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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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Submission	Applicant/Respondent's Response to Opposer's Motion for Protective Order to Prevent Deposition of President Ed Dunn
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Date	01/05/2005
Attachments	ugi002.PDF (11 pages)

**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 RESPONSE TO OPPOSER'S MOTION FOR PROTECTIVE
ORDER TO PREVENT DISCOVERY DEPOSITION OF PRESIDENT ED DUNN**

Applicant/Respondent, UGI HVAC Enterprises, Inc. ("Applicant") pursuant to 37 C.F.R. § 2.127(a), files this Response opposing Opposer's Motion for Protective Order on the grounds that it is not germane to Applicant's pending Motion to Compel Discovery Responses and is, in any event, premature in light of the suspension of the proceedings pending disposition of Applicant's Motion to Compel, the inability of Opposer's Rule 30(b)(6) designee, Mitchell T. Engel, to testify as to all of the topics appended to Applicant's Rule 30(b)(6) deposition notice, and the forthcoming deposition of American Residential Services' President Mark Burel.

Pursuant to TBMP § 523.01, Trademark Rule 2.120(e)(2), and the Board's November 8, 2004 Order attached hereto as Exhibit A, the parties are not to file any paper which is not germane to the Applicant's Motion to Compel Discovery Responses. Opposer does not, because it cannot, suggest that its Motion for Protective Order is germane to Applicant's pending Motion to Compel Discovery Responses. Unlike Opposer's simultaneously filed Motion for Leave to File Amended Notices of Opposition and Amended Petition for Cancellation, the

Motion for Protective Order *will not* “narrow the legal issues presented by the consolidated proceedings and thus partially resolve the pending Motion to Compel Discovery Responses.” As such, the Motion is not germane and was, therefore, improperly filed during the suspension of the proceedings pending the disposition of Applicant’s Motion to Compel.

Opposer’s Motion for Protective Order is not only not germane to Applicant’s Motion to Compel but it is also premature to the extent that the necessity of Ed Dunn’s deposition depends upon Opposer’s responses to Applicant’s outstanding discovery. Unless and until Opposer is compelled to respond to its discovery (especially that discovery related to the branding practices of Opposer’s related companies), Applicant is in no position to evaluate Opposer’s claim that Dunn does not possess unique knowledge regarding issues relevant to the proceedings.

The necessity of Dunn’s deposition also depends upon whether the combination of the deposition of Opposer’s Chief Marketing Officer, Mitchell T. Engel (initial deposition taken on November 10, 2004), and the deposition of the President of American Residential Services (“ARS”) Mark Burel¹ (forthcoming), satisfies Opposer’s obligation to offer up individuals capable and prepared to testify regarding the topics appended to Applicant’s Rule 30(b)(6) deposition notice. Engel, during his deposition, was clearly unprepared to discuss Rule 30(b)(6) topics related to Opposer’s related companies, including Dunn’s company, American Mechanical Services (“AMS”), and when asked about the trademarks used in connection with

¹ Opposer, at one point, claimed that neither Dunn nor Burel, as Presidents of Opposer’s related companies AMS and ARS respectively, “have unique knowledge of the facts at dispute in this proceeding.” (See Exhibit B to Opposer’s Motion for Protective Order). Opposer has since offered up Burel for a discovery deposition but has not had a similar change of position with regard to the similarly situated Dunn.

the provision of goods and services by AMS, specifically legacy names used by AMS, could only respond vaguely²:

Q: Okay are those legacy names of companies that are AMS companies?

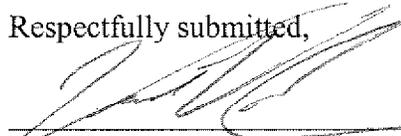
A: I would assume so. I have not—I don't get intimately involved in AMS often because there's just not a lot of marketing done there, so I can't—I can't speak to, you know, Tri Pacific, for example, you know, what the origin of that name was. But it would—these would appear to be legacy names, yes.

