

UNITED STATES FEDERAL DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK

ONEIDA INDIAN NATION,

Plaintiff;

v.

UNITED STATES DEPARTMENT OF THE
INTERIOR,

Defendant.

No.: 5:17-CV-0913 (MAD/TWD)

DEFENDANT UNITED STATES
DEPARTMENT OF THE
INTERIOR'S REPLY IN SUPPORT OF ITS
MOTION TO DISMISS

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**DEFENDANT UNITED STATES DEPARTMENT OF THE INTERIOR'S
REPLY IN SUPPORT OF ITS MOTION TO DISMISS**

There have been two federally-recognized Tribes who share a history and have had the word “Oneida” as part of their name for centuries. In 2015, the Oneida Tribe of Wisconsin changed its name to the Oneida Nation. In 2016 Plaintiff the Oneida Indian Nation of New York changed its name to the Oneida Indian Nation. Plaintiff now sues the United States Department of the Interior claiming that it was the Department’s approval of the Oneida Nation’s constitution and inclusion of its new name on a list of federally-recognized Tribes that is causing unspecified “confusion.”

In order to demonstrate standing, the Plaintiff must show a concrete and actual or imminent injury. Plaintiff has generally alleged that the Oneida Nation’s name change has caused confusion, but this vague and conjectural injury is not sufficiently concrete or actual. Even if Plaintiff had shown a concrete injury, however, it still could not identify the Department as the cause of that injury as opposed to the actions of the non-party Oneida Nation. Moreover, remanding the Department’s actions would not result in any actual significant reduction in “confusion” or other redress.

It is a plaintiff’s burden to establish standing for every claim and form of relief. Plaintiff has not met that burden here. But even were Plaintiff to demonstrate standing, its claims still fail, first because it has not identified a final agency action as required by the APA, and second because it has not stated a claim upon which relief can be granted. Plaintiff’s Complaint should be dismissed.

I. PLAINTIFF LACKS STANDING¹

A. Plaintiff has not alleged a sufficiently “concrete” or “actual” injury

1. Confusion in the abstract is not a concrete injury

Plaintiff’s argument is that the Department’s inclusion of the Oneida Nation on a list of federally-recognized Indian Tribes following approval of a constitutional amendment “confuses the public and siphons away the goodwill that the [Plaintiff] has created in its business and governmental relations.” Compl. ¶ 31,

¹ Plaintiff takes issue with the Department’s discussion of facts drawn from outside the Complaint. These are not necessary to any of the Department’s legal arguments and were provided for background.

ECF No. 1. But to show an “injury” for standing purposes Plaintiff must do more than merely allege confusion in the abstract or a vague loss of goodwill.

A generalized allegation of “confusion” is the type of “conjectural or hypothetical” harm that is not sufficient to show standing. *Lujan v. Defs. of Wildlife*, 504 U.S. 555, 560 (1992) (internal quotation marks and citation omitted); *see also United States v. Propper*, 170 F.3d 345, 349 (2d Cir. 1999); *Gambles v. Sterling Infosystems, Inc.*, 234 F. Supp. 3d 510, 519 (S.D.N.Y. 2017). Moreover, unspecified “confusion” or loss of goodwill is too general to be considered sufficiently “concrete.” *See, e.g., Cal. Bankers Ass’n v. Shultz*, 416 U.S. 21, 69 (1974) (“Abstract injury is not enough.”); *Gerber Prod. Co. v. Perdue*, 254 F. Supp. 3d 74, 81 (D.D.C. 2017) (business uncertainty not sufficient).²

An analogous case is *N. Am. Olive Oil Ass’n*, 2017 WL 5054714, at *6. In that case, the North American Olive Oil Association (“NAOOA”) sued, *inter alia*, to cancel D’Avoilio’s trademark for an “Ultra Premium” olive oil certification. Just as here, the plaintiffs argued that confusion would lead to a loss of business. Just as here, plaintiff’s complaint did not establish a concrete injury, but made only vague statements such as plaintiffs “have suffered and will continue to suffer damage including damage to their reputation, business and goodwill.” *Id.* at *3 (citation omitted). The court dismissed on standing grounds, finding that:

The Plaintiff fails to explain how the Defendants' conduct impacts the Plaintiff or its members with any level of specificity. Mere conclusory statements that the actions at issue resulted in lost sales or damaged reputations are wholly insufficient . . . Such a lack of specificity is equally prevalent in its claims of reputational harm as in its claims of pecuniary harm. It is not enough to allege, as the Plaintiff does, that Veronica's trademark harmed the business reputations of NAOOA . . . The Plaintiff must allege facts that explain how the trademark had an impact on itself and its members' reputations . . . As such, the Plaintiff has failed to allege an injury in fact to support standing

² Plaintiff is incorrect to argue that to demonstrate standing it need not show “actual” confusion (or some other actual or imminent injury). Pl.’s Opp’n, ECF No. 19 at 12 n.1. Plaintiff cites to *Church of Scientology Int’l v. Elmira Mission of the Church of Scientology*, 794 F.2d 38, 41-44 (2d Cir. 1986) which is inapposite for many reasons, including that the case was an appeal from a denial of a preliminary injunction, and standing was not an issue. The case was brought under the Lanham Act, which specifically requires “likelihood” of confusion to state a claim, but nonetheless a plaintiff must demonstrate an injury-in-fact to show standing as in any other suit. *See, e.g., N. Am. Olive Oil Ass’n v. D’Avoilio, Inc.*, No. 2:16-CV-06986, 2017 WL 5054714, at *6 (E.D.N.Y. Nov. 2, 2017), *appeal docketed*, No. 17-3864 (2d Cir. Nov. 29, 2017).

Id. at *6 (citing *Floyd v. City of New York*, 302 F.R.D. 69, 119 (S.D.N.Y.), *aff'd in part, appeal dismissed in part*, 770 F.3d 1051 (2d Cir. 2014) (per curiam)).

Plaintiff criticizes the Department's brief for focusing on the first paragraphs in Plaintiff's Complaint thus apparently "pretending away important parts of the complaint . . ." ECF No. 19 at 12. But detailed recitations of a concrete injury-in-fact are not something the Department overlooked in Plaintiff's Complaint. The primary portions of the Complaint Plaintiff cites in its response largely assert vague "confusion" without any concrete example of any purported injury.³ The only paragraph that is at all concrete as to a specific business injury is Paragraph 49 which states that the Oneida Nation "intended to host a professional golf tournament" originally to be called the "Oneida LPGA Classic" which Plaintiff implies could have harmed its own golf business. ECF No. 1. However the Oneida Nation "change[d] the name of the LPGA tournament . . . to Thornberry Creek LPGA Classic." ECF No. 1-4 ¶ 28. Therefore any potential injury stemming from confusion about this golf tournament is not "de facto"—that is, it does not exist—and is not sufficient for standing purposes. *Spokeo, Inc. v. Robins*, 136 S. Ct. 1540, 1548-49 (2016).

Plaintiff has cited to no case where abstract "confusion," divorced from any specific or concrete injury, was found sufficient to demonstrate standing in this context. *Cf. 578539 B.C., Ltd. v. Kortz*, No. CV 14-04375, 2014 WL 12572679, at *6 (C.D. Cal. Oct. 16, 2014) ; *Fernandez v. Leidos, Inc.*, 127 F. Supp. 3d 1078, 1087 (E.D. Cal. 2015), *appeal docketed*, No. 15-17285 (9th Cir. Nov. 19, 2015). This is insufficient to demonstrate an injury-in-fact and the case should be dismissed on that basis.

2. Possible future cancellation of Plaintiff's Trademark is not an "actual" or "imminent" injury

Plaintiff's brief implies it has an injury based on assertions that the Oneida Nation is "exploit[ing]... the Department's approvals in order to curtail the [Plaintiff's] rights in its own name." ECF No. 19 at 12. The only "rights" the Plaintiff seems to claim are being curtailed are the Plaintiff's trademarks on the term

³ Paragraph 65(d) of the Complaint asserts "confusion" with no elaboration; Paragraph 31 alleges "confus[ion]" and loss of "goodwill" but only in the abstract; Paragraph 55 uses the phrase "business harm" but provides no elaboration. ECF No. 1.

