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

Proceeding	92071349
Party	Plaintiff NT-MDT LLC
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Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Lance C. Venable
Filer's email	uspto@venableiplaw.com
Signature	/Lance C. Venable/
Date	01/09/2020
Attachments	2020-01-09 Stipulation to Amend Petition - Final.pdf(71219 bytes) Exhibit A - Employment Agreement.pdf(2666771 bytes) Exhibit B - Settlement Agreement.pdf(1067549 bytes) Exhibit C - Business Card.pdf(135254 bytes) Exhibit D - Registration Certificate.pdf(105089 bytes) Exhibit E - Correspondence with Curt Handley.pdf(538195 bytes) 2020-01-09 Amended Petition to Cancel - Redline.pdf(269388 bytes) 2020-01-09 Amended Petition to Cancel - Clean.pdf(260732 bytes)

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

In the matter of trademark Registration No. 5,753,336, registered May 14, 2019

NT-MDT LLC.

Petitioner,

v.

IRINA KOZODAEVA,

Registrant

In re Registration of NT-MDT

Cancellation No. 92071349

**Unopposed Motion Allowing
Petitioner to File Amended Petition
to Cancel**

On May 20, 2019, Petitioner NT-MDT LLC filed its Petition to Cancel trademark registration No. 5,753,336. Petitioner seeks to file a First Amended Petition to Cancel. The Petition amplifies the current factual allegations and adds no new claims. A copy of a redlined version and a clean version of the proposed First Amended Petition is attached.

The Petitioner moves that: (1) Petitioner should be granted leave to file its First Amended Petition to Cancel, and (2) Respondent's responsive pleading will be due 14 days after the First Amended Petition is filed. Respondent consents to all the relief requested, including both the filing of the amended pleading and the time to respond to the amended pleading.

Respectfully submitted this 9th day of January 2020

s/Lance C. Venable

Law Office of Lance C. Venable, PLLC.
4939 West Ray Rd.
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Chandler, AZ 85226
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docketing@venableiplaw.com
Attorney for the Petitioner

Certificate of Service

I hereby certify that the forgoing was electronically FILED via ESTTA on January 9, 2020, and that a copy has been SERVED on counsel for Registrant Irina Kozodaeva on January 9, 2020 by forwarding the copy by email to

Kenneth M. Motolenich-Salas
16210 North 63rd Street
Scottsdale, AZ 85254
Telephone: (202) 257-3720
Email: Ken@motosalaslaw.com
Counsel for Registrant Irina Kozodaeva.

By: s/Lance C. Venable/

EXHIBIT A

EMPLOYMENT CONTRACT

THE UNDERSIGNED

Nano Technology Instruments - Europe BV, a company having its registered office at Arnhemseweg 34-D, 7331 BL Apeldoorn, the Netherlands ('NTI'), for the purposes hereof represented by Julia Alexeeva;

and

Mr. Dmitry Kozodaev, born on 14 March 1973, residing at Hoveniersdreef 315 7328 KJ Apeldoorn, Netherlands ('Employee');

WHEREAS

- a. This Employment Contract replaces the employment contract dated 23 January 2005. The first date of employment will remain 1 February 2006;

HAVE AGREED AS FOLLOWS

1 Commencement, Term and Termination

- 1.1 This Employment Contract is entered into for an unlimited period of time (*onbepaalde tijd*).
- 1.2 Either party may terminate this Employment Contract with due observance of the statutory notice period. Notice may be given in writing only.
- 1.3 The Employment Contract will end in any event without notice being required at the beginning of the month in which Employee reaches the age of 65.

2 Position

- 2.1 Employee will hold the position of Sales Manager.
- 2.2 Employee covenants that he will also perform duties other than those that are considered his usual duties, if such performance may be reasonably expected from him in accordance with "Job Description" which is integral part of this Contract.

3 Working Hours and Workplace

- 3.1 The workweek will consist of 5 days. The working hours amount to 40 hours per week.
- 3.2 Employee will perform his work at the NTI offices in the Netherlands. NTI may relocate Employee's workplace if its interests so require.
- 3.3 Employee covenants that, at NTI's request, he will work overtime whenever a proper performance of his duties so requires. Overtime is considered part of the job and will not be paid or otherwise compensated for excluding days-off, when it will be necessary NTI direct activity purposes. This overtime should be confirmed by corresponding documents and will be compensated by means of granting additional days-off.



4 Salary

- 4.1 Employee will receive a salary of EUR 5000,00 gross (*bruto*) per month on the basis of a 40-hour working week with 5 % growth of salary due to inflationary bias.
- 4.2 Employee will be entitled to a monthly holiday allowance (*vakantiebijslag*) of 8% of the gross base monthly salary referred to in the preceding paragraph, payable in May each year. Employee's entitlement to holiday allowance accrues pro rata throughout the year.
- 4.3 Employee will participate in NTI's Bonus Plan. The granting of any bonuses is at NTI's discretion. Employee can in no event lay claim to a bonus that has not yet been granted. The granting of a bonus in any given year or during several years shall not create a precedent for any subsequent years.

5 Expenses

- 5.1 NTI will reimburse reasonable business-related expenses, if and insofar such reimbursement may be provided free of tax and social security premiums. An expense statement must be submitted to NTI prior to the end of the month following the month in which they were incurred. Expenses can be claimed upon submission of the original receipts, specifying the business-related reason for which they were incurred.
- 5.2 Employee will use company car for transportation from Home to the place where office NTI has been arranged (De Pinckart 54, 5674 CC Nuenen, Netherlands, Eindhoven) and back with other employees. If company car is not be available for employees transportation, NTI will reimburse reasonable business-related expenses at the level of public conveyances costs.

6 Mobile Phone, Laptop

- 6.1 For the duration of this Employment Contract, NTI will place at Employee's disposal a mobile phone and a laptop computer for the performance of his work. Private use of the mobile phone and laptop computer is permitted within reasonable limits. Tax and social insurance consequences, if any, will be for Employee's account.

7 Days' holiday

- 7.1 Employee will be entitled to 25 days' holiday each calendar year. Employee's entitlement to holiday allowance accrues pro rata throughout the year.
- 7.2 Days' holiday may be taken in consultation with and upon approval of NTI.
- 7.3 Days' holiday must be taken as much as possible in the calendar year in which they are accrued. No more than 5 days' holiday may be carried forward.
- 7.4 If Employee has taken days' holiday in excess of his entitlement on termination, NTI will deduct such days from the final salary payment.

8 Illness

- 8.1 If Employee is unable to perform the agreed work due to illness or medical incapacity (hereafter collectively: 'illness'), he is obliged to inform NTI thereof on the first day of illness, stating the reasons, the expected period of illness and the address at which he can be reached during that period. As soon as Employee knows when he will be able to resume work, he is required to inform NTI thereof.
- 8.2 In case of illness, Employee will remain entitled to continued payment of:
 - 100% of the most recent gross base salary during the first 4 months of illness; and
 - 70% of the most recent gross base salary from the 5th until the 24th month of illness.
- 8.3 NTI may suspend or cease payment of the salary under the preceding paragraph if Employee

does not comply with the statutory and/or NTI's sick leave instructions.

9 Health Insurance

- 9.1 In accordance with the Health Care Insurance Act (*Zorgverzekeringswet*), NTI will pay on behalf of Employee the income-related contribution as set by governmental order each year.

10 Pension

- 10.1 For the duration of the Employment Contract, Employee will participate in the Employer's collective Pension Plan, if and as soon as he meets the relevant requirements. Pension rights and obligations are laid down in the Pension Plan, of which Employee declares to have received a copy.
- 10.2 The costs of the Pension Plan will be borne jointly by the Employer and the Employee in accordance with the Pension Plan. Employee hereby authorises NTI to withhold his contribution from the salary, to the extent possible in equal instalments upon each salary payment. NTI will arrange for payment of the total premium to the pension insurer.

11 Confidentiality

- 11.1 Neither during the term of this Employment Contract nor upon termination thereof, shall Employee, other than for the benefit of NTI (or NT-MDT head company branches) within the normal scope of his work, (i) inform any third party in any form, directly or indirectly, of any particulars concerning or related to the business conducted by NTI or its affiliates, regardless of whether such information includes any reference to its confidential nature or ownership and regardless of how Employee learned of the particulars, nor (ii) copy, compile, merge, assemble or process information, products or systems of NTI or disassemble, reproduce or decompile the source code of the computer software included in those products or systems or attempt to deduce the source code of such software in any other manner.

12 Non-compete clause

- 12.1 For a period of 12 months after termination, Employee may not without NTI's prior written consent –
- (i) engage in any activities that in any way, directly compete with NTI's or its affiliates' business, nor establish, conduct (alone or with others) or cause the conduct of any competing business, nor take any interest in or be employed in any way whatsoever by such business, whether or not for consideration;
 - (ii) directly or indirectly induce employees of NTI or its affiliates to terminate their employment contracts with NTI or its affiliates;
 - (iii) directly or indirectly, solicit, assist in soliciting, accept or facilitate the acceptance of the custom or business of firms that or individuals who were clients, customers or other business relations of NTI or its affiliates at the time of termination, or at any time during the 2-year period preceding termination;
- 12.2 Upon each breach of article the preceding paragraph, the 12-month period stated in the first sentence of that paragraph, will be extended by the duration of such breach.

13 Sidelines

- 13.1 During the term of this Employment Contract, Employee must refrain from undertaking or holding any sidelines or additional posts, without NTI's prior written consent, if such activities may affect Employee's full dedication to NTI, regardless of whether NTI is aware of

the activities.

14 Return of Property

- 14.1 Upon termination of this Employment Contract or at NTI's first request if Employee is suspended from work or unable to perform his work for any other reason for a period exceeding 2 months, Employee must promptly return to NTI any goods made available to him.

15 Intellectual Property Rights

- 15.1 All intellectual property rights, including but not limited to patent rights, design rights, copyrights, neighbouring rights, database rights, trademark rights, chip rights, trade name rights and know-how, ensuing in the Netherlands or abroad, during or after this Employment Contract, from the work performed by Employee under this Employment Contract (hereafter collectively: 'Intellectual Property Rights') will exclusively vest in NTI.
- 15.2 Insofar as any Intellectual Property Rights are not vested in NTI by operation of law, Employee covenants that he will transfer to NTI at NTI's first request to that effect and, insofar as possible, hereby transfers those rights to NTI, which transfer is hereby accepted by NTI.
- 15.3 Insofar as any Intellectual Property Rights are incapable of being transferred from Employee to NTI, Employee hereby grants NTI the exclusive, royalty-free, worldwide, perpetual right, with the right to grant sublicenses, to use those Intellectual Property Rights in the broadest sense, which right is hereby accepted by NTI.
- 15.4 Insofar as any personal rights vest in Employee and insofar as permitted by law, Employee hereby waives all of his personal rights, including but not limited to the right to have one's name stated pursuant to the Copyright Act (*Auteurswet 1912*).
- 15.5 Employee will promptly disclose to NTI all works, inventions, results, information and Intellectual Property Rights that ensue from his work under this Employment Contract and/or that are in any way relevant to the creation, protection and/or enforcement of the Intellectual Property Rights.
- 15.6 During the term of this Employment Contract and after its termination, Employee will perform all acts that are necessary to register the Intellectual Property Rights in NTI's name with any competent authority in the world.
- 15.7 If Employee is unable to provide the cooperation referred to in paragraph 2 and 6 for any reason, he hereby grants NTI an irrevocable power of attorney to represent him with respect to the assignment and registration of the Intellectual Property Rights referred to in paragraph 2 and 6.
- 15.8 Employee acknowledges that his salary includes reasonable compensation for the loss of Intellectual Property Rights however in certain special cases NTI will compensate employee for intellectual property that has been formally patented.

16 Personal Data Protection

- 16.1 It is understood and agreed that NTI will process Employee's personal data to comply with its statutory obligations, including, without limitation, withholding wage tax and social insurance contributions, maintaining and improving personnel and payroll records, administering benefits and programmes and plans relating to training and development, job assessment, compensation and planning.
- 16.2 NTI will take measures to ensure that Employee's personal data is secure, accurate and fully

updated. Employee, at any time, may review and update his personal data. NTI will hold Employee's personal data only for as long as appropriate and legally required.

