

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

\_\_\_\_\_)  
 TRUGREEN LIMITED PARTNERSHIP, )  
 )  
 Opposer, )  
 )  
 v. )  
 )  
 UNITED INDUSTRIES CORP., )  
 )  
 Applicant. )  
 \_\_\_\_\_)

Opposition No.: 91154132  
Appln. Serial No. 75/829,745



02-19-2004

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

Honorable Commissioner of Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

**MOTION TO COMPEL**

Opposer, TruGreen Limited Partnership, by and through its undersigned counsel, hereby moves the Board for an order pursuant to Trademark Rule 2.120(e) directing Applicant to answer Opposer's First Set of Interrogatories to Applicant and to produce the documents requested in the Opposer's First Request for Production of Documents and Things. Copies of the Interrogatory and Document Requests are attached as Exhibit 1.

Opposer served the subject discovery on May 30, 2003. As the parties entered into settlement negotiations shortly thereafter, Opposer consented to extensions of time, both for Applicant's Answer to the Amended Notice of Opposition and to the outstanding written discovery request. On July 23, 2003, Opposer presented an outline of terms for resolution and, at the same time, granted further extensions. Please see the copy of correspondence dated July 23, 2003, attached as Exhibit 2.

On the basis of a statement that a response to Opposer's proposal was forthcoming, a further 30-day extension of time was granted on September 17, 2003. On October 17, 2003, Applicant filed its Answer to Opposer's Amended Notice of Opposition. By telephone conference of October 21, 2003, counsel for Opposer inquired about the status of negotiations. Counsel for Applicant indicated that there were some problems with the proposed terms but that Applicant would respond to the proposal. A further extension of discovery and trial dates was agreed to by counsel for Applicant on November 10, 2003.

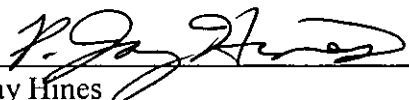
On December 30, 2003, counsel for Applicant indicated that discovery responses were being prepared and consented to a further extension of discovery and trial dates. He also indicated that Applicant had a change of heart and wished to defend its application. On January 15, 2004, counsel for Opposer, in an effort to advance the prosecution of the Opposition, wrote to counsel for Applicant giving them 15 additional days to respond to the outstanding written discovery. A copy of the letter of January 15, 2004 is enclosed as Exhibit 3.

The outstanding written discovery requests remain totally unaddressed. Accordingly, at this stage, Opposer has no recourse but to call upon the powers of the Trademark Trial and Appeal Board to compel Applicant's answers to the outstanding interrogatories and document requests.

In light of the foregoing, Opposer, through its undersigned counsel, hereby moves the Board for an Order pursuant to Trademark Rule 2.120(e) compelling Applicant to answer the outstanding interrogatories and produce the documents requested.

Respectfully submitted,

TRUGREEN LIMITED PARTNERSHIP

By:   
P. Jay Hines  
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](mailto:tmdocket@oblon.com)

Date: February 19, 2004  
PJH/lcd {E:\atty\PJH\ServiceMaster\TruGreen\3165-228489US-mot.doc}

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **MOTION TO COMPEL** was served on counsel for Applicant, this 19th day of February, 2004, by sending same via First Class mail, postage prepaid, to:

Andrew B. Mayfield, Esquire  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740

  
\_\_\_\_\_

# **EXHIBIT 1**

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

TruGreen Limited Partnership,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. <u>91/154,132</u>
	)	Mark: TURF GREEN
United Industries Corp.,	)	Appln. Serial No. 75/829,745
	)	
Applicant.	)	
	)	

**OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT**

Now comes Opposer, TruGreen Limited Partnership (hereinafter "Opposer"), and serves the following interrogatories under Rule 33, Fed. R. Civ. P., and Rules 2.116 and 2.120 of the Trademark Rules of Practice, to be answered separately and fully in writing under oath by Applicant, United Industries Corp. (hereafter "Applicant"). Each separately numbered or lettered sub-part of each interrogatory requires a separate answer thereto. Furthermore, these interrogatories shall be deemed to be continuing to the fullest extent permitted by the Rules and Applicant shall provide Opposer with any supplemental answers and additional information that are requested herein which shall become available to Applicant at a later date.

**DEFINITIONS AND INSTRUCTIONS**

The following interrogatories and requests are subject to the definitions set forth below:

- A. The term "document" shall be construed in its broadest permissible sense under Rule 34, Fed. R. Civ. P., and shall include, but is not limited to, the original and any non-identical copy (whether different from the original because of notes made on said copy or otherwise) of any


INTERROGATORY NO. 14

Identify each and every person known by Applicant to have supplied information for or participated in responding to these interrogatories and Opposer's First Requests for Production of Documents to Applicant.

