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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 for Summary Judgment Yes , the Filer previously made its initial disclosures pursuant to Trademark Rule 2.120(a); OR the motion for summary judgment is based on claim or issue preclusion, or lack of jurisdiction. The deadline for pretrial disclosures for the first testimony period as originally set or reset: 10/10/2020
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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

**PETITIONER'S MOTION FOR
SUMMARY JUDGMENT**

PART 1 OF 2

Under Rule 56, Petitioner, NT-MDT, LLC (“NT-MDT, LLC”), moves for summary judgment based on the uncontroverted fact that Registrant, Irina Kozodaeva, did not use the NT-MDT trademark (the “Mark”) in interstate commerce prior to filing her statement of use on March 10, 2019. In fact, at least as of early June 2020, Kozodaeva still had not used the Mark in interstate commerce in the U.S. Hence, the resulting ‘336 Registration must be voided *ab initio*.¹

NOTE: The supporting declarations and exhibits for Parts 1 and 2 of this motion have been filed as separate docket entries referred to as PART 1 OF 2 SUPPORTING DOCUMENTS and PART 2 OF 2 SUPPORTING DOCUMENTS. The stipulated facts sections for Parts 1 and 2 from the Joint Stipulation of the Parties to Proceed Via ACR

¹ See *Aycock Engineering, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1357, 90 U.S.P.Q.2d 1301 (Fed. Cir. 2009) (“The registration of a mark that does not meet the use requirement is void *ab initio*.”).

have also been filed as part of the PART 1 and PART 2 SUPPORTING DOCUMENTS respectively.

Statement of Facts

On July 19, 2018, Kozodaeva filed an intent-to-use application for the NT-MDT (logo and words) in Class 9 of goods.² The USPTO examined the application and subsequently issued the Notice of Allowance on February 12, 2019.³ In an email exchange from February 14-25, 2019, between Kozodaeva's husband, Dimitry Kozodaev, and Kozodaeva's U.S. attorney, Ms. Christina Schmidt, Kozodaev asserted that his wife first used the mark in interstate commerce on January 8, 2019, concerning an alleged sale of goods to the University of Texas at Dallas that his wife never consummated.⁴

From: info@techno-nt.com <info@techno-nt.com>
Sent: Friday, February 15, 2019 4:54 PM
To: 'Marcaria.com' <info@marcaria.com>
Cc: 'consuelo@marcaria.com' <consuelo@marcaria.com>
Subject: RE: June 12, 2019: SPECIMEN OF USE - NT-MDT - USA

Dear Christina,

Please find quotation for our customer in Dallas Texas University in the attachment. So we are in Purchase process now. We plan to sale there the exact system which is on the pictures. Also you can find our direct communications with customer attached.

So the date of first use in commerce in USA is 8th January 2019.

We hope that it will be enough for now.

When is the deadline?

Best regards

Dmitry Kozodaev

Dmitry Kozodaev February 25, 2019 23:00

² Stipulated Facts – Part 1 of ACR ¶ 1; Declaration of Lance C. Venable, ¶ 3, (NT-00042-46).

³ Declaration of Lance C. Venable, ¶ 3. (NT-00028).

⁴ *Id* ¶ 4, Exhibit E (KOZ446-5); *See also*, Declaration of Timothy Shaw ¶ 7; Declaration of Lori Matthews ¶ 4.

Dear Christina,

Please find some pictures of our product in the attachment.

We are planing to sell this system to Dallas Texas University. We have already an order from them.

You can see also our logo on this product.

We hope it will be enough for now.

Best regards,

Dmitry Kozodaev

Based on these uncontroverted emails, the record is clear that, as of January 8, 2019, Kozodaeva **had not used the mark** in U.S. interstate commerce by selling or shipping any item bearing the Mark to the U.S to the University of Texas at Dallas, or otherwise,⁵ which is fatal to Kozodaeva's registration.⁶ As the email above shows, instead of complying with the legal requirements for using goods in interstate commerce, Dimitry Kozodaev told the attorney that as of February 15, 2019, he and his wife only had a "plan to sell there."⁷

Despite knowing that Kozodaeva had not shipped or sold anything, 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, 2019.⁸ On April 11, 2019, the USPTO accepted the statement of use,⁹ and on May 14, 2019, the USPTO issued the registration of NT-MDT mark.¹⁰

During discovery, Kozodaeva's counsel confirmed that the only product she had ever allegedly sold to the U.S. was this purported single sale that she made to the

⁵ Stipulated Facts of ACR – Part 1, ¶ 4, 10.

⁶ See *Aycock Engineering, Inc.*, 560 F.3d at 1357.

⁷ See Declaration of Lance C. Venable ¶ 4. (KOZ52-53).

⁸ See *id.*, ¶ 3, (NT-00021-27); Stipulated Facts of ACR – Part 1, ¶ 5.

⁹ See Declaration of Lance C. Venable, ¶ 2, (NT-00012); Stipulated Facts of ACR – Part 1 ¶ 6.

¹⁰ See Declaration of Lance C. Venable, ¶ 2, (NT-00012); Stipulated Facts of ACR – Part 1 ¶ 7.

University of Texas at Dallas referenced in the February email exchange supporting the Statement of Use.¹¹ Furthermore, Kozodoeva never filed a corrected or amended statement of use either,¹² and the TMEP rules prohibit her from any further changes to the first use date.¹³ And, in fact, Kozodaeva admits that as of the '336 registration date, Kozodaeva had not used the mark in the U.S.,¹⁴ which is undoubtedly fatal to her registration.¹⁵

Not only has Kozodaeva admitted these facts, the University of Texas has also confirmed that they are uncontroverted. On October 11, 2019, the University of Texas at Dallas' counsel, Mr. Timothy Shaw, responded to NT-MDT, LLC's counsel's inquiry regarding the details of Kozodaeva's purported sale. Shaw responded with the following email:¹⁶

¹¹ See Declaration of Lance C. Venable, ¶ 5, (Kozodoeva's Response 52 to First Set of Interrogatories, served September 17, 2019) (declaring that Kozodaeva had sold only one item in the United States as of the date of first use alleged in the statement of use); See also *id.*, ¶ 4 (KOZ453) (Kozodoev confirmed to Schmidt that the only alleged buyer in the U.S. is UT Dallas and their alleged first use in commerce was on January 8, 2019).

¹² Stipulated Facts of ACR – Part 1, ¶ 8.

¹³ TMEP § 1609.07; 37 C.F.R. § 2.71(c)(2).

¹⁴ Stipulated Facts of ACR – Part 1, ¶ 8; 10.

¹⁵ See *Aycock Engineering, Inc.*, 560 F.3d at 1357.


¹⁶ See Declaration of Lance C. Venable, ¶ 6.



Shaw, Timothy <Tim.Shaw@utdallas.edu>

To: Lance Venable

Cc: Kunz, Leigh; Vockell, Marc

 You forwarded this message on 5/19/2020 9:58 PM.

 Reply  Reply All  Forward 

Fri 10/11/2019 2:00 PM

Lance,

I received your email. Where did you get a copy of the email from Dr. Malko? In any event, the university has not purchased anything from Mr. Kozodaev or Techno NT, nor do we have any plans to purchase anything from Mr. Kozodaev or Techno NT. The decision not to purchase from Mr. Kozodaev or Techno NT was made prior to receiving your letter yesterday and based on academic and research-related reasons.

I hope you are able to resolve your dispute with Mr. Kozodaev and his wife to your client's satisfaction.

