

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

Schiedmayer Celesta GmbH, )  
 )  
           Petitioner, )  
 )  
        -against- )  
 )  
 Piano Factory Group, Inc. and )  
 Sweet 16 Musical Properties, Inc. )  
 )  
           Registrants. )  
 \_\_\_\_\_ )

Cancellation No. 92/061,215  
Reg. No.: 3,340,759  
Mark: SCHIEDMAYER

**PETITIONER'S BRIEF IN SUPPORT OF PETITION TO CANCEL**

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PLAINTIFF'S FINAL BRIEF

Pursuant to Trademark Rule 2.128(a) and TBMP § 801.02(a), Plaintiff, Schiedmayer Celesta GmbH (Schiedmayer Celesta), hereby submits this Brief in support of the Petition to Cancel United States Trademark Registration No. 3,340,759, which issued originally to Piano Factory Group for pianos, namely, upright pianos, grand pianos and digital pianos.

The subject registration is currently owned by Sweet 16 Musical Properties, Inc. which does business as Hollywood Piano.

Sweet 16 Musical Properties, Inc. is the assignee of Piano Factory Group and accordingly, both parties are listed as Defendants. Since Sweet 16 Musical Properties, Inc., the current owner, does business as Hollywood Piano, the Defendants herein shall be cumulatively referred to as "Hollywood Piano."

## INTRODUCTION

This is a Petition to Cancel U.S. Trademark Registration No. 3,340,759 for the mark SCHIEDMAYER and registered on November 20, 2007.

The subject Petition for Cancellation was filed on April 1, 2015 after the Petitioner, Schiedmayer Celesta, first learned of the existence of the subject registration in the context of filing for its own trademark applications for its name Schiedmayer for musical keyboard instruments.

Plaintiff had filed two trademark applications for the mark SCHIEDMAYER, Application Nos. 79/166,455 and 86/600,864 for musical instruments and musical keyboard instruments, including celestas. Each of the subject applications were rejected based upon the registration sought to be cancelled herein and each of the applications is currently suspended pending the outcome of this Petition for Cancellation.

## THE PLEADINGS

The basis of this Petition for Cancellation is violation of § 2(a) of the Lanham Act, False Association, and also Abandonment of the subject trademark, for failure to engage in bona fide use.

Plaintiff's pleading may be found at 34TTABVUE, dated January 3, 2017. This is Plaintiff's Amended Petition for Cancellation. The Answer was filed at 35TTABVUE.

## STANDING

Plaintiff has set forth allegations which have a reasonable basis in fact, and which, if proven, would establish that it has a personal interest in the outcome of this proceedings beyond that of the general public. See *Ritchie v. Simpson*, 50 USPQ2d at 1025-26. Thus, Plaintiff has sufficiently pleaded its standing to bring this proceeding. See *Association Pour la Defense et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838, 1841 (TTAB 2007); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223; (TTAB 1995). Moreover, Plaintiff has sufficiently set forth the elements of a section 2(a) claim, and thus has pleaded that Defendants obtained their registration contrary to a statutory bar to registration. In particular, Plaintiff specifically pleaded that it is the actual institution with which consumers will presume a false suggestion of a connection when confronted with Defendants' identical Schiedmayer mark, and which is implicated by that false suggestion. See *Aruba v. Excelsior Inc.*, 5 USPQ2d 1685 (TTAB 1987). Plaintiff also properly pleaded abandonment in that Defendants did not engage in 'use in commerce' which by definition requires that any such use be 'bona fide'.

## PRIORITY

Priority clearly resides with the Plaintiff. Exhibit F to the Elianne Schiedmayer Declaration, 38TTABVUE clearly shows numerous invoices dating back into the 1960s and 1970s, long prior to any use by Defendants.

Indeed, Plaintiff is the inheritor of Schiedmayeyer trademark usage dating back hundreds of years.

Plaintiff's priority is not an issue in this proceeding.

#### THE PLAINTIFF

Plaintiff, Schiedmayer Celesta GmbH, is a German company owned and operated by Elianne Schiedmayer. The business of Schiedmayer Celesta is the manufacture and sale throughout the world, including with particularity the United States, of the celesta/piano instrument. A celesta is a type of piano, differing only in that in a celesta the felt hammer activated by depressing a key on the keyboard strikes a plate rather than a wire thereby rendering a softer, more muted tone. In all other respects, a celesta is de facto a piano and for this reason there is an identity with regard to the goods involved in this proceeding.

Schiedmayer Celesta is the current manufacturer of musical keyboard instruments dating back continuously for a period of almost 300 years. Schiedmayer is believed to be the oldest family owned continuous manufacturer of keyboard musical instruments in the world, having been manufactured and owned by representatives of the Schiedmayer family continuously since 1735.

For a clear and concise summary of the business and background of Plaintiff Schiedmayer Celesta, the reader is respectfully referred to the testimony in chief Declaration of Elianne Schiedmayer, 38TTABVUE, and the exhibits appended



thereto. A reading of the Elianne Schiedmayer Declaration will afford an excellent understanding of the background of the Plaintiff in the subject Petition for Cancellation.

