

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

Mailed: January 2, 2009

Opposition No. 91177036

Nationstar Mortgage LLC

v.

Mjuahid Ahmad

**Robert H. Coggins,
Interlocutory Attorney:**

This case now comes up for consideration of applicant's motion (filed January 31, 2008) to compel discovery. After suspending proceedings and determining cross-motions for summary judgment and applicant's motion to amend the filing basis of the involved application, the Board allowed opposer time in which to file a brief in opposition to the motion to compel. Opposer filed its brief in opposition on July 2, 2008. Applicant filed no brief in reply.

Motion to Compel

By way of the motion, applicant seeks a Board order compelling opposer to produce responsive documents for Document Request Nos. 4, 5, and 6, and failing such production compelling opposer to amend its response to Interrogatory No. 1.

As a preliminary matter, the Board finds that applicant has shown that he made a good faith effort, pursuant to Trademark Rule 2.120(e)(1), to resolve with opposer the

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outstanding discovery issues presented in the aforementioned motion prior to seeking Board intervention.

The issues in the motion to compel revolve around priority and opposer's first use of its mark.

Document Request No. 4

Document Request No. 4 seeks "documents from which it can be determined the date of first use by opposer" of the mark NATIONSTAR MORTGAGE. Applicant claims this request seeks documents from which the date "of first use in commerce" can be determined. However, the request makes no mention of use in commerce. Opposer's interpretation of the plain wording of the request that it seeks documents relating to opposer's "first use" and not opposer's "first use in commerce" is correct. Opposer need not respond further to Request No. 4.

Document Requests No. 5 and 6

Document Requests No. 5 and 6 seek advertisements, promotional material, and media references. Opposer states that it produced a representative sample of documents responsive to these requests concurrently with the filing of its brief in opposition to the motion to compel. Inasmuch as applicant filed no brief in reply or otherwise refuted opposer's statement of its production of documents, the motion to compel is moot with regard to these requests.

Interrogatory No. 1

Interrogatory No. 1 seeks information concerning opposer's first use in commerce of the NATIONSTAR MORTGAGE mark. Instead of providing the date of first use in commerce of the mark,

opposer answered this interrogatory by stating opposer's date of first use anywhere of the mark. The Board construes opposer's response to mean that opposer is not using its mark in commerce and does not rely on its use of the mark in commerce to claim priority in this proceeding. This is supported by opposer's statements in its brief in opposition to the motion that "opposer is not currently relying upon use in commerce to establish priority in this proceeding" (Opp. Br. p. 2) and "opposer is not currently alleging that it used [its mark] in commerce prior to the filing date of" the opposed application (Opp. Br. p. 3).

Further, the Board construes these statements and opposer's allegation in paragraph 18 of the notice of opposition that opposer "began making bona fide preparations to use" its mark to mean that opposer is relying on use analogous to trademark use to claim priority in this proceeding. See *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536 (TTAB 2007) (An opposer may attempt to establish priority by use analogous to trademark use regardless of how the adverse party seeks to establish priority). See also *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251 (TTAB 1995); and *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998). Under the theory of analogous use, a party may rely upon pre-sale activities in order to "tack on" non-trademark usage for purposes of establishing priority under Section 2(d). See 3 J. Thomas McCarthy on Trademarks and Unfair Competition, § 20:16 (4th Ed. 1996). However, the Board

makes no determination herein as to whether opposer's presumed use analogous to trademark use is sufficient to create a proprietary right in the user for purposes of a likelihood of confusion claim. That is an issue which remains to be proven at trial. Because opposer does not rely on its use in commerce for priority, opposer need not answer this interrogatory further.

Uncertainty on the issue of priority was brought on by opposer's lack of clarity in its pleading. However, now that the issue has been brought to light and time remains in the discovery period, applicant may take discovery on this issue should it so chose. For example, applicant may serve interrogatories or document requests concerning what type of use forms the basis of opposer's claim of priority, and concerning specific events that opposer believes support its claim of priority.

Duties of Parties

The parties are reminded that each has a duty to make a good faith effort to satisfy its adversary's discovery needs and to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. See TBMP § 408.01 (2d ed. rev. 2004). Furthermore, a party that has responded to a discovery request has a duty to supplement or correct that response. See Fed. R. Civ. P. 26(e). The parties are also reminded that, when a party, without substantial justification, fails to disclose information required, or fails to amend or supplement a

prior response, as required, that party may be prohibited from using as evidence the information not so disclosed. See Fed. R. Civ. P. 37(c)(1).

Resumption of Proceedings

Proceedings are resumed. The close of discover and trial dates are reset according to the schedule below.

Discovery period to close:	3/20/09
30-day testimony period for party in position of plaintiff to close:	6/18/09
30-day testimony period for party in position of defendant to close:	8/17/09
15-day rebuttal testimony period to close:	10/1/09

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 of completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 Fed. Reg. 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>