Thanks,

Tim

Timothy Shaw

University Attorney

The University of Texas at Dallas

800 West Campbell Road, AD 2.412

Mailcode: AD35

Richardson, TX 75080

tim_shaw@utdallas.edu

Additionally, Mr. Shaw and Ms. Lori Matthews, who is the University's Director of Purchasing, have provided declarations under penalty of perjury confirming that as of August 26, 2020, the University had never consummated any sale of goods with Kozodaeva.¹⁷

Furthermore, as recently as May 13, 2020, Kozodaeva has refused to provide any evidence of her purported sale to the University. In an email exchange between May 6-13, 2020, with Kozodaeva's counsel, Mr. Kenneth Motolenich-Salas, NT-MDT, LLC's counsel specifically requested Mr. Salas to confirm whether Kozodaeva had any evidence that she sold or shipped any product to UT Dallas or somewhere else in the U.S. prior to June 12, 2019.¹⁸ Despite several cordial requests, Mr. Salas refused to respond. But in the parties' Joint Stipulation for the ACR, Kozodaeva's counsel confirmed that Kozodaeva never sold or shipped any product to the University or use the Mark in interstate commerce in the U.S. in any way.¹⁹

¹⁷ See Declaration of Timothy Shaw ¶¶ 1-7; See Declaration of Lori Matthews ¶¶ 1-4.

¹⁸ See *id.*, ¶¶ 7-9 (Lance Venable's emails to Kenneth Motolenich-Salas dated May 6, 2020, 7:42 PM, May 6 8:16, May 13, 2020, 2:41 PM, and May 13, 2020, 3:01 PM).

¹⁹ Stipulated Facts of ACR – Part 1, ¶ 8, 10.

Argument

I. Because Kozodaeva never shipped or sold any product bearing the NT-MDT mark as she declared in the statement of use, the TTAB must void the ‘336 Registration *ab initio*.

Summary judgment is appropriate when “there is no genuine dispute as to any material fact, and the movant is entitled to judgment as a matter of law.”²⁰ In deciding a motion for summary judgment, the Court (or TTAB in this instance) generally accepts the non-moving party's evidence as true.²¹

Section 1(d)(1) of the Trademark Act requires that “the applicant shall file ... a verified statement that the mark is in **use in commerce** ...”²² within six months of the notice of allowance, or within a previously granted extension of time to file a statement of use.²³

Section 45 of the Trademark Act states:

“The term “**use in commerce**” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce.”²⁴

²⁰ Fed.R.Civ.P. 56(a), which is applicable for TTAB proceedings under TBMP § 101.01.

²¹ *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986).

²² 15 U.S.C. §1051(d)(1).

²³ TMEP § 1109.10.

²⁴ 15 U.S.C. § 45.

When an applicant has not used the mark in interstate commerce on any of the goods identified in the listing of goods in the application as of the date alleged in the statement of use, the remedy for non-use, which is not correctable outside of the statement of use filing deadline, is the cancellation of the mark by voiding it *ab initio*.²⁵ Because Kozodaeva can present no facts disputing her own admissions that she had not used the mark as of the ‘336 registration date, let alone her alleged date of first use in her statement of use, the TTAB must grant summary judgment in NT-MDT, LLC’s favor and void the ‘336 Registration *ab initio*.

A. Because Kozodaeva neither sold, shipped, nor transported goods in U.S. interstate commerce bearing the NT-MDT mark, Kozodaeva did not satisfy the “use in commerce” requirement when she filed the statement of use.

Lanham Act § 45, 15 U.S.C.A. § 1127 defines use in commerce for a trademark on goods as when the mark is: (1) placed on the goods or documents associated with the goods and (2) “the goods are sold or transported in commerce.” The mere interstate delivery of trademarked goods to applicants from the manufacturer, without actual

²⁵ 37 CFR § 2.59(b)(2); *Sensient Techs. Corp. v. SensoryEffects Flavor Co.*, 613 F.3d 754, 762–63 (8th Cir. 2010) (cited in *Couture v. Playdom, Inc.*, 778 F.3d 1379, 1382 (Fed. Cir. 2015) (holding no use in commerce where ... there was no evidence of any sale or transport of goods under the SensoryFlavors name, Sensient fails to establish a triable issue of fact as to whether the goods were “used in commerce,”).

sale,²⁶ or shipments and sales between foreign nations do not establish trademark rights in the United States.²⁷

Here, The USPTO issued the Notice of Allowance on February 12, 2019. On March 10, 2019, Kozodaeva filed a statement of use, under penalty of perjury, alleging that the first date she ever used the mark in interstate commerce in the U.S. was on January 8, 2019.²⁸ Kozodaeva based her alleged January 8, 2019, first use date on a supposed single sale of a computer controller to the University of Texas at Dallas. But Kozodaeva admitted that sale never occurred. The evidence shows that not only did this supposed sale never occur as of January 9, 2019, to this day Kozodaeva has sold and shipped no goods utilizing the Mark in interstate commerce to the U.S.

1. Kozodaeva's email exchange with her trademark counsel reveals that, as of January 8, 2019, she had never sold or transported any goods to the U.S.

As shown above in the email exchange between Dimitry Kozodaev and Kozodaeva's U.S. trademark counsel, Christina Schmidt from Marcaria.com Network,

²⁶ *The Clorox Company v. Salazar*, 108 U.S.P.Q.2d 1083, 1087, 2013 WL 5498171 (T.T.A.B. 2013) (“[S]uch transportation of [parts] from a manufacturer to the owner of the trademark, even when the goods bear the trademark, is purely a delivery of the goods to the trademark owner in preparation for **offering the goods for sale and, therefore, does not constitute bona fide use of applicant's mark in commerce.**”). (emphasis ours); *See also, Avakoff v. Southern Pacific Co.*, 765 F.2d 1097, 1098, 226 U.S.P.Q. 435, 436 (Fed. Cir. 1985) (“[D]elivery of the goods to applicant from the manufacturer ... was a shipment of the goods in preparation for offering the goods for sale. It did not make the goods available to the purchasing public. Clearly, the shipment by applicant's manufacturer to the applicant **was not use of the mark by applicant in commerce.**”) (emphasis ours).

²⁷ *General Healthcare Ltd. v. Qashat*, 364 F.3d 332, 70 U.S.P.Q.2d 1566 (1st Cir. 2004) (Intra-corporate transportation of ingredients from the U.S. to the U.K. for assembly and sales in the Middle East does not count as trademark "use." Thus, the party was held to have abandoned whatever trademark rights it acquired by purchase).

²⁸ Declaration of Lance C. Venable, ¶ 3, (NT-00021-27); *See also, id* ¶ 5.

Kozodaeva never sold or shipped any product bearing the Mark to the University of Texas at Dallas as of her purported date of first use of January 8, 2019.²⁹ Kozodaeva's statements in this email exchange demonstrate that she had not used the mark in interstate commerce as of January 8, 2019. Despite knowing that she had not sold or shipped the goods to the U.S., she falsely claimed she had used the Mark as of January 8, 2019 in her statement of use.³⁰ For that reason alone, the TTAB must void the '336 registration.³¹

2. The University of Texas at Dallas' attorney confirmed that the University never purchased anything from Kozodaeva at any time between January 8, 2019, and October 11, 2019.

As stated above, not only did Kozodaeva confirm in her own words that she never sold or shipped any product to the University of Texas, the attorney who represents that University confirmed this fact to be true. The University of Texas at Dallas attorney's categorical denial that the University had ever "purchased anything from Mr. Kozodaev or Techno NT or have any plans to purchase anything from Mr. Kozodaev or Techno NT"³² leaves no doubt that Kozodaeva falsified the March 10, 2019, statement of use. Clearly, Kozodaeva's own words, and Mr. Shaw's negation confirm that Kozodaeva never sold or shipped any products bearing the NT-MDT Mark to the University. Again, based on this evidence the TTAB must void the '336 Registration.

²⁹ *See id.*, ¶ 4.

³⁰ *See id.*

³¹ *See Sensient Techs. Corp.*, 613 F.3d, at 762–63.

³² *See* Declaration of Lance C. Venable, ¶ 6.

3. Despite several recent attempts requesting Kozodaeva’s counsel correct the record and produce any evidence to support that Kozodaeva sold any product to the University, her counsel has ignored the requests.

