

TTAB

Attorney Docket No.: 224797US36

TTAB

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.: 125,743
) Appln. Serial No. 76/237,328
)

) Opposition No.: 152,104
) Appln. Serial No. 76/166,568
)

) Cancellation No. 92/041,147
) Registration No. 2,591,190
)
)
)

OPPOSER'S MOTION FOR PROTECTIVE ORDER TO
PREVENT DISCOVERY DEPOSITION OF JONATHAN P. WARD

Opposer, The ServiceMaster Company, by counsel, moves the Board for an Order directing that the discovery deposition of Opposer's Chairman and Chief Executive Officer, Jonathan P. Ward ("CEO Ward"), not proceed pursuant to Rule 26(c)(1), Fed. R. Civ. P., and Trademark Rule 2.120(f). In support of its motion, Opposer states that the discovery deposition of Opposer's chief executive, who has little or no unique knowledge of the facts at dispute in this litigation, is intended to embarrass and harass Opposer, and that the discovery sought is available to Applicant through less intrusive methods.

BACKGROUND

Opposer filed a Notice of Opposition on June 17, 2002. The Opposition proceeding, assigned Opposition No. 91/152,104, was later consolidated with the related Opposition No. 91/125,743 and Cancellation No. 92/041,147, by Order of July 8, 2003 ("the consolidated proceeding").



09-10-2004

In the consolidated proceeding, Opposer objects to the registration of SERVICEMARK, U.S. Appln. Serial No. 76/166,568 and SERVICEMARK HEATING COOLING PLUMBING (& Design), U.S. Appln. Serial No. 76/237,328, and Registration No. 2,591,190 for use in connection with sales, repair and maintenance of HVAC and plumbing equipment, on the basis of Opposer's longstanding registration of and common law rights in the SERVICEMASTER marks of U.S. Registration Nos. 1,220,269 and 1,272,228 ("the SERVICEMASTER marks"), for identical and overlapping goods and services.

On August 16, 2004, Applicant's counsel noticed the deposition of CEO Ward for September 23, 2004. A copy of the Notice of Deposition is attached hereto as Exhibit A. CEO Ward has served as Opposer's Chairman and Chief Executive Officer since April 2002. Although he has general knowledge of Opposer's SERVICEMASTER marks and of the goods and services offered under the marks, CEO Ward's responsibilities and duties do not include activities directly related to the selection and adoption of the SERVICEMASTER marks, nor to the marketing or legal enforcement efforts regarding the company's SERVICEMASTER marks.

It is unclear how Applicant arrived at CEO Ward as a potential deponent in this case. Opposer did not identify CEO Ward as a person with information relevant to the facts at issue in the consolidated proceeding in response to Applicant's written discovery requests.¹ Instead, Opposer has identified at least three other employees as the persons most knowledgeable of the facts at issue, namely Douglas Colber, Esq., Vice President, Assistant Secretary, and Legal Counsel; Sherry Campbell, Trademark Manager, Legal Department; and Mitchell T. Engel,

¹ Applicant's Interrogatory No. 1: Identify the person or persons most familiar with the use by Opposer of the marks SERVICEMASTER, Reg. No. 1,220,269 and Reg. No. 1,272,228.
Opposer's Answer: Douglas W. Colber, Esq., Vice President, Assistant Secretary and Legal Counsel; Sherry Campbell, Trademark Manager, Legal Department.

Chief Marketing Officer ("Mr. Engel"). Indeed, Opposer has offered Mr. Engel, one of the highest ranking officers in the company.

Upon receipt of the Notice of Deposition, and in an attempt to resolve this matter, counsel for Opposer contacted counsel for Applicant by telephone, on August 19 and August 26, 2004, offering to substitute a more knowledgeable witness in the place of CEO Ward, noting that Mitchell T. Engel, Chief Marketing Officer, was the most appropriate witness. Applicant's counsel, in response, has refused to substitute any of the proposed witnesses in place of CEO Ward. Applicant's counsel's written response of August 30, 2004, attached hereto as Exhibit B, states:

[I]t appears that Mr. Ward possesses unique personal knowledge of matters relevant to issues in this dispute and that he has issued highly pertinent statements, the meaning and effect of which cannot be adequately explained by other potential deponents.

In response, Opposer filed this Motion.

ARGUMENT

Trademark Rule 2.120(f) and Rule 26(c) of the Federal Rules of Civil Procedure grant the Board discretion, upon a showing of good cause, to fashion an order limiting discovery, where justice so requires, to protect a party or person from annoyance, embarrassment, oppression or undue burden or expense. Among the relief the Board may grant is that a deposition not be had. Rule 26(c), Fed. R. Civ. P. and Trademark Rule 2.120(f).

The Board made clear in *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759 (TTAB 1999), an *inter partes* proceeding very similar to this one, that the unnecessary deposition of a high level executive constitutes the type of harassing conduct that the rules of practice were

Applicant's Interrogatory No. 4: Identify the person or persons employed by Opposer who had, or has, primary responsibility for maintenance and protection of the SERVICEMASTER marks. Answer: Douglas W. Colber, Esq., Vice President, Assistant Secretary and Legal Counsel.

crafted to prevent. In the *FMR* case, the Board considered the noticed depositions of two “high level” officers of Opposer FMR Corporation. The Board noted that the officers were not identified by the moving party as persons with relevant knowledge of the issues presented by the Opposition, and that several other potential witnesses had, in fact, been offered by Opposer in place of the named deponents.

The Board noted in its opinion issuing a protective order that, “[v]irtually every court which has addressed the subject [of depositions of high-level executives] has observed that the deposition of an official at the highest level or ‘apex’ of corporate management creates a tremendous potential for abuse and harassment.” *Id.* at 1762. The Board’s decision not to permit the depositions to go forward was based on its findings that (1) the named deponents lacked unique or specialized personal knowledge of the relevant facts, and (2) the Applicant had attempted to “start at the top” prior to exhausting less intrusive and burdensome measures of obtaining the same discovery. *Id.* at 1762, citing *Salter v. Upjohn Co.*, 593 F.2d 649 (5th Cir. 1979).

The Board, expressly adopting the burden shifting analysis articulated in *Salter*, wrote:

[w]hen a party seeks to depose a very high-level official of a large corporation, and that official (or corporation) files a motion for protective order to prohibit the deposition, the movant must demonstrate through an affidavit or other evidence that the official has no direct knowledge of the relevant facts or that there are other persons with equal or greater knowledge of the relevant facts. If the movant meets this initial burden, then the burden shifts to the party seeking the deposition to show that the official has unique or superior personal knowledge of the relevant facts. If the party seeking the deposition does not satisfy this showing, then the Board will grant the motion for protective order and require that the party seeking the deposition attempt discovery through less intrusive methods.

FMR Corp. v. Alliant Partners at 1763. The same test has been applied by a number of courts in forbidding the depositions of high level executives to proceed. *See Baine v. General Motors Corp.*, 141 F.R.D. 332 (M.D. Ala. 1991) (deposition of Vice-President of General Motors denied

as “oppressive, inconvenient and burdensome” unless plaintiffs first deposed lower level employees, the corporate representative, and propounded written interrogatories) and *Mulvey v. Chrysler Corp.*, 106 F.R.D. 364 (D.R.I. 1985)(Plaintiffs denied deposition of Chairman of Chrysler because he was “a singularly unique and important individual who can be easily subjected to unwarranted harassment and abuse” and was ignorant of the facts at issue).