It is noted that all of the contents from the Declaration of Elianne Schiedmayer are based upon her own personal knowledge. Reference is also made to 39TTABVUE, 40TTABVUE and 41 TTABVUE, representing exhibits to the Elianne Schiedmayer Declaration, as well as Plaintiff's Notice of Reliance and the Declaration of Olga Fuchs.

From a reading of the above referred to testimony of Plaintiff, it will be seen that Plaintiff herein enjoys a continuum of sales of musical keyboard instruments dating back almost 300 years. It will also be seen that the Schiedmayer piano and Schiedmayer keyboard instruments have always been held in the highest regard, having won 36 Worlds Fair medals throughout the world, including several in the United States, 38TTABVUE7.

Even the Defendants have acknowledged the excellence and reputation of Plaintiff Schiedmayer's history. See for instance Exhibit 4 to Defendants' Declaration Testimony of June 25, 2018, 66TTABVUE, which represents an extract from the book "Piano Encyclopedia," and which states the following:

"The Schiedmayer family were distinguished builders of clavichords, harpsicords and pianos in 18<sup>th</sup> Century Bavaria.

The modern branch of the firm was founded in 1809 in Stuttgart...Their eclectic output of grands, squares and pyramids was of the highest quality and variety of style unusual of the early years of the 19<sup>th</sup> century.

Georg Schiedmayer [the deceased husband of Elianne Schiedmayer, the owner of the Plaintiff] was the last in his family to build pianos, changed his focus to building celestas...”

#### THE DEFENDANTS

The Defendants herein, Piano Factory Group and Sweet 16 Musical Properties, Inc., are cumulatively referred to by the dba of Sweet 16 Musical Properties, Inc., namely “Hollywood Piano.” Hollywood Piano is a small piano store located next to a highway in Burbank, California. The operator of Hollywood Piano is Glenn Treibitz, whose Declaration, 66TTABVUE, forms the Defendants’ testimony. See also the Cross examination of Treibitz 70TTABVUE.

Hollywood Piano sells pianos of different brands, new and used, and also rents pianos.

#### PLAINTIFF’S EVIDENCE

Plaintiff’s evidence in support of its Petition for Cancellation is as follows:

1. Testimony Declaration of Elianne Schiedmayer  
and the exhibits appended thereto, 38TTABVUE.
2. Notice of Reliance and exhibits appended  
thereto, 39TTABVUE.
3. Declaration of Olga Fuchs, 40TTABVUE.
4. Testimony Declaration of Helga Kasimoff, 41TTABVUE.
5. Discovery Deposition of Glenn Treibitz, 42TTABVUE.

6. Petitioner's Notice of Reliance, 37TTABVUE and 71TTABVUE.
7. Notice of Reliance, 72TTABVUE.
8. Cross Examination of Treibitz 70TTABVUE
9. Testimony Rebuttal Declaration of Elianne Schiedmayer, 73TTABVUE.
10. Rebuttal Declaration of Michael Floymayr, 74TTABVUE.

#### DEFENDANT'S EVIDENCE

Defendant's evidence in connection with this Petition is as follows:

1. Defendant's Notice of Reliance, 65TTABVUE.
2. Defendant's Testimony Declaration of Glenn Treibitz and Russell Kassman, 66TTABVUE.

#### STATEMENT OF THE ISSUES

The issues before this Board are whether Defendants' Federal Trademark Registration No. 3,340,759 should be cancelled based upon either one of the following:

1. False 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);
2. Defendants' abandonment of any usage of the mark SCHIEDMAYER because 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.

Plaintiff has asserted the claims of Sec. 2 (a) and Abandonment in its Amended Petition for Cancellation appearing at 34TTABVUE of January 3, 2017. It is noted that Count III of the Amended Petition for Cancellation has been withdrawn.

### FACTS

As disclosed in Defendants' Declaration Testimony of Glenn Treibitz, 66TTABVUE, there came a time when Glenn Treibitz, the operator of Hollywood Piano, (Treibitz) decided to appropriate the names of German piano manufacturers which he believed were no longer engaged in the business of manufacturing pianos 42TTABVUE34. According to the Treibitz Declaration, Treibitz intended to utilize the names of such piano manufacturers for his own profit by purchasing what are referred to as cheap "no-name" pianos having no brand name typically manufactured in Indonesia and China, and he would then apply thereon the name of a German piano manufacturer and sell the piano accordingly, at a sharply higher price which a German Piano commanded.

Put another way, Treibitz simply decided to palm off cheap, no name pianos by applying thereon the name of a respected German manufacturer of pianos and selling it as a German piano.