17 Collective Labour Agreement

17.1 Parties acknowledge that no Collective Labour Agreement (*CAO*) applies to this Employment Contract.

18 Amendments

18.1 NTI may unilaterally amend the employment terms in accordance with article 7:613 Civil Code (*BW*).

19 Applicable Law

19.1 This Employment Contract is governed by the laws of the Netherlands.

Drawn up in duplicate originals and signed in Nuenen on "29" June 2007, each party acknowledging having received one signed copy of this contract.

NTI-Europe BV



Julia Alexeeva

Employee



Dimitry Kozodaev

EXHIBIT B

**SETTLEMENT AGREEMENT PURSUANT TO
SECTION 7:900 (et seq.) OF THE DUTCH
CIVIL CODE**

THIS AGREEMENT is made between:

- (1) **Nano Technology Instruments – Europe B.V.**, a private company with limited liability (*besloten vennootschap met beperkte aansprakelijkheid*) incorporated under Dutch law, with registered office at Apeldoorn and principal place of business at Arnhemseweg 34-D, (7331 BL) Apeldoorn (the **Employer**); and
- (2) **D.A. Kozodaev**, born on 14 March 1973, residing at Hoveniersdreef 315, (7328 KJ) Apeldoorn (the **Employee**).

The Employer and the Employee hereinafter to be referred to jointly as **Parties** and individually **Party**.

BACKGROUND:

- (A) The Employee has been employed by the Employer on the basis of an employment agreement for an indefinite period of time (the **Employment Agreement**);
- (B) The Employer ceased trading in the end of 2016 and is in the process to be wind up. Since January 2017 the Employee has not performed any work for the Employer and the Employer has ceased payment of the Employee's salary as per January 2017;
- (C) As the Employee has taken the position that the Employment Agreement was not formally terminated, the Employer has taken the initiative to formally terminate the Employment Agreement by mutual consent;
- (D) There is neither an urgent cause (*dringende reden*) as referred to in section 7:678 of the Dutch Civil Code (the **DCC**) for termination of the Employment Agreement nor is the Employee to blame for the termination of the Employment Agreement;
- (E) Parties have consulted with each other to discuss the terms under which the Employment Agreement will be terminated by mutual consent, they have reached agreement thereon and now wish to lay down the terms and conditions of the termination of the Employment Agreement in this settlement agreement (the **Agreement**). With the Agreement, Parties have envisioned coming to an exhaustive, comprehensive arrangement;
- (F) At the termination of the Employment Agreement and the entering into of the Agreement, the Employee was assisted by a legal advisor; and

IT IS AGREED AS FOLLOWS:

1 TERMINATION EMPLOYMENT AGREEMENT

The Employment Agreement shall terminate by mutual consent (*met wederzijds goedvinden*) as per 1 June 2017 (the **Termination Date**).

2 SALARY OVER JANUARY, FEBRUARY AND MARCH 2017

- 2.1 The Employer will receive salary and accrue corresponding pension over the months January, February and March 2017 with retroactive effect, in the amount of EUR 4,000.00 gross per month inclusive of holiday allowance. The March 2017 salary will be paid within 5 working days after the signing date of this Agreement. The January and February 2017 salary will be paid within 20 working days after the signing date of this Agreement.
- 2.2 All accrued but untaken holidays of the Employee shall be deemed to be taken in the months January, February and March 2017.

3 FINAL SETTLEMENT

As per the Termination Date, the Employee shall have no claim on the Employer on any basis whatsoever apart from the salary due as provided for in article 2.1 of this Agreement.

4 DESTRUCTION OF CONFIDENTIAL INFORMATION

The Employee shall destroy, at the latest on the Termination Date, all confidential documents, correspondence, other data carriers of a confidential nature or copies thereof which bear relation to the Employer.

5 FUTURE CONDUCT

- 5.1 In the future, Parties shall conduct themselves, vis-à-vis each other, in accordance with the standards of prudence which parties are deemed to duly observe and shall refrain from the making of negative statements about the other Party vis-à-vis third parties.
- 5.2 Parties reciprocally undertake not to make any comment on or statement about the Agreement to third parties, unless a statutory obligation is imposed.

6 NON-COMPETITION CLAUSE

After the Termination Date the Employee shall not be bound by the non-competition clause as referred to in article 12 of the Employment Agreement.

7 CONFIDENTIALITY

After the Termination Date the Employee shall be obliged to observe the confidentiality clause as referred to in article 11 of the Employment Agreement.

8 MISCELLANEOUS

- 8.1 In the event any provision of the Agreement should prove to be invalid, the remaining provisions of the Agreement shall remain in full force. In that case, the Employee and the Employer shall replace the invalid provision by a valid provision in accordance with the objective and the purport of the Agreement, which is as similar as possible in substance to the invalid provision.
- 8.2 The Agreement may exclusively be amended by means of a statement to that effect laid down in writing and signed by the Employee and the Employer.

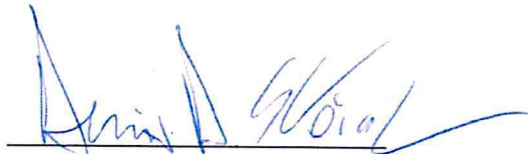
- 8.3 Parties hereby grant each other full and final discharge (*finale kwijting*) regarding all claims Parties have or may have arising from the Employment Agreement and the termination thereof or otherwise with the exception of the mutual obligations as set forth in the Agreement. If and when a Party fails to comply with an obligation under the Agreement, such party is in default by operation of law without any notice being required.
- 8.4 The Employee is entitled to cancel (*ontbinden*) this Agreement within 14 days of signing it, without giving reasons, by sending the Employer written notice.
- 8.5 The Agreement is governed by Dutch law.
- 8.6 All disputes which may arise further to the Agreement or further to agreements which may be a consequence thereof, shall exclusively, in the first instance, be brought before the competent court at Apeldoorn.

SIGNED ON 31 May 2017

Nano Technology Institute – Europe B.V.

D.A. Kozodaev

31.05.2017



By: D.D. Stoiakine
Title: Managing Director

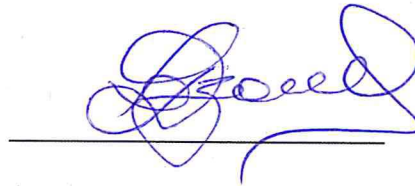


EXHIBIT C



Dr. Dimitry KOZODAEV

Director

www.nt-mdt.eu

NT-MDT B.V.

Hoveniersdreef 315,
7328KJ, Apeldoorn,
the Netherlands

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kozodaev@ntmdt.nl
kozodaev@gmail.com

EXHIBIT D

United States of America

United States Patent and Trademark Office



Reg. No. 5,753,336

Kozodaeva, Irina S. (NETHERLANDS INDIVIDUAL)
Hoveniersdreef 315
Apeldoorn, NETHERLANDS 7328KJ

Registered May 14, 2019

Int. Cl.: 9

Trademark

Principal Register

CLASS 9: Apparatus for recording, transmitting and reproducing sound and images; Computer operating software; Computers; Data processing apparatus; Microscopes and their parts; Nautical and photographic apparatus and instruments, namely, underwater housings for cameras, underwater enclosures for cameras and underwater enclosures for photographic lenses; Optical apparatus, namely, a non-lethal security device that uses a light source to detect, warn, repel, temporarily blind, disorient, nauseate, disable, confuse, debilitate, stun, subdue, stop, or incapacitate persons or animals; Scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings therefor; Transistors; Scanning probe microscopes

FIRST USE 1-8-2019; IN COMMERCE 1-8-2019

The color(s) red and blue is/are claimed as a feature of the mark.

The mark consists of a stylized design comprised of a blue rectangle with a circular cutout and a red triangle through it, next to the letters, "NT-MDT", in a large stylistic blue font.

SER. NO. 88-045,462, FILED 07-19-2018



Andrei Iancu

Director of the United States
Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years*

What and When to File:

- **First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.
- **Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.

EXHIBIT E

PATENTS, TRADEMARKS, COPYRIGHTS,
TRADE SECRETS, LICENSING,
LITIGATION AND RELATED MATTERS

REGISTERED TO PRACTICE BEFORE THE
U.S. PATENT AND TRADEMARK OFFICE



THE LAW OFFICE OF
LANCE C. VENABLE
PLLC
INTELLECTUAL PROPERTY LAW

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Tel: (602) 730-1422

lance@venableiplaw.com

April 9, 2019

VIA ELECTRONIC MAIL
(curt@intuitlaw.com)

Mr. Curt Handley
Law Office of Curt Handley
19540 Buckingham Drive
Suite 1
Mokena, IL 60448

Re: NT-MDT Trademark
Our File No.: 2031-001

Dear Mr. Handley,

My firm represents NT-MDT, LLC and its affiliate companies NT-MDT America, NT-MDT Development, NT-MDT Spectrum Instruments, and Nano Technology Instruments - Europe B.V. (collectively, "NT-MDT") in its domestic intellectual property matters. I am writing to you concerning U.S. Trademark Application Serial No. 88/045,462 ("the '462 application") for the NT-MDT and design trademark application that you filed with the USPTO on July 19, 2018, for Irina Kozodaeva, who is a resident of The Netherlands. This letter serves as a formal demand that you immediately withdraw and expressly abandon the '462 application.

I will not presume that you were familiar with my client when you filed and signed the trademark application on behalf of Ms. Kozodaeva. Therefore, I will take this opportunity to inform you of the basis for the demand.

NT-MDT has existed for nearly 28 years and has done business in the United States since January 1999. In the 20 years it has operated in the U.S., it has grown its presence internationally in the development, production, and support of research instrumentation, primarily pertaining to atomic force microscopes (AFM) and its combinations with ultrahigh resolution spectroscopy for nanotechnology and its applications. NT-MDT has created many devices, whose functions and capabilities cover a broad range of customer needs including university education, academic, and industrial research. NT-MDT research and development has led to an impressive combination of scanning probe microscopy with Raman spectroscopy.

Since early 1999, NT-MDT has continuously used the NT-MDT trademark and its accompanying logo throughout the entire U.S. by selling its products to virtually every portion of the country. And by doing so, NT-MDT has acquired substantial goodwill, recognition, and common-law rights in its mark throughout the U.S.

Recently, my client learned that you filed the '462 application for Ms. Kozodaeva. In case you did not know, Ms. Kozodaeva's spouse, Dmitry Kozodaev is a former employee of Nano Technology Instruments. Mr. Kozodaev worked in the Netherlands under an employment agreement as a sales manager from January 2005 to June 2017. I have attached a copy of the agreement with this letter. After 12 years, Nano Technology terminated Mr. Kozodaev's employment due to a contentious dispute between the parties.

As a long-term employee of NT-MDT's affiliate company, certain facts are irrefutable: (1) Mr. Kozodaev understood his employer owned and used the NT-MDT mark and its accompanying logo throughout the U.S.; (2) his employment agreement expressly stated that any work that he did as an employee inured to NT-MDT's benefit; (3) the agreement required him to assist NT-MDT to register any intellectual property rights even if he left the company; and (4) his wife certainly understood Mr. Kozodaev's responsibilities under the agreement as well.

Based on these facts, it is NT-MDT's position that Ms. Kozodaeva had no legitimate basis for filing the '462 application. NT-MDT does not doubt that by Ms. Kozodaeva filing the '462 application, she has committed fraud upon the U.S. Patent and Trademark Office. Ms. Kozodaeva, who gave you power of attorney to sign her application, alleged under 18 U.S.C. § 1001 and penalty of perjury that to the best of her knowledge and belief:

- the facts recited in the application were accurate – that is false;
- no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive – that is also false;
- after an inquiry reasonable under the circumstances, the allegations and other factual contentions made [in the application] have evidentiary support – again that is false; she believed she was entitled to use the mark in commerce – that is also false; and
- she had a bona fide intention to use the mark in commerce on or in connection with the goods/services in the application – again clearly false.

