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

Mailed: August 24, 2011

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 before the Board for consideration of applicant's motion (filed January 24, 2011) for reconsideration of the Board's December 20, 2010 order, as well as a request that its motion for reconsideration should be entertained by an administrative trademark judge rather than the interlocutory attorney who authored the Board's December 20, 2010 order. The motion is fully briefed.

We first turn applicant's request that an administrative trademark judge entertain its request for reconsideration of the Board's December 20, 2010 order. Applicant's request is denied for the reasons set forth below.

An interlocutory motion, request, or other matter which is not actually or potentially dispositive of a proceeding, may be acted upon by a single Board judge, or by a Board

attorney to whom authority so to act has been delegated. *See* Trademark Rule 2.127(c); *see also* TBMP § 502.04. When a single Board judge, or a single duly authorized attorney, has acted upon an interlocutory motion, request, or other matter not actually or potentially dispositive of the proceeding, and one or more of the parties is dissatisfied with the action, the dissatisfied party or parties may seek review thereof by requesting, under 37 CFR § 2.127(b), the same single Board judge, or the same single attorney, to reconsider the action, and/or by filing a petition to the Director for review of the decision under 37 CFR § 2.146(e)(2) (*see* TBMP § 905). A request that the action of the single Board judge, or single attorney, be reviewed by one or more (other) judges of the Board is improper and will be denied.

In this instance, the Board notes that opposer's motion to strike, the disposition of which was rendered by the Board's December 20, 2010 order, was an interlocutory motion that was not actually or potentially dispositive of this case.

In view of thereof and since applicant has not demonstrated extraordinary circumstances to warrant its request, applicant's request that an administrative trademark judge entertain its motion for reconsideration instead of the assigned interlocutory attorney who issued the Board's December 20, 2010 order under his signature, as duly authorized to do so, is **denied** as improper.

We now turn to the merits of applicant's motion for reconsideration.

As background, on December 20, 2010, the Board granted, in part, opposer's motion to strike certain exhibits and appendixes to exhibits introduced during the testimony deposition of two of applicant's witnesses, as well as testimony related thereto. In striking these exhibits/appendixes and related testimony, the Board found, with the exception of Exhibit 16 as discussed below, that these exhibits/appendixes were responsive to opposer's Document Request No. 21 which requested "all documents and things referring or relating to third-party use of applicant's mark" but were not produced by applicant during discovery.

The stricken exhibits were as follows:

> Exhibit 16 – two photographs of an embossing tool owned by applicant used to make the lettering "BFDF EPDM" on applicant's pipe boot mark.
>
> Appendix Nos. 23 and 25 of Exhibit 20 consisting of a fax transmission from a third-party to applicant and a letter from applicant to a third-party concerning specifications of applicant's mark, as used by a third-party.
>
> Appendix Nos. 26 and 33-36 of applicant's Exhibit 21 consisting of (1) a specification sheet of applicant's pipe boot mark as used by a third-party reviewed by one of applicant's employees, (2) a plurality of emails between applicant and a third-party relating to specifications of applicant's pipe boot mark as used by a third party, and (3) a letter from applicant's employee to a third party regarding a distribution binder and samples concerning applicant's involved pipe boot mark.

In support of its motion for reconsideration, applicant argues that it objected to opposer's Document Request No. 21

on the grounds it was too broad. Applicant further maintains that opposer never filed a motion to compel documents responsive to opposer's Document Request No. 21 to obtain more documents than the ones produced and, therefore, opposer is barred from relying on applicant's failure to produce the exhibits/appendixes at issue during discovery. Applicant further contends that the Board's December 20, 2010 decision provides no reasons for striking the exhibits although the Board did provide the reasons for striking them during the telephonic hearing on the motion held on December 20, 2010. Applicant also argues that the Board apparently did not know about applicant's objections to opposer's Document request No. 21 until the telephonic hearing on the motion when applicant's counsel apprised the Board of applicant's objection. Additionally, applicant maintains that the exhibits/appendixes at issue were introduced to show that applicant's mark and the specifications therefor, as used by a third-party, originated from and/or were authored by applicant and to preclude their introduction into evidence would prejudice applicant and its defense in this matter.

Generally, the premise underlying a request for reconsideration under Trademark Rule 2.127(b) is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. *See* TBMP § 518 (3d ed. 2011) and authorities cited therein. The request

normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate changes. *See Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005)(reconsideration denied because Board did not err in considering disputed evidence).

We find no error in our December 20, 2010 decision. We first note that in issuing its December 20, 2010 decision, the Board took into consideration all arguments raised by counsel during the telephonic conference on opposer's motion to strike, including applicant's appraisal of its objection to opposer's Document Request No. 21, as well as the supporting correspondence and the record of the case, in coming to a determination regarding the merits of opposer's motion. Moreover, the Board, during the telephonic conference on the motion, did apprise the parties as to the reasons for its decision, as conceded by applicant.

With regard to Exhibit 16, applicant's counsel advised, during the Board's December 20, 2010 telephone conference, that the two photographs were taken by applicant's counsel a few days before the designated testimony depositions. In striking the exhibit, the Board found that applicant could not create evidence during its own testimony period and then attempt to introduce such evidence during its assigned testimony without having provided prior notice of such

evidence to opposer and which may have been potentially responsive to opposer's discovery requests.

With regard to the remaining stricken exhibits/appendixes, these documents clearly, on their face, refer or relate to a third party's use of applicant's pipe boot mark. More significantly, applicant seeks to introduce these exhibits/appendixes to demonstrate that applicant's involved pipe boot mark and specifications therefor, as used by a third party, originated from applicant. For applicant now to complain that these exhibits/appendixes should not be stricken because opposer never sought to compel production of these responsive documents is unavailing. Applicant was under a duty to provide full responses to opposer's document requests, notwithstanding its objections thereto. Applicant cannot discriminately pick and choose documents which it believed to be responsive and produce them during discovery while withhold other responsive documents and then attempt to introduce such withheld documents into evidence during its testimony period without having provided any prior notice to opposer that these responsive documents exist.

In view of the foregoing, applicant's motion for reconsideration is denied. The Board's December 20, 2010 order stands as issued.

During the course of the December 20, 2010 telephone conference, opposer's counsel advised that opposer would not

pursue rebuttal testimony. Accordingly, proceedings herein are resumed and the case will proceed to final briefing upon the schedule set forth below:

Opposer's brief due:	**October 24, 2011**
Applicant's brief due	**November 23, 2011**
Opposer's reply brief, if filed, due:	**December 8, 2011**

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.[1]

[1] As a reminder, in each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of taking of testimony. Trademark Rule 2.125. Moreover, all trial testimony depositions that are taken in a Board *inter partes* proceeding must be filed with the Board, and, when filed, automatically constitute part of the evidentiary record in the proceeding. The Board will accept transcripts of testimony depositions at any time prior to the submission of the case for final decision.