

ESTTA Tracking number: **ESTTA348874**

Filing date: **05/20/2010**

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 bruce.mcdonald@bipc.com,lloyd.smith@bipc.com,bassam.ibrahim@bipc.com,kathleen.hemmerdinger@bipc.com |
| Submission | Motion to Quash |
| Filer's Name | Bruce A. McDonald |
| Filer's e-mail | bruce.mcdonald@bipc.com |
| Signature | /Bruce A. McDonald/ |
| Date | 05/20/2010 |
| Attachments | ALX1_GENERAL-#2051407-v1-Opposer_s_Motion_to_Quash_Notice_of_Deposition.pdf (28 pages)(603067 bytes) |

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

| | | |
|---------------------------|---|-------------------------|
| Nationstar Mortgage, LLC, | : | |
| | : | |
| Opposer, | : | |
| | : | |
| v. | : | |
| | : | Opposition No. 91177036 |
| Mujahid Ahmad, | : | |
| | : | |
| Applicant. | : | |

OPPOSER'S MOTION TO QUASH NOTICE OF TESTIMONY DEPOSITION

Opposer moves the Board to quash the Notice of Testimony Deposition of Zulfikhar Sharieff scheduled for Wednesday, May 26, 2010. As grounds for this motion, Opposer states that Applicant is engaged in a maneuver to prevent an opportunity for Opposer to cross-examine this witness as part of a larger scheme to defraud Opposer and the U.S. Patent and Trademark Office. To effectuate this plan, Applicant unilaterally cancelled the deposition of Mr. Sharieff that was scheduled to take place on May 19, 2010, then issued a notice of deposition for Mr. Sharieff to take place on May 26, 2010, the single day when Applicant's counsel knew that Opposer's counsel was categorically unavailable, informing Opposer's counsel that this was the single day during the entire testimony period in which Mr. Sharieff was available - after accepting an offer from Opposer's counsel to extend the testimony period for this very purpose. The duplicity of the conduct is breathtaking.

Facts

(1) The deposition of Zulfikhar Sharieff was originally scheduled to take place on Wednesday, May 19, 2010, pursuant to a notice of deposition dated May 11, 2010 (copy appended as Exhibit A).

(2) The deposition of Mr. Sharieff was one of the following three testimony depositions scheduled by Applicant's counsel for May 19, 2010:

| <u>Time</u> | <u>Witness</u> |
|-------------|--------------------|
| 12:00 noon | Abid Hussain |
| 1:00 p.m. | Zulfikhar Sharieff |
| 3:00 p.m. | Mujahid Ahmad |

(3) Opposer's undersigned counsel was prepared to go forward with the deposition of Mr. Sharieff on May 19 but requested additional time for the deposition of the Applicant. On May 14, 2010, the undersigned faxed a letter to Applicant's counsel, Patrick Rea (copy appended as Exhibit B). The letter stated:

Opposer hereby objects to the lack of opportunity for cross-examination presented by your proposed schedule. It is Opposer's position that Applicant is engaged in fraud on the PTO, and the Board has alluded to prima facie evidence of such fraud in at least one written order. Opposer is entitled to an opportunity for full cross-examination on this issue. We demand that you allot at least one full day for the deposition of the Applicant and provide for a continuation of that deposition if the cross-examination is not completed within that time.

(4) In response to the letter quoted above, the undersigned received a telephone call from Mr. Rea offering to go forward with the depositions of Messrs. Hussain and Sharieff on May 19 and to schedule the deposition of Applicant for the following day, May 20.

(5) In response to Mr. Rea's voice mail, the undersigned spoke with Mr. Rea, confirmed the parties' understanding, offered a 30-day extension of the trial calendar to Mr. Rea as an accommodation, and faxed a letter to him stating the same (copy appended as Exhibit C).

(6) On May 17, 2010, the undersigned was surprised to receive a fax from Mr. Rea (copy appended as Exhibit D), stating:

Based on our conversation last Friday and the stipulated agreement to extend the applicant's testimony period, I am trying to reschedule our testimony depositions to times that are more accommodating to your desire for extensive cross examination. I have

canceled the testimony originally planned for Wednesday, May 19. We are trying to re-schedule this testimony for later in the testimony period. Tentatively, we are trying for June 9 and June 16 for Mr. Hussain and Mr. Sharieff. We will designate another day near this time for Mr. Ahmad. Once the dates are firm, I will re-notice the depositions.

