

ESTTA Tracking number: **ESTTA23851**

Filing date: **01/19/2005**

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

Proceeding	91125743
Party	Plaintiff THE SERVICEMASTER COMPANY ,
Correspondence Address	P. JAY HINES OBLON, SPIVAK, MCCLELLAND 1940 DUKE STREET ALEXANDRIA, VA 22314
Submission	Opposer's Reply in Support of Opposer's Motion for Leave to File Amended Pleadings
Filer's Name	P. Jay Hines
Filer's e-mail	tmddocket@oblon.com, phines@oblon.com, acahill@oblon.com
Signature	/P. Jay Hines/PJH/ASC/ojb/
Date	01/19/2005
Attachments	reply1.pdf (21 pages)

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

THE SERVICEMASTER COMPANY,)	<u>Consolidated Opposition No.: 125,743</u>
)	
Opposer,)	Opposition No.: 125,743
)	Appln. Serial No.: 76/237,328
v.)	
)	Opposition No.: 152,104
UGI HVAC ENTREPRISES, INC.,)	Appln. Serial No.: 76/166,568
)	
Applicant.)	Cancellation No.: 92/041,147
)	Registration No.: 2,591,190

OPPOSER/PETITIONER'S REPLY IN SUPPORT OF MOTION
FOR LEAVE TO FILE AMENDED NOTICES OF OPPOSITION
AND AMENDED PETITION FOR CANCELLATION

Opposer/Petitioner, The ServiceMaster Company ("Opposer"), by counsel, submits this Reply in support of Opposer's Motion for Leave to File Amended Notices of Opposition and Amended Petition for Cancellation.

Applicant filed a Motion to Compel Discovery Responses on November 3, 2004. In its Motion to Compel, Applicant identified several requests for production and interrogatories that it contends Opposer failed to answer adequately. In response, Opposer detailed the manner in which it had responded to Applicant's outstanding discovery requests, including the production of 1200 pages of responsive documents, and outlined its plan to supplement its production with additional documents located since the date of Opposer's original written discovery responses, and in some cases, since the date that Applicant's Motion to Compel was filed.

Opposer fulfilled its duty to supplement its discovery responses by producing additional documents, in four separate supplemental productions. The first supplemental production, made on November 23, 2004, included 180 pages of additional documents including four “attorneys eyes only” studies and updated Brand Usages Guidelines. See November 23, 2004 Letter to counsel for Applicant attached as Exhibit A. The second supplemental production, comprised of 1055 pages of responsive documents, took place on December 2, 2004. See December 2, 2004 Letter to counsel for Applicant attached as Exhibit B. Opposer sent a third supplemental document production comprised of 38 pages of documents on December 8, 2004. See December 8, 2004 Letter to counsel for Applicant attached as Exhibit C. A Fourth and Final document production was made on January 19, 2005 and was composed of 30 pages. See January 19, 2005 letter to counsel for Applicant attached as Exhibit D.

Opposer has made a good faith effort to be responsive to all additional issues raised during the deposition of its Chief Marketing Officer, Mitchell T. Engel, the issues raised by Applicant’s Motion to Compel, and the issues raised in the letter from Applicant’s counsel of December 21, 2004, attached as Exhibit E. In all of the supplemental productions, Opposer has opted to produce, even when disclosed documents were considered irrelevant or non-responsive.

As part of this process, Opposer has considered Applicant’s outstanding objections to Opposer’s discovery responses and concludes that the only remaining documents in dispute are those supporting Opposer’s claim of federal trademark dilution. As the Board is no doubt aware, the law of trademark dilution has been the subject of a U.S. Supreme Court decision that clarified the legal standard for proving dilution. Although the law continues to develop in both civil cases and in Board proceedings, the Supreme Court’s decision in *Moseley v. V. Secret Catalog, Inc.*, 65 USPQ2d 1801 (2003), establishing an “actual dilution” standard, makes proceeding and

prevailing on such a claim a more difficult proposition. After further consideration and consultation with counsel, Opposer made the decision to eliminate formally, its claim for federal trademark dilution and filed its Motion for Leave to File Amended Notices of Opposition and Amended Petition for Cancellation.