Simply stated, NT-MDT's position is that she filed this application to retaliate against my client for terminating her husband. There is just no logical explanation of why you and your client applied a mark that is identical to my client's mark other than the ill will of Ms. Kozodaeva and her husband had toward my client. And if you were aware of the facts stated above, your signature can be construed as a conspiracy to commit fraud on the USPTO by filing the application. Furthermore, in your recent Statement of Use filing, you submitted a specimen showing that Ms. Kozodaeva used the NT-MDT trademark in interstate commerce in the U.S. as of January 8, 2019, on an identical product that my client sells. We believe that this was not only a mere token use of the mark even if it was a legitimate use, but your client has also infringed my client's trademark rights under 15 U.S.C. § 1125 et seq.

Although my client is confident that it would be successful in any action it would take against your client; my client is willing to resolve this dispute amicably to avoid substantial expense and time to both parties. In addition to immediately withdrawing and abandoning the '462

application, my client further demands that Ms. Kozodaeva: (1) immediately cease all present and future sales of any products bearing the NT-MDT trademark or any confusingly similar marks within the U.S. or any other country that NT-MDT has a business presence; (2) preserve any records pertaining to sales of products she has sold under the infringing mark; and (3) provide the details and location of where she sold any products in the U.S. – especially the product used as the specimen in the Statement of Use that you filed.

If your client is willing to comply with the above demands by no later than April 12 at 5:00 pm (PST), my client will refrain from taking any further action against your client for trademark infringement and other causes of action. If, however, you reject any of these demands, my client has authorized me to take immediate steps to protect its intellectual property rights without further notice to you, which will also include filing a petition to cancel the registration for the '462 application immediately after it issues. If my client has to proceed, it will seek damages, injunctive relief, and attorneys fees and costs to the limits of the law.

I look forward to your response.

THE LAW OFFICE OF LANCE C. VENABLE, PLLC



Lance C. Venable
For the Firm

LCV/roc

cc: Mr. Oleg Butyaev

Enclosure:

Lance Venable

From: Curt Handley, Esq. <curt@intuitlaw.com>
Sent: Monday, April 15, 2019 4:59 PM
To: Lance Venable
Subject: Re: NT-MDT Trademark (2031-001)

AmicusDealtWith: Yes

Lance,

I did forward the letter and the employment agreement, but again, have not heard back. It was sent by email.

I will have to ask if I can disclose her email. I have seen webinars where email addresses are stated as both AC privilege and not. However, under GDPR, which sadly can apply here given her locale, an email address is considered protected information. As she is in a GDPR country, I cannot release without her approval.

I didn't receive a locale for the specimen; what was provided can be found on TSDR.

Given her lack of communication, I do not anticipate hearing from her at all, especially since I have withdrawn as attorney of record. She has your email and attachments in complete form. So if she chooses to communicate with you, you'll know.

I wish you the best of luck on this one.

Sincerely,
Curt

From: Lance Venable
Sent: Monday, April 15, 2019 4:50 PM
To: Curt Handley, Esq.
Subject: RE: NT-MDT Trademark (2031-001)

Curt,

Thank for providing me with the notice by email.

Can you please forward an email address where I can reach your former client? I need to communicate with her directly and it could take several days if not a couple of weeks before any mail reaches her.

Also, can you please confirm that you forwarded her a copy of the letter I sent to you? I assume you sent it to her by email if you did.

Additionally, can you please provide me with any information regarding the location within the U.S. where she used her product as shown in your statement of use?

Finally, if you do receive any communication from her regarding this matter, and in particular if she responds to my letter, can you please let me know what she intends to do regarding her application and her business of selling any products bearing my client's trademark?

Regards,

Lance

Lance C. Venable
Registered Patent Attorney
The Law Office of Lance C. Venable, PLLC
4939 W. Ray Rd.
Suite 4-219
Chandler, AZ 85226-2066

Tel: 602-730-1422
E-mail: lance@venableiplaw.com
Web: www.venableiplaw.com

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From: Curt Handley, Esq. <curt@intuitlaw.com>
Sent: Monday, April 15, 2019 9:22 AM
To: Lance Venable <lance@venableiplaw.com>
Subject: Re: NT-MDT Trademark (2031-001)
Importance: High

Lance,

To confirm, I have just removed myself from this mark.

Any further correspondence with regard to this matter and related matters should be directed to the applicant.

Best of luck to you!
Curt

From: Curt Handley, Esq.
Sent: Monday, April 15, 2019 10:55 AM
To: Lance Venable
Subject: Re: NT-MDT Trademark (2031-001)

Lance,

Hope you had a nice weekend.

This is to inform you that:

A) I still have no answer.

B) As you can confirm from PTO records, this mark is heading to registration.

C) I am withdrawing as attorney for the mark due to the fact that upon information from you and my own subsequent investigation, I have been unwittingly used to commit fraud on the PTO.

Sincerely,
Curt

From: Lance Venable
Sent: Monday, April 15, 2019 10:34 AM
To: Curt Handley, Esq.
Subject: RE: NT-MDT Trademark (2031-001)

Dear Curt,

Please advise me on the status of your client's response.

My client needs to know your client's position by the end of the day today and will proceed accordingly without confirmation.

I look forward to your response.

Regards,

Lance

Lance C. Venable
Registered Patent Attorney
The Law Office of Lance C. Venable, PLLC
4939 W. Ray Rd.
Suite 4-219
Chandler, AZ 85226-2066

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law. If you have received this message in error, please notify the sender immediately by telephone (602-730-1422) or by electronic mail at lance@venableiplaw.com.

From: Lance Venable
Sent: Wednesday, April 10, 2019 1:18 PM
To: Curt Handley, Esq. <curt@intuitlaw.com>
Subject: RE: NT-MDT Trademark (2031-001)

Dear Curt,

Thank you for the quick response. I suspected you may not have been aware of the situation so I am glad that you confirmed that fact.

As soon as you receive a response from your client, please let me know what your position is.

As for the prior application, I was not counsel at that time so I have no answer to provide.

I look forward to your supplemental response.

Regards,

Lance

Lance C. Venable
Registered Patent Attorney
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From: Curt Handley, Esq. <curt@intuitlaw.com>
Sent: Wednesday, April 10, 2019 9:51 AM
To: Lance Venable <lance@venableiplaw.com>
Cc: butyaev@ntmdt-si.us
Subject: Re: NT-MDT Trademark (2031-001)
Importance: High

Lance,

I am in receipt of your communications.

No, I was not aware of the facts you have presented. This is highly unfortunate.

May I inquire why your client never filed a follow up application to the one they attempted in 2006?

Regardless, I have forwarded your communications to my client.

Thanks!

Curt

From: Lance Venable
Sent: Wednesday, April 10, 2019 11:31 AM
To: Mr. Curt Handley
Cc: butyaev@ntmdt-si.us
Subject: NT-MDT Trademark (2031-001)

Dear Mr. Handley,

I have attached a letter regarding your client Irina Kozodaeva's trademark application for the NT-MDT and logo trademark.

Please review the letter and respond as requested in the letter.

Regards,

Lance C. Venable
Registered Patent Attorney
The Law Office of Lance C. Venable, PLLC
4939 W. Ray Rd.
Suite 4-219
Chandler, AZ 85226-2066

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

In the matter of trademark Registration No. 5,753,336, registered May 14, 2019

NT-MDT LLC.

Petitioner,

v.

IRINA KOZODAEVA,

Registrant

In re Registration of NT-MDT

Amended Petition for Cancellation

Cancellation No. 92071349

Registrant Irina Kozodaeva (“Kozodaeva”) is an individual and resident of The Netherlands and has her principal address located in the Netherlands.

Kozodaeva is listed in the United States Patent and Trademark Office’s records as the registrant of U.S. Registration No. 5,753,336 (“the ‘336 Registration”) of the following mark identified as NT-MDT (“the Mark”):



The Mark issued on May 14, 2019, for “Apparatus for recording, transmitting and reproducing sound and images; Computer operating software; Computers; Data processing apparatus; Microscopes and their parts; Nautical and photographic

apparatus and instruments, namely, underwater housings for cameras, underwater enclosures for cameras and underwater enclosures for photographic lenses; Optical apparatus, namely, a non-lethal security device that uses a light source to detect, warn, repel, temporarily blind, disorient, nauseate, disable, confuse, debilitate, stun, subdue, stop, or incapacitate persons or animals; Scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings therefor; Transistors; Scanning probe microscopes” in International Class 9.

Petitioner NT-MDT LLC (“NT-MDT”) is a Russian limited liability company with its principal address located in Moscow, Russia. NT-MDT believes it will be damaged by the continued registration of the Mark. Through its authorized attorneys, NT-MDT hereby petitions to cancel the Registration.

The grounds for cancellation are as follows:

BACKGROUND INFORMATION

1. NT-MDT is a Russian limited liability company with its principal offices located in Moscow, Russia.

2. NT-MDT ~~owns~~is one of several ~~affiliate~~affiliated entities that make up the “NT-MDT Co.” group of companies. Other entities include NT-MDT America (an Arizona corporation with its principal location in Tempe, Arizona), NT-MDT Development (an Arizona corporation with its principal location in Tempe, Arizona), NT-MDT Spectrum Instruments (a Russian company with its

principal location in Moscow, Russia), NT-MDT China,¹ a Chinese corporation with offices currently located in Beijing and Shanghai, China, and Nano Technology Instruments - Europe B.V. (a Dutch company with its principal location in Apeldoorn, The Netherlands).

3. NT-MDT Co. has existed for nearly 28 years and has done business in the United States since January 1999, primarily by distributing products that four companies manufactured: CJSC NT-MDT (1999-2003); NTI (2003-2005); NT-MDT Service & Logistics (2005-2015); and NT-MDT (2015-present). These companies were all part of the NT-MDT Co. group at one time or another. Each of their histories, as well as their ownership, control, and use of the Mark, will be discussed below.

CJSC NT-MDT

4. CJSC NT-MDT (“CJSC”) was a Russian closed joint stock company that was formed in 1995 by its owners Victor Bykov and others.²

3.5. CJSC was registered as a small business and, under Russian law, could not have more than 50 employees.

¹ The Chinese entity was formed in 2009 and is currently being reorganized.

² Mazurenko Larisa Lazarevna, Bikmullin Rais Suleymanovich, Aleksandrovich, Baranov Valerii Dmitrievich, Shubin Andrey Borisovich, Saunin Sergey Alekseevich, Samsonov Nikolay Sergeevich, Anisiforova Nalia Victorovna

6. In 1999, CJSC developed the NT-MDT Mark, which it began using to identify AFM products that it manufactured and distributed.

7. Between 1999 and 2003, CJSC manufactured and shipped Atomic Force Microscopes (“AFM”) products directly to distributors and customers in the United States under an oral license to use the NT-MDT Mark.

8. In 2003, owner Victor Bykov assigned the trademark rights in the NT-MDT Mark to CJSC NTI (discussed below).

9. At no time after 2003 did CJSC ever manufacture and ship AFM products to the United States under the NT-MDT Mark.

10. And because CJSC has not directly used or licensed any third-party to use the NT-MDT Mark in the U.S. since 2003, CJSC abandoned any common law rights it had in the United States in the Mark by no later than 2006.

CJSC NTI

11. In 2002, CJSC expanded its business and needed more than 50 employees. NT-MDT CJSC formed CJSC NTI (“NTI”) and owned 100% of it. NTI was a Russian entity that allowed for the greater number of employees under Russian law.

12. NTI became the successor entity to CJSC, and owner Victor Bykov assigned the NT-MDT Mark to NTI from CJSC in 2003.

13. Between 2003 and 2005, NTI manufactured and shipped AFM products directly to distributors and customers in the U.S under an oral license to use the NT-MDT Mark.

14. In 2005, owner Victor Bykov assigned the U.S. trademark rights in the NT-MDT Mark exclusively to NT-MDT Service & Logistics (discussed below).