See Exhibit B, Deposition of Mitchell T. Engel, at 148:8-148:17. As with Engel, it is unclear whether Burel, as President of ARS, will have knowledge equal or greater to Dunn's regarding Rule 30(b)(6) topics that implicate the branding practices of AMS. Opposer should not be rewarded with a Protective Order for improperly limiting the scope of its discovery responses and failing to produce Rule 30(b)(6) designees prepared to testify regarding the issues raised in Applicant's Rule 30(b)(6) topics. Nor is Opposer entitled to an Order preventing Applicant from noticing depositions in Philadelphia when Opposer failed to offer up capable and prepared Rule 30(b)(6) designees when counsel for Applicant traveled to Chicago in November for the purposes of conducting depositions.

² Engel's vague response is not surprising in light of his admission that he did "very little" to prepare himself to testify on behalf of Opposer. See Exhibit B, Deposition of Mitchell T. Engel, at 13:6-13:22.

For the foregoing reasons, it is submitted that good grounds exist for denying Opposer's Motion for Protective Order, and such action is requested.

Respectfully submitted,



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Dated: January 5, 2005

Attorneys for Applicant/Respondent
UGI HVAC Enterprises, Inc.

United States Patent and Trademark Office
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

DUNN
Mailed: November 8, 2004

Opposition No. 91125743

THE SERVICEMASTER COMPANY

v.

UGI HAVC ENTERPRISES, INC.

Elizabeth A. Dunn, Attorney:

Proceedings herein are suspended pending disposition of applicant's motion to compel¹, filed November 3, 2004, except as discussed below. The parties should not file any paper which is not germane to the motion to compel. See Trademark Rule 2.120(e)(2).

This suspension order does **not** toll the time for either party to respond to discovery requests which had been duly served prior to the filing of the motion to compel, nor does it toll the time for a party to appear for a discovery deposition which had been duly noticed prior to the filing of the motion to compel. See *Id.* The motion to compel will be decided in due course.

¹ Applicant included a proposed order with its motion. Such orders are not necessary in Board proceedings, and should not be filed with the Board.

S49405

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

The ServiceMaster Company,) Opposition No.
) 91/125,743
 Opposer/Petitioner,) Application Serial
) No. 76/237,328;
 vs.) Opposition No.
) 91/152,104
 UGI HVAC ENTERPRISES, INC.,) Application Serial
) No. 76/166,568;
 Applicant/Respondent.) Cancellation No.
) 92/041,147
) Registration No.
) 2,591,190

30(b) (6) deposition of The ServiceMaster Company through MITCHELL T. ENGEL, called as a witness by the Applicant/Respondent, pursuant to the provisions of the Federal Rules of Civil Procedure pertaining to the taking of depositions, before Melanie L. Humphrey-Sonntag, CSR, RDR, CRR, FAPR, and a Notary Public in and for the County of DuPage, State of Illinois, taken at Lord, Bissell & Brook, LLP, 35th Floor, 115 South LaSalle Street, Chicago, Illinois, on the 10th day of November, A.D. 2004, at the hour of 9:20 o'clock a.m.

**CERTIFIED
COPY**

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4		
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1 PRESENT:
 2 OBLON, SPIVAK, MC CLELLAND, MAIER & NEUSTADT,
 3 P.C., by
 4 MR. P. JAY HINES,
 5 1940 Duke Street
 6 Alexandria, Virginia 22314
 7 (703) 413-3000
 8 appeared on behalf of Opposer/Petitioner; and
 9 PEPPER HAMILTON, LLP, by
 10 MR. VINCENT V. CARISSIMI,
 11 3000 Two Logan Square
 12 Eighteenth and Arch Streets
 13 Philadelphia, Pennsylvania 19103-2799
 14 (215) 981-4000
 15 appeared on behalf of Applicant/Respondent.
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 22
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 24

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(Exhibits are bound separately.)

