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

Proceeding	92071349
Party	Defendant Irina S. Kozodaeva
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NT-MDT LLC,
Petitioner,
v.
Irina Kozodaeva,
Registrant.

Opposition No. 92/071,349
Mark: NT-MDT Design Mark
Reg. No. 5,753,336
Filing Date: July 19, 2018
Registered: May 14, 2019
VIA ESTTA General Filings

**Registrant Irina Kozodaeva’s Answer to Petitioner NT-MDT LLC’s Petition for
Cancellation**

Pursuant to TBMP § 311, Registrant Irina Kozodaeva (“Registrant”), the owner of record of Reg. No. 5,753,336 for the NT-MDT Design Mark copied below (“the Mark”) in class 009 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” (Registrant’s Goods”) hereby respectfully submits, by and through undersigned counsel, her Answer to Petitioner NT-MDT LLC’s (“Petitioner”) Petition for Cancellation.



1. Admitted.
2. Admitted.
3. Registrant admits that NT-MDT has done business in the United States since 1999, but is without knowledge or information sufficient to form a belief about the truth of the remaining allegations of Paragraph 3, and therefore denies the same.
4. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 4, and therefore denies the same.
5. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 5, and therefore denies the same.
6. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 6, and therefore denies the same.
7. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 7, and therefore denies the same.
8. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 8, and therefore denies the same.
9. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 9, and therefore denies the same.
10. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 10, and therefore denies the same.
11. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 11, and therefore denies the same.
12. Registrant admits that Mr. Dimitry Kozodaev's ("Kozodaev") employment with Nano Technology Instruments ("Nano") commenced in January 2005 in the capacity of sales manager, but denies that the employment agreement attached as Exhibit A to the Petition is the employment agreement that Kozodaev entered into in or around January 2005.

13. Admitted.

14. Registrant admits that Kozodaev's employment with Nano ended in June 2017, but denies the remaining allegations of Paragraph 14.

15. Registrant admits that Kozodaev's employment agreement contains provisions concerning (i) work he performed for Nano and Nano's related intellectual property rights and (ii) a request for assistance to Nano by Kozodaev concerning registration of such rights, but denies the remaining allegations of Paragraph 15.

16. Registrant admits that Kozodaev is, during the term of the employment and settlement agreements referenced in Paragraph 16, bound by the terms therein that are determined to be legal and enforceable, but denies the remaining allegations of Paragraph 16.

17. Denied.

18. Denied.

19. Denied.

20. Registrant admits that her company NT-MDT BV registered nt-mdt.eu and other domain names at the country code top-level domain and printed and distributed business cards for the new company, but denies the remaining allegations of Paragraph 20.

21. Denied.

22. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 22, and therefore denies the same.

23. Registrant admits that Petitioner filed a trademark application for the below-copied design on April 25, 2019, which was assigned Ser. No. 88/402,894, but is without knowledge or information sufficient to form a belief about the truth of the remaining allegations of Paragraph 23, and therefore denies the same.



24. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 24, and therefore denies the same.

25. Registrant admits that Petitioner has attached to the Petition, as Exhibit E, a letter it sent to Curt Handley (“Handley”) concerning the Mark, but is without knowledge or information sufficient to form a belief about the truth of the remaining allegations of Paragraph 25, and therefore denies the same.

26. Registrant admits that Handley responded to correspondence from NT-MDT sent by NT-MDT’s counsel and made statements therein, all of which Registrant denies. To the extent not addressed by the foregoing, Registrant denies the remaining allegations of Paragraph 26.

27. Registrant admits that Handley responded to correspondence from NT-MDT sent by NT-MDT’s counsel and made statements therein, all of which Registrant denies. To the extent not addressed by the foregoing, Registrant denies the remaining allegations of Paragraph 27.

28. Registrant admits that Handley withdrew as counsel of record for the Mark and, in such withdrawal, made statements therein, all of which Registrant denies. To the extent not addressed by the foregoing, Registrant denies the remaining allegations of Paragraph 28.

29. Registrant avers that the communications between Handley and Registrant are protected by the work product doctrine and attorney-client privilege, as well as the attorney’s duty of confidentiality owed to Registrant, and therefore are not subject to scrutiny in this Opposition such that Registrant is not obligated to admit or deny the allegations made in

Paragraph 29.

FIRST GROUND FOR CANCELLATION: REGISTRATION VOID *AB INITIO*

30. Registrant incorporates by reference her responses in the previous paragraphs of this Answer as though fully set forth herein.

31. Denied.

32. Admitted.

33. Admitted.

34. Admitted.

35. Admitted.

36. Admitted.

37. Denied.

38. Denied.

39. Admitted.

40. Denied.

41. Admitted.

42. Denied.

43. Denied.

SECOND GROUND FOR CANCELLATION: LIKELIHOOD OF CONFUSION

UNDER 15 U.S.C. § 1052(d)

44. Registrant incorporates by reference her responses in the previous paragraphs of this Answer as though fully set forth herein.

45. Admitted.

46. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 46, and therefore denies the same.

47. Registrant is without knowledge or information sufficient to form a belief about

the truth of the allegations of Paragraph 47, and therefore denies the same.

48. Registrant admits that Petitioner contends that what it terms the “common law NT-MDT Trademark” is distinctive, which is a legal conclusion and, as such, Registrant is without knowledge or information sufficient to form a belief about the truth of that contention or its related allegations, and therefore denies the same.

49. Admitted.

50. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 50, and therefore denies the same.