15. At no time after 2005 did NTI ever manufacture and ship AFM products to the U.S. under the NT-MDT Mark.

16. And because NTI has not directly used the NT-MDT Mark in the U.S. since 2005, NTI abandoned any U.S. common law rights it had in the mark by no later than 2008.

NT-MDT Service & Logistics

17. NT-MDT Service & Logistics (“S&L”) is an Irish corporation formed on August 9, 2004. At its inception, Andrey Bykov owned 90% of S&L, and Vladimir Kotov owned 10% of the company. The owners formed S&L to be the successor to NTI to develop, manufacture, and distribute AFM products directly to distributors and customers throughout the world, including the United States, under the NT-MDT Mark.

18. Between 2005 and 2014, S&L developed significant technological products and filed and obtained patents including the following:

<u>Patent No.</u>	<u>Title</u>	<u>Filing/Issue Dates</u>	<u>Inventors</u>
<u>EP2219036B1</u>	<u>Multifunctional Scanning Probe Microscope</u>	<u>2/13/2009</u> <u>3/12/2014</u>	<u>Andrey Bykov</u> <u>Victor Bykov</u> <u>Vladimir Kotov</u>
<u>US 8,312,560</u>	<u>Multifunctional Scanning Probe Microscope</u>	<u>2/13/2009</u> <u>11/13/2012</u>	<u>Andrey Bykov</u> <u>Victor Bykov</u> <u>Vladimir Kotov</u>

19. Also, between 2005 and 2014, S&L was the exclusive developer, manufacturer and seller of AFM products to the U.S. under the NT-MDT Mark. S&L filed and registered several U.S. trademarks including the following:

<u>Reg. No.</u>	<u>Title</u>	<u>Filing/Reg. Dates</u>
<u>3,890,721</u>	<u>Solver Next</u>	<u>2/25/2009</u> <u>12/14/2010</u>
<u>3,944,839</u>	<u>ScanScaler</u>	<u>11/26/2008</u> <u>10/13/2009</u>
<u>4,009,834</u>	<u>Isoshield System</u>	<u>11/26/2008</u> <u>8/9/2011</u>
<u>4,009,835</u>	<u>ExpertFBA</u>	<u>11/26/2008</u> <u>8/9/2011</u>
<u>4,012,840</u>	<u>Pinpoint</u>	<u>11/30/2008</u> <u>8/16/2011</u>
<u>4,019,833</u>	<u>Headhipex</u>	<u>11/26/2008</u>

		<u>8/30/2011</u>
<u>4,359,596</u>	<u>Solver Nano</u>	<u>4/30/2012</u> <u>7/2/2013</u>
<u>4,359,597</u>	<u>Solver Spectrum</u>	<u>4/30/2012</u> <u>7/2/2013</u>
<u>4,962,139</u>	<u>iCAIR</u>	<u>10/1/2015</u> <u>5/24/2016</u>
<u>3,832,139</u>	<u>NTEGRA LIFE</u>	<u>8/17/2009</u> <u>8/10/2010</u>
<u>3,910,380</u>	<u>Solver Open</u>	<u>2/25/2010</u> <u>1/25/2011</u>

20. During this time frame, S&L shipped approximately 138 products valued at an estimated \$11.5 million dollars to the U.S. And based on the assignment of trademark rights in the NT-MDT Mark from NTI, and its extensive regional uses in the U.S., and under oral licenses it had with its distributors in the U.S., it maintained and owned all common law rights to the NT-MDT Mark in the U.S.

21. Between 2005 and 2008, S&L manufactured and shipped AFM products directly to its customers throughout the U.S., as well as to resale distributors that S&L licensed to use the NT-MDT Mark.

22. Beginning in 2008, and continuing through 2014, S&L manufactured and shipped its AFM products and licensed the NT-MDT Mark exclusively to one marketing and resale entity – NT-MDT America, Inc.

23. On January 1, 2015, S&L assigned all rights to its trademarks - including the NT-MDT Mark, and all of its rights in the U.S. – to NT-MDT LLC (Petitioner).

24. After S&L assigned the trademark rights to NT-MDT, NT-MDT licensed the use of the NT-MDT Mark back to S&L to continue fulfilling signed orders and marketing activities.

25. S&L also continues to sell accessories to the AFM products. But in 2015, S&L ceased all manufacturing and sales of AFM products to the U.S through NT-MDT America.

NT-MDT LLC (Petitioner)

26. NT-MDT LLC is a Russian limited liability company formed in 2013. Andrey Bykov owns 100% of the company.

27. Bykov created NT-MDT to collaborate with Center of Innovations “Skolkovo” in Moscow, which is analogous to Silicon Valley in the U.S., to develop new systems under the “NT-MDT” logo, and to commercialize these new systems.

28. Between 2013 and December 31, 2014, S&L licensed NT-MDT the U.S. common law rights in the NT-MDT Mark.

29. As stated above, beginning January 1, 2015, NT-MDT acquired all rights in the NT-MDT Mark, which included all U.S. common law rights.

30. NT-MDT then continued to orally license the U.S. common law rights to the following entities: (1) NT-MDT America, to market and distribute AFM products under the NT-MDT Mark; (2) NT-MDT Spectrum Instruments; and (3) Scientific Technology Company (“STC”). These three entities will be discussed further below.

31. Beginning in 2017, NT-MDT became the primary entity to manufacture and ship AFM products under the NT-MDT Mark to NT-MDT America, and under the common law trademark license, NT-MDT America continued being the exclusive marketer and distributor of AFM products in the U.S. under the NT-MDT Mark.

Other Companies

Spectrum Instruments Companies

32. There are two companies with the name Spectrum Instruments. The first is NT-MDT Spectrum Instruments (“Spectrum Instruments Russia”), which is a Russian entity formed in 2015, with its headquarters in Moscow. Andrey Bykov owns 84% of that company, with Vladimir Kotov owning the remaining 16%. The

owners created Spectrum Instruments Russia to support NT-MDT LLC (“LLC”) for sales in Russia and worldwide. LLC does not sell third party components, parts, or systems. It only sells those parts that LLC manufactured. When a customer requests third-party component (lasers, optical tables, etc.), LLC does not fulfill the request and therefore Spectrum Instruments Russia does.

33. The second company is Spectrum Instruments LTD, which is an Irish company formed in 2014 (“Spectrum Instruments Ireland”). Between 2015 and 2017, Spectrum Instruments Ireland would ship third-party components, parts, and systems to NT-MDT America for distribution to LLC’s customers in the U.S. NT-MDT America sold these items under the NT-MDT Mark in the U.S. under the license LLC provided to NT-MDT America.

Scientific Technology Company

34. Scientific Technology Company (“STC”) is a Russian entity formed in 2012 with its headquarters in Moscow.

35. Vladimir Kotov owns 100% of the company. Kotov formed STC to serve some Russian contracts.

36. Between 2015 and 2017, LLC licensed STC to manufacture and ship AFM microscopes to LLC’s customers in America through NT-MDT America in 2015-2017.

37. When NT-MDT America bought systems from Spectrum Instruments, the latter purchased microscopes from STC, purchased some third-party components (objectives, optical tables, etc.), added them to the microscope and shipped them to NT-MDT America.

NT-MDT America, Inc.

38. NT-MDT America, Inc. was formed on June 17, 2008 as a California corporation in Santa Clara, California.

39. In May 2014, the company moved its headquarters to Tempe, Arizona and became an Arizona corporation.

40. NT-MDT America's primary purpose was to market and distribute AFM products that S&L produced in Ireland under the NT-MDT Mark in the U.S.

41. Between June 2008 and December 31, 2014, S&L manufactured and shipped approximately \$11.5 million dollars in AFM equipment to NT-MDT America under the NT-MDT Mark.

42. Beginning in 2015, NT-MDT America began receiving shipments of AFM products from Spectrum Instruments Ireland and STC. This continued until 2017, when NT-MDT America began exclusively obtaining shipments of AFM products to be distributed to customers throughout the U.S. under the NT-MDT Mark, which continues through today.

43. At all times between 2008 and the present, NT-MDT America marketed and distributed the AFM products using the NT-MDT Mark under a license from the owners of the U.S. common law rights, which was S&L (2008-2014) and LLC (2015-present).

4.44. In the past 20 years it has operated in the U.S., ~~it~~NT-MDT has either licensed the NT-MDT Mark directly, or obtained the common law rights of that Mark in the U.S. through the predecessor entities that owned an interest in the NT-MDT Mark, all without any gaps. NT-MDT has grown its presence internationally in the development, production, and support of research instrumentation, primarily pertaining to atomic force microscopes (AFM) and its combinations with ultrahigh resolution spectroscopy for nanotechnology and its applications.

5.45. NT-MDT has created many devices, whose functions and capabilities cover a broad range of customer needs including university education, academic, and industrial research.

6.46. NT-MDT's research and development has led to an impressive combination of scanning probe microscopy with Raman spectroscopy.

7.47. NT-MDT's primary trademark that it has used since its inception is the following:



8.48. Since ~~its inception in 1991~~ 1999, NT-MDT has continuously and extensively used the above mark (“the NT-MDT trademark”) and the words “NT-MDT” alone and in combination with the NT-MDT logo.

9.49. Prior to 1999, NT-MDT Co. had used the NT-MDT trademark in Russia and in several European countries.

10.50. In early 1999 NT-MDT Co. expanded its business to the United States. Since then, NT-MDT ~~has~~ and the predecessor companies that have owned the common law rights in the U.S. have used the NT-MDT trademark through its licensing of its mark to its affiliate companies NT-MDT America, NT-MDT Spectrum Instruments, ~~and~~ NT-MDT Development, and its distributors throughout the entire U.S. by selling its products to customers in every portion of the country.

11.51. In this 20-year period, NT-MDT has become a 50 million USD company with annual sales in the U.S. exceeding 2 million USD. By doing so, NT-MDT has acquired substantial goodwill, recognition, and common-law rights in the NT-MDT trademark throughout the entire U.S.

12.52. In January 2005, NT-MDT’s affiliate company, Nano Technology Instruments (“Nano”) of the Netherlands hired Dimitry Kozodaev (“Kozodaev”) as a sales manager under an employment agreement. A copy of Kozodaev’s employment agreement is attached as Exhibit A.

13.53. On information and belief, since Kozodaev’s hire date he has been:

- a. a resident of the Netherlands; and
- b. married to the Registrant, Kozodaeva.

~~14.~~54. In June 2017, Nano terminated Kozodaev's employment due to a contentious dispute between the parties. A copy of the settlement agreement that governed the termination is attached as Exhibit B.

~~15.~~55. As a long-term employee of NT-MDT's affiliate company,

- a. Kozodaev understood NT-MDT owned and used the NT-MDT trademark throughout the U.S.;
- b. Kozodaev's employment agreement expressly stated that any work that he did as an employee and intellectual property rights used or developed inured to NT-MDT's benefit;³
- c. the agreement required him to assist NT-MDT to register any intellectual property rights even if he left the company;⁴ and
- d. as his wife Kozodaeva certainly knew or should have known Kozodaev's responsibilities under the agreement.

~~16.~~56. Under the employment and settlement agreements, Kozodaev was bound by their terms. The express language in the agreement is clear and Kozodaev was unequivocally aware that use of the NT-MDT trademark violated

³ Exhibit A ¶15.

⁴ *Id.*

the terms of the agreements. And therefore, any attempt to register the NT-MDT trademark would constitute fraud upon the USPTO that should have precluded Kozodaev and his wife Kozodaeva from filing any subsequent application for a trademark for the mark NT-MDT.

~~17.57.~~ On information and belief, prior to his termination, Kozodaev had made illegal and infringing copies of NT-MDT's proprietary trade secrets schematics and product designs as well as its copyrighted software and removed them from NT-MDT's workplace.

~~18.58.~~ Unbeknownst to NT-MDT, Kozodaev intended to use the illegally obtained proprietary information and copyrighted software to operate a business that assembled the identical hardware products NT-MDT sells.