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

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1 A Sometime around -- you know, shortly after this.
2 It was in the very early stages of 2000, 2001,
3 that time period.
4 So this is a 2000 report, so almost
5 concurrent because this would have come out in
6 early 2001.
7 But by the time I arrived in 2002,
8 "ServiceMaster Clean" had become the official
9 designation of that particular line of business.
10 Q Okay. Focus your attention on page 35 through 42.
11 I'd just ask you whether this kind of
12 reference to the spiritual side of
13 ServiceMaster's business is not typical of what
14 ServiceMaster would include in its annual
15 reports, as you testified to earlier.
16 A For that particular time, this would have been
17 typical of my understanding of the -- the
18 ServiceMaster culture at the time.
19 Q Okay. Direct your attention to page 68.
20 A Yes.
21 Q Look at that third paragraph, if you would,
22 please.
23 A Okay. So Rescue Rooter was a separate
24 acquisition from ARS.

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1 Q Okay. I was just going to ask whether that
2 refreshed your recollection.
3 A Yeah, it doesn't refresh it. I just never knew.
4 Q You don't know --
5 A I knew they -- acquisitions were getting into the
6 space, so that helps clarify.
7 MR HINES: Does it give a date?
8 THE WITNESS: It says, "In 1998 the
9 company completed a number of acquisitions,
10 including Rescue Industries," then it goes on
11 later to clarify that Rescue operates Rescue
12 Rooter.
13 Good. Thank you.
14 MR. CARISSIMI: You're welcome.
15 BY MR. CARISSIMI:
16 Q Direct your attention to what has been marked and
17 placed before you as ServiceMaster Exhibit No. 16.
18 A 16? Yes.
19 Q Yes.
20 And as you can see from the lower
21 right-hand corner, these documents were printed
22 out on the date October 25th, and a few later
23 ones are October 24th, from -- do you -- let me
24 ask you, do you recognize these as pages on AMS'

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1 Web site?
2 A Look to be, yes. I don't have their pages
3 memorized, but this is very consistent with AMS
4 format, yes.
5 Q Okay. And is the use of "A ServiceMaster
6 Company" on the first page of Exhibit No. 16
7 consistent with how you described the secondary
8 branding --
9 A Yes.
10 Q -- using the company name?
11 A Yes.
12 Q Turn your attention to the third page of
13 Exhibit 16.
14 A Okay.
15 Q And you'll recall earlier today you gave some
16 testimony regarding heritage names or however we
17 want to refer to those names -- is -- heritage
18 name? Is that -- does that work for you?
19 A We can use that. That's fine.
20 Q Is there a different term that's used?
21 A We call them legacy names inside the
22 organization.
23 Q Okay. A legacy name. Let's call it a legacy
24 name.

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1 This is, again, from October 25th, 2004,
2 AMS' Web site, and it lists a number of
3 companies, including Anderson Air, Elcor
4 Electric, Southcoast, Tri Pacific, Westland
5 Heating & Air Conditioning.
6 Do you see those?
7 A Yes.
8 Q Okay. Are those legacy names of companies that
9 are AMS companies?
10 A I would assume so. I have not -- I don't get
11 intimately involved in AMS often because there's
12 just not a lot of marketing done there, so I
13 can't -- I can't speak to, you know, Tri Pacific,
14 for example, you know, what the origin of that
15 name was.
16 But it would -- these would appear to be
17 legacy names, yes.
18 Q And on the next page following, in Maryland,
19 Freestate Electrical?
20 A Yes.
21 Q And T. A. Beach, also legacy names used by those
22 companies?
23 A Right. I know Freestate's used actively, yes.
24 Q Okay. So tell me how -- how Freestate is

37 (Pages 145 to 148)