As if Kozodaeva’s and Shaw’s words were not enough, even today, Kozodaeva’s Attorney has refused to substantively respond to NT-MDT, LLC’s recent requests for any evidence that Kozodaeva sold or shipped any product to UT Dallas or somewhere else in the U.S. prior to June 12, 2019.³³ The TTAB should take Mr. Salas’ abdication as confirmation that Kozodaeva has no evidence supporting any use of the Mark as of today let alone her alleged date of first use of January 8, 2019. Again, based on this evidence the TTAB must void the ‘336 registration.

4. Because Kozodaeva confirmed that her only alleged “use” pertains to her purported “sale” she references in her statement of use involving the University of Texas at Dallas, Kozodaeva never used the mark as of her statement of use filing date.

Kozodaeva swore under oath in Response 52 to her first set of Interrogatories that, as of March 27, 2020, her only use of the mark pertained to her purported sale of a single item to the University of Texas at Dallas on January 8, 2019.³⁴ And because NT-MDT, LLC has shown that her this has been shown this demonstrably and unequivocally false, Kozodaeva never used the Mark as of her statement of use filing date, and therefore, violated the use requirement under Section 1(d)(1) of the Trademark Act. As a result, the TTAB must void the ‘336 Registration.

³³ See *id.*, ¶¶ 7-9 (email chain between May 6–13, 2020 between Lance Venable and Kenneth Motolenich-Salas).

³⁴ See *id.*, ¶ 5.

B. Because Kozodaeva never used the mark in the U.S. as stated before the USPTO on January 8, 2019, and March 10, 2019, the TTAB must Grant the Petitioner's Motion and Cancel Kozodaeva's '336 Registration as void

In a petition to cancel a registration less than five years old, the allegation of non-use in commerce is a proper ground to void the mark *ab initio*.³⁵ NT-MDT, LLC has proven that as of the registration date of May 14, 2019, ***Kozodaeva never used the trademark in interstate commerce.*** Kozodaeva also intentionally falsified her statement of use by claiming she had used the Mark as of January 8, 2019, and then by never correcting the document prior to the deadline to file the statement of use. Kozodaeva did not ship, sell, or transport any product bearing the NT-MDT mark to the U.S. NT-MDT, LLC confirmed this fact not only with Kozodaeva's own words, but with the words from the only purported purchaser that denied purchasing any product in the past or planned in the future from either Irina Kozodaeva or any business that she owns. Kozodaeva's attorney further confirmed this fact by ignoring several recent requests to provide any evidence by May 13, 2020, to prove the use in the commerce of their registered mark.

Thus, based on the evidence presented, there are no disputed issues of fact regarding Kozodaeva's non-use of the Mark in U.S. commerce, and the TTAB must void the Mark *ab initio*.

³⁵ See *Aycock Engineering, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1357, 90 U.S.P.Q.2d 1301 (Fed. Cir. 2009) (“The registration of a mark that does not meet the use requirement is void *ab initio*.”); See also *Paramount Pictures Corp. v. White*, 31 U.S.P.Q.2d 1768 (T.T.A.B. 1994) (holding an allegation that the applicant's mark was **not properly “used” in “commerce” is a proper ground for opposition** to a use-based application).

II. Conclusion

To summarize:

- Kozodaeva has categorical admitted that she has never used the Mark in U.S. interstate commerce at any time prior to the ‘336 Registration date;
- Kozodaeva has provided no evidence that she has ever used the Mark in U.S. interstate commerce; and
- The University of Texas at Dallas categorically denies that it purchased any goods at any time under the Mark from Kozodaeva. The University is the only entity that Kozodaeva purportedly sold any goods to under the Mark.

Based on Kozodaeva’s stipulated admissions, the documentary evidence, and third-party declarations, is uncontroverted that Kozodaeva not only never used the Mark in interstate U.S. commerce prior to the ‘336 Registration date, it is clear she falsely claimed that she used the Mark in of any goods in her statement of use she filed on March 10, 2019. Therefore, NT-MDT, LLC respectfully submits that this Board grant it summary judgment and cancel the ‘336 Registration *ab initio*.

**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

**PETITIONER’S MOTION FOR
SUMMARY JUDGMENT**

PART 2 OF 2

In addition to the arguments in Part 1 of 2 of this document, under Rule 56, Petitioner, NT-MDT, LLC (“NT-MDT, LLC”), moves for summary judgment based on the uncontroverted fact that Registrant, Irina Kozodaeva, did not own the applied-for NT-MDT trademark (the “Mark”) when she filed her statement of use on March 10, 2019. Hence, the resulting ‘336 Registration is void.

Alternatively, NT-MDT, LLC is entitled to summary judgment because the entity (NT-MDT CJSC) from which Kozodaeva claims she received her rights in the U.S., had assigned those rights to a third party in 2005 and then abandoned those rights shortly thereafter. Since Kozodaeva did not have superior common law rights when she filed the ‘462 Application, the Board must cancel the ‘336 Registration.

Background Facts

Since 2015, NT-MDT, LLC has owned and used the following mark in the U.S. on atomic force microscopes and related goods.³⁶



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.³⁷

NT-MDT, LLC is a Russian limited liability company that is part of a group of companies that have operated under the name NT-MDT Co. NT-MDT Co. has existed for the past 28 years.³⁸ And since 1999, NT-MDT Co. has done business in the U.S. primarily by distributing products that four companies manufactured: CJSC NT-MDT (1999-2003); CJSC NTI (2003-2005); NT-MDT Service & Logistics (2005-2014); and NT-MDT, LLC (2014-present).³⁹ These companies were all part of the NT-MDT Co.

³⁶ Nano technology instruments, namely, microscopes, measuring apparatus and measuring instruments, namely, atomic force microscopes, scanning probe microscopes, integrated atomic force microscopes and confocal Raman microscopes, integrated atomic force microscopes with interferometers for nano-IR infrared measurements, scanning tunneling microscopes, atomic force microscopes for electrochemical measurements, atomic force microscopes with external magnetic fields, atomic force microscopes for work in low vacuum, atomic force microscopes for quantitative nano-mechanical measurements, atomic force microscopes for work in liquids, computers; downloadable and recorded computer software for control of atomic force microscopes systems, image acquisition, image in the field of chemistry, physics, biology, semiconductors, metrology, material science; electric apparatus and instruments, namely, atomic force microscopes, scanning probe microscopes, scanning tunneling microscopes, scanning confocal Raman microscopes; microscopes and parts thereof; *See also*, Stipulated Facts – Part 2 ¶ 1.

³⁷ Stipulated Facts – Part 2 ¶¶ 2-3

³⁸ Affidavit of Victor Bykov ¶ 2.

³⁹ *Id.*

group at one time or another.⁴⁰ Each of their histories, as well as their ownership, control, and use of the subject NT-MDT Mark, will be discussed below. A demonstrative timeline graphic has been prepared and provided as Exhibit P, which is fully supported factually by the Affidavits of Victor Bykov, Andrey Bykov, and Vladimir Kotov.

Currently, NT-MDT Co. comprises several affiliate companies. They include NT-MDT America (an Arizona corporation with its principal location in Tempe, Arizona), NT-MDT Development (an Arizona corporation located in Tempe, Arizona), NT-MDT Spectrum Instruments (a Russian company with its principal location in Moscow, Russia), NT-MDT China, a Chinese corporation with offices in Beijing and Shanghai, China, and Nano Technology Instruments - Europe B.V. (a Dutch company with its principal location in Apeldoorn, The Netherlands), NT-MDT Service & Logistics, an Irish corporation with its principal location in Limerick, Ireland, and the Petitioner NT-MDT, LLC.⁴¹

CJSC NT-MDT

In 1995, along with several individuals,⁴² Mr. Victor Bykov formed CJSC NT-MDT (“CJSC”) as a Russian closed joint-stock company.⁴³ From CJSC’s beginning, Bykov served as its General Manager and had full authority to administer, operate, and decide intellectual property issues on CJSC’s behalf.⁴⁴ Because CJSC had less than 50 employees, Russian law required CJSC to register as a small business entity.⁴⁵ CJSC became part of NT-MDT Co.⁴⁶ CJSC’s primary purpose was to develop, manufacture,

⁴⁰ *Id.*

⁴¹ *Id.* ¶ 3.

⁴² Mazurenko Larisa Lazarevna, Bikmullin Rais Suleymanovich, Aleksandrovich, Baranov Valerii Dmitrievich, Shubin Andrey Borisovich, Saunin Sergey Alekseevich, Samsonov Nikolay Sergeevich, and Anisiforova Nalia Victorovna.

⁴³ Affidavit of Victor Bykov ¶ 5.

⁴⁴ *Id.* ¶ 4, 6.

⁴⁵ *Id.* ¶ 7.

⁴⁶ *Id.*

and distribute Atomic Force Microscopes (“AFM”) products.⁴⁷ Although CJSC’s initial target market was within Russia, its owners decided that CJSC would expand and develop an international customer base to distribute its products.⁴⁸

In 1999, CJSC created and began using the Mark to identify AFM products that it manufactured, shipped, and distributed in the U.S.⁴⁹ CJSC actively manufactured and shipped Atomic Force Microscopes (“AFM”) products and related goods from Russia directly to distributors and customers in the U.S.⁵⁰ Between 1999 and 2003, CJSC manufactured and shipped the AFM products directly to distributors and customers in the U.S to use the NT-MDT Mark.⁵¹ As General Manager of NT-MDT Co., Victor Bykov personally managed and effectuated this aspect of the business.⁵²

In 2002, CJSC expanded its business and needed more than 50 employees. Under Victor Bykov’s direction, NT-MDT CJSC formed CJSC NTI (“NTI”).⁵³ NTI was a Russian entity that allowed for the greater number of employees under Russian law.⁵⁴ CJSC owned 100% of NTI.⁵⁵

CJSC NTI

In 2003, NTI succeeded CJSC. And at that time, because CJSC intended to move all manufacturing and distribution to the new entity, under proper authority, Victor Bykov orally assigned the common law U.S. trademark rights and goodwill in the NT-MDT Mark to NTI from CJSC.⁵⁶ As NTI’s Manager, Victor Bykov had

⁴⁷ *Id.* ¶ 8.

⁴⁸ *Id.*

⁴⁹ *Id.* ¶ 9.

⁵⁰ *Id.* ¶ 10.

⁵¹ *Id.* ¶ 11.

⁵² *Id.*

⁵³ *Id.* ¶ 12.

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ *Id.* ¶ 13.

personal knowledge of these events and authority to transfer and license the U.S. common law rights of the Mark.⁵⁷ *At no time after 2003 did CJSC ever manufacture and ship AFM products to the U.S. under the NT-MDT Mark.*⁵⁸

Between 2003 and 2005, under Victor Bykov's direction, NTI actively manufactured and shipped AFM products from Russia directly to distributors and customers in the U.S. to use the NT-MDT Mark.⁵⁹

NT-MDT Service & Logistics

NT-MDT Service & Logistics ("S&L") is an Irish corporation formed on August 9, 2004. At its inception, Mr. Andrey Bykov, owned 90% of S&L, and Vladimir Kotov owned the other 10% of the company.⁶⁰ These owners formed S&L to be the successor entity to NTI to develop, manufacture, and distribute AFM products directly to distributors and customers throughout the world under the NT-MDT Mark.⁶¹

In 2005, as Manager, and under proper authority, Victor Bykov orally assigned the common law U.S. trademark rights in the NT-MDT Mark exclusively to S&L.⁶² That same year, NTI began phasing out all manufacturing and shipping of AFM products to the U.S. under the NT-MDT Mark with the intent to move these functions to S&L.⁶³ Under Victor Bykov's direction, and authority granted to him by the authority of the owners of S&L, between 2005 and 2014, S&L developed significant technological products.⁶⁴ Additionally, S&L filed and obtained patents and was the exclusive developer, manufacturer, and seller of AFM products.⁶⁵ Between 2005 and

⁵⁷ *Id.* ¶ 14.

⁵⁸ *Id.* ¶ 15.

⁵⁹ *Id.* ¶ 16-17.

⁶⁰ *Id.* ¶ 18; Affidavit of Andrey Bykov ¶ 3.

⁶¹ Affidavit of Victor Bykov ¶¶ 18-19; Affidavit of Andrey Bykov ¶¶ 3-4.

⁶² Affidavit of Victor Bykov ¶ 20; Affidavit of Andrey Bykov ¶ 5.

⁶³ Affidavit of Victor Bykov ¶ 21; Affidavit of Andrey Bykov ¶ 6.

⁶⁴ Affidavit of Victor Bykov ¶ 22; Affidavit of Andrey Bykov ¶ 7.

⁶⁵ Affidavit of Victor Bykov ¶ 23; Affidavit of Andrey Bykov ¶ 8.

2014, S&L shipped approximately 138 products valued at an estimated \$11.5 million to its distributors for further sales throughout the U.S. utilizing the NT-MDT Mark.⁶⁶

S&L also filed and registered several U.S. trademarks.⁶⁷

Beginning in 2008, and continuing through 2014, S&L manufactured and shipped its AFM products and utilized the NT-MDT Mark exclusively to one marketing and resale entity in the U.S. – NT-MDT America, Inc.⁶⁸

In 2014, under Victor Bykov’s direction, NT-MDT Co. decided to have S&L phase out the manufacturing and shipping of AFM products to the U.S. and move these functions to a new Russian entity – the Petitioner NT-MDT, LLC.⁶⁹

On January 1, 2015, S&L assigned in writing all rights to the Mark to NT-MDT, LLC.⁷⁰ After S&L assigned the trademark rights to NT-MDT, LLC, NT-MDT, LLC orally licensed the use of the Mark back to S&L temporarily to continue fulfilling outstanding signed orders and marketing activities.⁷¹ Presently, S&L 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.⁷²

NT-MDT LLC (Petitioner)

In 2013, NT-MDT Co., under Andrey Bykov’s direction, formed the Petitioner NT-MDT, LLC. NT-MDT, LLC is a Russian limited liability company.⁷³ Andrey Bykov, owns 100% of the company, with Victor Bykov continuing in a valued

⁶⁶ Affidavit of Andrey Bykov ¶ 9-10; 16.

⁶⁷ *Id.* ¶ 8.

⁶⁸ Affidavit of Victor Bykov ¶ 26; Affidavit of Andrey Bykov ¶ 11.

⁶⁹ Affidavit of Victor Bykov ¶ 27; Affidavit of Andrey Bykov ¶ 12.

⁷⁰ Affidavit of Victor Bykov ¶ 28; Affidavit of Andrey Bykov ¶ 12; Affidavit of Vladimir Kotov ¶ 12.

⁷¹ Affidavit of Victor Bykov ¶ 29; Affidavit of Andrey Bykov ¶ 14; Affidavit of Vladimir Kotov ¶ 13.

⁷² *Id.* ¶ 30.

⁷³ Affidavit of Victor Bykov ¶ 32; Affidavit of Andrey Bykov ¶ 17.

consultant role.⁷⁴ Andrey Bykov created NT-MDT, LLC to collaborate with the Center of Innovations “Skolkovo” in Moscow (analogous to Silicon Valley in the U.S.), to develop new systems under “NT-MDT” logo, and to commercialize the new systems.⁷⁵

Between 2013 and December 31, 2014, (before the January 1, 2005 assignment), S&L orally licensed NT-MDT, LLC the U.S. common law rights in the NT-MDT Mark.⁷⁶ After the January 1, 2015 assignment, NT-MDT, LLC continued to orally license the U.S. common law rights to the following NT-MDT Co. 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”). The Petitioner will discuss these three entities will further below.⁷⁷

Beginning in 2017, NT-MDT, LLC became the primary entity to manufacture and ship AFM products under the 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 under the NT-MDT Mark in the U.S.⁷⁸

Other NT-MDT Co. Companies
Spectrum Instruments Cos.