Although Applicant does not oppose Opposer's Motion for Leave, Opposer believes that it is necessary to detail Opposer's efforts towards resolving the discovery disputes in response to Applicant's representation that Opposer's Motion for Leave to Amend was merely "the latest in a long line of moves made by Opposer designed to circumvent its discovery obligations." (Applicant's Response to Opposer's Motion for Leave, Page 1, Paragraph 2). Just the opposite is true. Opposer has worked diligently to narrow or eliminate the disputed discovery issues between the parties and continues to do so in supplementing its discovery responses and in seeking to narrow the legal grounds for its oppositions and petition for cancellation.

As Applicant concedes (in a footnote), Applicant's Document Request No. 18 (First Set) calling for the production of "all documents and things which support Opposer's assertions that the SERVICEMASTER mark has achieved the status of a famous mark" will be rendered moot by the elimination of the dilution claim. This request alone, when directed to Opposer and its business units, may have involved thousands of disputed documents. Such broad, open-ended requests are clearly inappropriate and overly burdensome in a likelihood of confusion proceeding, particularly given the size and history of Opposer and its SERVICEMASTER mark. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (Discovery requests that were proper when served upon respondent were unduly burdensome when served upon petitioner because petitioner used its marks for over seventy years, while respondent used its mark for only two to three years).

Opposer has produced documents and information supporting the strength of its marks for HVAC and plumbing services and does not dispute that such documents and information are relevant to a likelihood of confusion analysis before the Board. It is Opposer's position that in granting its Motion for Leave to Amend eliminating one of the legal bases for Opposer's claims that the remaining discovery issues between the parties will be narrowed or eliminated.

Accordingly, Opposer respectfully requests that its Motion for Leave to File Amended Notices of Opposition and Amended Petition for Cancellation be granted.

Respectfully submitted,

THE SERVICEMASTER COMPANY

By:



P. Jay Hines
Amy Sullivan Cahill
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314
(703) 413-3000
fax: (703) 413-2220
e-mail: tmdocket@oblon.com

Date: January 19, 2005
PJH/ASC/ojb {I:\ATTY\PJH\SERVICEMASTER\244183-224797US-RPLY.DOC}

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **OPPOSER/PETITIONER'S REPLY IN SUPPORT OF MOTION FOR LEAVE TO FILE AMENDED NOTICES OF OPPOSITION AND AMENDED PETITION FOR CANCELLATION** was served on counsel for Applicant, this 19th day of January, 2005, by sending same via First Class mail, postage prepaid, to:

Vincent V. Carissimi, Esquire
Barbara L. Delaney, Esquire
PEPPER HAMILTON LLP
3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, Pennsylvania 19103-2799

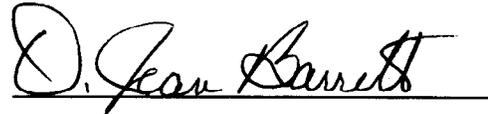


EXHIBIT A



November 23, 2004

ATTORNEYS AT LAW

P. JAY HINES
(703) 412-7028
JHINES@OBLON.COM

Vincent V. Carissimi, Esquire
PEPPER HAMILTON LLP
3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, Pennsylvania 19103-2799

Re: *The ServiceMaster Company v. UGI HVAC Enterprises, Inc.*
Opposition Nos. 125,743 & 152,104; Cancellation No. 41,147
Marks: SERVICEMARK HEATING COOLING PLUMBING
& DESIGN and SERVICEMARK
Our Ref: 224797US-244183-3165-36

Dear Vinny:

We enclose copies of the following documents that are responsive to Applicant's Requests for Production of Documents:

SVM01020 – SVM1046	Advertisement: Mailers for ServiceMaster Home Center
SVM1047 - SVM1055	Brochure: "How Do You Keep Your Home Looking and Feeling Its Best? – ServiceMaster Family of Brands"
SVM01056-SVM01057	Advertisement: Coupon ServiceMaster Home Service Center 10% off any service up to \$150 off"
SVM01058-SVM01059	Advertisement: Glossy Circular "Give the Gift of Time"
SVM01060-SVM01061	Advertisement: "Give Your Employees the Gift of Time"
SVM01062-SVM1069	Advertisement: "Bringing more top-name services to the place you call home"
SVM01070-SVM01077	Presentation: "The Gift of Time" Gift Certificates Q & A: Corporate Program"
SVM01078-SVM01108	Study: Driving Growth Through Enhances Customer Relationships (September 20, 2000)

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SVM01109-SVM01134 Study: Improving the Value of the Consumer Services Business (May 4, 2001)

SVM01135-SVM01159 Study: Capturing the Business Support Services Opportunity (January 16, 2002)

SVM01160-SVM01190 Study: Valuation of Various Trademarks of the ServiceMaster Company as of April 30, 2003 (redacted)

SVM01191-SVM01200 ServiceMaster Company/ServiceMaster Brand Usage Guidelines

These documents recently were located and provided by our client.