To this end, Treibitz filed four trademark applications for the names of companies which he believed were defunct German manufacturers of pianos. They are as follows:

Bernard Shoninger,	Registration No. 3,340,761
Kurtzmann,	Registration No. 3,340,760
Vose & Sons,	Application No. 78/157,550 (did not register)
SCHIEDMAYER,	Registration No. 3,340,759 (sought to be cancelled herein)

Treibitz took the names from a book of piano decals 42TTABVUE54. Accordingly, he knew perfectly well when he took these names that these were the names of German piano manufacturers whom he believed were no longer in business. Such decal books sell piano decals typically to be used when old pianos are being renovated and new decals for trademarks are needed in this connection.

#### DEFENDANTS' SCHIEDMAYER TRADEMARK APPLICATION PROSECUTION

Treibitz proceeded with the filing of a trademark application for the mark SCHIEDMAYER based upon intent to use.

In the course of prosecution, Trademark Attorney Darlene D. Johnson of law office 111, refused registration to the Defendants based upon Trademark Act § 2(a) 15 USC 1052(a), TMEP § 1203.03 because the Applicant's mark SCHIEDMAYER suggests a false connection with the pianos previously and currently manufactured under the trademark SCHIEDMAYER. A copy of the Office Action in its entirety follows herewith:

**To:** Piano Factory Group ([jalumit@tmlawoffices.com](mailto:jalumit@tmlawoffices.com))  
**Subject:** TRADEMARK APPLICATION NO. 78157552 - SCHIEDMAYER - N/A  
**Sent:** 9/12/03 5:00:15 PM  
**Sent As:** ECom111  
**Attachments:** [Attachment - 1](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/157552

**APPLICANT:** Piano Factory Group

**CORRESPONDENT ADDRESS:**

JOHN ALUMIT  
 LAW OFFICES OF ALEX D. PATEL  
 20121 VENTURA BLVD., SUITE 302  
 WOODLAND HILLS CA 91364

**RETURN ADDRESS:**

Commissioner for Trademarks  
 2900 Crystal Drive  
 Arlington, VA 22202-3514  
[ecom111@uspto.gov](mailto:ecom111@uspto.gov)

**MARK:** SCHIEDMAYER

**CORRESPONDENT'S REFERENCE/DOCKET NO :** N/A

**CORRESPONDENT EMAIL ADDRESS:**

[jalumit@tmlawoffices.com](mailto:jalumit@tmlawoffices.com)

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**OFFICE ACTION**

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.**

Serial Number 78/157552

This letter responds to the applicant's communication filed on June 25, 2003.

The amendment to the identification of goods is noted and made of record.

The examining attorney refuses registration because the mark consists of or comprises matter, which may falsely suggest a connection with SCHIEDMAYER. Trademark Act Section 2(a), 15 U.S.C. §1052(a); TMEP §§1203.03, 1203.03(e) and 1203.03(f). *See generally University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985). Mr. Schiedmayer was a famous maker of pianos. Additionally pianos are currently being made under the method previously used by Schiedmayer and carry his name and the SCHIEDMAYER trademark; as such the applicant's mark suggests a false connection with the pianos previously and currently manufactured under the trademark SCHIEDMAYER.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

/Darlene D. Johnson/  
Examining Attorney  
Law Office 111  
(703)308-9111 ext 145

**How to respond to this Office Action:**

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**



## Schiedmayer

upright pianos und grands since 1809

### Short history of Schiedmayer piano company

Founded in 1809 by Johann Lorenz Schiedmayer (1784-1860) using the brand mark

SCHIEDMAYER & SÖHNE

Resider: Always his father Johann David Schiedmayer was producer of music instruments in Erlangen (b. 1753 in Erlangen, changed in 1797 to Nürnberg, 3. in Nürnberg 3/20/1805).

Two sons of Johann Lorenz Schiedmayer, Adolf (d. 10/16/1890 in Stuttgart) and Hermann, followed their father in managing the company. They had two brothers too, Julius (b. 2/17/1822 in Stuttgart, d. Februar 1878) and Paul (b. 1829, d. 6/18/1890 in Kissingen), who founded a harmonium factory in 1853 under their own brand mark Julius & Paul Schiedmayer, which later changed to a great piano factory.

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

SCHIEDMAYER (est. 1809)

to his friend Mr. IBACH.

### IBACH and Schiedmayer

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 (TM) is a brand mark of IBACH

#### Books:

A. Eisenmann: Vorgeschichte, Gründung und fernere Entwicklung der Firma Schiedmayer und Söhne, Stuttgart 1909  
M. Rupprecht: Die Klavierbauerfamilie Schiedmayer, Dissertation Erlangen 1954

### Special offers

#### Upright Piano E 118

black or white, polished  
mahogany, polished



Schiedmayer E-118 mahogany polished

#### Upright Piano E 121

black, polished  
mahogany, polished

#### Grand piano 183 - J

black, polished

Ask for our current price list!

EMAIL  
address:

RUD. IBACH SOHN - WILHELMSTRASSE 43 - D 58332 SCHWELM  
Telefon: 0049-2336-9393-0 Telefax: 0049-02336-939393  
Produktion - Grosshandel - Einzelhandel



In response, Treibitz did not argue that the rejection based upon § 2(a) of the Lanham Act was improper. Rather, on behalf of the Defendants, he falsely stated that the mark SCHIEDMAYER had become abandoned and that therefore § 2(a) of the Act would not apply.

