UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: April 3, 2009

Opposition No. 91182064

AS Holdings, Inc.

v.

H & C Milcor, Inc., f/k/a
Aquatico of Texas, Inc.

George C. Pologeorgis, Interlocutory Attorney:

This case now comes up for consideration of opposer's motion (filed September 30, 2008) requesting a correction of the Board's September 29, 2008 which granted opposer's motion for an extension of discovery and subsequent disclosure and trial dates. The motion is fully briefed.

The Board, in its discretion, suggested that the issues raised in the aforementioned motion should be resolved by telephonic conference as permitted by TBMP § 502.06 (2nd ed. rev. 2004). The Board contacted the parties to discuss the date and time for holding the phone conference.

The parties agreed to hold a telephone conference at 2:30 p.m., Eastern Time on Thursday, April 2, 2009. The conference was held as scheduled among Terence J. Linn, as counsel for opposer, Dillis V. Allen, as counsel for

applicant, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

The Board carefully considered the arguments raised by the parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

Opposer's Motion for Correction of Board's September 29, 2008 Order

Opposer's motion requesting correction of the Board's September 29, 2008 order is **denied** for the reasons set forth below.

As background, the Board's January 24, 2008 institution order set the deadline for expert disclosures for August 31, 2008 and the close of discovery for September 30, 2008. On September 29, 2008, opposer filed a consented motion via the Board's ESTTA filing system to extend discovery and subsequent dates for sixty days. On September 29, 2008, the Board issued a computer-generated order which granted opposer's consented motion to extend by not only extending

the close of discovery and subsequent trial dates but by also resetting the deadline for expert disclosures.[1]

In support of its motion, opposer contends that when it filed its consented motion to extend it was not the parties' intention to reset the expert disclosure deadline inasmuch as the expert disclosure deadline had already expired when opposer's consented motion was filed. In view thereof, opposer argues that its computerized consented motion generated by the Board's ESTTA filing system and the subsequent computer-generated Board order granting the motion, which included the resetting of the expert disclosure deadline, were erroneously issued.

In response, applicant argues that it would be prejudiced if the Board corrected its September 29, 2008 order to exclude the reset date for the expert disclosure deadline inasmuch as applicant relied on the reset date when it served its expert disclosures upon opposer on October 3, 2008, a date prior to the reset deadline for expert disclosure set forth in the Board's September 29, 2008 order.

When parties seek to extend the close of discovery by thirty days or more, as is the case here, the Board will

[1] In light of the Board's September 29, 2008 order granting opposer's September 29, 2008 consented motion to extend, applicant's motion to extend filed on September 29, 2008 is deemed moot and will be given no further consideration.

automatically reset the previous deadline, i.e., the expert disclosure deadline, despite the fact that the expert disclosure deadline may have already expired when the parties filed their motion to extend the close of discovery. The reason is that the expert disclosure deadline is set in tandem with the deadline for taking discovery inasmuch as a party is entitled to disclose its plan to use an expert no later than thirty days prior to the close of discovery. *See* "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 72 Fed. Reg. 42242, 42244-46 (Aug. 1, 2007).

Accordingly, opposer's motion for correction is **denied** and the Board's September 29, 2008 order stands as issued.

During the telephone conference, the Board also noted that the expert disclosure served upon opposer by applicant on October 3, 2008 and a copy of which was filed with the Board on October 6, 2008 is insufficient under Fed. R. Civ. P. 26(a)(2)(B), made applicable to Board proceedings by Trademark Rule 2.120(a)(2), inasmuch as the expert disclosure only identifies the names and addresses of the three experts applicant intends to use, but fails to include the required written report from each identified expert as contemplated under Fed. R. Civ. P. 26(a)(2)(B).

In view thereof, applicant is allowed **thirty days** from the mailing date of this order in which to serve upon opposer a supplemental expert disclosure which includes a written

report, as set forth in Fed. R. Civ. P. 26(a)(2(B), for each expert identified in applicant's initially served expert disclosure, failing which applicant's expert disclosure as originally served will be deemed insufficient and applicant will be precluded from introducing expert testimony at trial.

To the extent that applicant does supplement its expert disclosure by serving the required report for each or any identified expert as ordered herein within the time set forth above, the Board notes that opposer would then be entitled to take discovery limited solely to the experts identified by applicant and the proceedings herein will be suspended pending the completion of such limited expert discovery. *See* "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 72 Fed. Reg. 42242, 42246 (Aug. 1, 2007).

Accordingly, in the event applicant does supplement its expert disclosure as ordered above, the parties must file, within **fifteen (15) days** from the date of service of applicant's supplemental expert disclosure upon opposer, a stipulation with the Board requesting suspension of the proceedings so that opposer may take limited discovery solely concerning applicant's identified experts. Discovery is otherwise closed in this case. Moreover, the stipulation should include the amount of time required by opposer to conduct limited discovery regarding the experts identified by applicant.

Notwithstanding the foregoing, proceedings herein are resumed and the trial schedule for this proceeding is reset, beginning with the close of opposer's testimony period, as follows:

Plaintiff's 30-day Trial Period Ends	**6/30/2009**
Defendant's Pretrial Disclosures	**7/15/2009**
Defendant's 30-day Trial Period Ends	**8/29/2009**
Plaintiff's Rebuttal Disclosures	**9/13/2009**
Plaintiff's 15-day Rebuttal Period Ends	**10/13/2009**

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to

supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address: http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm