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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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**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.

Cancellation No. 92071349

**JOINT STIPULATION OF THE
PARTIES TO PROCEED VIA
ACCELERATED CASE RESOLUTION
AND ESTABLISH FACTS AND
PROCEDURES FOR USE IN ACR**

Petitioner NT-MDT, LLC (“NT-MDT”) and Registrant Irina Kozodaeva (“Kozodaeva”) hereby stipulate and agree, subject to the approval of the Trademark Trial and Appeal Board, to: (1) bifurcate NT-MDT’s non-use in commerce claim and the ownership, priority of rights, and abandonment by CJSC NT-MDT claims; (2) utilize the Accelerated Case Resolution (“ACR”) procedure in connection with all claims alleged in the ACR; (3) allow the Board to resolve all genuine disputes of material fact raised by the parties’ ACR briefs or the record with respect to all claims; and (4) allow only new briefing on the non-use in commerce claim raised in NT-MDT’s ACR brief as the parties fully briefed the remaining claims in the summary judgment motion, response, and reply briefs the parties recently filed.

The parties stipulate to the following for purposes of the proposed ACR proceeding:

I. Conduct of ACR Proceeding.

The parties stipulate to conduct the ACR proceeding as follows:

1. The parties' ACR briefs will be presented as a single motion for summary judgment.

2. NT-MDT will submit to the Board its opening ACR brief. The brief will include two parts. The first part will include arguments, affidavits, and exhibits pertaining only to NT-MDT's non-use in interstate commerce claim directed to Kozodaeva's statement of use and any time beyond the filing date of the statement of use. The second part will include the contents of the original summary judgment brief that NT-MDT filed on March 13, 2020, with its original supporting exhibits and affidavits that all pertain to the ownership of the disputed mark, priority of rights between the parties, and abandonment by CJSC NT-MDT. NT-MDT cannot raise any new arguments or include any additional supporting materials pertaining to any claim NT-MDT included in the opening brief NT-MDT filed on March 13, 2020, nor may the Board consider any.

3. Kozodaeva's responsive ACR brief will also include two parts. The first part will include arguments and any related supporting materials such as declarations and exhibits, responding only to the first part of NT-MDT's opening ACR brief. The second part will include the contents of Kozodaeva's original responsive brief that she filed on May 5, 2020, with its original supporting exhibits and affidavits. Kozodaeva cannot raise any new arguments or include any additional supporting materials pertaining to any claim in the second part of NT-MDT's original opening brief it filed on March 13, 2020, or any defense in the second part of Kozodaeva's brief she filed on May 5, 2020, nor may the Board consider any.

4. NT-MDT's reply ACR brief will also include two parts. The first part will include arguments and any related supporting materials such as declarations and

exhibits, responding only to the first part of Kozodaeva's responsive ACR brief. The second part will include the contents of NT-MDT's original reply brief that it filed on May 26, 2020, with its original supporting exhibits and affidavits. NT-MDT cannot raise any new arguments or include any additional supporting materials pertaining to any claim or defense in the second part of the Kozodaeva original responsive brief she filed on May 5, 2020, nor may the Board consider any.

5. Substantive objections to evidence under the Federal Rules of Evidence, such as hearsay, relevance, and the like, may be raised in connection with the evidence submitted by a party in connection with its ACR brief, but no objections to evidence may be raised on the grounds that there was no prior disclosure of the evidence. Kozodaeva's objections to any evidence submitted by NT-MDT with NT-MDT's opening ACR brief must be included with Kozodaeva's responsive ACR brief. NT-MDT's objections to any evidence submitted by Kozodaeva with Kozodaeva's responsive ACR brief must be included with NT-MDT's reply ACR brief. Any objections can pertain to evidence in either the first or second parts of the ACR briefs.

6. The parties agree that all pleadings, discovery requests and responses, and exhibits and attachments to all such documents are admissible and will be entered into the record by attachment to the party's brief.

7. The parties agree that all documents listed in the file histories of Kozodaeva's registration for the NT-MDT mark are admissible and that all the documents are automatically made part of the record for the ACR proceeding without any action by the parties.

8. Neither party will rely on expert testimony.

9. Neither party will take any testimony depositions.

10. The parties agree that NT-MDT's opening ACR brief may not exceed 55 pages in length in its entirety, Kozodaeva's responsive ACR brief may not exceed 55

pages in length, and NT-MDT's reply brief may not exceed 25 pages in its entirety. Exhibits or appendices to a brief are not included within the page limits.

11. Each party reserves its right to request an oral hearing by the deadline set in the ACR schedule.

12. The parties consent to the Board's resolution of any disputed issues of material fact and to rendering a final decision based on the briefs and evidence presented.

13. The parties propose the following schedule for the ACR proceeding:

- a. NT-MDT submits its opening ACR brief and evidence – 10 days following the institution of the ACR proceeding.
- b. Kozodaeva submits her responsive ACR brief and evidence – 30 days following NT-MDT's submission of its opening ACR brief and evidence.
- c. NT-MDT submits its reply ACR brief and evidence – 15 days following Kozodaeva's submission of her responsive ACR brief and evidence.
- d. Deadline to request oral hearing on ACR – 7 days following NT-MDT's submission of its reply ACR brief and evidence.
- e. Board issues its decision – 50 days following NT-MDT's submission of its reply ACR brief and evidence.

