ESTTA Tracking number: **ESTTA333201**
Filing date: **02/19/2010**

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

Proceeding	91177036
Party	Plaintiff Nationstar Mortgage LLC
Correspondence Address	Bryce J. Maynard Buchanan Ingersoll & Rooney PC P. O. Box 1404 Alexandria, VA 22314 UNITED STATES bryce.maynard@bipc.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	S. Lloyd Smith
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Date	02/19/2010
Attachments	91177036MOTION.pdf (6 pages)(217714 bytes) 91177036EXHA.pdf (8 pages)(275109 bytes) 91177036EXHB.pdf (9 pages)(288527 bytes)

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

NATIONSTAR MORTGAGE LLC,	)	
	)	
Opposer,	)	
	)	Opposition No. 91177036
-v-	)	
	)	
MUJAHID AHMAD,	)	
	)	
Applicant.	)	
	)	
Attorney Docket No. 0055673-000033	)	
	)	

MOTION TO AMEND THE NOTICE OF OPPOSITION AND FOR A STAY OF OPPOSITION PENDING TTAB RULING

Pursuant to 37 C.F.R. § 2.107, Fed. R. Civ. P. 15(a), and TBMP §507.02, Opposer hereby moves to Amend the Notice of Opposition. A signed copy of the Amended Notice of Opposition ("Amended Notice") is attached hereto and herewith served on Applicant pursuant to TBMP § 507.01. Exhibit A. A redlined version of the Amended Notice of Opposition is attached hereto. Exhibit B. Opposer further moves for a stay of the Opposition pending disposition of this Motion.

Introduction

Opposer's original Notice of Opposition contained a count for "Invalid Application – No Use in Commerce" based on Applicant's original filing basis under Section 1(a) alleging actual use. Opposer's Amended Notice of Opposition substitutes a claim for "Invalid Application - Lack of a Bona Fide Intent to Use" because Applicant has amended its filing basis from Section 1(a) to Section1(b), pursuant to grant of the Board. In essence, Opposer's request is procedural

in order to conform the pleadings to the amended basis of the application at issue. There is no prejudice to Applicant.

ARGUMENT

A motion to amend a pleading in an *inter partes* proceeding before the Board is governed by Rule 15 of the Federal Rules of Civil Procedure. TBMP § 507.01. Rule 15(a) states:

> [A] party may amend the party's pleading . . . by leave of court . . .; and leave shall be freely given when justice so requires.

The TMBP confirms that the Board "liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." TBMP § 507.02. See *Commodore Electronics Ltd. V. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993) (quoting *American Optical Corp. v. American Olean Tile Co., Inc.*, 168 USPQ 471, 473 (TTAB 1971). See also, *Polaris Indus. V. DC Comics*, 59 USPQ2d 1798, 1799 (TTAB 2001). Opposer need not prove his case on this motion to amend nor prove a likelihood of success on the merits. Opposer need only satisfy the liberal pleading standards of Rule 12(b)(6) of the Federal Rules of Civil Procedure. "If the underlying facts or circumstances relied upon by a[n Opposer] may be a proper subject of relief, he ought to be afforded an opportunity to test his claims on the merits." *Foman v. Davis*, 331 U.S. 178, 182 (1962).

In the present case, the amendment is plainly in keeping with existing law, which recognizes that "the absence of any documentary evidence on the part of the applicant regarding [its claimed intent to use] is sufficient to prove the applicant lacks a bona fide intention to use its mark in commerce [at the time it filed its intent to use application] as required by Section 1(b)" of the Trademark Act, 15 USC 1051(b). *Commodore Electronics Ltd.*, 26 USPQ2d at 1507. See also *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009); *Boston Red Sox*

Baseball Club LP v. Sherman, 88 USPQ2d 1581 (TTAB 2008); *Lane Ltd. V. Int'l. Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994) ("applicant's mere statement of subjective intention, without more, would be insufficient to establish applicant's *bona fide* intention to use the mark in commerce"). Indeed, the facts here fall squarely within the decision issued by the Board in *Commodore Electronics Ltd.*

In *Commodore Electronics Ltd.*, the Opposer sought leave to amend its notice of opposition after it learned through discovery that the Applicant "did not have a single document to establish a bona fide intention to use [its mark] in commerce." 26 USPQ2d at 1504. Rejecting the Applicant's argument that such an allegation failed to state a claim upon which relief could be granted, the Board ruled that, in accord with an "objective good-faith test to establish that an applicant's intent is genuine," the Opposer stated a valid claim that would survive scrutiny under Rule 12(b)(6) of the Federal Rules of Civil Procedure. *Id.* at 1506-07. The Board held that if the Opposer could show that the Applicant possessed no documentary evidence of a *bona fide* intent to use, absent a compelling justification by the Applicant, the Opposer would succeed on its claim. *Id.* At 1507.