We will produce additional responsive documents identified in Opposer's Response to Applicant's Motion to Compel Discovery Responses in approximately seven to ten days.

Sincerely yours,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

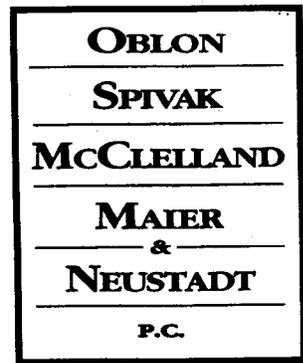
A handwritten signature in black ink, appearing to read 'P. Jay Hines', written in a cursive style.

P. Jay Hines

PJH/ASC/kae {I:\atty\PJH\ServiceMaster\244183-224797US-ltr16.doc}

Enclosure(s): As stated

EXHIBIT B



December 2, 2004

VIA COURIER

ATTORNEYS AT LAW

AMY SULLIVAN CAHILL
(703) 412-6464
ASULLIVAN@OBLON.COM

Vincent V. Carissimi, Esquire
PEPPER HAMILTON LLP
Eighteenth and Arch Streets
3000 Two Logan Square
Philadelphia, PA 19103-2779

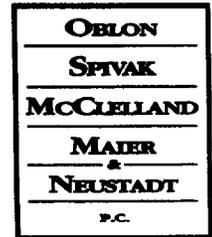
Re: *The Servicemaster Company v. UGI HVAC Enterprises, Inc.*
Opposition No.: 125,743 & 152,104; Cancellation No. 41,147
Mark: SERVICEMARK HEATING COOLING PLUMBING
& DESIGN and SERVICEMARK
Our Ref: 224797US-244183-3165-36

Dear Vinny:

We enclose copies of the following documents recently located by our client:

SVM01203-SVM01279	Voice of the Customer Program, Wave II - Summer 2003: Customer Satisfaction Survey
SVM01280-SVM01323	Voice of the Customer Program - Action Planning Guide, Summer 2003
SVM01324-SVM01402	American Residential Services Voice of the Customer Program - Findings and Recommendations, September 6, 2002
SVM01403	Handwritten Note re: Study Methodology
SVM01404	ARS Service Express Shooting Schedule: 2/25/04 Television Ad Shooting Schedule
SVM01405-SVM01413	Cramer Krasselt As Produced Radio Scripts - 2004
SVM01414-SVM01419	Cramer Krasselt As Produced Television Scripts
SVM01420-SVM01452	Agenda, Memo on Personnel, Calendars, Script Boards, Crew, Locations for Creating Television Advertisements
SVM01453-SVM01482	ServiceMaster Branding Initiative - September 25, 2002
SVM01483-SVM01600	Building a Brand Positioning and Brand ID Update
SVM01601-SVM01690	ARS/Rescue Rooter Phase II Positioning Exploratory
SVM01691-SVM01759	ARS/Rescue Rooter Phase II Positioning Exploratory 9/15/00 Executive Summary
SVM01760-SVM01828	ARS/Rescue Rooter Positioning Exploratory Focus Group 9/15/00 Qualitative Marketing Research, Executive Summary (with some notes)
SVM0829-SVM01873	Presentation of Rsearch Regarding Logos for ARS
SVM01874-SVM01880	Research Projects Status and Next Steps
SVM01881-SVM01900	Big Box Sales of Plumbing Supplies
SVM01901-SVM01902	Telephone Survey Data 12/20/02
SVM01903-SVM01958	ServiceMaster Home Services Panel Study - December 1999

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SVM01959-SVM02012	ServiceMaster Home Services Panel Study - November 1999
SVM02013-SVM02032	Market Profile Studies Presentation - February 2003
SVM02033-SVM02058	HVAC Service Market Profile Study - January 2003
SVM02059-SVM02090	HVAC - ARS Survey - 10/28/02 10/21/02
SVM02091-SVM02122	Plumbing Service Market Profile Study - January 2003
SVM02123	Email dated 10/30/02
SVM02124-SVM02153	Plumbing - ARS Survey - 10/31/02
SVM02154-SVM02180	Plumbing Service Emergency Calls versus Non Emergency Calls - May 2003
SVM02181-SVM02211	HVAC Service Emergency Calls versus Non Emergency Calls - May 2003
SVM02212-SVM02228	HVAC Repair Customers versus Replacement Customers - March 2003
SVM02229-SVM02255	PM Customer Versus Non-PM Customer
SVM02256-SVM02258	Who Does What When Getting HVAC Service

Note that all of the enclosed documents have been designated "ATTORNEYS EYES ONLY".

