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

Proceeding	91164718
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Novosoft, L.L.C., Opposer/Plaintiff, v. Novosoft, Inc., Applicant/Defendant	Opposition No. 91164718 Serial No. 78281736

APPLICANT'S OPPOSITION TO
OPPOSER'S RESPONSE TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Dated: May 15, 2009

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Pursuant to 37 C.F.R. § 2.127, Applicant Novosoft, Inc. hereby files its reply to Opposer's response to Applicant's motion for summary judgment and its response to Opposer's counter-motion for summary judgment. This submission is supported by the Declaration of Kevin Garden, the exhibits attached thereto, and the prior exhibits submitted in this proceeding.

I. Introduction

In the present matter, Opposer Novosoft L.L.C. has opposed Applicant Novosoft Inc.'s application for registration of the HANDY BACKUP Mark. Opposer acknowledges that Applicant made first use of that Mark in the marketplace.[1] However, Opposer claims that, at the time Applicant was using the Mark, Opposer controlled Applicant with respect to the nature and quality of the product sold under that Mark. Therefore, Opposer argues, Applicant was merely a 'Related Company' and Applicant's first use should inure to the benefit of Opposer.[2] However, the supported and undisputed material facts in this case, most of which are taken directly from Opposer's opposition, definitively show that Applicant was the original owner of the Mark and never relinquished that ownership or any control over the nature and quality of the product at issue.

Opposer's claim that it controlled the nature and quality of the product is based on the alleged individual efforts of Opposer's owner, Mr. Vladimir Vaschenko, while working with the Russian Branch of the Applicant. However, Mr. Vaschenko's work for Applicant's Russian Branch was made within the scope of his duties to Applicant and he was compensated for those

[1] Opp. at 1 (¶ 1)(the HANDY BACKUP product was first sold "using Applicant's name on the website"). The standard test for trademark ownership is priority of use. *Allard Enterprises, Inc. v. Advanced Programming Res., Inc.*, 146 F.3d 350, 358 (6th Cir. 1998).

[2] Opp. at 2 (¶ 2)(it is "Opposer's contention that Opposer owns the HANDY BACKUP Mark because Applicant was a 'Related Company' of Opposer at the time Applicant claims it initially used the Mark and through June 2003, such that any use of the Mark by Applicant at that time inured to the benefit of Opposer").

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efforts.[3] As such, those efforts were for the benefit of the Applicant. Accordingly, those efforts did not inure to the benefit of Opposer, nor did they render Applicant as a mere 'Related Company' to Opposer.

Opposer has now asserted that the contract Mr. Vaschenko had attempted to complete on its behalf to sell the rights to the use of the software program at issue was done simply to "confirm" Opposer's alleged pre-existing rights to use that software program. Opp. at 18. Opposer does not claim that this alleged contract in and of itself created ownership of those use rights, nor did the contract refer to the rights to the Mark itself or any goodwill. *Id.* As demonstrated herein, because there was no prior ownership of these use rights by Opposer, the alleged contract "confirms" nothing. Moreover, the alleged contract cannot stand on its own because it consisted of patent self-dealing by Mr. Vaschenko.

There is no genuine dispute as to these material facts set out above and in more detail below. In addition, the legal implications of these facts cannot be overcome by Opposer, no matter how much it relies on inferences, speculation and unsupported factual assertions. The undisputed facts show that Opposer's claim to own the Mark is not and cannot be true, and that Applicant is the owner of the Mark at issue. For that reason, summary judgment must be issued in Applicant's favor and Opposer's request for summary judgment must be denied.

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[3] The only exception is Mr. Vaschenko's attempt to sell the Applicant's rights in the HANDY BACKUP software to himself as the sole owner of Opposer. As explained below, Mr. Vaschenko's conduct in this regard was clearly outside the scope of his duties and obligations to Applicant and any such purported sale was legally void.

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