~~19.59.~~ Kozodaev further intended to misrepresent to the consuming public that the business entity was either related to NT-MDT or that Kozodaev had purchased the rights to sell the hardware and software by using the identical NT-MDT trademark and accompanying logo.

~~20.60.~~ Approximately one year after NT-MDT terminated Kozodaev, Kozodaev took several steps as part of his illegal scheme including:

- a. Filing and obtaining several internet domain names such as nt-mdt.eu and nt-mdt.us;⁵

⁵ Exhibit C.

- b. Printing and distributing business cards using the identical NT-MDT trademark that falsely represented Kozodaev as being a “director” of NT-MDT Europe, which intentionally confused consumers into believing that any products Kozodaev sold originated from Petitioner NT-MDT. A copy of the business card is shown below;



- c. Instructing his wife, Kozodaeva to file an intent-to-use trademark application on July 19, 2018 (Ser. No. 88/0454,462), with the USPTO individually on her own behalf for the Mark, which is identical to the NT-MDT trademark (the “’462 Application”). Kozodaeva filed the ‘462 Application despite having no bona fide intent to actually use the trademark in the U.S. This ‘462 Application ultimately issued on May 14, 2019 as Registration No. 5,753,336 (the ‘336 Registration) and is the subject of this cancellation proceeding;⁶

⁶ Exhibit D.

- d. Instructing his wife, Kozdaeva to file a Madrid Protocol application (Serial No. 017910749) claiming priority to the '462 Application for the Mark. This application ultimately issued on October 24, 2018;
- e. Contacting several companies that were either actual or potential NT-MDT customers and misrepresenting Kozodaev's company as being affiliated with NT-MDT by using the NT-MDT trademark all to sell the illegal hardware and software products to the companies; and
- f. Filing a fraudulent statement of use for the subject application for the Mark despite fully knowing that Kozodaeva had herself never actually used the Mark in interstate commerce within the U.S. and despite fully knowing that the Petitioner had used the NT-MDT trademark under the common law in the U.S. for over 20 years prior to filing her application.

[21.61.](#) Undoubtedly, when Kozodaeva applied for NT-MDT trademark with the USPTO, she did so while knowing her husband's agreements precluded her from doing so, and thus obtained her registration fraudulently.

[22.62.](#) In March 2019, months after the opposition period ended for Kozodaeva's U.S. application, NT-MDT learned of Kozodaev's illegal scheme and the fact that Kozodaeva had filed the U.S. and Madrid Protocol trademark applications.

[23-63](#). Since learning of Kozodaev's and Kozodaeva's illegal scheme, NT-MDT has taken affirmative steps to protect its trade secret, copyright, and trademark rights against them including filing a trademark application for the NT-MDT trademark on April 25, 2019 (U.S. Ser. No. 88/402,894) with the USPTO (the "894 Application").

[24-64](#). In addition to its rights under the '894 Application, NT-MDT alleges that its 20 years of extensive use throughout the U.S. of the NT-MDT trademark on its products provides it with widespread and superior common law rights for the NT-MDT mark over any rights that Kozodaev or Kozodaeva may claim.

[25-65](#). Additionally, NT-MDT sent Kozodaeva's attorney, Curt Handley who filed the application for the '336 Registration a cease and desist letter, demanding that he immediately instruct Kozodaeva to permit him to cancel the registration based the aforementioned fraud allegations.

[26-66](#). Shortly thereafter, Handley responded and indicated that he was unaware of what Kozodaeva had done.⁷

[27-67](#). Handley further stated that he agreed with NT-MDT's fraud allegations and was so appalled at his client's behavior that he stated in an email to NT-MDT's counsel, "I am withdrawing as attorney for the mark due to the fact

⁷ Exhibit E.

that upon information from you **and my own subsequent investigation**, I have been unwittingly used to commit fraud on the PTO.”⁸

[28-68](#). Shortly thereafter on April 15, 2019, Handley withdrew as counsel of record in the matter. As the reason stated for his withdrawal, Handley stated, “Due to recently uncovered information, Applicant appears to have intentionally misrepresented its position as true owner of this mark. As such, Attorney must withdraw due to ethical considerations.”⁹

[29-69](#). Handley also instructed his client to cancel the application. On information and belief, Kozdaeva refused to cancel the application.

FIRST GROUND FOR CANCELLATION THE REGISTRATION IS VOID *AB INITIO*

[30-70](#). NT-MDT incorporates allegations 1-[29-67](#) by reference and realleges them herein.

[31-71](#). NT-MDT petitions to cancel the ‘336 Registration under § 1 of the Trademark Act because the Registration is void ab initio as Kozodaeva did not, and could not, have used or owned the mark at the time she filed the application.

⁸ *Id.*

⁹ *Id.*

[~~32-72~~](#). On July 19, 2018 (the “Filing Date”), Irina Kozodaeva filed the ‘462 Application to register the NT-MDT trademark with the USPTO.

[~~33-73~~](#). Kozodaeva filed the ‘462 Application under § 1(b) of the Trademark Act for the following goods: “apparatus for recording, transmitting and reproducing sound and images; Computer operating software; Computers; Data processing apparatus; Microscopes and their parts; Nautical and photographic apparatus and instruments, namely, underwater housings for cameras, underwater enclosures for cameras and underwater enclosures for photographic lenses; Optical apparatus, namely, a non-lethal security device that uses a light source to detect, warn, repel, temporarily blind, disorient, nauseate, disable, confuse, debilitate, stun, subdue, stop, or incapacitate persons or animals; Scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings therefor; Transistors; Scanning probe microscopes” in International Class 9.

[~~34-74~~](#). Kozodaeva’s attorney signed the application on her behalf and listed her as the owner of the NT-MDT Mark.

[~~35-75~~](#). On March 10, 2019, Kozodaeva filed a statement of use and included a picture of a specimen of a product bearing the NT-MDT Mark that she alleged she had first used in the U.S. in interstate commerce on January 8, 2019.

[~~36-76~~](#). The ‘336 Registration issued to Kozodaeva on May 14, 2019.

[37.77.](#) On information and belief, as of the filing date of the ‘462 Application, Kozodaeva did not own the NT-MDT Mark, nor had she used it in interstate commerce in the U.S.

[38.78.](#) On information and belief, Kozodaeva never had a bona fide intent-to-use the ‘462 application in the U.S. and filed it only because Kozodaev instructed Kozodaeva to do so to avoid being liable for breach of Kozodaev’s employment agreement and to avoid detection from NT-MDT.

[39.79.](#) Under 37 C.F.R. § 2.17, “[a]n application filed in the name of an entity that did not own the mark as of the filing date of the application is void.”

[40.80.](#) The ‘462 Application was void because Kozodaeva had no bona fide intent to use the NT-MDT Mark as of the Filing Date, Kozodaeva did not own the NT-MDT mark as of the Filing Date, and Kozodaeva had not used the NT-MDT mark in interstate commerce as of January 8, 2019.

[41.81.](#) The ‘336 Registration creates a legal presumption that Kozodaeva has valid and exclusive rights in the NT-MDT Mark for goods identified in the ‘336 Registration.

[42.82.](#) For the reasons stated above, Kozodaeva is not entitled to the ‘336 Registration or to the legal presumptions that the ‘336 Registration creates.

[43.83.](#) The continued presence of the ‘336 Registration on the federal Principal Register constitutes an obstacle to NT-MDT’s ongoing and continuing

20-year use of its NT-MDT Mark under the common law and its current attempt to register its own Principal Register trademark for the NT-MDT Mark.

**SECOND GROUND FOR CANCELLATION
LIKELIHOOD OF CONFUSION UNDER 15 U.S.C. § 1052(D)**

[44.84.](#) NT-MDT incorporates allegations 1-~~43~~[83](#) by reference and realleges them herein.

[45.85.](#) NT-MDT petitions to cancel the ‘336 Registration under 15 U.S.C. § 1052(d).

[46.86.](#) NT-MDT has proprietary rights in its common law use of the NT-MDT trademark throughout the entire U.S.

[47.87.](#) NT-MDT has approximately 20 years of priority over Kozodaeva in the common law mark for the NT-MDT trademark.

[48.88.](#) NT-MDT asserts that common law NT-MDT Trademark is distinctive.

[49.89.](#) NT-MDT’s common law mark and Kozodaeva’s registration for the identical NT-MDT trademark are identical to each other, if not highly similar in sight, sound, meaning, and commercial impression.

[50.90.](#) The goods listed in each of Kozodaeva’s registration for the NT-MDT trademark and the goods NT-MDT uses the NT-MDT trademark upon are identical to each other (apparatuses for recording, transmitting and reproducing sound and

images; computer operating software; computers; data processing apparatus; microscopes and their parts; nautical and photographic apparatus and instruments, namely, underwater housings for cameras, underwater enclosures for cameras and underwater enclosures for photographic lenses; optical apparatus, namely, a non-lethal security device that uses a light source to detect, warn, repel, temporarily blind, disorient, nauseate, disable, confuse, debilitate, stun, subdue, stop, or incapacitate persons or animals; scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings therefor; transistors; scanning probe microscopes in International Class 9).

[51.91](#). Therefore, Kozodaeva's use of the NT-MDT trademark in the U.S. is likely to cause confusion with NT-MDT's senior rights in common law use of the identical NT-MDT trademark in the U.S. identified above and violate Section 2(d) of the Trademark Act.

**THIRD GROUND FOR CANCELLATION
FRAUD UPON THE U.S. PATENT AND TRADEMARK OFFICE
KNOWING USE BY OTHERS AT TIME OF FILING**

[52.92](#). NT-MDT incorporates allegations 1-~~54~~[91](#) by reference and realleges them herein.

[53.93](#). NT-MDT petitions to cancel the '336 Registration as Kozodaeva fraudulently procured the application.

[54.94.](#) Under Kozodaev's employment and settlement agreements between Kozodaev and NT-MDT, Kozodaev and his wife, the Registrant Kozodaeva were bound by the agreements' terms and as Kozodaeva's wife, she undoubtedly knew that NT-MDT had used the identical NT-MDT trademark that it intended to file in the U.S.

[55.95.](#) Kozodaev and Kozodaeva knew that NT-MDT had used the mark in the U.S. for approximately 20 years in the U.S. prior to the date Kozodaeva filed the '462 Application.

[56.96.](#) Based on the employment and settlement agreements that Kozodaev signed, Kozodaev and Kozodaeva undoubtedly knew that any attempt to use the NT-MDT trademarks in the U.S. would violate the terms of the agreements.¹⁰

[57.97.](#) The Agreements also precluded Kozodaev from either directly filing, or indirectly filing through Kozodaeva any subsequent application at the USPTO for a trademark for the identical goods NT-MDT sold in the U.S. under the identical NT-MDT trademark.¹¹

[58.98.](#) When Kozodaeva applied for the NT-MDT Trademark with the USPTO and signed the verified declaration, she did so knowing the employment

¹⁰ See Exhibit A at ¶ 15; see also Exhibit B.

¹¹ See *id.*

and settlement agreements precluded her from doing so, and thus signed the declaration fraudulently.

[~~59.99.~~](#) NT-MDT had superior legal rights to the NT-MDT trademark for the goods listed in the '462 Application Kozdaeva filed.

[~~60.100.~~](#) Kozodaeva undoubtedly knew that NT-MDT's rights in the mark in the U.S. were superior to Kozodaeva's rights and she knew that either the use of the NT-MDT mark in the U.S. would likely cause confusion with NT-MDT's use of the identical mark, or had no basis for believing that use of the mark would not cause confusion.

[~~61.101.~~](#) Kozodaeva, in failing to disclose these facts to the USPTO, intended to procure a registration to which she was not entitled, intended to deceive the USPTO, and therefore committed a fraud upon the USPTO.

[~~62.102.~~](#) The USPTO reasonably relied upon Kozodaeva's fraudulent representations and issued the '336 Registration based upon that fraud.

[~~63.103.~~](#) By the USPTO issuing the '336 Registration based upon Kozodaeva's fraudulent misrepresentations, NT-MDT has been damaged.