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

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1 (The document was thereupon
2 marked ServiceMaster Deposition
3 Exhibit No. 1 for identification
4 as of November 10, 2004.)
5 BY MR. CARISSIMI:
6 Q Mr. Engel, the Court Reporter has put before you
7 what has been marked as ServiceMaster No. 1.
8 A Uh-huh.
9 Q Do you recognize ServiceMaster No. 1?
10 A I'm sure I've seen it.
11 Do I recognize it? No.
12 Q Okay. You understand that you are here today to
13 testify on behalf of the company?
14 A Yes.
15 Q Do you understand that there are certain
16 categories where you're expected to testify
17 pursuant to the notice before you, ServiceMaster
18 No. 1?
19 A Yes.
20 Q Tell me what you did to prepare for today's
21 deposition.
22 A Very little. I -- I basically arrived.
23 Q Anything else?
24 A I had a, you know, brief premeeting with Jay,

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1 by answering questions, but I didn't review
2 drafts; I didn't participate in the drafting.
3 Q Did -- when you say you're sure you
4 participated --
5 A I would assume, as our attorneys have asked me
6 questions or as -- as this whole proceeding
7 has -- has continued, I've been involved, so I
8 suppose that I participated indirectly in
9 that way.
10 Q Have you participated in responding to the
11 document requests made by ServiceMark?
12 A I do not know. It could be that our attorneys
13 accessed materials through my assistant, but I
14 did not directly give them any documentation.
15 Q Were you asked directly to give any
16 documentation?
17 A I don't think so.
18 THE WITNESS: Jay, was it?
19 MR. CARISSIMI: That's all right.
20 You can -- don't ask him questions.
21 BY MR. CARISSIMI:
22 Q Is -- was -- to your knowledge, is there a point
23 person at ServiceMaster who is interfacing with
24 counsel on this matter?

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1 just to familiarize myself with what the day was
2 going to be about.
3 Q When was that meeting?
4 A This morning.
5 Q And when you say "Jay," you're referring to
6 counsel, Mr. Hines?
7 A Yes, Mr. Hines.
8 Q How long did that meeting last?
9 A Forty-five minutes.
10 Q Did you review any documents in preparation for
11 today's deposition?
12 A We looked at a few documents briefly this
13 morning.
14 Q Do you recall what they were?
15 A There were a few excerpts of -- of quotes from
16 our chairman that -- that I guess you all have
17 cited in some documentation.
18 I asked again to see something that had the
19 ServiceMark logo on it, and that's about what I
20 recall. There wasn't a lot.
21 Q Have you participated at all in the preparation
22 of the interrogatory answers that have been
23 provided by ServiceMaster?
24 A I did not -- I'm -- I'm sure I participated by --

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1 A Interfacing with outside counsel?
2 Q Yes.
3 A Yes, one of our in-house attorneys, Cristen Kogl,
4 C R I S T E N, K O G L.
5 Q Is there any businessperson that has any
6 particular responsibility for this matter?
7 A Well, it would probably -- it would probably
8 be me.
9 Q Do you know what efforts were made to gather
10 documents in response to the document requests --
11 A No.
12 Q -- served by ServiceMaster -- excuse me -- served
13 by ServiceMark?
14 When I say "ServiceMark," I'm referring
15 to UGI.
16 A UGI, sure.
17 No, I don't. I tend to let people do their
18 jobs and assume they're doing them well and
19 Cristen always does.
20 Q Did you participate in responding to the request
21 for admissions that were served on ServiceMaster?
22 A I do not believe I did.
23 Q Were you -- did you participate in the drafting
24 of the notice of opposition or the petition to

4 (Pages 13 to 16)

CERTIFICATE OF SERVICE

I certify that on January 5, 2005, I caused a true and correct copy of the foregoing Applicant/Respondent's Response to Opposer's Motion for Protective Order to Prevent Discovery Deposition of President Ed Dunn to be served *via facsimile and first-class mail*, upon the following:

P. Jay Hines, Esquire
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314



NATHAN W. DEAN