“Oneida.” Regardless, any purported future injury to Plaintiff’s rights in its trademarks are not sufficient to show an injury-in-fact in this case.

First, the Oneida Nation’s petition to dissolve Plaintiff’s trademark does not rest on either the Department’s approval of the Oneida Nation’s Constitution or the Department’s listing of the “Oneida Nation” on the list of federally-recognized Tribes. Rather, the grounds for cancelling Registration No. 2,309,491 (for “Oneida Indian Nation”) are fraud and abandonment. *See* Order Den. Mot. to Dismiss at 4, attached as Ex. A; Amended Petition for Cancellation, attached as Ex. B. The grounds directed at Registration Nos. 4,808,677 and 4,813,028, (both for “Oneida”) are based on the Oneida Nation’s extensive use of the term “Oneida” before Plaintiff filed its applications for registration in January 2006. *Id.*

As the Oneida Nation stated to the Trademark Trial and Appeal Board (“Trademark Board”), the Department’s actions

are not referenced within any of the enumerated grounds of the Amended Petition ([Ex. B] ¶¶ 131-216) beyond a general reference to the background section. Nor did the Board rely on them when it denied Registrant’s motion to dismiss [Ex. A]. Petitioner’s own “rights” are based on Petitioner’s historical use. The DOI did not “give” Petitioner any rights to a name, and Petitioner never alleged that.

Mot. for Reconsideration at 4-5, attached as Ex. C. Indeed, even the Plaintiff admits that the challenged actions here are “irrelevant to the TTAB proceedings.” ECF No. 19 at 13. Plaintiffs could not correctly argue otherwise given the grounds for establishing and canceling a trademark. *See, e.g.*, 2 J. Thomas McCarthy, Trademarks and Unfair Competition ch. 16 (5th ed. 2017) (acquiring trademarks); 3 J. Thomas McCarthy, Trademarks and Unfair Competition § 20:58 (5th ed. 2017) (cancelling trademarks).

Moreover, even if the Department’s actions could somehow “curtail” the Plaintiff’s rights to its trademark, this has not happened yet, nor is it “imminent.” Such an injury would have to await the conclusion of the Trademark board proceedings, which, are currently suspended. *See* Ex. C.

In sum, both parties in this case, as well as the non-party Oneida Nation agree that this case is “irrelevant” to the Trademark Board proceedings. Regardless such an injury has not been shown to exist or be imminent and cannot provide the required injury-in-fact necessary to show standing here.

B. Neither “confusion” nor any possible loss of Plaintiffs’ trademark is fairly traceable to the Department but rather to the non-party Oneida Nation

Even if Plaintiff had identified a sufficient injury-in-fact, it would face the additional hurdle of demonstrating that this injury was traceable to the Department, rather than to the Oneida Nation. Plaintiff cannot surpass this hurdle.

On a basic level, Plaintiff has not shown that the confusion it complains of is traceable to the Department’s actions of either approving the Oneida Nation’s constitution or updating the Oneida Nation’s name on the Department’s List. Nor could it, because the fundamental source of the alleged confusion is not any action of the Department, but rather that the two sovereign Tribes have similar names, having removed “of New York” and “Tribe of Wisconsin,” respectively from their names.

Fundamentally, it was not the Department who changed the Oneida Nation’s name, but rather it was “the result of the *independent* action of some third party not before the court” – the Oneida Nation. *Bennett v. Spear*, 520 U.S. 154, 169 (1997). The Plaintiff is incorrect that the Oneida Nation “did not change its name on its own.” ECF No. 19 at 14. While the Oneida Nation did decide to amend its *constitution* in 2015, there are historical documents from 100s of years ago in which tribal members use the name “Oneida Nation.”⁴ And the Tribe has used the name “Oneida Nation” on official government documents for decades prior to seeking to update the Constitution. *See, e.g.*, 1998 Compact Signing Agenda, 1997 Press Release, attached as Ex. D. Any confusion is not “fairly traceable” to the Department.