**FOURTH GROUND FOR CANCELLATION
FRAUD UPON THE U.S. PATENT AND TRADEMARK OFFICE
NON-USE AT STATEMENT OF USE FILING**

64.104. NT-MDT incorporates allegations 1-~~63~~103 by reference and realleges them herein.

65.105. NT-MDT petitions to cancel the ‘336 Registration as Kozodaeva fraudulently procured the application.

66.106. Kozodaeva knew at the time she filed her statement of use that she had never personally sold or used in interstate commerce in the U.S. any of the goods identified in her trademark application under the NT-MDT Trademark.

67.107. Despite knowing that she had not used the mark in interstate commerce, Kozodaeva filed a statement of use with an intent to deceive the USPTO that included a specimen showing a piece of hardware with the NT-MDT trademark affixed to it that Kozodaeva had not used as of the date of first use indicated in the statement of use.

68.108. By procuring and filing the false statements in the statement of use with the USPTO, Kozodaeva intended to deceive the USPTO and therefore committed a fraud upon the USPTO.

69.109. The USPTO reasonably relied upon Kozodaeva’s fraudulent representations and issued the ‘336 Registration based upon that fraud.

70.110. By the USPTO issuing the ‘336 Registration based upon Kozodaeva’s fraudulent misrepresentations, NT-MDT has been damaged.

**FIFTH GROUND FOR CANCELLATION
FRAUD UPON THE U.S. PATENT AND TRADEMARK OFFICE
LACK OF OWNERSHIP OF THE MARK**

71.111. NT-MDT incorporates allegations 1-~~70.110~~ by reference and realleges them herein.

72.112. NT-MDT petitions to cancel the ‘336 Registration as Kozodaeva fraudulently procured the application.

73.113. Under Kozodaev’s employment and settlement agreements ~~between Kozodaev and NT-MDT~~, Kozodaev and his wife, the Registrant Kozodaeva were bound by the agreements’ terms and as Kozodaeva’s wife, she undoubtedly knew that NT-MDT had used the identical NT-MDT trademark that it intended to file in the U.S.

74.114. Kozodaev and Kozodaeva knew that NT-MDT had used the mark in the U.S. for approximately 20 years in the U.S. prior to the date Kozodaeva filed the ‘462 Application.

75.115. Based on the employment and settlement agreements that Kozodaev signed, Kozodaev and Kozodaeva undoubtedly knew that any attempt to

use the NT-MDT trademarks in the U.S. would violate the terms of the agreements.¹²

~~76.~~116. The Agreements also precluded Kozodaev from either directly filing, or indirectly filing through Kozodaeva any subsequent application at the USPTO for a trademark for the identical goods NT-MDT sold in the U.S. under the identical NT-MDT trademark.¹³

~~77.~~117. When Kozodaeva applied for the NT-MDT Trademark with the USPTO and signed the verified declaration, she did so knowing the employment and settlement agreements precluded her from being an owner of the trademark, and thus signed the declaration fraudulently.

~~78.~~118. Furthermore, as shown in paragraph ~~2060~~(c) above, either Kozodaev or his fraudulent company shown on his business card NT-MDT Europe were the only entities attempting to use the NT-MDT Trademark.

~~79.~~119. Kozodaev instructed his wife, Kozodaeva to file the ‘462 Application in the U.S. solely to avoid being liable under the employment and settlement agreements and not to truly own the NT-MDT Trademark.

~~80.~~120. When Kozodaeva filed the ‘462 Application, she undoubtedly knew that she as an individual did not~~;~~ and could not own the NT-MDT mark.

¹² See Exhibit A at ¶15; see also Exhibit B.

¹³ See *id.*

~~81.121.~~ Kozodaeva, in failing to disclose these facts to the USPTO, intended to procure a registration to which she was not entitled, intended to deceive the USPTO, and therefore committed a fraud upon the USPTO.

~~82.122.~~ The USPTO reasonably relied upon Kozodaeva's fraudulent representations and issued the '336 Registration based upon that fraud.

~~83.123.~~ By the USPTO issuing the '336 Registration based upon Kozodaeva's fraudulent misrepresentations, NT-MDT has been damaged.

WHEREFORE, Petitioner NT-MDT respectfully requests that the TTAB
cancel Kozodaeva's registration for U.S. Registration No. 5,753,336.

Dated: January 9, 2020

Respectfully submitted,

s/Lance C. Venable

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~~Certificate of Service~~

Certificate of Service

I hereby certify that the forgoing was electronically FILED via ESTTA on January 9, 2020, and that a copy has been SERVED on counsel for Registrant Irina Kozodaeva on January 9, 2020 by forwarding the copy by email to

Kenneth M. Motolenich-Salas
16210 North 63rd Street
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Telephone: (202) 257-3720
Email: Ken@motosalaslaw.com
Counsel for Registrant Irina Kozodaeva.

By: s/Lance C. Venable/

~~I hereby certify that the forgoing was electronically FILED and SERVED via ESTTA upon the Registrant, Kozodaeva:~~

~~on: May 20, 2019~~

~~By: s/Lance C. Venable/~~

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

In the matter of trademark Registration No. 5,753,336, registered May 14, 2019

NT-MDT LLC.

Petitioner,

v.

IRINA KOZODAEVA,

Registrant

In re Registration of NT-MDT

Amended Petition for Cancellation

Cancellation No. 92071349

Registrant Irina Kozodaeva (“Kozodaeva”) is an individual and resident of The Netherlands and has her principal address located in the Netherlands.

Kozodaeva is listed in the United States Patent and Trademark Office’s records as the registrant of U.S. Registration No. 5,753,336 (“the ‘336 Registration”) of the following mark identified as NT-MDT (“the Mark”):



The Mark issued on May 14, 2019, for “Apparatus for recording, transmitting and reproducing sound and images; Computer operating software; Computers; Data processing apparatus; Microscopes and their parts; Nautical and photographic

apparatus and instruments, namely, underwater housings for cameras, underwater enclosures for cameras and underwater enclosures for photographic lenses; Optical apparatus, namely, a non-lethal security device that uses a light source to detect, warn, repel, temporarily blind, disorient, nauseate, disable, confuse, debilitate, stun, subdue, stop, or incapacitate persons or animals; Scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings therefor; Transistors; Scanning probe microscopes” in International Class 9.

Petitioner NT-MDT LLC (“NT-MDT”) is a Russian limited liability company with its principal address located in Moscow, Russia. NT-MDT believes it will be damaged by the continued registration of the Mark. Through its authorized attorneys, NT-MDT hereby petitions to cancel the Registration.

The grounds for cancellation are as follows:

BACKGROUND INFORMATION

1. NT-MDT is a Russian limited liability company with its principal offices located in Moscow, Russia.
2. NT-MDT is one of several affiliated entities that make up the “NT-MDT Co.” group of companies. Other entities include NT-MDT America (an Arizona corporation with its principal location in Tempe, Arizona), NT-MDT Development (an Arizona corporation with its principal location in Tempe, Arizona), NT-MDT Spectrum Instruments (a Russian company with its principal

location in Moscow, Russia), NT-MDT China,¹ a Chinese corporation with offices currently located in Beijing and Shanghai, China, and Nano Technology Instruments - Europe B.V. (a Dutch company with its principal location in Apeldoorn, The Netherlands).

3. NT-MDT Co. has existed for nearly 28 years and has done business in the United States since January 1999 primarily by distributing products that four companies manufactured: CJSC NT-MDT (1999-2003); NTI (2003-2005); NT-MDT Service & Logistics (2005-2015); and NT-MDT (2015-present). These companies were all part of the NT-MDT Co. group at one time or another. Each of their histories, as well as their ownership, control, and use of the Mark, will be discussed below.

CJSC NT-MDT

4. CJSC NT-MDT (“CJSC”) was a Russian closed joint stock company that was formed in 1995 by its owners Victor Bykov and others.²

5. CJSC was registered as a small business and, under Russian law, could not have more than 50 employees.

¹ The Chinese entity was formed in 2009 and is currently being reorganized.

² Mazurenko Larisa Lazarevna, Bikmullin Rais Suleymanovich, Aleksandrovich, Baranov Valerii Dmitrievich, Shubin Andrey Borisovich, Saunin Sergey Alekseevich, Samsonov Nikolay Sergeevich, Anisiforova Nalia Victorovna

6. In 1999, CJSC developed the NT-MDT Mark, which it began using to identify AFM products that it manufactured and distributed.

7. Between 1999 and 2003, CJSC manufactured and shipped Atomic Force Microscopes (“AFM”) products directly to distributors and customers in the United States under an oral license to use the NT-MDT Mark.

8. In 2003, owner Victor Bykov assigned the trademark rights in the NT-MDT Mark to CJSC NTI (discussed below).

9. At no time after 2003 did CJSC ever manufacture and ship AFM products to the United States under the NT-MDT Mark.

10. And because CJSC has not directly used or licensed any third-party to use the NT-MDT Mark in the U.S. since 2003, CJSC abandoned any common law rights it had in the United States in the Mark by no later than 2006.

CJSC NTI

11. In 2002, CJSC expanded its business and needed more than 50 employees. NT-MDT CJSC formed CJSC NTI (“NTI”) and owned 100% of it. NTI was a Russian entity that allowed for the greater number of employees under Russian law.

12. NTI became the successor entity to CJSC, and owner Victor Bykov assigned the NT-MDT Mark to NTI from CJSC in 2003.

13. Between 2003 and 2005, NTI manufactured and shipped AFM products directly to distributors and customers in the U.S under an oral license to use the NT-MDT Mark.

14. In 2005, owner Victor Bykov assigned the U.S. trademark rights in the NT-MDT Mark exclusively to NT-MDT Service & Logistics (discussed below).

15. At no time after 2005 did NTI ever manufacture and ship AFM products to the U.S. under the NT-MDT Mark.

16. And because NTI has not directly used the NT-MDT Mark in the U.S. since 2005, NTI abandoned any U.S. common law rights it had in the mark by no later than 2008.

NT-MDT Service & Logistics

17. NT-MDT Service & Logistics (“S&L”) is an Irish corporation formed on August 9, 2004. At its inception, Andrey Bykov owned 90% of S&L, and Vladimir Kotov owned 10% of the company. The owners formed S&L to be the successor to NTI to develop, manufacture, and distribute AFM products directly to distributors and customers throughout the world, including the United States, under the NT-MDT Mark.

18. Between 2005 and 2014, S&L developed significant technological products and filed and obtained patents including the following:

Patent No.	Title	Filing/Issue Dates	Inventors
EP2219036B1	Multifunctional Scanning Probe Microscope	2/13/2009 3/12/2014	Andrey Bykov Victor Bykov Vladimir Kotov
US 8,312,560	Multifunctional Scanning Probe Microscope	2/13/2009 11/13/2012	Andrey Bykov Victor Bykov Vladimir Kotov

19. Also, between 2005 and 2014, S&L was the exclusive developer, manufacturer and seller of AFM products to the U.S. under the NT-MDT Mark. S&L filed and registered several U.S. trademarks including the following:

Reg. No.	Title	Filing/Reg. Dates
3,890,721	Solver Next	2/25/2009 12/14/2010
3,944,839	ScanScaler	11/26/2008 10/13/2009
4,009,834	Isoshield System	11/26/2008 8/9/2011
4,009,835	ExpertFBA	11/26/2008 8/9/2011
4,012,840	Pinpoint	11/30/2008 8/16/2011
4,019,833	Headhipex	11/26/2008

		8/30/2011
4,359,596	Solver Nano	4/30/2012 7/2/2013
4,359,597	Solver Spectrum	4/30/2012 7/2/2013
4,962,139	iCAIR	10/1/2015 5/24/2016
3,832,139	NTEGRA LIFE	8/17/2009 8/10/2010
3,910,380	Solver Open	2/25/2010 1/25/2011

20. During this time frame, S&L shipped approximately 138 products valued at an estimated \$11.5 million dollars to the U.S. And based on the assignment of trademark rights in the NT-MDT Mark from NTI, and its extensive regional uses in the U.S., and under oral licenses it had with its distributors in the U.S., it maintained and owned all common law rights to the NT-MDT Mark in the U.S.