There are two NT-MDT Co. 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.⁷⁹ Andrey Bykov owns 84% of that company, and Vladimir Kotov owns the remaining 16%.⁸⁰ The owners created Spectrum Instruments Russia to support Petitioner NT-MDT, LLC for

⁷⁴ *Id.*

⁷⁵ Affidavit of Victor Bykov ¶ 33; Affidavit of Andrey Bykov ¶ 18.

⁷⁶ Affidavit of Victor Bykov ¶ 34; Affidavit of Andrey Bykov ¶ 19.

⁷⁷ Affidavit of Victor Bykov ¶ 35-36; Affidavit of Andrey Bykov ¶ 20-21.

⁷⁸ Affidavit of Victor Bykov ¶ 37; Affidavit of Andrey Bykov ¶ 22.

⁷⁹ Affidavit of Victor Bykov ¶ 39; Affidavit of Andrey Bykov ¶ 24.

⁸⁰ *Id.*

sales in Russia and worldwide. NT-MDT, LLC does not sell third party components, parts, or systems.⁸¹ It only sells those parts that NT-MDT, LLC manufactured.⁸² When a customer requests third-party component (lasers, optical tables, etc.) from NT-MDT, LLC, Spectrum Instruments Russia fulfills those requests.⁸³

The second company is Spectrum Instruments LTD, which is an Irish company formed in 2014 (“Spectrum Instruments Ireland”).⁸⁴ Between 2015 and 2017, Spectrum Instruments Ireland would ship third-party components, parts, and systems to NT-MDT America for distribution to Petitioner NT-MDT, LLC’s customers in the U.S.⁸⁵ NT-MDT America sold these items under the NT-MDT Mark in the U.S. under the oral license Petitioner NT-MDT, LLC provided to NT-MDT America.⁸⁶

Scientific Technology Company

Scientific Technology Company (“STC”) is a Russian entity formed in 2012 with its headquarters in Moscow under the NT-MDT Co. group of entities.⁸⁷ Vladimir Kotov owns 100% of the company.⁸⁸ Mr. Kotov formed STC to serve certain Russian contracts.⁸⁹

Between 2015 and 2017, Petitioner NT-MDT, LLC orally licensed STC to manufacture and ship AFM microscopes to NT-MDT, LLC’s customers in the United

⁸¹ Affidavit of Victor Bykov ¶ 40; Affidavit of Andrey Bykov ¶ 25.

⁸² *Id.*

⁸³ *Id.*

⁸⁴ Affidavit of Victor Bykov ¶ 41; Affidavit of Andrey Bykov ¶ 26.

⁸⁵ *Id.*

⁸⁶ *Id.*

⁸⁷ Affidavit of Victor Bykov ¶ 42; Affidavit of Andrey Bykov ¶ 27; Affidavit of Vladimir Kotov ¶ 19.

⁸⁸ Affidavit of Victor Bykov ¶ 43; Affidavit of Andrey Bykov ¶ 28; Affidavit of Vladimir Kotov ¶ 20

⁸⁹ *Id.*

States through NT-MDT America in 2015-2017.⁹⁰ When NT-MDT America bought AFM 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.⁹¹

NT-MDT America, Inc.

NT-MDT America, Inc. is another NT-MDT Co., entity.⁹² NT-MDT America was formed on June 17, 2008, as a California corporation in Santa Clara, California.⁹³ Andrey Bykov owns 51% of the company and Vladimir Kotov owns 49% of the company. ⁹⁴In May 2014, the company moved its headquarters to Tempe, Arizona, and became an Arizona corporation.⁹⁵ NT-MDT America's primary purpose was to market and distribute AFM products that S&L produced in Ireland in 2008 under the NT-MDT Mark in the U.S.⁹⁶

Between June 2008 and December 31, 2014, S&L manufactured and shipped approximately \$9 million in AFM equipment to NT-MDT America under the Mark.⁹⁷

⁹⁰ Affidavit of Victor Bykov ¶ 44; Affidavit of Andrey Bykov ¶ 29; Affidavit of Vladimir Kotov ¶ 21.

⁹¹ Affidavit of Victor Bykov ¶ 45; Affidavit of Andrey Bykov ¶ 30; Affidavit of Vladimir Kotov ¶ 22.

⁹² Affidavit of Victor Bykov ¶ 46; Affidavit of Andrey Bykov ¶ 31; Affidavit of Vladimir Kotov ¶ 23.

⁹³ *Id.*; Stipulated Facts – Part 2, ¶¶ 4-5.

⁹⁴ *Id.*; Stipulated Facts – Part 2, ¶¶ 6.

⁹⁵ Affidavit of Victor Bykov ¶ 47; Affidavit of Andrey Bykov ¶ 32; Affidavit of Vladimir Kotov ¶ 24.

⁹⁶ Affidavit of Victor Bykov ¶ 48; Affidavit of Andrey Bykov ¶ 33; Affidavit of Vladimir Kotov ¶ 25.

⁹⁷ Affidavit of Victor Bykov ¶ 49; Affidavit of Andrey Bykov ¶ 34; Affidavit of Vladimir Kotov ¶ 26.

Beginning in 2015, NT-MDT America began receiving shipments of AFM products from Spectrum Instruments Ireland and STC.⁹⁸ These shipments continued until 2017 when Petitioner NT-MDT, LLC began exclusively shipping the AFM products to NT-MDT America under the Mark to be distributed to customers throughout the U.S.⁹⁹ This activity continues through today.¹⁰⁰

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 Petitioner NT-MDT LLC (2015-present).¹⁰¹

NT-MDT CJSC' Russian Bankruptcy Proceeding

Since 1999, NT-MDT, LLC and its predecessors that owned the U.S. common law rights have continuously and extensively used the Mark and the words “NT-MDT” alone and in combination with the NT-MDT logo.¹⁰²

In 2015, CJSC NT-MDT filed for bankruptcy in Russia.¹⁰³ At that time, CJSC NT-MDT and NTI had not manufactured, sold, shipped, or distributed any AFM products or related goods to the U.S. under the Mark since at least 2005.¹⁰⁴ Although CJSC NT-MDT and NTI had retained certain “assets” since 2005, the full extent of these assets were identified in a document entitled “Full list of assets of the Closed Joint Stock Company ‘Nanotechnology-MDT.’”¹⁰⁵

⁹⁸ Affidavit of Victor Bykov ¶ 50; Affidavit of Andrey Bykov ¶ 35; Affidavit of Vladimir Kotov ¶ 27.

⁹⁹ *Id.*

¹⁰⁰ *Id.*

¹⁰¹ Affidavit of Victor Bykov ¶ 51; Affidavit of Andrey Bykov ¶ 36; Affidavit of Vladimir Kotov ¶ 28.

¹⁰² Affidavit of Victor Bykov ¶ 52.

¹⁰³ *Id.* ¶ 53; Stipulated Facts – Part 2, ¶ 7.

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* ¶ 54; Stipulated Facts – Part 2, ¶ 8.

The only intellectual property-related assets on that list were Russian-registered patents and trademarks.¹⁰⁶ Under U.S. law, Russian issued patents and registered trademarks confer no rights within the U.S.¹⁰⁷ The rights afforded any Russian-registered patent and trademark in the asset list are limited solely to the Russian Federation.¹⁰⁸ Thus, when CJSC NT-MDT's bankruptcy sale concluded, **no assets pertaining to any rights within the U.S.** had been part of the sale.¹⁰⁹

Kozodaeva claims that on March 7, 2019, an individual named Anastasia Yakovleva purchased the assets of the CJSC NT-MDT bankruptcy sale and then subsequently signed or sold those assets to Kozodaeva.¹¹⁰ But two critical facts are undisputed: (1) because CJSC NT-MDT had not manufactured, sold, or distributed any products to the U.S. under the Mark since at least 2005, CJSC NT-MDT abandoned the mark no later than 2008; and (2) consistent with CJSC NT-MDT's abandonment of the Mark, *the bankruptcy asset sale did not include or identify any U.S. common law rights in the Mark.*¹¹¹ Thus, whatever "assets" Kozodaeva may have purchased from Yakovleva, what Kozodaeva received is limited to what the bankruptcy court listed in the official bankruptcy asset listing. And the listing does not include any U.S. common law rights in the Mark, which CJSC NT-MDT had long ago abandoned.¹¹²

¹⁰⁶ *Id.* ¶ 55.

