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

Proceeding	91125743
Party	Defendant UGI HAVC ENTERPRISES, INC. ,
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

THE SERVICEMASTER COMPANY,	:	
	:	
Opposer/Petitioner,	:	Opposition No.: 125,743
	:	Appln. Serial No. 76/237,328
	:	
v.	:	Opposition No.: 152,104
	:	Appln. Serial No. 76/166,568
	:	
UGI HVAC ENTERPRISES, INC.	:	Cancellation No. 92/041,147
	:	Registration No. 2,591,190
	:	
Applicant/Respondent.	:	

**APPLICANT/RESPONDENT’S REPLY BRIEF IN SUPPORT OF ITS MOTION TO
COMPEL DISCOVERY RESPONSES AND TO EXTEND DISCOVERY, TESTIMONY
AND TRIAL DATES**

Applicant/Respondent, UGI HVAC Enterprises, Inc. (“Applicant”) pursuant to 37 C.F.R. § 2.127(a), files the instant Reply Brief with the Trademark Trial and Appeal Board (the “Board”) in support of its Motion to Compel Discovery Responses.

Opposer, in its Response to Applicant/Respondent’s Motion to Compel Discovery Responses, has continued its refusal to adequately respond to Applicant’s outstanding discovery. Even though nothing short of complete a complete response to Applicant’s discovery requests will satisfy Opposer’s obligations, Opposer has again refused to respond to Applicant’s discovery concerning the marks used by Opposer’s “related companies” in connection with the provision of HVAC and plumbing services. Opposer instead, and at long last, has produced only a limited number of responsive and relevant advertisements and studies, and made vague, and to date unfulfilled, promises to produce certain documents and to produce additional documents “should they be located.” Opposer’s continued obstruction of discovery of facts necessary to test it’s allegations of continuous and substantial common law use of Opposer’s Mark for the HVAC

and plumbing services at issue in these proceedings (even in the face of Applicant's Motion to Compel) clearly requires the Board's entry of an Order instructing Opposer to respond fully and promptly rather than to the extent that it deems necessary and within a time-frame of its own choosing.

In particular, Opposer's continued refusal to respond to Applicant's discovery concerning the marks used by Opposer's "related companies" in connection with the provision of HVAC and plumbing services prevents any determination as to whether Opposer uses Opposer's Mark at all when it offers such services and, if so, whether it actually uses the ServiceMaster Company name as a trademark. Opposer's refusal to respond also prevents any inquiry into the relative strength and fame of Opposer's Mark in connection with the provision of HVAC and plumbing services as asserted by Opposer in its Notice of Opposition. The relevancy and importance of such an inquiry has been confirmed by the deposition testimony of Opposer's Rule 30(b)(6) witness, and Chief Marketing Officer, Mitchell T. Engel taken after Applicant filed its Motion to Compel:

Q: Since you've been at the company, have there been any—let me describe this handful of operations—have there—has there been any continuation of those handful of operations that use the ServiceMaster mark in association with the HVAC and plumbing services?

A: The operations themselves may be operative, but they're certainly not operating under the name "ServiceMaster" as the primary brand.

...

Q: Would it be fair to say that, at the time of the applicant's application, which obviously preceded July 9, 2002,¹ you would not characterize the use of the ServiceMaster mark in connection with HVAC and plumbing services as having fame or being famous?

¹ Opposer filed its Notice of Opposition opposing the Federal registration of Applicant's SERVICEMARK HEATING COOLING PLUMBING & Design mark (Serial No. 76/237,328) on July 9, 2002 which was preceded by a Notice of Opposition opposing Applicant's SERVICEMARK mark (Serial No. 76/166,568) on June 17, 2002 and followed by a Petition for Cancellation of Applicant's SERVICEMARK HEATING COOLING PLUMBING & Design mark (Registration No. 2,591,190) on September 16, 2002.

A: All right. Well, "fame," as in "public" in the prior paragraph we went over, are relative terms. I mean, there are small publics and there are big publics, and there could be—you could have fame amongst a small group, and then you can have fame amongst a big group.

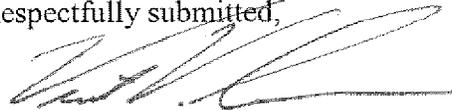
Q: All right. Well, let's take the—

A: Relatively speaking, certainly, you can sense, from the way I've been answering the questions, I can't—you know, I...I couldn't represent that I would have expected a significant—certainly, a majority—of—of the public in general to be associating ServiceMaster with plumbing or heating and air conditioning.