21. Between 2005 and 2008, S&L manufactured and shipped AFM products directly to its customers throughout the U.S., as well as to resale distributors that S&L licensed to use the NT-MDT Mark.

22. Beginning in 2008, and continuing through 2014, S&L manufactured and shipped its AFM products and licensed the NT-MDT Mark exclusively to one marketing and resale entity – NT-MDT America, Inc.

23. On January 1, 2015, S&L assigned all rights to its trademarks - including the NT-MDT Mark, and all of its rights in the U.S. – to NT-MDT LLC (Petitioner).

24. After S&L assigned the trademark rights to NT-MDT, NT-MDT licensed the use of the NT-MDT Mark back to S&L to continue fulfilling signed orders and marketing activities.

25. S&L also continues to sell accessories to the AFM products. But in 2015, S&L ceased all manufacturing and sales of AFM products to the U.S through NT-MDT America.

NT-MDT LLC (Petitioner)

26. NT-MDT LLC is a Russian limited liability company formed in 2013. Andrey Bykov owns 100% of the company.

27. Bykov created NT-MDT to collaborate with Center of Innovations “Skolkovo” in Moscow, which is analogous to Silicon Valley in the U.S., to develop new systems under the “NT-MDT” logo, and to commercialize these new systems.

28. Between 2013 and December 31, 2014, S&L licensed NT-MDT the U.S. common law rights in the NT-MDT Mark.

29. As stated above, beginning January 1, 2015, NT-MDT acquired all rights in the NT-MDT Mark, which included all U.S. common law rights.

30. NT-MDT then continued to orally license the U.S. common law rights to the following entities: (1) NT-MDT America, to market and distribute AFM products under the NT-MDT Mark; (2) NT-MDT Spectrum Instruments; and (3) Scientific Technology Company (“STC”). These three entities will be discussed further below.

31. Beginning in 2017, NT-MDT became the primary entity to manufacture and ship AFM products under the NT-MDT Mark to NT-MDT America, and under the common law trademark license, NT-MDT America continued being the exclusive marketer and distributor of AFM products in the U.S. under the NT-MDT Mark.

Other Companies

Spectrum Instruments Companies

32. There are two companies with the name Spectrum Instruments. The first is NT-MDT Spectrum Instruments (“Spectrum Instruments Russia”), which is a Russian entity formed in 2015, with its headquarters in Moscow. Andrey Bykov owns 84% of that company, with Vladimir Kotov owning the remaining 16%. The

owners created Spectrum Instruments Russia to support NT-MDT LLC (“LLC”) for sales in Russia and worldwide. LLC does not sell third party components, parts, or systems. It only sells those parts that LLC manufactured. When a customer requests third-party component (lasers, optical tables, etc..), LLC does not fulfill the request and therefore Spectrum Instruments Russia does.

33. The second company is Spectrum Instruments LTD, which is an Irish company formed in 2014 (“Spectrum Instruments Ireland”). Between 2015 and 2017, Spectrum Instruments Ireland would ship third-party components, parts, and systems to NT-MDT America for distribution to LLC’s customers in the U.S. NT-MDT America sold these items under the NT-MDT Mark in the U.S. under the license LLC provided to NT-MDT America.

Scientific Technology Company

34. Scientific Technology Company (“STC”) is a Russian entity formed in 2012 with its headquarters in Moscow.

35. Vladimir Kotov owns 100% of the company. Kotov formed STC to serve some Russian contracts.

36. Between 2015 and 2017, LLC licensed STC to manufacture and ship AFM microscopes to LLC’s customers in America through NT-MDT America in 2015-2017.

37. When NT-MDT America bought systems from Spectrum Instruments, the latter purchased microscopes from STC, purchased some third-party components (objectives, optical tables, etc.), added them to the microscope and shipped them to NT-MDT America.

NT-MDT America, Inc.

38. NT-MDT America, Inc. was formed on June 17, 2008 as a California corporation in Santa Clara, California.

39. In May 2014, the company moved its headquarters to Tempe, Arizona and became an Arizona corporation.

40. NT-MDT America's primary purpose was to market and distribute AFM products that S&L produced in Ireland under the NT-MDT Mark in the U.S.

41. Between June 2008 and December 31, 2014, S&L manufactured and shipped approximately \$11.5 million dollars in AFM equipment to NT-MDT America under the NT-MDT Mark.

42. Beginning in 2015, NT-MDT America began receiving shipments of AFM products from Spectrum Instruments Ireland and STC. This continued until 2017, when NT-MDT America began exclusively obtaining shipments of AFM products to be distributed to customers throughout the U.S. under the NT-MDT Mark, which continues through today.

43. At all times between 2008 and the present, NT-MDT America marketed and distributed the AFM products using the NT-MDT Mark under a license from the owners of the U.S. common law rights, which was S&L (2008-2014) and LLC (2015-present).

44. In the past 20 years it has operated in the U.S., NT-MDT has either licensed the NT-MDT Mark directly, or obtained the common law rights of that Mark in the U.S. through the predecessor entities that owned an interest in the NT-MDT Mark, all without any gaps. NT-MDT has grown its presence internationally in the development, production, and support of research instrumentation, primarily pertaining to atomic force microscopes (AFM) and its combinations with ultrahigh resolution spectroscopy for nanotechnology and its applications.

45. NT-MDT has created many devices, whose functions and capabilities cover a broad range of customer needs including university education, academic, and industrial research.

46. NT-MDT's research and development has led to an impressive combination of scanning probe microscopy with Raman spectroscopy.

47. NT-MDT's primary trademark that it has used since its inception is the following:



48. Since 1999, NT-MDT has continuously and extensively used the above mark (“the NT-MDT trademark”) and the words “NT-MDT” alone and in combination with the NT-MDT logo.

49. Prior to 1999, NT-MDT Co. had used the NT-MDT trademark in Russia and in several European countries.

50. In early 1999 NT-MDT Co. expanded its business to the United States. Since then, NT-MDT and the predecessor companies that have owned the common law rights in the U.S. have used the NT-MDT trademark through its licensing of its mark to its affiliate companies NT-MDT America, NT-MDT Spectrum Instruments, NT-MDT Development, and its distributors throughout the entire U.S. by selling its products to customers in every portion of the country.

51. In this 20-year period, NT-MDT has become a 50 million USD company with annual sales in the U.S. exceeding 2 million USD. By doing so, NT-MDT has acquired substantial goodwill, recognition, and common-law rights in the NT-MDT trademark throughout the entire U.S.

52. In January 2005, NT-MDT’s affiliate company, Nano Technology Instruments (“Nano”) of the Netherlands hired Dimitry Kozodaev (“Kozodaev”) as a sales manager under an employment agreement. A copy of Kozodaev’s employment agreement is attached as Exhibit A.

53. On information and belief, since Kozodaev’s hire date he has been:

- a. a resident of the Netherlands; and
- b. married to the Registrant, Kozodaeva.

54. In June 2017, Nano terminated Kozodaev's employment due to a contentious dispute between the parties. A copy of the settlement agreement that governed the termination is attached as Exhibit B.

55. As a long-term employee of NT-MDT's affiliate company,

- a. Kozodaev understood NT-MDT owned and used the NT-MDT trademark throughout the U.S.;
- b. Kozodaev's employment agreement expressly stated that any work that he did as an employee and intellectual property rights used or developed inured to NT-MDT's benefit;³
- c. the agreement required him to assist NT-MDT to register any intellectual property rights even if he left the company;⁴ and
- d. as his wife Kozodaeva certainly knew or should have known Kozodaev's responsibilities under the agreement.

56. Under the employment and settlement agreements, Kozodaev was bound by their terms. The express language in the agreement is clear and Kozodaev was unequivocally aware that use of the NT-MDT trademark violated

³ Exhibit A ¶15.

⁴ *Id.*

the terms of the agreements. And therefore, any attempt to register the NT-MDT trademark would constitute fraud upon the USPTO that should have precluded Kozodaev and his wife Kozodaeva from filing any subsequent application for a trademark for the mark NT-MDT.

57. On information and belief, prior to his termination, Kozodaev had made illegal and infringing copies of NT-MDT's proprietary trade secrets schematics and product designs as well as its copyrighted software and removed them from NT-MDT's workplace.

58. Unbeknownst to NT-MDT, Kozodaev intended to use the illegally obtained proprietary information and copyrighted software to operate a business that assembled the identical hardware products NT-MDT sells.

59. Kozodaev further intended to misrepresent to the consuming public that the business entity was either related to NT-MDT or that Kozodaev had purchased the rights to sell the hardware and software by using the identical NT-MDT trademark and accompanying logo.

60. Approximately one year after NT-MDT terminated Kozodaev, Kozodaev took several steps as part of his illegal scheme including:

- a. Filing and obtaining several internet domain names such as nt-mdt.eu and nt-mdt.us;⁵

⁵ Exhibit C.

- b. Printing and distributing business cards using the identical NT-MDT trademark that falsely represented Kozodaev as being a “director” of NT-MDT Europe, which intentionally confused consumers into believing that any products Kozodaev sold originated from Petitioner NT-MDT. A copy of the business card is shown below;



- c. Instructing his wife, Kozodaeva to file an intent-to-use trademark application on July 19, 2018 (Ser. No. 88/0454,462), with the USPTO individually on her own behalf for the Mark, which is identical to the NT-MDT trademark (the “’462 Application”). Kozodaeva filed the ‘462 Application despite having no bona fide intent to actually use the trademark in the U.S. This ‘462 Application ultimately issued on May 14, 2019 as Registration No. 5,753,336 (the ‘336 Registration) and is the subject of this cancellation proceeding;⁶

⁶ Exhibit D.

- d. Instructing his wife, Kozdaeva to file a Madrid Protocol application (Serial No. 017910749) claiming priority to the '462 Application for the Mark. This application ultimately issued on October 24, 2018;
- e. Contacting several companies that were either actual or potential NT-MDT customers and misrepresenting Kozodaev's company as being affiliated with NT-MDT by using the NT-MDT trademark all to sell the illegal hardware and software products to the companies; and
- f. Filing a fraudulent statement of use for the subject application for the Mark despite fully knowing that Kozodaeva had herself never actually used the Mark in interstate commerce within the U.S. and despite fully knowing that the Petitioner had used the NT-MDT trademark under the common law in the U.S. for over 20 years prior to filing her application.

61. Undoubtedly, when Kozodaeva applied for NT-MDT trademark with the USPTO, she did so while knowing her husband's agreements precluded her from doing so, and thus obtained her registration fraudulently.

62. In March 2019, months after the opposition period ended for Kozodaeva's U.S. application, NT-MDT learned of Kozodaev's illegal scheme and the fact that Kozodaeva had filed the U.S. and Madrid Protocol trademark applications.

63. Since learning of Kozodaev's and Kozodaeva's illegal scheme, NT-MDT has taken affirmative steps to protect its trade secret, copyright, and trademark rights against them including filing a trademark application for the NT-MDT trademark on April 25, 2019 (U.S. Ser. No. 88/402,894) with the USPTO (the "894 Application").

64. In addition to its rights under the '894 Application, NT-MDT alleges that its 20 years of extensive use throughout the U.S. of the NT-MDT trademark on its products provides it with widespread and superior common law rights for the NT-MDT mark over any rights that Kozodaev or Kozodaeva may claim.

65. Additionally, NT-MDT sent Kozodaeva's attorney, Curt Handley who filed the application for the '336 Registration a cease and desist letter, demanding that he immediately instruct Kozodaeva to permit him to cancel the registration based the aforementioned fraud allegations.