Had the Defendants not made this false assertion, a registration would never have issued.

#### PALMING OFF OF THE SCHIEDMAYER TRADEMARK BY DEFENDANTS

Palming off of the Schiedmayer name by Hollywood Piano is relevant to the issue of false association, because it represents a clear indication of intent to

misappropriate the name of another company. Such 'intent' is a powerful element in support of False Association.

It is also relevant to the issue of abandonment because palming off of the Schiedmayer name does not constitute bona fide use of the trademark, and in the absence of bona fide use of the trademark by Defendants, the trademark must be considered as abandoned. A Registrant cannot avoid a claim of Abandonment by palming off Plaintiff's mark.

Upon finally receiving a trademark registration for the mark SCHIEDMAYER, the Defendants set out to engage in a long and protracted act of palming off cheap, no-name pianos as authentic Schiedmayer pianos. This is exemplified in the Discovery Deposition of Treibitz, 42TTABVUE, as well as the cross-examination of Treibitz, 70TTABVUE of August 21, 2018. There follows herewith a typical extract from the cross-examination Deposition of Glenn Treibitz in which Treibitz in his own words admits palming off no-name cheap Chinese made pianos as authentic Schiedmayer pianos (70TTABVUE21-Line18;26-Line10):

18           Q.    So no-name pianos then are purchased for sale as  
19           Schiedmayer pianos; correct?

20           A.    Yes.  Among others.

10 Q. So the source of these pianos is China; correct?

11 A. Correct.

12 Q. Would it be correct then that you purchased  
13 no-name pianos from -- that are manufactured in China and  
14 then affix the Schiedmayer label thereto?

15 A. Yes.

16 Q. And sell them as a Schiedmayer piano?

17 A. Yes.

Other glaring examples of Defendants palming off of Schiedmayer pianos are exemplified in Exhibit 12 to the Treibitz Declaration, 66TTABVUE, and Exhibit D to Plaintiff's Notice of Reliance, 72TTABVUE.

Copies of these advertisements are attached for ease of reference as Final Brief Exhibits A and B respectively (Slightly enlarged for legibility).

It is noted that in Exhibit 12 to the Treibitz Declaration, (Final Brief Exhibit A attached hereto) there appears an advertisement of a Hollywood Piano Memorial Day sale in 2018 in which a cheap "no-name" piano appears as an authentic Schiedmayer product. It is further noted that in the blurb describing the piano, it is stated that the piano has "German strings." Obviously only a German made piano will have German strings. At Exhibit D to Plaintiff's Notice of Reliance, 72TTABVUE, (Final Brief Exhibit B attached hereto), there appears a Facebook advertisement for Hollywood Piano in which two "Schiedmayer" pianos are offered for sale.

It is noted that in the advertisement (Final Brief Exhibit B) for the baby grand Schiedmayer (actually a cheap no-name piano), the advertisement states that the piano has:

“German design”

“German strings”

“German pin block”

“German hammer felt.”

The upright piano (also a cheap no-name piano masquerading as an authentic Schiedmayer) is said to have “German strings.”

It is again emphasized that Hollywood Piano, the Defendants herein, freely admit that all Schiedmayer pianos which it ever offered for sale or sold, constitute cheap, no-name pianos manufactured in either Indonesia or China, 70TTABVUE21Line 18.

Plaintiff wishes to emphasize that this Petition to Cancel is not based upon Defendants’ palming off of Plaintiff’s products. Rather, Plaintiff is calling attention to Defendants’ acts of palming off as it establishes Intent, which is a strong element in finding a 2(a) violation, and also because palming off on Plaintiff’s trademark Schiedmayer does not establish ‘bona fide use in commerce’ as a rebuttal to the allegation of Abandonment.

## THE MISSING DOCUMENTS

During the discovery period of the subject proceeding, Plaintiff filed four Requests for Production of Documents which are in evidence in this case at Plaintiff's Notice of Reliance, 37TTABVUE. In each of the four Requests for Production of Documents, Plaintiff requested Hollywood Piano to produce all documents of any type referring or relating to the promotion or sale of Schiedmayer pianos.

Although Treibitz freely admitted that in connection with any sale of a Schiedmayer piano, a contract is drawn with the purchaser, Hollywood Piano failed or refused to produce one single solitary such contract 70TTABVUE16. Hollywood Piano excused this refusal to produce any documents over a period of ten years with the lame excuse that a computer broke down. This is something akin to a dog eating the homework. The fact is that for each sale of a Schiedmayer piano sold by Defendants, a contract was drawn with the purchaser that clearly described the piano. Any such contracts would have clearly substantiated the assertion that the Defendants were offering for sale no-name cheap pianos as authentic Schiedmayer pianos. *It is for this reason alone that Hollywood Piano failed and refused to submit any such documentation.*

TRADEMARK REGISTRATION NO. 3,340,759 UNLAWFULLY CREATES A FALSE ASSOCIATION WITH PLAINTIFF AND PLAINTIFF'S TRADEMARK AND SHOULD BE CANCELLED BASED UPON § 2(a) OF THE LANHAM ACT

T.M.E.P. § 1206 provides in relevant part:

The right to privacy protects a party's control over the use of its identity or "persona". A party acquires a protectable interest in a name or equivalent designation under § 2(a) where the name or designation is unmistakably associated with, and points uniquely to, that parties' personality or "persona."

