

ESTTA Tracking number: **ESTTA23852**

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

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

<b>Proceeding</b>	91125743
<b>Party</b>	Plaintiff THE SERVICEMASTER COMPANY ,
<b>Correspondence Address</b>	P. JAY HINES OBLON, SPIVAK, MCCLELLAND 1940 DUKE STREET ALEXANDRIA, VA 22314
<b>Submission</b>	Reply in Support of Motion
<b>Filer's Name</b>	P. Jay Hines
<b>Filer's e-mail</b>	phines@oblon.com, acahill@oblon.com, tmdocket@oblon.com
<b>Signature</b>	/P. Jay Hines/PJH/ASC/OJB
<b>Date</b>	01/19/2005
<b>Attachments</b>	Reply2.pdf ( 12 pages )

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

THE SERVICEMASTER COMPANY,	)	<b><u>Consolidated Opposition No.: 125,743</u></b>
	)	
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 PROTECTIVE**  
**ORDER TO PREVENT DISCOVERY DEPOSITION OF PRESIDENT ED DUNN**

Opposer/Petitioner, The ServiceMaster Company ("Opposer"), by counsel, submits this Reply in support of Opposer's Motion for Protective Order to Prevent Discovery Deposition of President Ed Dunn.

Opposer's Motion for Protective Order to Prevent Discovery Deposition of Ed Dunn is timely because Applicant noticed the disputed deposition for October 28, 2004. *See* Applicant/Respondent's Notice of Deposition of Ed Dunn attached as Exhibit A. Despite Opposer's counsel's good faith efforts to resolve the matter, Applicant maintained that it was entitled to take the discovery deposition of the highest ranking officer of one of Opposer's business units until as recently as November 2, 2004. *See* copies of November 1 and November 2, 2004 correspondence attached as collective Exhibit B. Applicant filed its Motion to Compel Discovery Responses the next day, on November 3, 2004.

The Board's suspension order of November 8, 2004 clearly states that the suspension "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 noticed prior to the filing of the motion to compel”. See Board’s November 8, 2004 Order; *see also* Trademark Rule 2.120(e)(2). It is therefore unclear to Opposer how its motion for protective order could be untimely.

Opposer’s motion for protective order is also germane to Applicant’s pending motion to compel discovery responses. Certain of the disputed discovery requests relate to documents and information in the custody of Opposer’s business unit, American Mechanical Services (“AMS”), of which Ed Dunn is President. It is Opposer’s position that discovery sought by Applicant relating to AMS, in general, as opposed to AMS’s use of the SERVICEMASTER mark, in both the form of written discovery requests and through the discovery deposition of Ed Dunn, is irrelevant and beyond the scope of the current proceeding.<sup>1</sup>

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<sup>1</sup> To the extent that certain of Applicant’s discovery requests relate to the fame of Opposer’s SERVICEMASTER mark, said discovery will be rendered moot in the event that the Board rules favorably on Opposer’s Motion for Leave to File Amended Notices of Opposition and Petition for Cancellation, a motion which Applicant has not opposed. Opposer acknowledges that fame as a measure of the strength of Opposer’s mark will be weighed by the Board in its likelihood of confusion analysis pursuant to the *DuPont* factors. *See E. I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A.1973). However, Opposer believes it has met or exceeded its production obligations with respect to fame as a *DuPont* factor. *See* Opposer/Petitioner’s Reply in Support of Motion for Leave to File Amended Notices of Opposition and Amended Petition for Cancellation.

For the forgoing reasons, Opposer's Motion for Protective Order to Prevent Discovery Deposition of Ed Dunn should 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: [tmddocket@oblon.com](mailto:tmddocket@oblon.com)

Date: January 19, 2005  
PJH/ASC/ojb {I:\ATTY\PJH\SERVICEMASTER\244183-224797US-RPLY2.DOC}

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **OPPOSER/PETITIONER'S REPLY  
IN SUPPORT OF MOTION FOR PROTECTIVE ORDER TO PREVENT DISCOVERY  
DEPOSITION OF PRESIDENT ED DUNN** was served on counsel for Applicant, this 19<sup>th</sup>  
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

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

THE SERVICEMASTER COMPANY,	:	
	:	
Opposer/Petitioner,	:	Opposition No.: 91/125,743
	:	Appln. Serial No. 76/237,328
	:	
v.	:	Opposition No.: 91/152,104
	:	Appln. Serial No. 76/166,568
	:	
	:	Cancellation No. 92/041,147
UGI HVAC ENTERPRISES, INC.	:	Registration No. 2,591,190
	:	
Applicant/Respondent.	:	

**APPLICANT/RESPONDENT'S NOTICE OF DEPOSITION OF ED DUNN**

PLEASE TAKE NOTICE that pursuant to Rule 30 of the Federal Rules of Civil Procedure, and Trademark Rules 2.120, UGI HVAC Enterprises, Inc. ("Applicant/Respondent"), by and through its counsel, will take the deposition upon oral examination of Ed Dunn, AMS Business Unit Leader of The ServiceMaster Company ("Opposer/Petitioner").