C. Plaintiff can obtain no redress without binding the non-party Oneida Nation

The most basic reason that Plaintiff can obtain no relief from this suit is that what the Oneida Nation calls itself is not something the Department can control. As discussed above, the Tribe referred to itself as the “Oneida Nation” for decades before the change in its constitution and it is at best speculative to believe that if

⁴ Sierra Gillespie, *Historic Scrapbook Gives Look at Early Days of Northeast Wisconsin*, WBAY News, (May 24, 2017), <http://www.wbay.com/content/news/Historic-scrapbook-gives-look-at-early-days-of-Northeast-Wisconsin--424140694.html>.

the Department listed it differently the Tribe would change its internal documents, website, or make any other change. *See ASARCO Inc. v. Kadish*, 490 U.S. 605, 615 (1989).⁵

Indeed, the Oneida Nation could simply amend its constitution to remove the requirement of Secretarial approval of future constitutional changes, as many Tribes—including the Plaintiff—have done. At that point the Oneida Nation could change its constitution and name without federal approval or any involvement by the Department, as the Plaintiff did in 2016 when it removed “of New York” from its name.

Finally, Plaintiff argues that a remand could lead to redress in this case as it could “eliminate the [Oneida Nation’s] ability to rely on the Department’s actions in its TTAB proceedings” despite the fact that the Plaintiff and Oneida Nation agree that the Department’s actions are “irrelevant” to these proceedings. ECF No. 19 at 15. While the Plaintiff is correct that plaintiffs can satisfy the redressability requirement if setting aside an agency’s decision *could* affect the plaintiff’s position in an administrative proceeding, *id.*, that situation is not present here and Plaintiff cannot demonstrate redress on this basis.

In short, any reduction in the “confusion” that Plaintiff identifies as an injury is not something the Department or this Court can remedy. The non-party Oneida Nation determines what it is called.

II. PLAINTIFF’S FIRST CLAIM DOES NOT IDENTIFY A FINAL AGENCY ACTION AND IS NOT REVIEWABLE UNDER THE APA

A. Updating a Tribe’s name on a list is not “final agency action”

Plaintiff’s first claim fails because it does not concern “agency action” within the meaning of the APA. That term has a particular meaning in this context and cannot be treated as “a general term with the all-embrasive meaning usually conveyed by those words.” *Hearst Radio, Inc. v. FCC*, 167 F.2d 225, 227 (D.C. Cir. 1948). The APA defines “agency action,” 5 U.S.C. § 551(13), and further defines the items set forth in

⁵ Plaintiff is correct that because they allege an error in procedure, they need not “definitively establish that further review or consultation would result in the outcome it desires in order to demonstrate redressability.” *Friends of Hamilton Grange v. Salazar*, No. 08 Civ. 5220(DLC), 2009 WL 650262, at *14 (S.D.N.Y. Mar. 12, 2009). In other words, Plaintiff does not need to demonstrate that if this Court remands the Department’s approval of the Tribe’s Constitution and listing of the Tribe’s name for additional explanation that the Department will necessarily take any different action. Nonetheless, Plaintiff must at least show this is a possible result from the suit. Plaintiff cannot make that showing here. Further, Plaintiff still has not demonstrated that its injury is concrete, and “deprivation of a procedural right without some concrete interest that is affected by the deprivation ... is insufficient to create Article III standing.” *Summers v. Earth Island Inst.*, 555 U.S. 488, 496 (2009).

that list. *Id.* § 551(4), (6), (8)-(11)). “Broad as is the judicial review provided by the [APA], it covers only those activities included within the statutory definition of ‘agency action,’” *Hearst Radio*, 167 F.2d at 227, and “does not provide judicial review for everything done by an administrative agency.” *Invention Submission Corp. v. Rogan*, 357 F.3d 452, 459 (4th Cir. 2004).