¹⁰⁷ *Id.* (See *Person's Co. v. Christman*, 900 F.2d 1565, 1568-69 (Fed. Cir. 1990) ("The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country's statutory scheme.")); Stipulated Facts – Part 2, ¶ 9.

¹⁰⁸ International Comparative Legal Guides, *Russia: Trade Marks 2019*, at § 2.7 (Global Legal Group, 4/26/19) (A Russian "trade mark covers only the territory of the Russian Federation").

¹⁰⁹ Affidavit of Victor Bykov ¶ 56; Stipulated Facts – Part 2, ¶ 10.

¹¹⁰ Exhibit L (Kozodaeva's Responses to Petitioner's First Set of Interrogatories Nos. 1; 24; 30).

¹¹¹ Affidavit of Victor Bykov. ¶¶ 53-56.

¹¹² *Id.*

Kozodaeva's Trademark Registration and Alleged Asset Purchase

On July 19, 2018, Kozodaeva filed an intent-to-use application for the Mark.¹¹³ The Mark is identical to NT-MDT, LLC's mark. Kozodaeva filed the application in Class 9 for a listing of goods that is virtually identical to AFM-related goods NT-MDT, LLC, directly and through its predecessors, have used with the Mark with since 1999. Kozodaeva does not contest that the parties' respective marks and goods are identical.¹¹⁴

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 the U.S. and therefore, owned no rights to the mark in the U.S.¹¹⁵ After examining the application, the USPTO published it and subsequently issued a notice of allowance on February 12, 2019. NT-MDT, LLC was not aware of the pending application, or it would have opposed the application before the opposition period ended.¹¹⁶ On March 10, 2019, Kozodaeva filed a statement of use alleging that she had personally used the Mark on all the goods listed in her application as of January 8, 2019.¹¹⁷ More importantly, Kozodaeva swore under penalty of perjury that as of the date she filed the statement of use, she was the owner of the mark sought to be registered.¹¹⁸

The USPTO accepted the statement of use, and shortly thereafter, NT-MDT, LLC learned of the pending application.¹¹⁹ On May 14, 2019, the USPTO issued the registration, and NT-MDT, LLC filed this cancellation proceeding a week later.

¹¹³ *See generally*, 336 Registration file history attached as Exhibit M (NT-00042-46).

¹¹⁴ Exhibit N - Kozodaeva's Response to Petitioner's First Set of Requests for Admissions 12-13; 17.

¹¹⁵ *Id.* No. 3 (no use prior to January 8, 2019).

¹¹⁶ Affidavit of Victor Bykov ¶ 58; Affidavit of Andrey Bykov ¶ 37.

¹¹⁷ Exhibit M (NT-00021-27). According to Kozodaeva's own discovery responses, at best, she sold one item to an entity in the U.S. for an AFM microscope controller and nothing else. Exhibit L (Response 52).

¹¹⁸ Exhibit M (NT-00024).

¹¹⁹ *Id.* (NT-00012).

Kozodaeva alleges that her sole source of obtaining the rights in the Mark was her purchase of the Mark from Yakovleva in a “Trademark Purchase Agreement” (“TPA”)¹²⁰ dated March 24, 2019, who allegedly purchased the Mark in CJSC NT-MDT’s March 7, 2019 bankruptcy sale.¹²¹ But according to the TPA:

- (1) the TPA limits the scope of the purchase to Russian trademark registration 188978 (“’978 Registration”), which conveys no rights within the U.S. to the Mark;¹²²
- (2) the TPA did not assign any ongoing business to Kozodaeva with the ‘978 Registration meaning the TPA constituted an invalid in-gross sale of the Mark;¹²³ and
- (3) as of March 7, Yakovleva owned only what she purchased from the bankruptcy asset list, and therefore, when Kozodaeva filed her statement of use 3 days later, and 14 days before the effective date of the TPA, *she could not have been the owner of the Mark when she filed her statement of use.*¹²⁴

¹²⁰ Exhibit O (KOZ88-90).

¹²¹ Exhibit L (Response 1; 24; 30); *See also*, Exhibit O (NT-00094); Exhibit K (NT-00100-102); Stipulated Facts – Part 2, ¶ 11.

¹²² Exhibit O (KOZ88 - Section 1.1).

¹²³ *See id.* *See Sugar Busters LLC v. Brennan*, 177 F.3d 258, 265 (5th Cir. 1999) (If ownership of a U.S. trademark is transferred without the associated goodwill, the transfer is determined to be an “assignment in gross” and can result in an assignee’s losing rights to the assigned trademark).

¹²⁴ *See* Exhibit K (NT-00100-102) “Full list of assets”; *See* Stipulated Facts – Part 2, ¶ 17 (noting also that the only trademark asset Yakovleva allegedly purchased was the ‘978 registration, which was a different mark entirely and was not inclusive of the disputed Mark).

ARGUMENT

I. Because Kozodaeva Was Not the Owner of the Mark When She Filed Her Statement of Use, the Registration Is Void.

Summary judgment is appropriate when “there is no genuine dispute as to any material fact, and the movant is entitled to judgment as a matter of law.”¹²⁵ In deciding a motion for summary judgment, the Court (or TTAB in this instance) generally accepts the non-moving party's evidence as true.¹²⁶

Section 1(d)(1) of the Trademark Act requires that “the applicant shall file ... a verified statement that the mark is in use in commerce ...”¹²⁷ within six months of the notice of allowance, or within a previously granted extension of time to file a statement of use.¹²⁸ ***The party filing the statement of use must be the owner of the mark at the time of filing.***¹²⁹ This rule is a statutory requirement that must be satisfied before the expiration of the deadline for filing the statement of use.¹³⁰ If the party who files a statement of use was the owner of the mark at the time of filing, evidence to establish ownership may be provided after the deadline for filing the statement of use expires.¹³¹ But if the party who files a statement of use ***was not the owner of the mark at the time of filing***, and no time remains in the statutory period for filing the statement of use, the application is abandoned.¹³²

¹²⁵ Fed.R.Civ.P. 56(a), which is applicable for TTAB proceedings under TBMP § 101.01.

¹²⁶ *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986).

¹²⁷ 15 U.S.C. §1051(d)(1)

¹²⁸ TMEP § 1109.10.

¹²⁹ *Id* (emphasis added).

¹³⁰ *In re Colombo, Inc.*, 33 USPQ2d 1530 (Comm’r Pats. 1994).

¹³¹ TMEP § 1109.10 (emphasis added); *see also* 37 C.F.R. §§3.71(d), 3.73(b).

¹³² *Id.*

To establish ownership, the owner must either: (1) record an assignment or other document of title with the Assignment Recordation Branch, and include a statement in the response to the Office action that the document has been recorded; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another, or an explanation, supported by an affidavit or declaration under 37 C.F.R. §2.20, *that a valid transfer of legal title occurred prior to filing the statement of use.*¹³³

In this case, the TTAB must grant NT-MDT, LLC's Motion. Even if every fact that Kozodaeva alleges is true regarding how she allegedly acquired rights in the Mark, her testimony and documentary evidence establishes that, Yakovleva – not Kozodaeva – owned the rights in the Mark when Kozodaeva filed her Statement of Use for the '336 Registration on March 10, 2019.