66. Shortly thereafter, Handley responded and indicated that he was unaware of what Kozodaeva had done.⁷

67. Handley further stated that he agreed with NT-MDT's fraud allegations and was so appalled at his client's behavior that he stated in an email to NT-MDT's counsel, "I am withdrawing as attorney for the mark due to the fact

⁷ Exhibit E.

that upon information from you **and my own subsequent investigation**, I have been unwittingly used to commit fraud on the PTO.”⁸

68. Shortly thereafter on April 15, 2019, Handley withdrew as counsel of record in the matter. As the reason stated for his withdrawal, Handley stated, “Due to recently uncovered information, Applicant appears to have intentionally misrepresented its position as true owner of this mark. As such, Attorney must withdraw due to ethical considerations.”⁹

69. Handley also instructed his client to cancel the application. On information and belief, Kozdaeva refused to cancel the application.

FIRST GROUND FOR CANCELLATION THE REGISTRATION IS VOID *AB INITIO*

70. NT-MDT incorporates allegations 1-67 by reference and realleges them herein.

71. NT-MDT petitions to cancel the ‘336 Registration under § 1 of the Trademark Act because the Registration is void ab initio as Kozodaeva did not, and could not, have used or owned the mark at the time she filed the application.

⁸ *Id.*

⁹ *Id.*

72. On July 19, 2018 (the “Filing Date”), Irina Kozodaeva filed the ‘462 Application to register the NT-MDT trademark with the USPTO.

73. Kozodaeva filed the ‘462 Application under § 1(b) of the Trademark Act for the following goods: “apparatus for recording, transmitting and reproducing sound and images; Computer operating software; Computers; Data processing apparatus; Microscopes and their parts; Nautical and photographic apparatus and instruments, namely, underwater housings for cameras, underwater enclosures for cameras and underwater enclosures for photographic lenses; Optical apparatus, namely, a non-lethal security device that uses a light source to detect, warn, repel, temporarily blind, disorient, nauseate, disable, confuse, debilitate, stun, subdue, stop, or incapacitate persons or animals; Scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings therefor; Transistors; Scanning probe microscopes” in International Class 9.

74. Kozodaeva’s attorney signed the application on her behalf and listed her as the owner of the NT-MDT Mark.

75. On March 10, 2019, Kozodaeva filed a statement of use and included a picture of a specimen of a product bearing the NT-MDT Mark that she alleged she had first used in the U.S. in interstate commerce on January 8, 2019.

76. The ‘336 Registration issued to Kozodaeva on May 14, 2019.

77. On information and belief, as of the filing date of the ‘462 Application, Kozodaeva did not own the NT-MDT Mark, nor had she used it in interstate commerce in the U.S.

78. On information and belief, Kozodaeva never had a bona fide intent-to-use the ‘462 application in the U.S. and filed it only because Kozodaev instructed Kozodaeva to do so to avoid being liable for breach of Kozodaev’s employment agreement and to avoid detection from NT-MDT.

79. Under 37 C.F.R. § 2.17, “[a]n application filed in the name of an entity that did not own the mark as of the filing date of the application is void.”

80. The ‘462 Application was void because Kozodaeva had no bona fide intent to use the NT-MDT Mark as of the Filing Date, Kozodaeva did not own the NT-MDT mark as of the Filing Date, and Kozodaeva had not used the NT-MDT mark in interstate commerce as of January 8, 2019.

81. The ‘336 Registration creates a legal presumption that Kozodaeva has valid and exclusive rights in the NT-MDT Mark for goods identified in the ‘336 Registration.

82. For the reasons stated above, Kozodaeva is not entitled to the ‘336 Registration or to the legal presumptions that the ‘336 Registration creates.

83. The continued presence of the ‘336 Registration on the federal Principal Register constitutes an obstacle to NT-MDT’s ongoing and continuing

20-year use of its NT-MDT Mark under the common law and its current attempt to register its own Principal Register trademark for the NT-MDT Mark.

**SECOND GROUND FOR CANCELLATION
LIKELIHOOD OF CONFUSION UNDER 15 U.S.C. § 1052(D)**

84. NT-MDT incorporates allegations 1-83 by reference and realleges them herein.

85. NT-MDT petitions to cancel the ‘336 Registration under 15 U.S.C. § 1052(d).

86. NT-MDT has proprietary rights in its common law use of the NT-MDT trademark throughout the entire U.S.

87. NT-MDT has approximately 20 years of priority over Kozodaeva in the common law mark for the NT-MDT trademark.

88. NT-MDT asserts that common law NT-MDT Trademark is distinctive.

89. NT-MDT’s common law mark and Kozodaeva’s registration for the identical NT-MDT trademark are identical to each other, if not highly similar in sight, sound, meaning, and commercial impression.

90. The goods listed in each of Kozodaeva’s registration for the NT-MDT trademark and the goods NT-MDT uses the NT-MDT trademark upon are identical to each other (apparatuses for recording, transmitting and reproducing sound and

images; computer operating software; computers; data processing apparatus; microscopes and their parts; nautical and photographic apparatus and instruments, namely, underwater housings for cameras, underwater enclosures for cameras and underwater enclosures for photographic lenses; optical apparatus, namely, a non-lethal security device that uses a light source to detect, warn, repel, temporarily blind, disorient, nauseate, disable, confuse, debilitate, stun, subdue, stop, or incapacitate persons or animals; scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings therefor; transistors; scanning probe microscopes in International Class 9).

91. Therefore, Kozodaeva's use of the NT-MDT trademark in the U.S. is likely to cause confusion with NT-MDT's senior rights in common law use of the identical NT-MDT trademark in the U.S. identified above and violate Section 2(d) of the Trademark Act.

**THIRD GROUND FOR CANCELLATION
FRAUD UPON THE U.S. PATENT AND TRADEMARK OFFICE
KNOWING USE BY OTHERS AT TIME OF FILING**

92. NT-MDT incorporates allegations 1-91 by reference and realleges them herein.

93. NT-MDT petitions to cancel the '336 Registration as Kozodaeva fraudulently procured the application.

94. Under Kozodaev's employment and settlement agreements between Kozodaev and NT-MDT, Kozodaev and his wife, the Registrant Kozodaeva were bound by the agreements' terms and as Kozodaeva's wife, she undoubtedly knew that NT-MDT had used the identical NT-MDT trademark that it intended to file in the U.S.

95. Kozodaev and Kozodaeva knew that NT-MDT had used the mark in the U.S. for approximately 20 years in the U.S. prior to the date Kozodaeva filed the '462 Application.

96. Based on the employment and settlement agreements that Kozodaev signed, Kozodaev and Kozodaeva undoubtedly knew that any attempt to use the NT-MDT trademarks in the U.S. would violate the terms of the agreements.¹⁰

97. The Agreements also precluded Kozodaev from either directly filing, or indirectly filing through Kozodaeva any subsequent application at the USPTO for a trademark for the identical goods NT-MDT sold in the U.S. under the identical NT-MDT trademark.¹¹

98. When Kozodaeva applied for the NT-MDT Trademark with the USPTO and signed the verified declaration, she did so knowing the employment

¹⁰ See Exhibit A at ¶ 15; see also Exhibit B.

¹¹ See *id.*

and settlement agreements precluded her from doing so, and thus signed the declaration fraudulently.

99. NT-MDT had superior legal rights to the NT-MDT trademark for the goods listed in the '462 Application Kozdaeva filed.

100. Kozodaeva undoubtedly knew that NT-MDT's rights in the mark in the U.S. were superior to Kozodaeva's rights and she knew that either the use of the NT-MDT mark in the U.S. would likely cause confusion with NT-MDT's use of the identical mark, or had no basis for believing that use of the mark would not cause confusion.

101. Kozodaeva, in failing to disclose these facts to the USPTO, intended to procure a registration to which she was not entitled, intended to deceive the USPTO, and therefore committed a fraud upon the USPTO.

102. The USPTO reasonably relied upon Kozodaeva's fraudulent representations and issued the '336 Registration based upon that fraud.

103. By the USPTO issuing the '336 Registration based upon Kozodaeva's fraudulent misrepresentations, NT-MDT has been damaged.

**FOURTH GROUND FOR CANCELLATION
FRAUD UPON THE U.S. PATENT AND TRADEMARK OFFICE
NON-USE AT STATEMENT OF USE FILING**

104. NT-MDT incorporates allegations 1-103 by reference and realleges them herein.

105. NT-MDT petitions to cancel the ‘336 Registration as Kozodaeva fraudulently procured the application.

106. Kozodaeva knew at the time she filed her statement of use that she had never personally sold or used in interstate commerce in the U.S. any of the goods identified in her trademark application under the NT-MDT Trademark.

107. Despite knowing that she had not used the mark in interstate commerce, Kozodaeva filed a statement of use with an intent to deceive the USPTO that included a specimen showing a piece of hardware with the NT-MDT trademark affixed to it that Kozodaeva had not used as of the date of first use indicated in the statement of use.

108. By procuring and filing the false statements in the statement of use with the USPTO, Kozodaeva intended to deceive the USPTO and therefore committed a fraud upon the USPTO.

109. The USPTO reasonably relied upon Kozodaeva’s fraudulent representations and issued the ‘336 Registration based upon that fraud.

110. By the USPTO issuing the ‘336 Registration based upon Kozodaeva’s fraudulent misrepresentations, NT-MDT has been damaged.

**FIFTH GROUND FOR CANCELLATION
FRAUD UPON THE U.S. PATENT AND TRADEMARK OFFICE
LACK OF OWNERSHIP OF THE MARK**

111. NT-MDT incorporates allegations 1-110 by reference and realleges them herein.

112. NT-MDT petitions to cancel the ‘336 Registration as Kozodaeva fraudulently procured the application.

113. Under Kozodaev’s employment and settlement agreements, Kozodaev and his wife, the Registrant Kozodaeva were bound by the agreements’ terms and as Kozodaeva’s wife, she undoubtedly knew that NT-MDT had used the identical NT-MDT trademark that it intended to file in the U.S.

114. Kozodaev and Kozodaeva knew that NT-MDT had used the mark in the U.S. for approximately 20 years in the U.S. prior to the date Kozodaeva filed the ‘462 Application.

115. Based on the employment and settlement agreements that Kozodaev signed, Kozodaev and Kozodaeva undoubtedly knew that any attempt to use the NT-MDT trademarks in the U.S. would violate the terms of the agreements.¹²

¹² See Exhibit A at ¶15; see also Exhibit B.

116. The Agreements also precluded Kozodaev from either directly filing, or indirectly filing through Kozodaeva any subsequent application at the USPTO for a trademark for the identical goods NT-MDT sold in the U.S. under the identical NT-MDT trademark.¹³

117. When Kozodaeva applied for the NT-MDT Trademark with the USPTO and signed the verified declaration, she did so knowing the employment and settlement agreements precluded her from being an owner of the trademark, and thus signed the declaration fraudulently.

118. Furthermore, as shown in paragraph 60(c) above, either Kozodaev or his fraudulent company shown on his business card NT-MDT Europe were the only entities attempting to use the NT-MDT Trademark.

119. Kozodaev instructed his wife, Kozodaeva to file the '462 Application in the U.S. solely to avoid being liable under the employment and settlement agreements and not to truly own the NT-MDT Trademark.

120. When Kozodaeva filed the '462 Application, she undoubtedly knew that she as an individual did not and could not own the NT-MDT mark.

121. Kozodaeva, in failing to disclose these facts to the USPTO, intended to procure a registration to which she was not entitled, intended to deceive the USPTO, and therefore committed a fraud upon the USPTO.

¹³ *See id.*

122. The USPTO reasonably relied upon Kozodaeva's fraudulent representations and issued the '336 Registration based upon that fraud.

123. By the USPTO issuing the '336 Registration based upon Kozodaeva's fraudulent misrepresentations, NT-MDT has been damaged.

WHEREFORE, Petitioner NT-MDT respectfully requests that the TTAB
cancel Kozodaeva's registration for U.S. Registration No. 5,753,336.

Dated: January 9, 2020

Respectfully submitted,

s/Lance C. Venable

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Certificate of Service

I hereby certify that the forgoing was electronically FILED via ESTTA on January 9, 2020, and that a copy has been SERVED on counsel for Registrant Irina Kozodaeva on January 9, 2020 by forwarding the copy by email to

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By: s/Lance C. Venable/