- *University of Notre Dame du Lac v J.C. Gourmet Food Imports Co., Inc.*, 703 F2d @ 1376-77, 217 USPQ @ 509; *Buffett v Chi-Chi's, Inc.*, 226 USPQ 428,429 (TTAB 1985).

There are four elements to be considered for a § 2(a) analysis:

1. That the mark is the same as or a close approximation of, the name or identity previously used by another person;
2. The mark would be recognized as such in that it points uniquely and unmistakably to that person;
3. The person named by the mark is not connected with the activities performed by the applicant under the mark;
4. The fame or reputation of the person is such that, when the mark is used with the applicant's goods, a connection with the person would be presumed. See, *In re: Julie White*, 2014 TTAB Lexis 529, 15-16, 79 USPQ 2d (BNA 1713) (TTAB 2004):

“A party acquires a protectable interest in a name under § 2(a) when a name claimed to be appropriated points uniquely and unmistakably to that party’s personality or ‘persona’.”

*Jimmy Buffett v Chi-Chi’s, Inc.*, 1985 TTAB Lexis 80, 226 USPQ (BNA 428) (TTAB 1985)

The reference to persona is particularly apt in connection with the subject proceeding because the name Schiedmayer is indeed the name of the family which has manufactured the keyboard musical instruments herein for a period of almost 300 years. Indeed, the company itself is owned and operated by Elianne Schiedmayer who enjoys the name of the company. Clearly, the persona of the name Schiedmayer has been violated by the Defendants herein.

1. THE MARK IS THE SAME AS, OR A CLOSE APPROXIMATION OF THE NAME OR IDENTITY PREVIOUSLY USED BY ANOTHER PERSON OR INSTITUTION.

The facts of this case clearly meet this proviso. The mark SCHIEDMAYER was wrongly appropriated by Defendants and is identical to Plaintiff’s previously used SCHIEDMAYER for identical goods.

2. THE MARK WOULD BE RECOGNIZED AS SUCH, IN THAT IT POINTS UNIQUELY AND UNMISTAKEABLY TO THAT PERSON OR INSTITUTION.

The mark SCHIEDMAYER is unique. There is no other institution or other entity using the name SCHIEDMAYER. It is unique and has been unique for the past 300 years, representing uniquely and only the creation of keyboard musical instruments by the Plaintiff. Clearly this element of § 2(a) false suggestion has been met.

Defendants have not cited any other use of the trademark Schiedmayer and none exists.

3. THE PERSON OR INSTITUTION NAMED BY THE MARK IS NOT CONNECTED WITH THE ACTIVITIES PERFORMED BY THE APPLICANT UNDER THE MARK.

This is the case herein. There is absolutely no connection between Defendants and Plaintiff and no such allegation has ever been made.

4. THE FAME OR REPUTATION OF THE PERSON OR INSTITUTION IS SUCH THAT, WHEN THE MARK IS USED WITH THE APPLICANT'S GOODS OR SERVICES, A CONNECTION WITH THE PERSON OR INSTITUTION WOULD BE PRESUMED.

Clearly this proviso has been met by Plaintiff herein.

First, it is noted that this proviso of § 2(a) of the Lanham Act does not require that the mark itself be famous:

“There is nothing in § 2(a) of the Act which would indicate that it is intended to afford protection only to large or nationally known institutions.”  
*Gavel Club v Toastmasters International*, 127 USPQ 88, 94 (TTAB 1960).

See also: *In Re: Hseih*, Serial No. 78/367,205 (TTAB 2008), where the relatively unknown trademark P. MAURIAT was refused based upon § 2(a) of the Lanham Act and in which a magazine article and a Wikipedia entry alone were found to be sufficient to establish fame or reputation:

“The excerpts from the Space Age Music (magazine) and Wikipedia website are sufficient to establish the fame or



renown of Paul Mauriat for purposes of proving that applicant's mark falsely suggests a connection..."

The Schiedmayer name has been used in connection with musical keyboard instruments for a period of almost 300 years.

Currently, the Schiedmayer name is being used by Plaintiff herein on a keyboard musical instrument virtually identical to the same type of piano manufactured as a Schiedmayer musical instrument almost 300 years ago.

As set forth in the testimony declaration of Elianne Schiedmayer, 38TTABVUE, the Schiedmayer dynasty has always been family owned. Clearly the persona of the Schiedmayer name is involved.