Kozodaeva filed an intent-to-use application, which acknowledges she never owned any rights before she applied. As stated in Kozodaeva's statement of use, the first date she ever used the Mark in the U.S. was not until January 8, 2019.¹³⁴

NT-MDT, LLC has offered uncontested testimony that CJSC NT-MDT abandoned its rights in the Mark 14 years earlier than its bankruptcy sale.¹³⁵ Furthermore, Kozodaeva does not dispute that regarding the Mark, the bankruptcy asset list included only a Russian trademark asset – the '978 Russian Registration - that provides no rights in the U.S.¹³⁶ But even assuming Kozodaeva's assertion that Yakovleva purchased an asset that included U.S. rights in the Mark, Kozodaeva does not dispute that she did not obtain those rights from the TPA until 14 days after Kozodaeva filed her statement of use.¹³⁷

¹³³ 37 C.F.R. §3.73(b)(1); TMEP §502.01 (emphasis added).

¹³⁴ See e.g., Exhibit N, Response 3.

¹³⁵ Declaration of Victor Bykov ¶¶ 13-15; 20-21.

¹³⁶ See Exhibit K (NT-00100-102).

¹³⁷ See Exhibit L (Responses 1; 24; 30); Exhibit O (KOZ-0088-0090); See also Exhibit M (NT-00024-00025).

Kozodaeva admitted in her interrogatory and admission responses¹³⁸ that she derived all her rights in the U.S. from the Russian ‘978 Registration she purchased on March 24, 2019, in the TPA.¹³⁹ Therefore, at best, Yakovleva still owned whatever rights Kozodaeva ultimately obtained when Kozodaeva prematurely filed her statement of use. And since Yakovleva did not assign anything to Kozodaeva until 14 days after Kozodaeva filed her statement of use, and Yakovleva did not sign the statement of use as the owner of the Mark, as a matter of law, the TTAB must cancel the ‘336 Registration.¹⁴⁰

II. Because CJSC NT-MDT assigned the U.S. common law rights in the Mark in 2005, Kozodaeva could not have obtained any U.S. rights in the Mark from CJSC in its March 2019 bankruptcy sale. Therefore, Petitioner NT-MDT, LLC’s U.S. common law rights are superior to any rights Kozodaeva claim.

A trademark owner derives rights in the U.S. from the actual use of the mark in interstate commerce.¹⁴¹ Once obtained, common law trademark rights may be assigned orally.¹⁴² Additionally, a trademark owner abandons its U.S. rights when it stops using the mark in interstate commerce.¹⁴³ And prima facie abandonment of a trademark

¹³⁸ See, Exhibit L, (Responses 1; 24; 30), & Exhibit N (Responses 2 and 3).

¹³⁹ See *id.*

¹⁴⁰ 15 U.S.C. §1051(d)(1); TMEP § 1109.10.

¹⁴¹ *Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1203, 103 U.S.P.Q.2d 1161 (9th Cir. 2012)

¹⁴² See *Taylor v. Thomas*, 624 Fed.Appx. 322, 326 (6th Cir. 2015) (“When, as here, an assignment is not in writing, the plaintiff can prove an implied agreement to transfer with strong evidence of conduct manifesting agreement.” (quotation omitted)); *Doebler’s Pa. Hybrids, Inc. v. Doebler*, 442 F.3d 812, 822 (3d Cir. 2006), as amended (May 5, 2006) (“Even if a writing is lacking, an assignment may be proven ... by the clear and uncontradicted oral testimony of a person in a position to have actual knowledge.”); *TMT N. Am., Inc. v. Magic Touch GmbH*, 124 F.3d 876, 884 (7th Cir. 1997) (“Assignments of trademark rights do not have to be in writing.”).

¹⁴³ 15 U.S.C. § 1127.

occurs in the U.S. when a trademark owner has not used the mark in interstate commerce for at least three years.¹⁴⁴

Petitioner NT-MDT, LLC asserts that it received the U.S. common law rights in the Mark through a series of oral and written assignments dating back to 2003. To support NT-MDT's assertion, it has offered the uncontroverted testimony from Mr. Victor Bykov. In his affidavit, Bykov asserts the following facts:

- Bykov was the owner of CJSC NT-MDT, which existed as a small Russian entity from until 2003 and was the sole entity that manufactured and shipped AFM Microscope related for distribution through the U.S. under the Mark;¹⁴⁵
- Under Bykov's authority as an owner, in 2003, he formed and owned a new entity CJSC NTI, and he orally assigned the U.S. common law rights in the Mark from CJCS NT-MDT to CJSC NTI. The new entity became the sole entity responsible for manufacturing and shipping AFM Microscopes to the U.S. under the Mark;¹⁴⁶
- CJSC NT-MDT no longer used the mark in the U.S. as of 2003;¹⁴⁷
- In 2005, under Bykov's authority as owner of CJSC NTI, he orally assigned the U.S. common law rights in the Mark to NT-MDT Service & Logistics (S&L), which is an Irish entity;¹⁴⁸
- S&L became the sole entity responsible for manufacturing and shipping AFM microscope-related products to be distributed to the U.S. under the Mark;¹⁴⁹

¹⁴⁴ *Id.*

¹⁴⁵ Declaration of Victor Bykov ¶¶ 5-12.

¹⁴⁶ *Id.* ¶¶ 13-17.

¹⁴⁷ *Id.* ¶ 15.

¹⁴⁸ *Id.* ¶ 20.

¹⁴⁹ *Id.*

- As a result of the 2005 assignment, CJSC NTI no longer manufactured or shipped any products to the U.S. after 2005 and effectively abandoned its U.S. common law rights in the Mark;¹⁵⁰

NT-MDT, LLC has also offered the uncontroverted testimony from Andrey Bykov, who is an owner of S&L. Andrey Bykov asserts in his affidavit the following facts:

- Based on the rights received in the 2005 assignment, between 2005 and 2014, S&L was the sole entity responsible for manufacturing and shipping AFM microscope-related products to be distributed to the U.S. under the Mark;¹⁵¹
- On December 12, 2014, Andrey Bykov assigned the U.S. common law rights in the Mark to NT-MDT, LLC with an effective date of January 1, 2015;¹⁵²
- Since 2015, NT-MDT, LLC has owned the U.S. common law rights in the Mark; has been the sole entity to manufacture and ship AFM microscope-related products to the U.S. and has orally licensed NT-MDT America the rights to distribute those goods throughout the U.S. under the Mark.¹⁵³

In sum, Kozodaeva cannot dispute that Petitioner NT-MDT, LLC obtained its ownership of the U.S. common law rights in the Mark before July 19, 2018 – the effective filing date of Kozodaeva’s intent-to-use trademark application. Furthermore, Kozodaeva cannot dispute that CJSC NT-MDT and NTI assigned and subsequently abandoned all U.S. common law rights as late as 2005. In the most recent 21 years of use in the U.S. of the Mark, the specific entities identified above manufactured, shipped, and distributed tens of millions of dollars in AFM equipment to the U.S. and developed and obtained all common law rights in the mark in the U.S. And those common law rights have inured to Petitioner NT-MDT, LLC’s benefit.¹⁵⁴ NT-MDT,

¹⁵⁰ *Id.* See also, 15 U.S.C. § 1127.

¹⁵¹ Affidavit of Andrey Bykov. ¶¶ 10-11.

¹⁵² *Id.* ¶ 13.

¹⁵³ *Id.* ¶¶ 14-15.

¹⁵⁴ See *Watec Co., Ltd. v. Liu*, 403 F.3d 645, 74 U.S.P.Q.2d 1128 (9th Cir. 2005).

LLC's factual assertions regarding ownership, transfer, and abandonment of the Mark are uncontroverted.

A. Without any contravening and substantiated testimony from any person with contemporaneous, personal knowledge of the facts, there can be no genuine issue of material fact in dispute. Because Kozodaeva cannot dispute NT-MDT LLC's testimony regarding ownership, the TTAB must grant summary judgment to Petitioner NT-MDT, LLC on its claim of prior use.