(7) Mr. Rea's statement above is disingenuous, for lack of a better word, since the undersigned did not request that the depositions be re-scheduled. The undersigned accordingly faxed a letter to Mr. Rea (copy appended hereto as Exhibit E) objecting to his characterization of the parties' communications and setting forth Opposer's position in regard to the factual issues requiring face-to-face cross-examination.

(8) On May 19, 2010, the undersigned received an amended notice of deposition scheduling Mr. Sharieff's deposition for May 26, 2010 (copy appended hereto as Exhibit F). The notice was accompanied by an e-mail (Exhibit G) stating in relevant part:

Please note that Mr. Sharieff's deposition is scheduled for next Wednesday at 1 pm. Unfortunately, this is the only day that Mr. Sharieff is available. He will be travelling [sic] the entire months of June and July.

(9) Mr. Rea was aware that the undersigned, along with each and every trademark lawyer in his law firm, would be in Boston on May 26 for the annual meeting of the International Trademark Association (INTA). Therein lies the crux of the problem.

(10) In response to the amended notice of deposition for Mr. Sharieff, and in an effort to confer with Mr. Rea as a means to avoid this motion, the undersigned counsel called Mr. Rea to express his umbrage and to request that Mr. Rea reschedule the deposition for any day during the extended thirty-day period to which the undersigned had agreed the previous Friday as an accommodation to Mr. Rea. His request was declined.

Argument

The Board will grant a motion to quash a testimony deposition where the notice is unreasonable. *National Football League, NFL Properties LLC v. DNH Management, LLC*, 85 USPQ2d 1852 (TTAB 2008). In this case the notice was unreasonable not because Applicant failed to provide a sufficient time for Opposer to prepare. The notice was unreasonable because, within the entire period that was available to Applicant for the conduct of a single deposition, *which period was extended by Opposer an accommodation*, Applicant revoked a date that was agreeable to Opposer for a plainly dishonest reason, and then substituted a single date, and no other date, known to be unavailable to Opposer, depriving Opposer of a meaningful opportunity for full and fair cross-examination.

The Trademark Trial and Appeal Board should not be drawn into immature squabbles among counsel regarding the timing and logistics of depositions and discovery. That is not what is happening here. This is a case in which Applicant's counsel identified a single day (May 19) for the deposition of a witness (Mr. Sharieff), to which the undersigned agreed. Applicant's counsel then unilaterally cancelled that deposition for reasons that he falsely attributed to the undersigned (see Exhibit D), notwithstanding the accommodation offered to him by the undersigned in the form of a 30-day extension in the testimony period. Of the entire 30-day period that followed - making a total of 60 days in all - Applicant's counsel noticed a deposition for a single date that he knew the undersigned - and all his trademark partners and associates - would be unavailable.

This is not a case in which cross-examination can be conducted over the telephone. Considering the issues of fraud (see Exhibit E), only face-to-face cross-examination will provide Opposer with a meaningful opportunity to test the veracity of the witness in question. Nor is it

a case in which one of the undersigned's partners or associates can substitute for him at the deposition, as all of his trademark partners and associates will be with him at the INTA meeting in Boston.

The undersigned believes, and the circumstances described above establish, that the purpose of Mr. Rea's machinations is to prevent an opportunity for face-to-face cross-examination of Mr. Sharieff. Such a result would amount to a denial of due process. Moreover, the U.S. Patent and Trademark Office has a direct interest in allowing Opposer to test the veracity of this Applicant and his witnesses. If Applicant cannot make Mr. Sharieff available for deposition on any day during his entire 60-day testimony period besides the one day that he knows Opposer's counsel is unavailable, he should be foreclosed from introducing the testimony of this witness.

Respectfully submitted,

NATIONSTAR MORTGAGE LLC



Bruce A. McDonald
Attorneys for Applicant
Buchanan Ingersoll & Rooney, P.C.
P.O. Box 1404
Alexandria, Virginia 22314
(703)836-6620

Date: May 20, 2010

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S MOTION TO QUASH NOTICE OF TESTIMONY DEPOSITION was served this 20th day of May, 2010, by electronic mail, and on May 21, 2010, by facsimile, on:

Patrick I. Rea, Esq.
TAYLOR & REA, PLC
3925 Old Lee Hwy, Suite 200
Fairfax, VA 22030



Bruce A. McDonald
Attorney
BUCHANAN INGERSOLL & ROONEY PC

Exhibit A

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

In the Matter of Serial No. 78/866376
Filed on April 20, 2006
For the Mark NATIONSTAR
Published for Opposition on January 2, 2007

| | |
|---|-------------------------|
| Nationstar Mortgage LLC, <i>Opposer</i> vs. Mujahid Ahmad, <i>Applicant</i> | Opposition No. 91177036 |
|---|-------------------------|