See Exhibit A, Deposition of Mitchell T. Engel, at 71:14-71:22 and 104:17-105:12. Opposer has asserted that Opposer's Mark is famous in connection with HVAC and plumbing services. As a consequence, Applicant is certainly entitled to see what consumers are presented with when HVAC and plumbing services are actually offered and/or actually rendered by Opposer. Unless Opposer is compelled to respond to Applicant's discovery concerning the marks used by Opposer's "related companies" in connection with the provision of HVAC and plumbing services, Applicant simply cannot defend its applications for Federal registration against Opposer's assertions in its Notice of Opposition.

For the foregoing reasons, it is submitted that good grounds exist for granting Applicant's Motion to Compel Discovery Responses, and such action is requested.

Respectfully submitted,



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Dated: December 2, 2004

Attorneys for Applicant/Respondent
UGI HVAC Enterprises, Inc.

EXHIBIT A

MITCHELL T. ENGEL -- 11/10/04
EXAMINATION BY MR. CARISSIMI

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1 conversations, we had a handful of operations.
2 We were determining whether or not it was a --
3 you know -- a . . . a good space, a growth space
4 for us to get into.

5 And as we were getting our early
6 experiences in the space, the ARS entity became
7 available -- came on the market -- and the
8 management at the time decided, even though we
9 probably hadn't fully figured out what our
10 commitment and business model would be to the
11 space, that these were assets that we probably
12 should take advantage of while they were on the
13 market.

14 Q Since you've been at the company, have there been
15 any -- let me describe this handful of
16 operations -- have there -- has there been any
17 continuation of those handful of operations that
18 use the ServiceMaster mark in association with
19 the HVAC or plumbing services?

20 A The operations themselves may be operative, but
21 they're certainly not operating under the name
22 "ServiceMaster" as the primary brand.

23 (The document was thereupon
24 marked ServiceMaster Deposition

1 I want to focus on the last half of that
2 paragraph, where it says -- well, let's look at
3 the whole paragraph. I don't want to take it out
4 of context.

5 "On the actual filing date of its
6 application, applicant had constructive notice of
7 opposer's ownership of the ServiceMaster mark and
8 had knowledge or upon reasonable -- reasonable
9 inquiry would have had knowledge and, therefore,
10 had constructive knowledge --" and here's what I
11 want to focus you on "-- of the fame of the
12 ServiceMaster mark in connection with consumer
13 services, including heating, ventilating, and air
14 conditioning (HVAC), and plumbing services."

15 Do you see that?

16 A Yes.

17 Q Would it be fair to say that, at the time of the
18 applicant's application, which obviously preceded
19 July 9, 2002, you would not characterize the use
20 of the ServiceMaster mark in connection with HVAC
21 and plumbing services as having fame or being
22 famous?

23 A All right. Well, "fame," as in "public" in the
24 prior paragraph we went over, are relative terms.

MITCHELL T. ENGEL -- 11/10/04
EXAMINATION BY MR. CARISSIMI

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1 I mean, there are small publics and there
2 are big publics, and there could be -- you could
3 have fame amongst a small group, and then you can
4 have fame amongst a big group.

5 Q All right. Well, let's take the --

6 A Relative speaking, certainly, you can sense, from
7 the way I've been answering the questions, I
8 can't -- you know, I . . . I couldn't represent
9 that I would have expected a significant --
10 certainly, a majority -- of -- of the public in
11 general to be associating ServiceMaster with
12 plumbing or heating and air conditioning.

13 Q You have no studies or quantitative research, as
14 you schooled me on earlier --

15 A Right.

16 Q -- that would, in fact, reflect that there was
17 any fame of the ServiceMaster mark in connection
18 with the provision of HVAC or plumbing services
19 as of July 9, 2002; correct?

20 A Correct.

21 Q Or preceding it or after it?

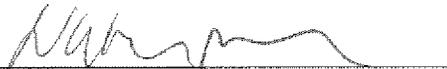
22 A Correct.

23 Q Would it be fair to describe the headquarters at
24 Downers Grove, Illinois -- is that where the

CERTIFICATE OF SERVICE

I certify that on December 2, 2004, I caused a true and correct copy of the foregoing Applicant/Respondent's Reply Brief in Support of Motion to Compel Discovery Responses and to Extend Discovery, Testimony and Trial Dates to be served *via facsimile and first-class mail*, upon the following:

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