The deposition will begin at 2:30 p.m. on October 28, 2004, at the law offices of Lord, Bissell & Brook, 115 S. LaSalle Street, Chicago, Illinois 60603, or at such other place as may be agreed upon in writing by counsel for the parties. This deposition will be conducted before an officer authorized to administer oaths and will continue for day to day until completed. The testimony at this deposition will be recorded by stenographic and/or videographic means.

Ed  
Dunn

You are invited to attend and cross-examine the witness.



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Vincent V. Carissimi  
Barbara L. Delaney  
PEPPER HAMILTON LLP  
3000 Two Logan Square  
Eighteenth & Arch Streets  
Philadelphia, PA 19103-2799  
(215) 981-4194

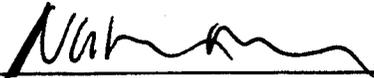
Dated: October 8, 2004

Attorneys for Applicant/Respondent  
UGI HVAC ENTERPRISES, INC.

**CERTIFICATE OF SERVICE**

I certify that on October 8, 2004, I caused a true and correct copy of the foregoing Notice of Deposition of 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

# **EXHIBIT B**

3000 Two Logan Square  
Eighteenth and Arch Streets  
Philadelphia, PA 19103-2799  
215.981.4000  
Fax 215.981.4750

**RECEIVED**

NOV 02 2004

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

Hines  
JK

Vincent V. Carissimi  
direct dial: 215.981.4351  
direct fax: 215.689.4625  
carissimiv@pepperlaw.com

November 1, 2004

**Via Facsimile and First Class Mail**

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

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

Dear Jay:

This will confirm the 30(b)(6) deposition of ServiceMaster on November 10, 2004. We will send you a revised notice tomorrow.

You have informed me that The ServiceMaster Company continues to refuse to produce Mark Burel and Ed Dunn as requested by the October 8, 2004 Notices of Deposition. I have informed you that I wanted to make one trip to depose ServiceMaster witnesses and was dubious as to whether Mr. Engel's testimony would suffice.

As I explained to you in our telephone conversation, we cannot acquiesce in your refusal to produce these witnesses. You have mentioned that Mitch Engel, who you are producing both in his individual capacity as well as The ServiceMaster Company's 30(b)(6) witness, will be able to provide all relevant information regarding ARS/Rescue Rooter and AMS. To the extent he is unable to testify fully regarding issues involving the provision and branding of services of these two companies, we will notice the depositions of other witnesses for their appearance in Philadelphia. It seems implausible that Mr. Engel, no matter how well prepared, will be able to testify fully as to all of the subject matters listed in the 30(b)(6) notice as well as relevant matters within the knowledge of Messrs. Ward, Burel and Dunn.

PHLEGAL: #1653669 v1 (ZF2901!.DOC)

Philadelphia

Washington, D.C.

Detroit

New York

Pittsburgh

Berwyn

Harrisburg

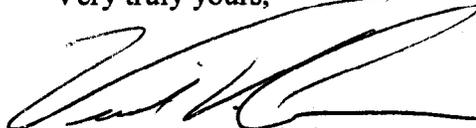
Princeton

Wilmington

P. Jay Hines, Esquire  
November 1, 2004  
Page 2

Please be advised, therefore, that my attendance at the 30(b)(6) deposition on November 10, 2004 does not waive any rights with respect to any of the other depositions we have noticed.

Very truly yours,

A handwritten signature in black ink, appearing to read 'Vincent V. Carissimi', written in a cursive style.

Vincent V. Carissimi

VVC/lsn

3000 Two Logan Square  
Eighteenth and Arch Streets  
Philadelphia, PA 19103-2799  
215.981.4000  
Fax 215.981.4750

Vincent V. Carissimi  
direct dial: 215.981.4351  
direct fax: 215.689.4625  
carissimiv@pepperlaw.com

November 2, 2004

**RECEIVED**

NOV 04 2004

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

**Via Facsimile and First Class Mail**

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

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

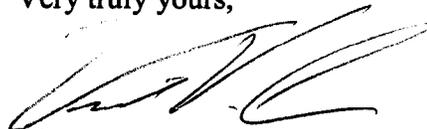
Dear Jay:

On behalf of UGI HVAC Enterprises, Inc., we are serving the enclosed Notice of Deposition Pursuant to Rule 30(b)(6) of Opposer/Petitioner The ServiceMaster Company.

Please note that while the definitions, instructions, and topics have not changed, the date and time have been changed to November 10, 2004 at 9:30 a.m.

As stated in my November 1, 2004 letter, my attendance at the 30(b)(6) deposition on November 10, 2004 does not waive any rights with respect to the depositions of Mark Burel and Ed Dunn that we requested by the October 8, 2004 Notices of Deposition.

Very truly yours,



Vincent V. Carissimi

VVC/kh  
Enclosure