NOTICE OF TESTIMONY DEPOSITION OF ZULFIKHAR SHARIEFF

PLEASE TAKE NOTICE that pursuant to Rule 30 of the Federal Rules of Civil Procedure and 37 CFR § 2.123, Applicant, Mujahid Ahmad will take the oral testimony deposition of:

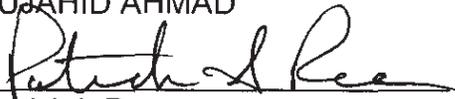
Zulfikhar Sharieff
4363 Ensbrook Lane
Dale City, VA 22193

The deponent is a person who received services from the applicant in the above captioned matter. The deposition will take place on Wednesday, May 19, 2010, in the offices of the applicant's attorney located at 3925 Old Lee Highway, Suite 200, Fairfax, VA 22030. The deposition will begin at 1 pm. The deposition will take place before a Notary Public or other officer authorized by law to administer oaths. The deposition will be recorded by audio, video and/or other stenographic means.

Respectfully submitted,

MUJAHID AHMAD

Date: May 11, 2010



Patrick I. Rea

Taylor & Rea, PLC

3925 Old Lee Hwy, Ste 200

Fairfax, VA 22030

(703) 385-3322

(703) 385-5406 Fax

rea@taylorrealaw.com

CERTIFICATE OF MAILING

I hereby certify that on May 11, 2010, the foregoing NOTICE OF TESTIMONY DEPOSITION OF ZULFIKHAR SHARIEFF is being deposited with the United States Postal Service, with sufficient postage as first-class mail, in an envelope addressed to

S. Lloyd Smith
Bryce J. Maynard
Buchanan, Ingersoll & Rooney PC
P.O. Box 1404
Alexandria, VA 22314


Patrick I. Rea

Exhibit B

Bruce A. McDonald
703 838 6590
bruce.mcdonald@bipc.com

May 14, 2010

VIA FACSIMILE
(703) 385-3322

Patrick I. Rea, Esq.
TAYLOR & REA, PLC
3925 Old Lee Hwy, Suite 200
Fairfax, VA 22030

Re: *Nationstar Mortgage LLC v. Mujahid Ahmad*, Opposition No. 91177036 (TTAB),
Our Ref. 0055673.000033

Dear Mr. Rea:

This letter relates to your notices of depositions for the following witnesses on May 19, 2010 beginning at 10:00 a.m. at your office:

| Time | Witness |
|-------------|--------------------|
| 12:00 noon | Abid Hussain |
| 1:00 p.m. | Zulfikhar Sharieff |
| 3:00 p.m. | Mujahid Ahmad |

Opposer hereby objects to the lack of opportunity for cross-examination presented by your proposed schedule. It is Opposer's position that Applicant is engaged in fraud on the PTO, and the Board has alluded to prima facie evidence of such fraud in at least one written order. Opposer is entitled to an opportunity for full cross-examination on this issue. We demand that you allot at least one full day for the deposition of the Applicant and provide for a continuation of that deposition if the cross-examination is not completed within that time.

Patrick I. Rea, Esq.
May 14, 2010
Page 2

The undersigned is available for a continuation of these depositions on May 20, 2010. Alternatively, please provide us with additional dates for this purpose.

Sincerely,



Bruce A. McDonald

BAM:jd

cc: Nationstar Mortgage, LLC

Exhibit C

Bruce A. McDonald
703 838 6590
bruce.mcdonald@bipc.com

P.O. Box 1404
Alexandria, VA 22313-1404

1737 King Street, Suite 500
Alexandria, VA 22314-2727
T 703 836 6620
F 703 836 2021
www.buchananingersoll.com

May 14, 2010

VIA FACSIMILE
(703) 385-5406

Patrick I. Rea, Esq.
TAYLOR & REA, PLC
3925 Old Lee Hwy, Suite 200
Fairfax, VA 22030

Re: *Nationstar Mortgage LLC v. Mujahid Ahmad*, Opposition No. 91177036 (TTAB),
Our Ref. 0055673.000033

Dear Patrick:

I am writing to confirm that we have agreed to enlarge the deposition schedule to provide Opposer with a full and fair opportunity to cross examine the witnesses. It is my understanding that:

- (1) May 19, 2010, will be reserved for the depositions of the third-party witnesses, Messrs. Hussain and Sharieff, to commence at 9:00 a.m. at your office.
- (2) The deposition of Mr. Ahmad will commence at 9:00 a.m. the following day, May 20, 2010.
- (3) If Opposer's cross-examination of these witnesses cannot be completed during the allotted periods, the depositions will be continued and re-convened on one or more dates that are mutually convenient to the parties.
- (4) Further to the above we have agreed on a 30-day enlargement of the trial calendar, which has been filed and served under separate cover.

