

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

wbc

Mailed: January 30, 2018

Cancellation No. 92061215

Schiedmayer Celesta GMBH

v.

Piano Factory Group

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes up for consideration of Petitioner's motion to strike Respondent's notice to take testimonial cross-examination of Ms. Elianne Schiedmayer on written questions. *See* 52 TTABVUE; 53 TTABVUE. Additionally, Respondent has filed a cross-motion to strike the testimony of Ms. Schiedmayer. *See* 56 TTABVUE. The motions are fully briefed.¹

Petitioner seeks to strike Respondent's notice to cross-examine Ms. Schiedmayer on written question, who resides in Germany, arguing that Respondent has not complied with "certain specific and clear requirements of German law." 53 TTABVUE 2.

In response thereto, Respondent notes that it "hereby withdraws its Notice to Take Cross Examination by Written Questions and does not further contest

¹ The party's changes in correspondence are noted. *See* 54 TTABVUE; 55 TTABVUE. The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments made therein. The parties' arguments will not be summarized herein except as necessary to explain the Board's decision.

Petitioner's Motion to Strike the same"; that "Ms. Schiedmayer [is] entirely unavailable for cross examination"; and that "by withdrawing ... Respondent is not waiving its right to cross examination." 56 TTABVUE 9-11. Respondent further argues that because it has been unable to cross-examine Ms. Schiedmayer, the testimony of Ms. Schiedmayer should be excluded from consideration by the Board "as inadmissible hearsay." 56 TTABVUE 13.

On receipt of written notice that one or more testimony depositions are to be taken on written questions, the Board will generally suspend or reschedule other proceedings in the case to allow for the orderly completion of the depositions on written questions. *See* Trademark Rule 2.124(d)(2); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990); *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990).

The parties devoted large portions of their briefs discussion German law and the appropriate procedure to depose a witness on written questions in Germany. Taking the testimony of a witness, residing in a foreign country, requires compliance with Fed. R. Civ. P. 28(b). Further, although a witness in a foreign country may be taken on notice before the U.S. consular official or before anyone authorized by the law of the foreign country to administer oaths therein, some countries prohibit the taking of testimony within their boundaries for use in any other country, including the U.S.; or may permit the taking of testimony only if certain procedures are followed. *See* TBMP § 703.02 (June 2017) and authorities cited therein.

The Board recognizes that testimony of a witness who resides in a foreign country is difficult and the procedures are cumbersome and not necessarily effective. *Cf. Galaxy Metal Gear Inc. v. Direct Access Tech. Inc.*, 91 USPQ2d 1859, 1862 n.5 (TTAB 2009); *Double J of Broward, Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612 (TTAB 1991). Accordingly, a party that wishes to take the testimony deposition in a foreign country should *first consult with local counsel* and/or with the Office of American Citizen Services, U.S. Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed. *See* TBMP § 703.01(g). The Board's procedure of suspending proceedings upon notice of testimony in a foreign country allows the parties time to consult local counsel and/or with the Office of American Citizen Services, U.S. Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed. In short, the question of whether (and how) the parties have complied with German law is a question that should be presented to those authorities.

Petitioner asserts that Ms. Schiedmayer "is ready, willing and able to voluntarily attend a deposition in Frankfurt, Germany." 57 TTABVUE 6. Inasmuch as Ms. Schiedmayer is a willing witness and the basis for Respondent's motion to strike and apparently, its withdrawal of its notice to cross-examine Ms. Schiedmayer on written questions, was Respondent's

assertion that Ms. Schiedmayer is an unwilling witness, Respondent has **fifteen days** from the date of this order to notify the Board, in a filing through ESTTA, and Petitioner that it wishes to cross-examine Ms. Schiedmayer on written questions, thereby effectively reinstating its notice to cross-examine Ms. Schiedmayer on written questions found at 52 TTABVUE. Upon receipt of such notification, proceedings will remain suspended so that the parties may consult with local counsel and/or with the Office of American Citizen Services, U.S. Department of State, in order to determine whether the taking of the deposition will be permitted under German law, and, if so, what procedure must be followed to secure and conduct Respondent's cross-examination of Ms. Schiedmayer on written questions.

If Respondent does not notify the Board and Petitioner that it wishes to cross-examine Ms. Schiedmayer within the timeframe noted in this order, the Board will presume it no longer wishes to cross-examine Ms. Schiedmayer. The testimony of Ms. Schiedmayer submitted by Petitioner will remain of record and proceedings will be resumed with dates reset, as appropriate.

In view of the Board's order, Petitioner's and Respondent's respective motions to strike are denied as moot.