Summary judgment may be based on uncontroverted testimonial evidence of an interested witness if the evidence is clear, positive and direct, otherwise credible and free from contradictions and inconsistencies, and could have been readily controverted. The party opposing a motion for summary judgment must point to an evidentiary conflict created on the record, at least by a counterstatement of facts outlined in detail in an affidavit by a knowledgeable affiant. The court must view the record in a light most favorable to the party opposing the motion.¹⁵⁵ A dispute is genuine only if, on the entirety of the record, a reasonable jury could resolve a factual matter in favor of the non-movant.¹⁵⁶

Here, NT-MDT, LLC has provided uncontroverted testimony that eliminates any relevant disputed facts for the TTAB to decide. In Victor Bykov's affidavit, he testified that he had contemporaneous, personal knowledge and first-hand information that, in his authoritative role as owner of CJSC NT-MDT, he orally assigned CJSC's U.S. common law rights in the Mark to CJSC NTI in 2003, and CJSC subsequently abandoned the Mark. Then, in 2005, he orally assigned NTI's U.S. common law rights in the Mark to NT-MDT S&L in 2005 and NTI subsequently abandoned the Mark. Furthermore, Andrey Bykov also testified that he had contemporaneous,

¹⁵⁵ *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 940 (Fed. Cir. 1990) (citing *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 836 (Fed.Cir.1984)).

¹⁵⁶ *Sweats Fashions v. Pannill Knitting Co.*, 833 F.2d 1560, 1562, 4 USPQ2d 1793, 1795 (Fed.Cir.1987).

personal knowledge and first-hand information that, in his authoritative role as owner of NT-MDT S&L, he assigned that entity's U.S. common law rights in writing to the Petitioner NT-MDT, LLC. And finally, NT-MDT, LLC has produced the written January 1, 2015, assignment, which itself that unequivocally proves the Petitioner obtained the U.S. common law rights in the Mark over three years before Kozodaeva filed her intent-to-use application.¹⁵⁷

Kozodaeva's entire defense is that she derived her common law rights to the Mark from CJSC NT-MDT's bankruptcy asset sale. But Kozodaeva cannot produce any evidence from a contemporaneous knowledgeable affiant or any document that can contradict Victor Bykov's and Andrey Bykov's sworn affidavits, nor can she contradict the plain language and authenticity of the 2015 written assignment between S&L and the Petitioner. And without any sufficient contravening evidence, NT-MDT, LLC has established that it owns the Mark and has superior common law rights in the U.S. over any rights that Kozodaeva can claim. Therefore, the TTAB should grant summary judgment in Petitioner NT-MDT, LLC's favor and cancel Kozodaeva's '336 Registration.

B. Because NT-MDT, LLC has produced undisputed evidence that CJSC NT-MDT abandoned the Mark, the TTAB must cancel Kozodaeva's '336 Registration

A trademark owner abandons its U.S. rights when it stops using the mark in interstate commerce.¹⁵⁸ And *prima facie* abandonment of a trademark occurs in the U.S. when a trademark owner has not used the mark in interstate commerce for at least three years.¹⁵⁹

¹⁵⁷ Exhibit E (NT-00975).

¹⁵⁸ 15 U.S.C. § 1127.

¹⁵⁹ *Id.* (A mark shall be deemed to be "abandoned" ... (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred

As discussed above, Victor Bykov has offered undisputed testimony based on contemporaneous personal knowledge and his own actions and authority as CJSC NT-MDT's Manager that he expressly abandoning CJSC NT-MDT's use of the Mark in the U.S. in 2003, and by NTI NT-MDT in 2005. Victor Bykov has offered undisputed testimony that at no time after 2003 did CJSC NT-MDT (and after 2005 for NTI NT-MDT) manufacture, ship, or distribute any AFM products under the Mark in the U.S. There are no documents to support Kozodaeva's claim that CJSC used or licensed the mark for use in the U.S. In fact, the decision maker is entitled to infer that the party's failure to present other witnesses who could have shed light on the use of a mark indicates that their testimony would be negative and that the mark was in fact not in use during the critical period.¹⁶⁰

At best, Kozodaeva has offered evidence of a Russian trademark registration that has no relevance to the U.S. For purposes of trademark rights in the United States, "use" means use in the United States, not use in other nations.¹⁶¹ And shipments and sales between foreign nations do not establish trademark rights in the United States.¹⁶²

Even assuming the customary three-year window, CJSC NT-MDT would have abandoned the Mark no later than 2006, and CJSC NTI would have abandoned the mark no later than 2008. Again, because Kozodaeva asserts that her sole source of U.S.

from circumstances. Nonuse for three consecutive years shall be prima facie abandonment).

¹⁶⁰ See *Auburn Farms Inc. v. McKee Foods Corp.*, 51 U.S.P.Q.2d 1439, 1999 WL 588247 (T.T.A.B. 1999) (the party asserting that the mark was in use failed to present evidence from customers, people who worked producing the product, people who made labels for the product and distributors in the chain of distribution of the product).

¹⁶¹ *Imperial Tobacco, Ltd., Assignee of Imperial Group PLC v. Philip Morris, Inc.*, 899 F.2d 1575, 14 U.S.P.Q.2d 1390 (Fed. Cir. 1990).

¹⁶² *General Healthcare Ltd. v. Qashat*, 364 F.3d 332, 70 U.S.P.Q.2d 1566 (1st Cir. 2004) (Intra-corporate transportation of ingredients from the U.S. to the U.K. for assembly and sales in the Middle East does not count as trademark "use." The sales between the U.K. and Saudi Arabia did not constitute a "use in commerce" sufficient to trigger the Lanham Act or to establish trademark rights in the United States. Thus, the party was held to have abandoned whatever trademark rights it acquired by purchase.).

rights originated from CJSC NT-MDT, and because CJSC NT-MDT had not manufactured, shipped, or distributed any AFM products under the Mark in the U.S. since 2005, any rights that Kozodaeva obtained from CJSC NT-MDT's bankruptcy could not possibly have included any U.S. rights in the abandoned Mark. Therefore, the TTAB must grant NT-MDT LLC's petition to cancel the Mark.

III. Conclusion

Petitioner NT-MDT, LLC has proven the following uncontroverted facts:

- When Kozodaeva filed the statement of use in the '336 Registration, she admitted that she was not the owner of the Mark;
- NT-MDT, LLC has owned the U.S. common law rights to the Mark since at least January 1, 2015, and since then has orally licensed those rights to NT-MDT America whereby NT-MDT America as used the mark extensively throughout the U.S.;
- Because Kozodaeva filed an intent-to-use application for the '336 Registration on July 19, 2018, NT-MDT, LLC's rights are superior to Kozodaeva's alleged rights;
- Kozodaeva's Mark in the '336 Registration is identical to the mark NT-MDT has used in the U.S.;
- Kozodaeva does not dispute that the goods listed in the '336 Registration are virtually identical to the goods NT-MDT claims it uses its mark on in the U.S.;
- CJSC NT-MDT had assigned its U.S. common law rights in the Mark in 2003 and subsequently abandoned any use of the Mark in the U.S.

The TTAB must grant summary judgment in Petitioner NT-MDT's favor because: (1) 15 U.S.C. § 1051(d)(1) requires the owner of the Mark to file the statement of use in an intent-to-use application, and Kozodaeva admits that she was not the owner of the Mark on March 10, 2019, when she filed her statement of use; (2) Petitioner NT-

MDT has been the superior owner of the U.S. common law rights in the Mark since at least January 1, 2015, which pre-dates any possible ownership claim that Kozodaeva can make; and (3) CJSC NT-MDT had abandoned its U.S. common law rights in the Mark in 2003, so CJSC NT-MDT's bankruptcy assets could not possibly have included the U.S. common law rights in the Mark , and Kozodaeva could not have purchased any U.S. common law rights in the Mark.

For these reasons, Petitioner NT-MDT respectfully submits that this Board should grant it summary judgment and cancel the '336 Registration.

Respectfully submitted this 11th day of September 2020

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Certificate of Service

I hereby certify that the preceding was electronically FILED via ESTTA on September 11, 2020 and that a copy has been SERVED on counsel for Registrant Irina Kozodaeva on September 11, 2020 by forwarding the copy by email to

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