must provide them yourself.
- **Food:** Participants may use the Consulate cafeteria; however, they may choose to bring their own food and beverages.

- **Messages and Clerical Services:** We are unable to take phone messages, make calls or send/receive faxes for you. Likewise, there is no photocopier available for deposition use.
- **Smoking:** There is no smoking anywhere inside the Consulate.

Important Security Requirements

- **List of Participants:** A list of the full names of all participants and a detailed list of electronic equipment to be used during the deposition must be provided to the Special Consular Services unit (fax +49-69-7535-2252, email germanyacs@state.gov) at least **three working days prior** to the deposition. Once this list has been forwarded to our security office **CHANGES IN PARTICIPANTS WILL NOT BE PERMITTED**. This includes videographers and court reporters.
- **Photo Identification:** All participants must present a valid photo ID (passport or German Ausweis) to enter the Consulate, submit to a bag search and pass through a metal detector. Witness(es), Court reporters, Interpreters, and Videographers will require a **second** valid, government-issued photo id in order for the Consular officer to administer the oath.
- **Building Access:** Deposition participants should use the Consulate employee entrance on Wetzlarer Straße, **not** the main entrance at Gießener Straße 30. Participants should inform the guard that they are deposition participants and ask that the Special Consular Services unit be notified of their arrival. Once admitted to the Consulate, participants must be escorted by a member of the Consulate staff to the deposition room. Participants must be escorted when exiting the Consulate and will only be permitted to re-enter with prior notice.
- **Cellular Phones and Electronic Devices:** You may not bring any electronic equipment, including but not limited to cellular phones, PDAs and laptops. Court reporting and videography equipment must be approved three days in advance and will be thoroughly screened. Equipment cannot be left in the Consulate overnight.

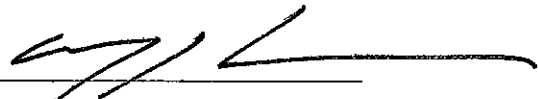
CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the attached Motion to Strike was served upon Counsel for the Respondent at his email address of record:

adam@iptech.law

This 12th day of September, 2017.

9 / 12 / 17



Michael Striker