In the present case, justice requires granting of leave to amend in order to conform to Applicant's amended filing basis granted by the Board. The Board granted Applicant's Motion to amend its application from a use basis under Section 1(a) to an intent to use basis under Section 1(b) on June 17, 2008. Proceedings then remained suspended pending briefing and disposition of Applicant's Motion to Compel Discovery. Applicant's counsel withdrew. After the appointment of new counsel, Applicant's deposition was taken on May 27, 2009, at which time Opposer confirmed that Applicant possessed no documentary evidence of a *bona fide* intent to use. *See Commodore Electronics,* 26 USPQ2d at 1507. Opposer then filed a Motion for

Summary Judgment in August, 2009 on grounds of fraud. Issues concerning Opposer's Motion for Summary Judgment were not resolved until January 25, 2010. Now that the proceedings have resumed, Opposer has filed the subject Motion to Amend the Notice of Opposition. Under such circumstances, Opposer's Motion to Amend should be granted. See *Commodore Electronics*, 26 USPQ2d at 1505-06 (in light of the pendency of its summary judgment motion, which would have disposed of case, Opposer was justified in delaying filing of a motion to amend pending the Board's ruling).

Allowing Opposer to amend the Notice of Opposition in this case will not cause any prejudice to Applicant. Applicant can point to no prejudice resulting from the amendment, particularly where Opposer acted diligently in seeking such amendment within a reasonable time after the facts upon which this motion is based were brought to Opposer's attention and Opposer was awaiting a decision on its Motion for Summary Judgment. The mere passage of time is generally not considered prejudicial in the absence of some other facts, such as loss of potential witnesses. See, e.g., *HGK Indus. Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1157-58 (TTAB 1998). See also *Regatta Sport, Ltd. V. Telux-Pioneer, Inc.*, 20 USPQ2d 1154 (TTAB 1991) ("delay alone is not a sufficient basis for establishing prejudice").

Moreover, since the proposed amendment relates solely to Applicant's own actions and involves facts within his sole knowledge, there is no additional discovery required on his part or other undue burden imposed by the amendment. See *CashFlow Technologies v. NetDecide*, No. 30,3632002, TTAB LEXIS 147, at *6 (TTAB Feb. 7, 2002) ("respondent should not need much, if any, discovery" where amendment relates to respondent's own activity or inactivity). Furthermore, as the parties have already taken discovery on the issue of Applicant's bona fide

intent to use the NATIONSTAR mark in commerce, the reopening of the discovery period is unnecessary.

Conclusion

For the above stated reasons, Opposer respectfully requests that the Board issue an order entering the attached Amended Notice of Opposition, and that the Board stay the case pending disposition of this motion.

NATIONSTAR MORTGAGE, LLC.

By_____

Bassam N. Ibrahim
S. Lloyd Smith
Attorneys for Opposer
Buchanan Ingersoll, P.C.
P.O. Box 1404
Alexandria, VA 22313-1404
(703) 836-6620

Date: February 19, 2010

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **MOTION TO AMEND THE NOTICE OF OPPOSITION AND FOR A STAY OF OPPOSITION PENDING TTAB RULING, AND AMENDED NOTICE OF OPPOSITION** was served this 19th day of February, 2010 by first-class mail, postage prepaid, on:

PATRICK I. REA
TAYLOR & REA, PLC
3925 OLD LEE HWY STE 200
FAIRFAX, VA 22030
UNITED STATES

Jean Bayou

EXHIBIT A

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

RE: U.S. Trademark Application Serial No. 78/866,376
Published in the *Official Gazette* on January 2, 2007

NATIONSTAR MORTGAGE LLC,	)	
	)	
Opposer,	)	
	)	Opposition No. 91177036
-v-	)	
	)	
MUJAHID AHMAD,	)	
	)	
Applicant.	)	
	)	
Attorney Docket No. 0055673-000033	)	
	)	

AMENDED NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Commissioner:

In the matter of U.S. Trademark Application Serial No. 78/866,376, filed on April 20, 2006 by Mujahid Ahmad ("Applicant"), to register the mark NATIONSTAR ("Applicant's NATIONSTAR Mark") in connection with "real estate brokerage; rental of real estate; real estate management services, namely, management of commercial and residential properties; real estate investment; residential and commercial property and insurance brokerage; mortgage brokerage; and business

finance procurement services" in International Class 36 ("Applicant's Services"), and published in the *Official Gazette* on January 2, 2007, Nationstar Mortgage LLC ("Opposer") believes that it will be damaged by registration of Applicant's NATIONSTAR Mark and hereby opposes same. The grounds for this opposition are as follows:

1. Applicant is the record owner of Application Serial No. 78/866,376 for the mark NATIONSTAR for Applicant's Services.

2. Opposer is a limited liability company organized under the laws of the State of North Carolina, located and doing business at 2828 North Harwood Street, 11th Floor, Dallas, Texas 75201.

3. Opposer is the owner of U.S. Application Serial No. 78/872,148 for the mark NATIONSTAR MORTGAGE and Design and U.S. Application Serial No. 78/871,883 for the mark NATIONSTAR MORTGAGE, both of which cover "mortgage lending services" ("Opposer's Services"), and both of which were filed on April 28, 2006. These applications are hereinafter collectively referred to as "Opposer's NATIONSTAR MORTGAGE Marks."

Count I: Fraud In The Application

A. Fraudulent Allegation of Use in Commerce

4. Applicant's application contains the statements that "[t]he applicant ... is using the mark in commerce," and that "the mark was first used at least as early as 04/04/2005, and first used in commerce at least as early as 04/04/2005, and is now in use in such commerce." The application also contains a standard declaration as to the truth of applicant's statements in the application.

5. Upon information and belief, Applicant did not use Applicant's NATIONSTAR Mark in connection with Applicant's Services in commerce on or anytime prior to April 20, 2006, the filing date of Applicant's NATIONSTAR Mark. Upon information and belief, Applicant has not used Applicant's NATIONSTAR Mark in connection with Applicant's Services in interstate commerce in the United States.

6. Upon information and belief, the alleged April 4, 2005 dates of first use and first use in commerce listed by Applicant in Application Serial No. 78/866,376 are based on nothing more than Applicant's registration of the domain names "nationstarmortgage.com" and "nationstarmortgage.net."

7. Upon information and belief, any company or individual providing mortgage services must be registered in every state in which such services are offered. Upon information and belief, Applicant is not registered to provide mortgage services in any state. Therefore, any alleged use of the NATIONSTAR Mark in connection with Applicant's Services is fraudulent.

8. Upon information and belief, Applicant made the false statements as to the use of his mark in commerce and the first use dates of that mark with the intent to procure a registration to which Applicant was not entitled, and Applicant was successful in procuring favorable examination, allowance, and publication of the application.

9. Upon information and belief, Applicant's false statements were made knowingly. Applicant made knowing false statements as to the use of his mark in commerce and the first use dates of that mark with the intent to procure a registration to which Applicant was not entitled, and Applicant was successful in procuring favorable examination, allowance, and publication of the application.

B. Fraudulent Specimen of Use

10. Applicant did not file a specimen of use with the original application on April 20, 2006. After receiving an office action requiring submission of a specimen, Applicant submitted an alleged specimen of use on October 19, 2006. The alleged specimen consisted of a printout that displayed the NATIONSTAR MORTGAGE mark in connection with the alleged offering of mortgage services.[1] The response submitted on October 19, 2006 also contained a signed declaration stating that "the specimen was in use in commerce at least as early as the filing date of the application" and that statements in the declaration were true.

11. Upon information and belief, the alleged specimen of use filed on October 19, 2006 was not in use in commerce at least as early as April 20, 2006, the filing date of Application Serial No. 78/866,376.

12. Upon information and belief, Applicant made the false statements as to the use of the specimen with the intent to procure a registration to which Applicant was not entitled, and Applicant was successful in procuring favorable examination, allowance, and publication of the application.

13. Upon information and belief, Applicant's false statements were made knowingly. Applicant made knowing false statements as to the use of the specimen with the intent to procure a registration to which Applicant was not entitled, and Applicant was successful in procuring favorable examination, allowance, and publication of the application.

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1 Applicant's email address displayed twice in the specimen submitted to the Examiner contains the term and registered service mark "Realtor"®. Upon information and belief, Applicant is neither a Realtor ® agent, a member of the National Association of Realtors, nor licensed to use that registered mark.