Sincerely,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Amy Sullivan Cahill

ASC/kae {I:\atty\PJH\ServiceMaster\244183-224797US-ltr17.doc}

Enclosure(s): As stated

cc: P. Jay Hines, Esquire

EXHIBIT C



December 8, 2004

Vincent V. Carissimi, Esquire
PEPPER HAMILTON LLP
Eighteenth and Arch Streets
3000 Two Logan Square
Philadelphia, PA 19103-2779

ATTORNEYS AT LAW

P. JAY HINES
(703) 412-7028
JHINES@OBLON.COM

Re: *The Servicemaster Company v. UGI HVAC Enterprises, Inc.*
Opposition No.: 125,743 & 152,104; Cancellation No. 41,147
Mark: SERVICEMARK HEATING COOLING PLUMBING
& DESIGN and SERVICEMARK
Our Ref: 224797US-244183-3165-36

Dear Vinny:

We enclose the following documents, numbered SVM02259-SVM02270, to supplement Opposer's production of documents in this matter. These documents recently were located by our client.

SVM02259	Correspondence dated January 12, 1996 from Sherry Campbell, Identity Coordinator forwarding Outsourcing Leadership Forum Manual
SVM02260-SVM02261	Outsourcing Leadership Forum Manual
SVM02262	Memo dated June 13, 1996 Re: Plumbing Services Info. Sheet
SVM02263-SVM02265	ServiceMaster Opens Its First Plumbing Service Center in Memphis
SVM02266	1996 Fed Ex Air Bill ServiceMaster Global Facility
SVM02267-SVM02270	Solutions Brochure
SVM02271-SVM02297	McKinsey Study Presentation Slides

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We believe that this completes Opposer's document production in this matter.

With best regards,

Sincerely yours,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'P. Jay Hines', with a stylized flourish at the end.

P. Jay Hines

PJH/ASC/kae/cds {E:\atty\PJHServiceMaster\244183-224797US-LTR18.doc}

Enclosure(s): As stated

EXHIBIT D



January 19, 2005

Via UPS Courier

ATTORNEYS AT LAW

P. JAY HINES
(703) 412-7028
JHINES@OBLON.COM

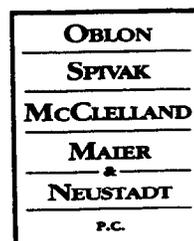
Vincent V. Carissimi, Esquire
PEPPER HAMILTON LLP
Eighteenth and Arch Streets
3000 Two Logan Square
Philadelphia, PA 19103-2779

Re: *The ServiceMaster Company v. UGI HVAC Enterprises, Inc.*
Opposition No.: 125,743 & 152,104; Cancellation No. 41,147
Mark: SERVICEMARK HEATING COOLING PLUMBING
& DESIGN and SERVICEMARK
Our Ref: 224797US-244183-3165-36

Dear Vinny:

Enclosed please find copies of the following documents (SVM02298-SVM02376) marked "ATTORNEYS EYES ONLY".

SVM02298-SVM02299	ServiceMaster Marketing Council Meeting Notes 11/29/04
SVM02300-SVM02301	ServiceMaster Marketing Council Meeting Notes 8/27
SVM02302-SVM02304	ServiceMaster Marketing Council Meeting Notes 9/25
SVM02305-SVM02306	ServiceMaster Marketing Council Meeting Notes 10/29
SVM02307-SVM02309	ServiceMaster Marketing Council Meeting Notes 12/11/2003
SVM02310-SVM02312	ServiceMaster Marketing Council Meeting Notes 1/28
SVM02313-SVM02314	ServiceMaster Marketing Council Meeting Notes 2/26
SVM02315-SVM02316	ServiceMaster Marketing Council Meeting Notes 3/18/03
SVM02317-SVM02318	ServiceMaster Marketing Council Meeting Notes 4/29