In this matter, Opposer has offered three witnesses: Douglas Colber, Esq., Vice-President, Assistant Secretary and Legal Counsel; Sherry Campbell, Trademark Manager; and Mitchell T. Engel, Chief Marketing Officer², as persons with knowledge relevant to these proceedings. In addition, Applicant is willing to identify the appropriate person in response to a Rule 30(b)(6) deposition noticed by Applicant. (Applicant has not noticed a Rule 30(b)(6) deposition to date.) However, at present, Applicant has failed utterly to exhaust less intrusive discovery methods before trying to go directly “to the top” to depose CEO Ward. In fact, Applicant has taken no depositions, and only one other deposition of a ServiceMaster employee has been noticed.³ Clearly Applicant is engaging in a discovery tactic intended for harassment and warranting a protective order. *See Salter v. Upjohn Co*, 593 F.2d 649 (5th Cir. 1979)(issuing a protective order to stop the deposition of an executive where the noticing party had not proceeded with the deposition of other employees whom the movant had offered as those with knowledge of the relevant facts).

Additionally, Applicant can make no showing that Opposer’s top executive, CEO Ward, has unique or specialized knowledge of the relevant facts. Mr. Engel, Chief Marketing Officer of The ServiceMaster Company, has personal knowledge of the facts set forth in his Declaration

² Ms. Campbell and Mr. Colber were identified in response to Applicant’s interrogatories. Mr. Colber is no longer employed by Opposer. Mr. Engel’s deposition has been noticed for late September.

³ In contrast, Applicant has deposed the General Manager, Vice-President, and a Rule 30(b)(6) representative of UGI HVAC Enterprises, Inc., the appropriate subsidiary of UGI Corporation.

attached hereto as Exhibit C. In his Declaration, Mr. Engel states that the named deponent, CEO Ward, does not possess unique or superior knowledge of the (1) the ownership of federal registrations and common law rights in the SERVICEMASTER marks, (2) The ServiceMaster Company's enforcement of its exclusive rights to use the SERVICEMASTER marks; (3) the goods and services offered by The ServiceMaster Company under the SERVICEMASTER marks; (4) the marketing or advertising of goods and services under the SERVICEMASTER marks; or (5) the channels of trade and the intended consumers for the goods and services offered under the SERVICEMASTER marks. *See* Engel Decl. attached as Exhibit C. Accordingly, Applicant should be required to proceed with the deposition of Mr. Engel or Ms. Campbell or a Rule 30(b)(6) witness, before seeking to harass Opposer's highest-ranking executive.

CONCLUSION

Both the Federal Rules of Civil Procedure and the Trademark Rules of Practice vest in the Board discretion to grant a protective order in order to manage the discovery procedures available to the parties and prevent abuse of those procedures. The supporting Declaration of Mr. Engel constitutes particular and specific evidence that CEO Ward is not an appropriate deponent, and that Opposer therefore is entitled to a protective order under the applicable legal test.

If, in this case, the Board finds that after taking all other depositions, Applicant is still not satisfied with the information obtained, and Applicant then properly re-notices the deposition of Chairman and CEO Ward, this issue may be entertained by the Board at a later time. The courts and the Board have held this to be an appropriate method for proceeding.

Opposer's counsel states, under penalty of perjury under the laws of the United States, that he has made a good faith effort to resolve the issues presented in this motion and has been

unable to reach an agreement with Applicant's counsel prior to resorting to the Board pursuant to Trademark Rule 2.120(f).

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

Date: September 10, 2004

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **OPPOSER'S MOTION FOR PROTECTIVE ORDER TO PREVENT DISCOVERY DEPOSITION OF JONATHAN P. WARD** was served on counsel for Applicant, this 10th day of September, 2004, by sending same via First Class mail, postage prepaid, to:

Barbara L. Delaney, Esquire
Vincent V. Carissimi, 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 JONATHAN P. WARD

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 Jonathan P. Ward, Chairman and Chief Executive Officer of The ServiceMaster Company ("Opposer/Petitioner").