Respectfully submitted,

TRUGREEN LIMITED PARTNERSHIP

By:

  
\_\_\_\_\_  
P. Jay Hines  
OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314  
(703) 413-3000  
fax: (703) 413-2220  
Attorneys for Opposer

Date: May 30, 2003

PJH/cds/lcd {I:\atty\PJH\31650228489us-int.wpd}

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT** was served on counsel for Applicant, this 30<sup>th</sup> day of May, 2003, by sending same, postage prepaid to:

Andrew B. Mayfield  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740

Rinda D. Collins



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

TruGreen Limited Partnership,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. <u>91/154,132</u>
	)	Mark: TURF GREEN
United Industries Corp.,	)	Appln. Serial No. 75/829,745
	)	
Applicant.	)	
	)	

**OPPOSER'S FIRST REQUEST FOR**  
**PRODUCTION OF DOCUMENTS AND THINGS**

Opposer, TruGreen Limited Partnership, by and through its attorneys, hereby requests, pursuant to Rule 34 of the Federal Rules of Civil Procedure and Sections 2.116 and 2.120 of the Trademark Rules of Practice of the Patent and Trademark Office, that Applicant, United Industries Corp., produce the documents listed below for inspection and copying, and that said production be made within thirty (30) days following the date of service of this Request upon Applicant, at the offices of Oblon, Spivak, McClelland, Maier & Neustadt, P.C., 1940 Duke Street, Alexandria, Virginia 22314.

**DEFINITIONS AND INSTRUCTIONS**

The definitions and instructions contained in Opposer's First Set of Interrogatories to Applicant (the "interrogatories") are incorporated herein by reference.

With respect to any document requested below for which a claim of privilege or work product is made, indicate the nature of the document; identify by name, address, title and business

18. All documents in the custody, control or possession of Applicant which contain any of Opposer's mark or which relate or refer in any way to any of Opposer's products and/or services under Opposer's mark.


19. All licenses granted by Applicant to any person to use TURF GREEN in connection with any product or service, including all amendments or modifications to any such licenses, and all documents relating or referring to any such license and/or amendments or modifications thereto.

20. All documents, not otherwise requested, and identified in response to the interrogatories.

Respectfully submitted,

TruGreen Limited Partnership

By:

  
\_\_\_\_\_

P. Jay Hines  
OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314  
(703) 413-3000  
fax: (703) 413-2220  
Attorneys for Opposer

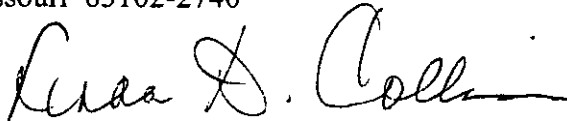
Date: May 30, 2003

PJH/cds/lcd {I:\ATTY\PJH\3165-228489US-PRO.DOC}

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **OPPOSER'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS** was served on counsel for Applicant, this 30<sup>th</sup> day of May, 2003, by sending same, postage prepaid to:

Andrew B. Mayfield  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740



# **EXHIBIT 2**

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

1940 Duke Street  
Alexandria, Virginia 22314

Telephone: (703) 413-3000

Facsimile: (703) 413-2220

**FACSIMILE TRANSMISSION**

**PLEASE DELIVER TO:**

Andrew B. Mayfield, Esquire  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740

**FACSIMILE NO.:** (314) 621-5065

**FROM:** P. Jay Hines

**DATE:** July 23, 2003

**OUR REF.:** 228489US-36

**NUMBER OF PAGES INCLUDING COVER LETTER:**  3

**IF YOU DO NOT RECEIVE ALL OF THE PAGES, PLEASE CONTACT THE TRADEMARK GROUP AT (703) 413-3000 OR FAX INFORMATION REGARDING MISSING PAGES TO (703) 413-2220.**

This facsimile may contain **PRIVILEGED AND CONFIDENTIAL** information intended only for the use of the addressee(s) named above. If you are not the intended recipient of this facsimile, or the employee or agent responsible for delivering it to the intended recipient, you are hereby notified that any dissemination or copying of this facsimile is strictly prohibited. If you have received this facsimile in error, please immediately notify the originating attorney above by telephone (collect call if necessary) and return the original facsimile to us at the above address via the U.S. Mail. Thank you.

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July 23, 2003  
VIA FACSIMILE

Andrew B. Mayfield, Esquire  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740

ATTORNEYS AT LAW

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

Re: TruGreen Limited Partnership v. United Industries Corp.  
Opposition No. 91/154,132  
Mark: TURF GREEN  
Our Ref: 228489US-3165-9932-36

Dear Mr. Mayfield:

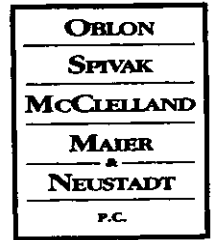
As you may know, Louis Laderman recently alerted us to a conflict due to a hiring of this firm in connection with an unrelated patent interference. Both parties have executed waivers of the conflict. However, in order to avoid any appearance of impropriety, we agreed to work only with outside counsel for United Industries Corp. and not have further discussions directly with Mr. Laderman.