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SVM02319- SVM02320	ServiceMaster Marketing Council Meeting Notes 5/28
SVM02321	ServiceMaster Marketing Council Meeting 6/24
SVM02322- SVM02323	SVM Enterprise Marketing Department - Purpose and Functional Descriptions
SVM02324- SVM02325	ServiceMaster Marketing Council Meeting 8/26
SVM02326- SVM02328	ServiceMaster Marketing Council Meeting 11/04/2003
SVM02329- SVM02331	ServiceMaster Marketing Council Meeting 11/04/03
SVM02332- SVM02334	ServiceMaster Marketing Council Meeting 01/12/04
SVM02335	ServiceMaster Marketing Council Meeting 02/09/04
SVM02336- SVM02337	ServiceMaster Marketing Council Meeting 03/22/04
SVM02338- SVM02339	ServiceMaster Marketing Council Meeting 04/13/04
SVM02340- SVM02341	ServiceMaster Marketing Council Meeting 05/17/04
SVM02342- SVM02343	ServiceMaster Marketing Council Meeting 09/27/04
SVM02344- SVM02345	ServiceMaster Marketing Council Actions/Decisions Recap 6/25/02
SVM02346- SVM02354	Management Agreement between ServiceMaster Brands LLC and ServiceMaster BSC LLC dated March 7, 2003
SVM02355- SVM02358	Management Agreement between ServiceMaster Brands LLC and Marsh Management Services, Inc. dated May 1, 2003
SVM02359- SVM02367	Management Agreement between ServiceMaster Brands LLC and ServiceMaster Brands Management LLC dated March 7, 2003
SVM02368- SVM02376	Management Agreement between ServiceMaster Brands Management LLC and ServiceMaster BSC LLC dated March 7, 2003



Vincent V. Carissimi, Esquire
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The enclosed documents were recently located and provided by our client or its business units.

Sincerely yours,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

P. Jay Hines

PJH/ASC/ojb {I:\atty\PJHServiceMaster\244183-224797US-LTR22.doc}

Enclosure(s): As Stated

EXHIBIT E

3000 Two Logan Square
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215.981.4000
Fax 215.981.4750

Nathan W. Dean
215-981-4121
deann@pepperlaw.com

December 21, 2004

VIA FACSIMILE AND FIRST CLASS MAIL

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

Re: *The ServiceMaster Company v. UGI HVAC Enterprises, Inc.*
Opposition Nos. 152,104 & 125,743; Cancellation No. 41,147

Dear Jay:

Outlined below are some lingering deficiencies in Opposer's Responses to Applicant's discovery requests.

Opposer's discovery responses are, to date, largely bereft of information or documents reflecting discussions, directions, deliberations, correspondence etc. responsive to Applicant's discovery requests including, but not limited to, the marketing department meeting summaries mentioned in the deposition testimony of Opposer's Rule 30(b)(6) designee, Mitchell T. Engel. (Deposition of Mitchell T. Engel at 20:6).

By way of example, Opposer, on November 23, 2004, produced what it purports to be the ServiceMaster Company/ServiceMaster Brand Usage Guidelines¹ and a number of studies. Opposer has not, however, produced any documents beyond a handwritten note relating to "study methodology" and a 10/30/02 email attaching a "revised residential plumbing study" reflecting any of the information and communications that went into the creation of the produced documents or any information and communications that resulted from the creation of those same documents.

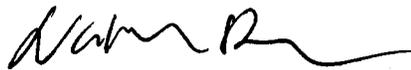
¹ We have yet to receive any Brand Usage Guidelines or Identity Manuals created for Opposer's ARS, ARS Service Express, AMS, and Rescue Rooter brands. Applicant expects that Opposer will produce these and other responsive documents relating to the use or non-use of Opposer's Mark on or in connection with the provision of HVAC and plumbing services and/or goods.

P. Jay Hines, Esquire
December 21, 2004
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Opposer has also failed to produce at least two licenses responsive to Applicant's discovery requests, one in which The ServiceMaster Company licensed use of Opposer's Mark to Aramark and another in which The ServiceMaster Company licensed use of Opposer's Mark to ServiceMaster Brands L.L.C. Applicant expects that Opposer will produce these and any other licenses responsive to Applicant's discovery requests and supplement its discovery responses accordingly.

If you have any questions regarding the deficiencies outlined above, please do not hesitate to contact me.

Very truly yours,



Nathan W. Dean

NWD:kh