UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: September 3, 2014

Opposition No. 91212861

Fairmont Holdings, Inc.

v.

Bacardi & Company Limited

George C. Pologeorgis,
Interlocutory Attorney:

This opposition proceeding now comes before the Board for consideration of Opposer's emergency motion (filed September 2, 2014) for a protective order. Applicant filed a response to Opposer's motion on September 3, 2014.

In support of its motion, Opposer maintains that Applicant has scheduled the discovery depositions of certain corporate representatives of Opposer for the week of September 2, 2014. Opposer further contends that, in preparation for the discovery depositions, Opposer became aware of alleged instances of infringement by Applicant of Opposer's registered and common law trademarks in the United States, in addition to other acts constituting unfair and deceptive trade practices. In view thereof, Opposer maintains that it will be immediately filing a federal court proceeding for an injunction, for infringement, for unfair and deceptive trade practices, among other causes of action. Opposer further contends that the federal court proceeding

would address and likely resolve all matters in this case. Opposer argues that, in light of the recent events prompting Opposer's imminent federal court proceeding, it would be unduly burdensome and expensive to proceed with the depositions at this time and, therefore, requests that the Board grant its motion for a protective order.

Decision

On motion pursuant to Trademark Rule 2.120(f), showing good cause, by a party from which discovery is sought, the Board may issue any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense. TBMP § 412.01 (2014).

Under the circumstances of this case, the Board finds Opposer's request for a protective order unwarranted for the reasons set forth below.

On the eve of discovery depositions properly noticed a month ago, and arrangements already in place to proceed with the depositions, Opposer now moves for a protective order barring the depositions from proceeding because Opposer intends to file a federal court action that allegedly concerns the issues in this proceeding. The foregoing reasons are insufficient to avoid Opposer's discovery obligations in this proceeding inasmuch as the federal court action has yet to be filed and where Applicant has already expended time and resources in preparing for the depositions. Based upon the foregoing, the Board finds no exigent circumstances to warrant the cessation of discovery in this case.

In view of the foregoing, Opposer's emergency motion for a protective order is **DENIED**.[1]

Trial dates remain as reset by the Board's June 19, 2014, order.[2]

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[1] Once Opposer does file its federal district court action, Opposer may then file a motion to suspend this proceeding pending the final disposition of the civil action for the Board's review, including a copy of the civil action complaint.

[2] In light of this order, Applicant's request for a telephone conference regarding the merits of Opposer's motion for a protective order is deemed moot and will be given no further consideration. Furthermore, Applicant's request that (1) the Board enter undefined sanctions against Opposer in light of the burden and expense placed on Applicant in preparing a response to Opposer's "emergency" motion, and (2) Opposer be required to conduct a telephone conference with Applicant and the assigned interlocutory attorney to this case before it files any further motions in this matter is **DENIED**.