Count II: Invalid Application - Lack of Bona Fide Intent to Use Mark in Commerce

14. Opposer repeats and realleges paragraphs 1 through 13 above.

15. Applicant's Application Serial No. 78/866,376 was filed and was approved and published based solely on alleged actual use of Applicant's NATIONSTAR Mark in commerce. Upon information and belief, Applicant had not made such use in commerce at any time prior to or on the filing date of the application and lacked the requisite bona fide intent to use Applicant's Mark on or in connection with Applicant's Services. Accordingly, Applicant's application is void and invalid for lack of a filing basis.

16. Upon information and belief, Applicant did not have a bona fide intention to use Applicant's Mark in commerce on Applicant's Goods when it filed Application Serial No. 78/866,376 for Applicant's Goods because Applicant does not have a single document to establish a bona fide intention to use Applicant's Mark in commerce on Applicant's Goods.

Count III: Likelihood of Confusion

17. Opposer repeats and realleges paragraphs 1 through 16 above.

18. Opposer began making bona fide preparations to use Opposer's NATIONSTAR MORTGAGE Marks in commerce prior to the April 20, 2006 filing date of Application Serial No. 78/866,376.

19. Opposer's counsel wrote to Applicant on April 11, 2006, offering to purchase the domain names "nationstarmortgage.com" and "nationstarmortgage.net," which Applicant had registered on April 5, 2005. Opposer's counsel sent a follow-up letter on April 18, 2006.

20. Upon information and belief, Applicant filed Application Serial No. 78/866,376 on April 20, 2006 only upon learning of Opposer's prior preparations to use Opposer's NATIONSTAR MORTGAGE Marks and of Opposer's intention to file applications for Opposer's NATIONSTAR MORTGAGE Marks.

21. Upon information and belief, Applicant had not used Applicant's NATIONSTAR Mark in interstate commerce and did not have a bona fide intent to use Applicant's NATIONSTAR Mark in interstate commerce on the April 20, 2006 filing date of Application Serial No. 78/866,376.

22. Opposer has rights in Opposer's NATIONSTAR MORTGAGE Marks which are prior and superior to any rights that Applicant may have in Applicant's NATIONSTAR Mark.

23. Applicant's NATIONSTAR Mark in Application Serial No. 78/866,376 is highly similar to Opposer's NATIONSTAR MORTGAGE Marks in sight, sound, and commercial impression. In Applicant's alleged specimen of use, the NATIONSTAR Mark is displayed in close proximity to the phrase MORTGAGE, INC., increasing the likelihood that consumers will confuse Applicant's NATIONSTAR Mark with Opposer's NATIONSTAR MORTGAGE Marks.

24. Applicant's Services and Opposer's Services are closely related and are sold or will be sold to identical or highly similar types of consumers through identical or highly similar channels of trade.

25. Applicant's NATIONSTAR Mark in Application Serial No. 78/866,376 so resembles Opposer's NATIONSTAR Mortgage Marks, in which Opposer has prior and superior rights, as to be likely, when applied to Applicant's Services, to cause confusion, to cause mistake, or to deceive, by

creating the erroneous impression that Applicant's Services originate from or are associated with Opposer, or that Applicant's Services are authorized, endorsed or sponsored by Opposer.

26. Applicant's filing of Application Serial No. 78/866,376 for Applicant's NATIONSTAR Mark is without license, authorization or permission from Opposer.

27. The granting of a trademark registration for Applicant's NATIONSTAR Mark would violate and diminish the prior and superior rights of Opposer in Opposer's NATIONSTAR MORTGAGE Marks and would be in violation of 15 U.S.C. § § 1052(d).

28. Opposer would be damaged if Application Serial No. 78/866,376 is allowed to register because Applicant will obtain statutory rights in Applicant's NATIONSTAR Mark in violation and derogation of the prior and superior rights of Opposer in Opposer's NATIONSTAR MORTGAGE Marks.