Patrick I. Rea, Esq.
May 14, 2010
Page 2

We appreciate your courtesy in this matter.

Sincerely,



Bruce A. McDonald

BAM:jd

cc: Nationstar Mortgage, LLC

Exhibit D

William S. Taylor ^{VD}
Patrick I. Rea ^{VD}

D Member DC Bar
V Member VA Bar

TAYLOR & REA, PLC
ATTORNEYS AT LAW
Suite 200, 3925 Old Lee Highway
Fairfax, Virginia 22030

Telephone: (703) 385-3322
Fax: (703) 385-5406
Email Address:
rea@taylorrealaw.com

May 17, 2010

VIA FAX: 703-836-2021

Mr. Bruce A. McDonald
Buchanan, Ingersoll & Rooney, PC
1737 King Street
Suite 500
Alexandria, VA 22314

RE: Nationstar Mortgage v. Ahmad

Dear Bruce:

Based on our conversation last Friday and the stipulated agreement to extend the applicant's testimony period, I am trying to reschedule our testimony depositions to times that are more accommodating to your desire for extensive cross examination. I have cancelled the testimony originally planned for Wednesday, May 19. We are trying to re-schedule this testimony for later in the testimony period. Tentatively, we are trying for June 9 and June 16 for Mr. Hussain and Mr. Sharieff. We will designate another day near this time for Mr. Ahmad. Once the dates are firm, I will re-notice the depositions.

Very truly yours,


Patrick I. Rea

Exhibit E

Bruce A. McDonald
703 838 6590
bruce.mcdonald@bipc.com

P.O. Box 1404
Alexandria, VA 22313-1404

1737 King Street, Suite 500
Alexandria, VA 22314-2727
T 703 836 6620
F 703 836 2021
www.buchananingersoll.com

May 17, 2010

VIA FACSIMILE
(703) 385-5406

Patrick I. Rea, Esq.
TAYLOR & REA, PLC
3925 Old Lee Hwy, Suite 200
Fairfax, VA 22030

Re: *Nationstar Mortgage LLC v. Mujahid Ahmad*, Opposition No. 91177036 (TTAB),
Our Ref. 0055673.000033

Dear Patrick:

We have received your facsimile of today's date cancelling the depositions scheduled for Wednesday and Thursday of this week, stating that you are "trying to reschedule [y]our testimony depositions" to times that are "more accommodating" to our "desire for extensive cross examination." You indicate that you are "trying for June 9 and June 16 for Mr. Hussain and Mr. Sharieff," and that you will "designate another day near this time for Mr. Ahmad."

Opposer objects to your characterization of our position as a "desire for extensive cross examination." You scheduled three depositions on a single day beginning at 10:00 a.m. We hardly think that our request for an additional day to conduct this testimony constitutes a "desire for extensive cross examination."

For the record, Opposer demands that your Applicant abandon his pending application on the grounds that he is engaged in fraud on the PTO and fraud targeted at our client, further to which we intend to prove that:

- Your client never had any intention to use the name "NationStar" until he learned that our client was interested in acquiring the Internet domain names NATIONSTARMORTGAGE.COM and NATIONSTARMORTGAGE.NET;
- Your client thereupon rushed to file a service mark application at the U.S. Patent and Trademark Office (PTO), based on a fraudulent claim of first use;

Patrick I. Rea, Esq.
May 17, 2010
Page 2

- Your client "dummied up" the advertisements, fliers, postcards and business cards that he submitted to the PTO and produced in discovery to document his supposed use of the name NATIONSTAR prior to April 2006;
- Your client committed a fraud on the PTO when he filed a service mark application attesting that he had used the name NATIONSTAR in commerce prior to April 2006, punishable by fine and imprisonment of up to five years pursuant to 18 U.S.C. § 1001;
- Your client understands the gravity of the fraud that he committed on the PTO, hence the amendment of his application on January 31, 2008, to retract his claim of first use and to allege a "good faith intent to use" instead of actual use;
- Your client nevertheless committed perjury on May 27, 2009, when he testified in deposition that he had used the name NATIONSTAR in commerce prior to April 2006, punishable by fine and imprisonment for up to five years pursuant to 18 U.S.C. § 1621;
- Independent of the fraud that your client has committed on the PTO, your client is engaged in a fraudulent course of conduct targeted at our client, and has attempted to extort money from our client in violation of the federal mail and wire fraud statutes, punishable by fine and imprisonment of up to twenty years pursuant to 18 U.S.C. § 1341 and 1342;
- If it is your client's intention to offer the testimony of Messrs. Sharieff and Hussain to corroborate his false claim that he used the name NATIONSTAR in commerce prior to April 2006, then your client will be engaged in subornation of perjury punishable by fine and imprisonment of up to five years pursuant to 18 U.S.C. § 1622.