The husband of Elianne Schiedmayer, Johann Georg Schiedmayer, inherited the company from his father in 1957. Schiedmayer Celesta GmbH was founded in 1995 to continue the manufacture of the celesta piano long prior to any use by Defendants herein. Elianne Schiedmayer inherited the estate and rights of her husband Johann Georg Schiedmayer. 38TTABVUE-Ex.C.

Schiedmayer keyboard musical instruments have won more than 36 Worlds Fair medals, including 20 Gold medal awards, 6 Silver awards and 10 Bronze awards at Worlds Fairs around the world. In 1976, a Schiedmayer piano won a Bronze award in Philadelphia and in 1897 a Schiedmayer piano won a Silver award at

Chicago's World Fair. In 1904, a Grand Prix award was awarded to a Schiedmayer piano at the World's Fair in St. Louis, 38TTABVUE7.

Schiedmayer musical keyboard instruments have been the subject of famous books such as "Men Who Made Piano History", Dover Publications. An extract therefrom reciting the Schiedmayer famous history is attached as Exhibit J to the testimony Declaration of Elianne Schiedmayer, 38TTABVUE.

For years prior to the registration date of the registration in question, a Schiedmayer piano was and is currently on display in the permanent collection of the Boston Museum of Fine Arts in Boston, MA, the fourth largest museum in the United States. 38TTABVUE8.

Reference is made to Exhibit E of the Declaration of Elianne Schiedmayer, 38TTABVUE, which represents a partial listing of purchasers of Schiedmayer Celestas prior to November 20, 2007, which is the registration date of the registration sought to be cancelled. Well over 100 of the greatest orchestras and symphonies in the United States are set forth as having purchased the Schiedmayer Celesta piano. Surely, this reflects a great and hallowed reputation for the Schiedmayer musical instrument. See also, the Declaration of Helga Kasimoff, a 50 year veteran in the sale of fine musical instruments who stated the following under oath at 41TTABVUE3:

"Because we have represented the sale and rental and servicing of the Schiedmayer Celesta continuously for the past 50 years, both myself and my son Kyrill are well aware of the fact that during all of these 50 years the Schiedmayer

Celesta has been regarded by the public with the highest degree of integrity and reputation.

The Schiedmayer reputation with regard to the manufacture and sale of Schiedmayer musical keyboard instruments is unparalleled and extremely highly regarded.

We are aware that the reputation and fame of Schiedmayer musical instruments dates back almost 300 years and that Schiedmayer Celesta GmbH and Elianne Schiedmayer represent the continuum of a history relating to the sale of keyboard musical instruments dating back almost 300 years.”

According to the statements set forth in the Declaration of Olga Fuchs, 40TTABVUE, a Google search was conducted for the name Schiedmayer on March 29, 2017. The resulting search comprised approximately 40 pages of entries for the mark SCHIEDMAYER and attached as Exhibit B to the Fuchs ‘Declaration’ are the first eight pages of entries for the mark SCHIEDMAYER, it being noted that each and every entry relates solely and exclusively to a Schiedmayer piano or celesta.

According to the Declaration of Olga Fuchs, a Google search for the mark “SCHIEDMAYER CELESTA” revealed 15 pages of search results attached as Exhibit C to her Declaration.

Olga Fuchs also conducted an Ebay search indicating the availability for sale on Ebay of records and decals and books all relating to Schiedmayer pianos and celestas. Olga Fuchs also located an extensive and detailed Wikipedia entry.

It is recognized that the searches conducted by Olga Fuchs were conducted after the registration date of the Defendants' registration.

However, it is believed that the Board may 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 the November 20, 2007, which is the registration date of the Defendants Schiedmayer registration. The above recited facts clearly illustrate a compliance with the fourth leg of the Sec. 2a test.

#### INTENT

A showing of intent is a powerful indication of the correct application of § 2(a) of the Lanham Act.

A false suggestion of a connection claim is particularly strong in cases where the defendant seeks registration of a mark for goods or services that are closely related to the activities for which the Plaintiff is known. See *The Board of Trustees of the University of Alabama v BAMA-werke Curt Baumann*, 231 USPQ 408,409-09 (TTAB 1986).

"Evidence of intent to suggest a connection is not required, but when such evidence exists, it weighs strongly in favor of refusing registration under § 2(a)."

See *Guide to TTAB Practice* – Handelman, 2016.

"Evidence of such intent would be highly persuasive that the public will make the intended false association."

*University of Notre Dame du Lac v J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372,1377, 217 USPQ 505,510 (Fed. Cir. 1983)

In the instant case, evidence of intent is self-evident.

Treibitz, the operator of the Defendants herein specifically intended to trade off of the reputation and goodwill of Schiedmayer. He selected the Schiedmayer name knowing that it had a history 42TTABVUE52:

14           A.       I didn't know the specific histories, but yes,  
15 any old name out there is going to have a history.

