

Exhibits

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Attorney Docket No.: 218039US-36

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

THE SERVICEMASTER COMPANY,
Opposer,

v.

UGI HVAC ENTERPRISES, INC.
Applicant.

Opposition No. _____
Appl. Serial No. 76/166,568
Mark: SERVICEMARK

TRADEMARK TRIAL AND
APPEAL BOARD

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06-17-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #34

NOTICE OF OPPOSITION

Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Commissioner:

The ServiceMaster Company, a corporation duly organized and existing under the laws of Delaware, located and doing business at One ServiceMaster Way, Downers Grove, Illinois 60515 (hereinafter Opposer), believing that it will be damaged by registration, hereby opposes Application Serial No. 76/166,568, filed November 16, 2000 under the Trademark Act of 1946, in the name of UGI HVAC Enterprises, Inc., published for opposition in the Official Gazette of December 25, 2001, Vol. 1253, No. 4, at Page TM 159, for the mark SERVICEMARK.

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The grounds of Opposition are as follows:

Count I - Confusion

1. The Opposer, The ServiceMaster Company, is a corporation duly organized and existing under the laws of Delaware, having its principal place of business at One ServiceMaster Way, Downers Grove, Illinois 60515.

2. Commencing long prior to Applicant's filing date, Opposer or its related companies have engaged, and are now engaged in the advertising, promotion and rendering of heating, ventilating and air conditioning (HVAC) and plumbing services in interstate commerce.

3. Commencing long prior to Applicant's filing date, Opposer or its related companies have used, and are now using the SERVICEMASTER name and mark (hereinafter sometimes referred to as "Opposer's Mark") in connection with advertising, promotion and rendering of heating, ventilating and air conditioning (HVAC) and plumbing services in interstate commerce.

4. Opposer is the owner of, and will rely herein, upon the following Federal trademark registrations, and the corresponding common law rights afforded by use thereof:

<u>MARK</u>	<u>REGISTRATION NO.</u>	<u>ISSUED</u>
SERVICEMASTER	1,220,269	December 14, 1982
SERVICEMASTER	1,272,228	March 27, 1984

Opposer's Registration No. 1,220,269 identifies the services as "Hospital and pharmacy management services with respect to purchasing and stock control; and repair and maintenance of buildings and equipment such as electrical, plumbing, heating and air conditioning" and "repair and maintenance of buildings and equipment such as electrical, plumbing, heating and air conditioning." Opposer's Registration No. 1,220,269 is incontestible by virtue of Opposer having filed a Section

15 Affidavit for the registration on March 28, 1990. The registration has been renewed. A copy of Registration No. 1,220,269 is attached hereto, as Opposer's Exhibit 1.

Opposer's Registration No. 1,272,228 identifies the services as "Energy conservation management services provided to institutional facilities ." Opposer's Registration No. 1,272,228 is incontestible by virtue of Opposer having filed a Section 15 Affidavit for the registration on March 30, 1990. The registration has been renewed. A copy of Registration No. 1,272,228 is attached hereto, as Opposer's Exhibit 2.

5. In addition to the services specified in the above-identified registrations, Opposer has also used Opposer's Mark for other and various related services including but not limited to electrical, drain rooting and cleaning services to residential and commercial customers and extended warranties for major home systems and appliances to residential customers. Use of Opposer's mark for these services is a natural extension of Opposer's use of its mark in connection with the services in the registrations above-identified.

6. Since its initial use of the aforementioned mark, Opposer has made a substantial investment in promoting its services under the SERVICEMASTER name and mark. Opposer has extensively used, promoted and offered Opposer's services in connection with the mark to the public through various channels of trade in commerce, with the result that Opposer's customers and the public in general have come to know and recognize Opposer's mark and associate same with Opposer and/or services rendered by Opposer. Opposer has built extensive goodwill in connection with the rendering of services under its mark.

7. Upon information and belief, notwithstanding Opposer's rights in and to its mark, on November 16, 2000, Applicant filed an application for registration of the alleged SERVICEMARK

mark for "installation, repair, maintenance and sales of heating, ventilation and cooling equipment and appliances, and installation, maintenance, repair and sales of plumbing and related equipment."

Said application was assigned Serial No. 76/166,568, and was published for Opposition in the Official Gazette of December 25, 2001 at Page TM 159 in connection with "distributorship featuring heating, ventilation, cooling and appliances, and plumbing and related equipment," in International Class 35; and "installation, repair and maintenance of heating, ventilation and cooling equipment and appliances; installation, repair, and maintenance of plumbing and related equipment," in International Class 37.

8. Applicant's **SERVICEMARK** mark is a simulation and colorable imitation of, and so resembles Opposer's aforesaid mark as to be likely, when applied to the services of Applicant, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

9. Upon information and belief, Opposer and Applicant are both engaged in the rendering and promotion of their respective services through the same channels of trade, and to the same general class of purchasers.

10. Upon information and belief, the bona fides of Applicant's intent-to-use is not apparent from materials of record in the subject application, and Opposer therefore challenges same and leaves the Applicant to its proofs with regard to the nature and sufficiency of its intent to use at the time of filing Application Serial No. 76/166,568.

11. Opposer, upon information and belief, avers that its customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's services marketed under Applicant's alleged **SERVICEMARK** mark and misled into

believing that such services are produced by, emanate from, or are in some way directly or indirectly associated with Opposer, to the damage and detriment of Opposer and its reputation.

Count II - Dilution

Opposer herein repeats and realleges paragraphs 1 through 11 above.

12. By virtue of the long use of the name and mark SERVICEMASTER and the high quality of consumer services rendered under the mark in connection with several well-known brands, the mark has achieved the status of a famous mark since 1994, a date preceding the filing of Applicant's application, and a date prior to the earliest date that Applicant can assert for its mark.

13. On the actual filing date of its application, Applicant had constructive notice of Opposer's ownership of the SERVICEMASTER mark and had knowledge, or upon reasonably inquiry would have had knowledge and therefore had constructive knowledge, of the fame of the SERVICEMASTER mark in connection with consumer services including heating, ventilating and air conditioning (HVAC) and plumbing services.

14. The use and registration of the SERVICEMARK mark by Applicant is likely to cause confusion, mistake or deception among members of the purchasing public concerning the origin, affiliation, association or authorization for the advertising, offering for sale, or sale of the services identified in the application.

15. The registration of SERVICEMARK in the name of the Applicant would dilute by blurring the distinctive quality of Opposer's SERVICEMASTER mark and would be in derogation of Opposer's right to preserve the SERVICEMASTER mark from dilution, as expressed in Section 43(c)(1) of the Trademark Act.

16. Opposer, upon information and belief, avers that it will be damaged by the continued use and registration by Applicant of the alleged SERVICEMARK mark, as set forth in Applicant's Trademark Application Serial No. 76/166,568, in that the mark is substantially similar to Opposer's trademark and common law rights and is used in connection with services identical to, or highly similar to, the services offered to the public by Opposer.

WHEREFORE, this Opposer, The ServiceMaster Company, believes and avers that it is being and will continue to be damaged by registration of the SERVICEMARK mark as aforesaid, and prays that said Application Serial No. 76/166,568 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed P. Jay Hines, a member of the law firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., a member of the Bar of the Commonwealth of Virginia, to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

P. Jay Hines
OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, Virginia 22202

The filing fee for this opposition in the amount of \$600 is enclosed herewith. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 50-2014.

Respectfully submitted,

THE SERVICEMASTER COMPANY

By: 
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Date: June 17, 2002

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