We do not believe that your client appreciates the gravity of the unlawful conduct in which he is engaged or the extent of liability that he is incurring for the resulting damage to our client. The fact that your client has withdrawn his claim of first use from the opposed application in no way lessens the impact of his fraudulent conduct for purposes of this proceeding. We strongly advise you to make your client aware of these realities before the dispute between the parties escalates.

Our client is prepared to waive any further action Mr. Ahmad if he abandons his fraudulent application at this time and makes no further effort to coerce payment from our client.

Patrick I. Rea, Esq.
May 17, 2010
Page 3

Otherwise your client is hereby on notice of our intention to hold him fully accountable for the damage that he has caused, and is continuing to cause.

Sincerely,



Bruce A. McDonald

BAM:jd

cc: Nationstar Mortgage, LLC

Exhibit F

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

In the Matter of Serial No. 78/866376
Filed on April 20, 2006
For the Mark NATIONSTAR
Published for Opposition on January 2, 2007

| | |
|--|--------------------------------|
| <p>Nationstar Mortgage LLC, <i>Opposer</i></p> <p>vs.</p> <p>Mujahid Ahmad, <i>Applicant</i></p> | <p>Opposition No. 91177036</p> |
|--|--------------------------------|

NOTICE OF TESTIMONY DEPOSITION OF ZULFIKHAR SHARIEFF

PLEASE TAKE NOTICE that pursuant to Rule 30 of the Federal Rules of Civil Procedure and 37 CFR § 2.123, Applicant, Mujahid Ahmad will take the oral testimony deposition of:

Zulfikhar Sharieff
4363 Ensbrook Lane
Dale City, VA 22193

The deponent is a person who received services from the applicant in the above captioned matter. The deposition will take place on Wednesday, May 26, 2010, in the offices of the applicant's attorney located at 3925 Old Lee Highway, Suite 200, Fairfax, VA 22030. The deposition will begin at 1 pm. The deposition will take place before a Notary Public or other officer authorized by law to administer oaths. The deposition will be recorded by audio, video and/or other stenographic means.

Date: May 18, 2010

Respectfully submitted,

MUHAMMAD AHMAD



Patrick I. Rea
Taylor & Rea, PLC
3925 Old Lee Hwy, Ste 200
Fairfax, VA 22030
(703) 385-3322
(703) 385-5406 Fax
rea@taylorrealaw.com

CERTIFICATE OF MAILING

I hereby certify that on May 18, 2010, the foregoing NOTICE OF TESTIMONY DEPOSITION OF ZULFIKHAR SHARIEFF is being deposited with the United States Postal Service, with sufficient postage as first-class mail, in an envelope addressed to

Bruce A. McDonald
S. Lloyd Smith
Bryce J. Maynard
Buchanan, Ingersoll & Rooney PC
P.O. Box 1404
Alexandria, VA 22314


Patrick I. Rea

Exhibit G

McDonald, Bruce A.

From: Patrick Rea [rea@taylorrealaw.com]
Sent: Wednesday, May 19, 2010 4:43 PM
To: Smith, S. Lloyd; McDonald, Bruce A.
Subject: Nationstar v. Ahmad
Attachments: 2010-05-18 - Notice of Deposition 2 - Ahmad.pdf; 2010-05-18 - Notice of Deposition 2 - Hussain.pdf; 2010-05-18 - Notice of Deposition 2 - Sharieff.pdf

Dear Bruce:

Attached are new notices of testimony deposition for Mr. Ahmad, Mr. Sharieff and Mr. Hussain. Please note that Mr. Sharieff's deposition is scheduled for next Wednesday at 1 pm. Unfortunately, this is the only day that Mr. Sharieff is available. He will be travelling the entire months of June and July. Mr. Hussain's deposition is scheduled for June 8 at 10 am. Mr. Ahmad's deposition is scheduled for June 9 at 10 am. If necessary, Mr. Ahmad can additionally be available on June 10.

Regards,

Patrick Rea