16           Q.       So you knew that there was a history. Correct?

17           A.       I knew that there was a history to the brands,  
18 but I didn't know the specific history.

19           Q.       But you know there was a history to each these  
20 brands. Correct?

21           A.       Of course there's a history to a -- to a brand.

Treibitz knew full well during the prosecution of the subject application that the name Schiedmayer was the name of a famous piano manufacturer. Indeed, this was pointed out in the initial rejection under § 2(a) of the subject application.

Treibitz even played a Schiedmayer Celesta piano during his visit to the piano store operated by Helga Kasimoff. See 41TTABVUE3.

It is beyond any reasonable dispute that Treibitz, respectively Hollywood Piano, respectively the Defendants herein, knew perfectly well that they intended to trade off the goodwill and reputation of the Schiedmayer name when the name was appropriated by Treibitz by selecting it from a book of decals for known and established piano manufacturers.

From all of the above it can be seen that the four-prong test for the application of § 2(a) of the Lanham Act has been fully met herein and the subject registration should be cancelled forthwith.

#### ABANDONMENT

Use of a trademark has been defined as requiring that any such usage be 'bona fide': TMEP Sec. 901-01 and 15 U.S.C. 1127.

In order to avoid abandonment of a subject registration, it is incumbent upon the Defendants to establish bona fide use of the trademark SCHIEDMAYER.

This has not taken place herein. The definition of "use in commerce" (T.M.E.P. § 901.01) was amended by the Trademark Law Revision Act of 1988 to add the phrase "the bona fide use of a mark in the ordinary course of trade..." While the Amendment was made in order to clarify the token use of the trademark, nevertheless it

is clear that any use in commerce intended to support a response to an allegation of abandonment, must represent a bona fide usage.

“It has long been the policy of the PTO’s Trademark Trial and Appeal Board that use in commerce only creates trademark rights when the use is lawful. See, e.g., *In re Midwest Tennis & Track Co.*, 29U.S.P.Q.2d 1386 n. 2, 1993 WL 562977 (1993); *Clorox Co. v. Armour-Dial, Inc.*, 214 U.S.P.Q. 850, 851, 1982 WL 50434 (1982); *In re Pepcom Indus., Inc.*, 192 U.S.P.Q. 400, 401, 1976 WL 21138 (1976); *In re Stellar Int’l, Inc.*, 159 U.S.P.Q. 48, 51, 1968 WL 8159 (1968)... we also agree with PTO’s policy and hold that only lawful use in commerce can give rise to trademark priority.”  
- *Creagri Inc. v. Usana Health Sciences Inc.* 474 F3d 626, 8, USPQ 2d 1592 (9<sup>th</sup> Cir 2007)

Bona fide use by the Defendants has not taken place herein.

As Glenn Treibitz repeatedly testified, the Defendants herein simply applied the name Schiedmayer to any no-name piano which they may have ordered, and then sold it as such.

The no-name piano could be interchangeably marked with a Schiedmayer trademark or a Bernard Shoninger trademark or a Kurtzmann trademark or a Hollywood Piano trademark.

The point being that in no way did the trademark SCHIEDMAYER ever point to the source of the product, which indeed is the very function of a trademark.

Additionally, 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.

Reference is again made to the two Exhibits attached hereto which are properly in evidence and in which no-name pianos marketed as Schiedmayer pianos are being promoted and offered for sale by the Defendants as German made products, with reference to German strings, German pin blocks, German keys and the like.

Any usage by the Defendants herein of the trademark SCHIEDMAYER is in no way bona fide. The name Schiedmayer has never been used to properly represent the source of the Schiedmayer product. It has simply been used interchangeably with other trademarks on no-name pianos to misrepresent to the public, that the piano is an authentic Schiedmayer product.



The Defendants herein studiously avoided producing any documentation regarding the actual sale of fake Schiedmayer pianos, including with particularity the contracts for the sale of the pianos because any such evidence would have clearly established once again that the Defendants were engaged in palming off of no-name pianos as authentic Schiedmayer products.

In view thereof, it is clear that the trademark SCHIEDMAYER has been abandoned by the Defendants because they have never engaged in any type of bona fide usage of the mark.

#### THE DEFENDANTS' ASSERTION OF LACHES

The Defendants herein, Hollywood Piano, have asserted an Affirmative Defense of Laches. Hollywood Piano has submitted some extraneous material in a Notice of Reliance, 65TTABVUE, indicating that it somehow supports a finding of Laches. It does not.

The elements of a laches defense include material prejudice attributable to any delay. See *Lincoln Logs Ltd. V. Lincoln Pre-Cut Logs Homes Inc.*, 971 F.2d 732, 23USPQ2d 1701, 1703 (Fed. Cir. 1992).

The party raising the affirmative defense has the burden of proving it. See *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1462 (Fed. Cir. 2001).

As the federal Circuit's predecessor put it, "[t]he registrant, of course, has the right to invoke the doctrine in a cancellation proceeding. ...[I]t, however, bears, the burden of showing the injustice." *Ralston Purina Co. v. Midwest Cordage Co.*, 373 F.2d 1015, 153 USPQ 73, 75-76 (CCPA 1967).