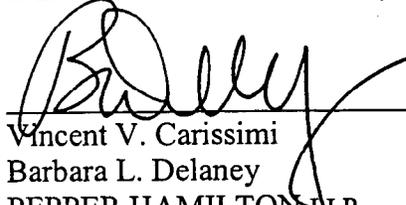
The deposition will begin at 10:00 a.m. on September 23, 2004, at the law offices of Lord, Bissell & Brook, 115 S. LaSalle Street, Chicago, Illinois 60603, or at such other place as may be agreed upon in writing by counsel for the parties. This deposition will be conducted before an officer authorized 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.

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

Dated: August 16, 2004

Respectfully submitted,

UGI HVAC ENTERPRISES, INC.

A handwritten signature in black ink, appearing to read "Carissimi", is written over a horizontal line.

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

Attorneys for Applicant/Respondent

CERTIFICATE OF SERVICE

I, Barbara L. Delaney, counsel for Applicant/Respondent UGI HVAC Enterprises, Inc., hereby certify that on August 16, 2004, I caused a true and correct copy of the foregoing Notice of Deposition of Jonathan P. Ward to be served via facsimile and Federal Express to:

P. Jay Hines, Esquire
Oblon, Spivak, McClelland, Maier
& Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314
*Counsel for Opposer,,
The Servicemaster Company*

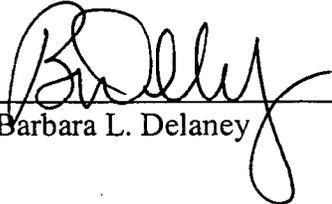
By: 
Barbara L. Delaney

EXHIBIT B

Pepper Hamilton LLP
Attorneys at Law

DT
2004

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

Barbara L. Delaney
215-981-4632
delaneyb@pepperlaw.com

August 30, 2004

VIA FACSIMILE AND FIRST CLASS MAIL

SEP 01 2004

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

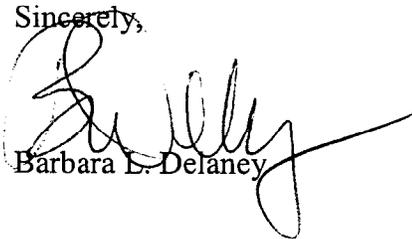
Re: The ServiceMaster Company v. UGI HVAC Enterprises, Inc.
Opposition Nos. 152,104 & 125,743; Cancellation No. 41,147

Dear Jay:

I am writing in response to your request that ServiceMaster be permitted to substitute another individual in place of Jonathan P. Ward for the deposition currently noticed for September 23, 2004. Based on a review of relevant documents, it appears that Mr. Ward possesses unique personal knowledge of matters relevant to issues in this dispute and that he has issued highly pertinent statements, the meaning and effect of which cannot be adequately explained by other potential deponents. Therefore, we cannot agree to substitute another individual in place of Mr. Ward. However, we are willing to make any arrangements necessary to accommodate his busy schedule, including rescheduling the time and date of his deposition.

If you have any questions, please feel free to contact me.

Sincerely,



Barbara L. Delaney

EXHIBIT C

- c. The goods and services offered by The ServiceMaster Company under the SERVICEMASTER marks;
 - d. The ServiceMaster Company's marketing and advertisement of goods and services under the SERVICEMASTER marks; and
 - e. The channels of trade and the intended consumers for the ServiceMaster Company's goods and services offered under the SERVICEMASTER marks.
5. I believe that there are other persons with equal or greater knowledge of the information identified above and I do not believe that Chairman and CEO Jonathan P. Ward has unique or superior knowledge of the information identified above.

I declare under penalty of perjury under the laws of the United States that the foregoing is true to the best of my knowledge, information and belief.

Date: 9/8/04

By: 
Mitchell T. Engel
Chief Marketing Officer
The ServiceMaster Company

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **DECLARATION OF MITCHELL T. ENGEL** was served on counsel for Applicant, this 3rd day of September, 2004, by sending same via First Class mail, postage prepaid, to:

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