We are in receipt of the Board Order of July 9, 2003 resuming the proceedings and allowing United Industries Corp. 40 days to answer the amended Notice of Opposition. It was not necessarily our intent to resume the proceedings. Accordingly, we are amenable to an extension of the present due date if you so request. The same is true with respect to a deadline for responding to the outstanding discovery requests.

In the meantime, we have received further instructions from our client. Set forth below are the main terms that our client would like to see in a coexistence agreement:

1. United Industries Corp. acknowledges TruGreen's ownership and right to use the TRUGREEN name and mark and recognizes the validity of U.S. Registration No. 2,543,094;
2. United Industries Corp. agrees not to contest or assist others in contesting TruGreen's ownership and right to use and register the TRUGREEN mark;

Andrew B. Mayfield, Esquire  
228489US-3165-9932-36  
Page 2



3. United Industries Corp. agrees to amend the identification of goods in pending application Serial No. 75/829,745 from "fertilizers for professional use" to "fertilizers for use by professional landscape companies";
4. United Industries Corp. agrees to always use the mark TURF GREEN as a secondary mark in conjunction with the mark BANDINI or the mark BANDINI PRO-CHOICE;
5. United Industries Corp. agrees not to apply the mark to goods directly for sale or distribution to residential customers;
6. United Industries Corp. agrees to limit its use of the mark TURF GREEN to the following western states: California, Oregon, Washington, Idaho, Nevada, Utah, Arizona, New Mexico, Colorado, Wyoming and Montana;
7. TruGreen, in return, will agree to withdraw Opposition Proceeding No. 154,132 without prejudice and, if necessary, with the consent of United Industries Corp.

Please consider the proposed terms for coexistence and let us have your reply in due course. We will be happy to provide a draft formal agreement for review.

With best regards,

Sincerely yours,

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



P. Jay Hines

PJH/cds (I:\ATTY\PJH\3165-228489US-LT2.DOC)

cc: Ms. Sherry Campbell

# **EXHIBIT 3**





January 15, 2004

Andrew B. Mayfield, Esquire  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740

ATTORNEYS AT LAW

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

Re: *TruGreen Limited Partnership v. United Industries Corp.*  
Opposition No. 91/154,132  
Mark: TURF GREEN  
Our Ref: 228489US-3165-9932-36

Dear Andy:

In our telephone conference of December 30, 2003, you indicated that you were preparing responses to the outstanding written discovery in this matter.

In order that we can consider follow up discovery, we ask that we receive those responses no later than **January 30, 2004**.

Sincerely yours,

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

P. Jay Hines

PJH/cds {I:\ATTY\PJH\244183-228489US-LT4.DOC}

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

_____	)	
TRUGREEN LIMITED PARTNERSHIP,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No.: 91154132
	)	Appln. Serial No. 75/829,745
UNITED INDUSTRIES CORP.,	)	
	)	
Applicant.	)	
_____	)	

Honorable Commissioner of Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

**DECLARATION OF P. JAY HINES**

Under penalty of perjury, pursuant to the laws of the United States, the undersigned declares that the following is, to the best of his knowledge, true and correct:

1. I am counsel to TruGreen Limited Partnership, the Opposer in the captioned proceeding.
  
2. On May 30, 2003, I served counsel for Applicant Opposer's First Set of Interrogatories to Applicant and Opposer's First Request for Production of Documents and Things, copies of which are attached to Opposer's Motion to Compel.


3. On July 23, 2003, I presented an outline of terms for resolution and at the same time granted further extensions; a copy of the letter of July 23, 2003 is attached to Opposer's Motion to Compel.
4. On September 17, 2003, Opposer consented to a further 30-day extension of time to answer the Amended Notice of Opposition. Counsel for Applicant indicated that there were some problems with the proposal but that a letter in response would be forthcoming.
5. On October 21, 2003, counsel for Applicant indicated that he would speak further with his client and respond to the proposal. An extension of discovery and trial dates was agreed to on November 10, 2003.
6. In a telephone conference between counsel on December 30, 2003, counsel for Applicant indicated that Applicant had a change of heart and wished to defend its application. He further indicated that discovery responses were being prepared and also consented to a further extension of the discovery and trial dates.

7. On January 15, 2004, I wrote to counsel for Applicant giving them 15 additional days to respond to the outstanding written discovery. A copy of the January 15, 2004 correspondence is attached to Opposer's Motion to Compel.

Respectfully submitted,

TRUGREEN LIMITED PARTNERSHIP

By: \_\_\_\_\_

  
P. Jay Hines  
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: February 19, 2004  
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