It is correct 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. However, it is also true 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 for the identical mark.

In this respect it is noted that although constructive notice did exist, nevertheless, the Plaintiff herein is a German company and it is quite obvious that under these circumstances the Plaintiff would be less likely to ascertain the evidence of the conflicting registration or application in another country.

While a considerable period of time has admittedly transpired prior to the filing of the Petition for Cancellation, it is nevertheless well established that mere delay will not support a finding of Laches:

“A mere lapse of time alone will not normally constitute Laches.”

*American Rice, Inc. v. Producers Rice Mill, Inc.*, 518 F.3d 321 (5<sup>th</sup> Cir.) 2008

“...Laches should not necessarily always be measured from Defendants very first use of the contested mark, but from the date that Defendants acts first significantly impacted on Plaintiff's goodwill and business reputation”

*Nabisco Brands, Inc. v. Kunusa Corp.*, 722 F Supp 1287-1292 (M.D.N.C. 1989)

It is Black Book that Laches will not apply unless there has been a detrimental reliance upon the delay.

“Without a showing of detrimental reliance and without an opportunity to address the reasonableness of the delay, application of Laches was improper.”

*In re: Panther Mountain Land Development, LLC*, 686 F.3d 916,928

“To prove Laches, in addition to showing unreasonable delay, the Applicant must show that it has suffered material prejudice as a result of the delay.”

*Hornby v. TJX Cos. Inc.*, 87 USPQ 2d 1411,1419 (TTAB 2008)

- Noting that mere delay in asserting a trademark related right does not necessarily result in changed conditions sufficient to support the defense of Laches; there must also have been some detriment due to the delay.

See also *Charrette Corp. v Bowater Communications Papers, Inc.*, 13 USPQ 2d 2040, 2043 (TTAB 1989)

- Noting that mere delay in asserting one's trademark rights is insufficient to give rise to an estoppel; Respondent in cancellation proceeding failed to show that it acted to its detriment.

In the instant case, the Defendants, Hollywood Piano, has never even asserted any damage due to the delay which has taken place herein. *There is not one scintilla of evidence in connection with the subject proceeding, that the Defendants were in any way prejudiced by some delay.*

Indeed, the Defendants have freely admitted that basically their promotion consisted of little more than sticking a Schiedmayer label on a no name Piano and putting it on the floor for sale:

“The primary form of advertising the SCHIEDMAYER mark has been putting pianos branded with the SCHIEDMAYER mark on the floor and in the rental pool of Hollywood Piano”

-Treibitz Testimonial Declaration. 66TTABVUE6.

The Defendants never engaged in any type of program or efforts to sell the Schiedmayer piano. Rather, as Treibitz himself testified, he simply bought no-name pianos from time to time, slapped on the Schiedmayer name and palmed it off as a Schiedmayer product. This is not the stuff of which detrimental delay is made.

In any event, it is noted that with respect to abandonment, Laches does not apply:

“The defenses of Laches and equitable estoppel are not available against a claim of abandonment. The rationale underlying this rule is that it is in the public interest to remove abandoned registrations from the register.”

*Guide to TTAB Practice Handelman 2016*

See also *Treadwell’s Drifters, Inc. v Marshak*, 18 USPQ 2d 1318,1320 (TTAB 1991).

## SUMMARY

A serious injustice has taken place here which cries out for resolution.

The Defendants have misappropriated a great name in musical instruments and pianos for their own greed and profit.

Defendants incorrectly obtained this registration by falsely asserting that the great name Schiedmayer has been abandoned when no such abandonment had ever taken place.

If the Defendants had honestly responded to the initial Office Action rejecting its application based upon § 2a of the Lanham Act, we would not be here today and this injustice would never have taken place.

The Defendants should not be permitted to profit by their false assertion to the Trademark Office that the mark SCHIEDMAYER had somehow become abandoned.

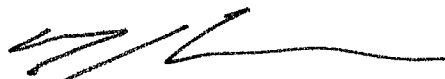
In conclusion, perhaps the best summary of this proceeding may be the words of Elianne Schiedmayer herself in the conclusion of her testimonial Declaration as follows, 48TTABVUE5:

"I am a Schiedmayer. I am proud to be a Schiedmayer and I am particularly proud to be the current holder of the Schiedmayer name which has represented the highest degree of excellence in musical keyboard instruments, including pianos and celestas for almost 300 years. The 9<sup>th</sup> consecutive Schiedmayer generation, Knut Schiedmayer, is currently our managing director.

The sale of cheap "no-name" pianos manufactured in China and Indonesia under the great name Schiedmayer diminishes and violates the fame and reputation of my name and the name of my company and one of the great names in musical keyboard instruments, having been first manufactured and continuously sold around the world since 1735."

Trademark Registration No. 3,340,759 should be cancelled forthwith.

Respectfully submitted,



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CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the attached document was served upon counsel for the Respondents at his email address of record:

adam@iptech.law

This 12 day of December, 2018.

/Michael J. Striker/

Michael J. Striker