WHEREFORE, Opposer requests that its Opposition be sustained, that Application Serial No. 78/866,376 be rejected and that the registration of NATIONSTAR as a trademark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

NATIONSTAR MORTGAGE LLC

Date: February 19, 2010

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Alexandria, Virginia 22313-1404
(703) 836-6620
Attorneys for Opposer

EXHIBIT B

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

RE: U.S. Trademark Application Serial No. 78/866,376
Published in the *Official Gazette* on January 2, 2007

NATIONSTAR MORTGAGE LLC,	)	
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Opposer,	)	
	)	Opposition No.
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MUJAHID AHMAD,	)	
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P.O. Box 1451
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Commissioner:

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residential and commercial property and insurance brokerage; mortgage brokerage; and business finance procurement services" in International Class 36 ("Applicant's Services"), and published in the *Official Gazette* on January 2, 2007, Nationstar Mortgage LLC ("Opposer") believes that it will be damaged by registration of Applicant's NATIONSTAR Mark and hereby opposes same. The grounds for this opposition are as follows:

1. Applicant is the record owner of Application Serial No. 78/866,376 for the mark NATIONSTAR for Applicant's Services.

2. Opposer is a limited liability company organized under the laws of the State of North Carolina, located and doing business at 2828 North Harwood Street, 11th Floor, Dallas, Texas 75201.

3. Opposer is the owner of U.S. Application Serial No. 78/872,148 for the mark NATIONSTAR MORTGAGE and Design and U.S. Application Serial No. 78/871,883 for the mark NATIONSTAR MORTGAGE, both of which cover "mortgage lending services" ("Opposer's Services"), and both of which were filed on April 28, 2006. These applications are hereinafter collectively referred to as "Opposer's NATIONSTAR MORTGAGE Marks."

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in commerce at least as early as 04/04/2005, and is now in use in such commerce." The application also contains a standard declaration as to the truth of applicant's statements in the application.

5. Upon information and belief, Applicant did not use Applicant's NATIONSTAR Mark in connection with Applicant's Services in commerce on or anytime prior to April 20, 2006, the filing date of Applicant's NATIONSTAR Mark. Upon information and belief, Applicant has not used Applicant's NATIONSTAR Mark in connection with Applicant's Services in interstate commerce in the United States.

6. Upon information and belief, the alleged April 4, 2005 dates of first use and first use in commerce listed by Applicant in Application Serial No. 78/866,376 are based on nothing more than Applicant's registration of the domain names "nationstarmortgage.com" and "nationstarmortgage.net."

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8. Upon information and belief, Applicant made the false statements as to the use of his mark in commerce and the first use dates of that mark with the intent to procure a registration to which Applicant was not entitled, and Applicant was successful in procuring favorable examination, allowance, and publication of the application.

9. Upon information and belief, Applicant's false statements were made knowingly. Applicant made knowing false statements as to the use of his mark in commerce and the first use

dates of that mark with the intent to procure a registration to which Applicant was not entitled, and Applicant was successful in procuring favorable examination, allowance, and publication of the application.

B. Fraudulent Specimen of Use

10. Applicant did not file a specimen of use with the original application on April 20, 2006. After receiving an office action requiring submission of a specimen, Applicant submitted an alleged specimen of use on October 19, 2006. The alleged specimen consisted of a printout that displayed the NATIONSTAR MORTGAGE mark in connection with the alleged offering of mortgage services.[1] The response submitted on October 19, 2006 also contained a signed declaration stating that "the specimen was in use in commerce at least as early as the filing date of the application" and that statements in the declaration were true.

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~~16. In~~lacked the ~~alternative, upon information and belief, even if Applicant had made any~~ requisite bona fide intent to use ~~in commerce of Applicant's NATIONSTAR~~Applicant's Mark ~~prior to~~ on or ~~on the filing date of the application, such use was unlawful as not in compliance~~in connection with ~~applicable laws and regulations.~~ Applicant's Services. Accordingly, Applicant's application is void and invalid for lack of ~~lawful use to support the sole~~a filing basis.

16. Upon information and belief, Applicant did not have a bona fide intention to use Applicant's Mark in commerce on Applicant's Goods when it filed Application Serial No. 78/866,376 for Applicant's Goods because Applicant does not have a single document to establish a bona fide intention to use Applicant's Mark in commerce on Applicant's Goods.

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proximity to the phrase MORTGAGE, INC., increasing the likelihood that consumers will confuse Applicant's NATIONSTAR Mark with Opposer's NATIONSTAR MORTGAGE Marks.

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26. Applicant's filing of Application Serial No. 78/866,376 for Applicant's NATIONSTAR Mark is without license, authorization or permission from Opposer.

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WHEREFORE, Opposer requests that its Opposition be sustained, that Application Serial No. 78/866,376 be rejected and that the registration of NATIONSTAR as a trademark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

NATIONSTAR MORTGAGE LLC

Date: ~~May 1, 2007~~ ~~/Bryce J. Maynard/~~February 19, 2010

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~~Bryce J. Maynard~~
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