14. If any disputes arise regarding this stipulation, or the ACR briefs, declarations, or affidavits, or accompanying exhibits submitted under this stipulation, the parties must make a good-faith effort to resolve the disputes by telephone before notifying the Board. If the parties are unable to resolve their disputes by telephone, the parties will jointly notify the assigned Interlocutory Attorney by telephone and request a telephone conference to resolve the disputes.

II. Stipulated Facts – Part 1

1. On July 19, 2018, Kozodaeva filed an intent-to-use application for the NT-MDT (logo and words) in Class 9 of goods.

2. By filing her application under § 1(b), Kozodaeva acknowledged that as of the filing date, she had not personally used the Mark on any goods in interstate commerce in the U.S. and therefore, did not own any rights to the mark in the U.S. as of the June 19, 2018.

3. The USPTO examined the application and subsequently issued the Notice of Allowance on February 12, 2019.

4. As of January 8, 2019, Kozodaeva had not used the mark in the U.S. by selling or shipping any item bearing the Mark to any entity in the U.S.

5. Even though Kozodaeva had not shipped or sold anything to the U.S. or used the mark in interstate commerce, on March 10, 2019, Kozodaeva filed a statement of use, swearing under penalty of perjury, that she had personally used the Mark on all the goods listed in her application as of January 8, 2019.

6. On April 11, 2019, the USPTO accepted the statement of use, and on May 14, 2019, the USPTO issued the registration of NT-MDT mark (“336 Registration”).

7. In response to an email on February 14, 2019 from Kozodaeva’s counsel requesting evidence of use in commerce and a date of first use in commerce, on February 15, 2019, Kozodaeva’s husband provided a quote for a sale and a photo specimen of a product that he alleged Kozodaeva planned to sell to the University of Texas at Dallas. In that email, Kozodaeva’s husband expressly stated that, based on the quote and photo, the date of first use in commerce in the USA was January 8, 2019. Kozodaeva’s agent at Marcaria subsequently confirmed the first use date.

8. Kozodaeva has never sold or shipped any product to the University of Texas at Dallas, and in particular, any product under the disputed mark during the statement of use period of the ‘336 Registration at any time between January 8, 2019 and May 14, 2019.

9. Kozodoeva never filed a corrected or amended statement of use during the prosecution of the application.

10. As of the '336 Registration date, Kozodaeva had never used the mark in interstate commerce in the U.S.

III. Stipulated Facts – Part 2

1. NT-MDT, LLC is a Russian limited liability company that has existed in good standing since 2015.

2. The disputed mark in this matter is of the following combination word mark and design.



3. The Mark consists of the words “NT-MDT” along with a graphic representing a red microscope probe pointing to a circular specimen within a blue rectangular plate.

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

5. Andrey Bykov owns 51% of the company and Vladimir Kotov owns 49% of the company.

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

NT-MDT CJSC’ Russian Bankruptcy Proceeding

7. In 2015, CJSC NT-MDT filed for bankruptcy in Russia.

8. The full extent of the assets to be sold in the bankruptcy were identified in a document entitled “Full list of assets of the Closed Joint Stock Company ‘Nanotechnology-MDT.’”

9. Under U.S. law, Russian registered trademarks confer no rights within the U.S and the rights afforded any Russian-registered trademark in the asset list are limited solely to the Russian Federation.

10. On March 7, 2019, an individual named Anastasia Yakovleva purchased the assets of the CJSC NT-MDT bankruptcy sale.

Yakovleva and Techno NT's Subsequent Trademark Purchase Agreement

11. On March 24, 2019, Yakovleva and a company by the name of Techno NT executed a Trademark Purchase Agreement (“TPA”).

12. Section 1 of the TPA titled “SCOPE” states that (i) “[t]he Assignor having the exclusive right to the Trademark **188978 (hereinafter referred to as the Trademark)** shall assign and the Assignee shall assume the exclusive right to the Trademark with respect to any and all goods and services as in the certificates; (ii) “[t]he exclusive right for the Trademark that is assigned by the Assignor is the exclusive right to use and dispose of the Trademark; and (iii) “[t]he exclusive right for the Trademark that is assigned by the Assignor gives the exclusive rights to the Assignee to use and register the trademark outside the Russian Federation – in the United States of America (first use since 1999), European Union (first use since 1996), in China (first use since 2000) and India (first use since 1999).”

13. Trademark Certificate 188978 is included in the “Full list of assets of the Closed Joint Stock Company ‘Nanotechnology-MDT.’” from the March 7, 2019 bankruptcy asset purchase.

14. The Russian trademark database identifies the mark in the ‘978 registration as being the following mark:



15. The disputed NT-MDT Mark and the '978 mark are not identical trademarks.

16. The TPA did not reference or include any assignment in the following mark:



17. As of March 10, 2019, Yakovleva would have owned what she purchased from the bankruptcy asset list, and therefore, when Kozodaeva filed her statement of that day, Yakovleva could not have transferred any rights to Kozodaeva in the mark identified in the '978 registration Mark when she filed her statement of use.

Respectfully submitted this 25th day of August 2020

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Certificate of Service

I hereby certify that the preceding was electronically FILED via ESTTA on August 25, 2020, and that a copy has been SERVED on counsel for Registrant Irina Kozodaeva on August 25, 2020, by forwarding the copy by email to:

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