51. Denied.

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

52. Registrant incorporates by reference her responses in the previous paragraphs of this Answer as though fully set forth herein.

53. Admitted.

54. Registrant admits that Kozodaev is, during the term of the employment and settlement agreements referenced in Paragraph 54, bound by the terms therein that are legal and enforceable, but denies the remaining allegations of Paragraph 54.

55. Denied.

56. Denied.

57. Denied.

58. Denied.

59. Denied.

60. Denied.

61. Denied.

62. Registrant denies that she made fraudulent representations to the U.S.P.T.O., and

is without knowledge or information sufficient to form a belief about the truth of the remaining allegations of Paragraph 62, and therefore denies the same.

63. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 63, and therefore denies the same.

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

64. Registrant incorporates by reference her responses in the previous paragraphs of this Answer as though fully set forth herein.

65. Admitted.

66. Denied.

67. Denied.

68. Denied.

69. Registrant denies that she made fraudulent representations to the U.S.P.T.O., and is without knowledge or information sufficient to form a belief about the truth of the remaining allegations of Paragraph 69, and therefore denies the same.

70. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 70, and therefore denies the same.

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

71. Registrant incorporates by reference her responses in the previous paragraphs of this Answer as though fully set forth herein.

72. Admitted.

73. Registrant admits that Kozodaev is, during the term of the employment and settlement agreements referenced in Paragraph 73, bound by the terms therein that are legal and enforceable, but denies the remaining allegations of Paragraph 73.

74. Denied.

75. Denied.

76. Registrant admits that Kozodaev is, during the term of the employment and settlement agreements referenced in Paragraph 76, bound by the terms therein that are legal and enforceable, but denies the remaining allegations of Paragraph 76.

77. Denied.

78. Denied.

79. Denied.

80. Denied.

81. Denied.

82. Registrant denies that she made fraudulent representations to the U.S.P.T.O., and is without knowledge or information sufficient to form a belief about the truth of the remaining allegations of Paragraph 82, and therefore denies the same.

83. Registrant is without knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 83, and therefore denies the same.

GENERAL DENIAL

84. Registrant denies any and all allegations that are not specifically admitted above.

AFFIRMATIVE DEFENSES

85. Registrant incorporates by reference her responses contained in the previous paragraphs of this Answer as though fully set forth herein.

86. Pursuant to Fed. R. Civ. P. 12(b)(6), the Petition for Cancellation fails to state a claim upon which relief can be granted.

87. On information and belief, the Petition for Cancellation is barred by the doctrine of unclean hands by virtue of the wrongful statements, conduct, agreements, and/or omissions of Petitioner made against Registrant.

88. On information and belief, Petitioner is estopped as to any and all rights which Petitioner claims under the doctrine of estoppel by virtue of the wrongful statements, conduct, agreements, and/or omissions (“actions”) of Petitioner made against Registrant, which were reasonably relied upon by Registrant, leading Registrant to infer that any rights that Petitioner has asserted in the Petition would not be asserted against Registrant such that Registrant would suffer material prejudice proximately caused by one or more of Petitioner’s aforementioned actions if the assertion of rights were permitted.

89. On information and belief, the Petition for Cancellation is barred by the doctrine of acquiescence.

90. One or more bases of cancellation set forth in the Petition for Cancellation is not set forth with sufficient particularity pursuant to Fed. R. Civ. P. 9(b) and, as such, is subject to dismissal.

91. On information and belief, the Petition for Cancellation is barred in whole or in part based on abandonment of the Mark by Petitioner through a substantial period of non-use of the Mark by Petitioner in the United States with no implied or express intent to resume such use.

92. On information and belief, the Petition for Cancellation is barred in whole or in part by the doctrine of laches.

93. On information and belief, the Petition for Cancellation is barred for lack of standing pursuant to Petitioner’s non-usage of the Mark in commerce pursuant to 15 U.S.C. § 1127.

94. On information and belief, there is no likelihood of confusion between Petitioner’s use of the Mark and usage by Registrant because Petitioner cannot demonstrate any likelihood that the public will be confused, mistaken, deceived, or misled as to the source of Registrant’s goods or that such goods are associated with, or endorsed by Petitioner in that some or all of Registrant’s goods are noncompetitive and unrelated to those of Petitioner, and/or some

or all of Registrant's goods are offered in a trade territory remote from Petitioner's usage.

95. By virtue of the wrongful statements, conduct, agreements, and/or omissions of Petitioner against Registrant, Petitioner has waived any and all rights which Petitioner claims under the facts alleged in the Petition under the doctrine of waiver.

96. Registrant reserves the right to add, amend, or withdraw any one or more affirmative defense as further investigation or discovery so dictates.

PRAYER FOR RELIEF

WHEREFORE, Registrant, having fully answered Petitioner's Petition for Cancellation, respectfully prays that the Petition be dismissed.

Dated: July 12, 2019

Respectfully submitted,
MotoSalas Law, PLLC




/Kenneth M. Motolenich-Salas/
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Counsel for Registrant Irina Kozodaeva

CERTIFICATE OF SERVICE

I hereby certify that on July 12, 2019, I filed the foregoing via ESTTA with the Trademark Office Trademark Trial and Appeal Board and that a true and complete copy of the foregoing has been served on counsel for Petitioner NT-MDT LLC by forwarding said copy on July 12, 2019 via email to:

Lance Venable
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/_____ /

/Kenneth M. Motolenich-Salas/
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