Plaintiff’s argument is that updating the Oneida Nation’s name on the List is an “agency order, sanction, and relief or the equivalent of those things.” ECF No. 19 at 17. Not so.

First, updating a Tribe’s name on a list is not an “order,” defined as “the whole or a part of a final disposition, whether affirmative, negative, injunctive, or declaratory in form, of an agency in a matter other than rule making but including licensing.” 5 U.S.C. § 551(6); *see, e.g., Horne v. Dep’t of Agric.*, 569 U.S. 513 (2013). On first impression it may appear that being included on the List is the agency’s “final disposition” as to whether a Tribe is federally recognized. However, as the Department demonstrated in its opening brief—and the Plaintiff does not dispute—it is the federal recognition regulations (25 C.F.R. Part 83), a treaty, or an act of Congress, that governs that process. Mere inclusion on the List is informational, rather than a substantive conclusion of any “agency matter.”

Similarly updating a Tribe’s name or otherwise publishing it on the List is not in any way a “sanction” which is generally a fine, penalty or other “restrictive action.” *See* 5 U.S.C. § 551(10).

Nor is updating a Tribe’s name on the Department’s List a form of “relief.”⁶ Plaintiff does not identify which particular form of “relief” it believes is applicable here. The only plausible candidate is “recognition of a . . . right, immunity [or] privilege,” however, as discussed above and as Plaintiff concedes, it is not publication of a Tribe’s name on the Department’s List that constitutes the United States’ “recognition” any “rights, immunity, privilege” or any other legally pertinent distinction. Rather, that occurs through the formal tribal recognition process, 25 C.F.R. Part 83, which is inapplicable in this case, as both tribes were recognized by treaty centuries ago.

⁶ “Relief” is defined to include the “whole or a part of an agency (A) grant of money, assistance, license, authority, exemption, exception, privilege, or remedy; (B) recognition of a claim, right, immunity, privilege, exemption, or exception; or (C) taking of other action on the application or petition of, and beneficial to, a person.” 5 U.S.C. § 551(11).

Unlike a “rule,” “sanction,” or any of the other items included in the definition of agency action, the challenged List is informational only and does not have any legal effect. Courts have repeatedly rejected attempts to characterize as agency action the type of informational list at issue in this case.⁷

Even if changing the Oneida Nation’s name on the List were an “agency action” it would not be “final.” In order to be “final” an agency action must have legal consequences, and Plaintiff does not dispute that no legal consequences flow from publication of the List itself.

Plaintiff argues that the List shows “federal agencies and the world” which Tribes are federal recognized. ECF No. 19 at 16-17. Though true, the Supreme Court has made clear that agency action is not made reviewable under the APA merely because it tends to inform or even as a practical matter influence third parties. For example, in *Dalton v. Specter*, 511 U.S. 462 (1994), the Court held that an agency report recommending closure of a naval shipyard was not final agency action notwithstanding the fact that it circumscribed the options available to the President, thereby influencing his decision. The Court held that the report was not final in the relevant sense because “[t]he action that will directly affect the military base[] is taken by the President, when he submits his certification of approval to Congress,” and the report itself carried “no direct consequences for base closings.” *Id.* at 469 (marks and citations omitted). Similarly, in *Parsons v. U.S. Dep’t of Justice (Parsons II)*, 878 F.3d 162 (6th Cir. 2017), fans of a musical group who self-identified as “Juggalos,” brought APA claims against the Department of Justice asserting that listing Juggalos as a gang in an FBI threat assessment was unlawful. The court found that the inclusion of “Juggalos” on a list was merely informational and had no legal consequences. *Id.* at 169.

An agency action has legal consequences “where it can otherwise be said of the action that “[i]t

⁷ For example, the Fourth Circuit rejected challenges to an EPA report that classified environmental tobacco smoke as a known human carcinogen, *see Flue-Cured Tobacco Coop. Stabilization Corp. v. EPA*, 313 F.3d 852, 861 (4th Cir. 2002), and to an advertising campaign by the U.S. Patent and Trademark Office that warned of invention promotion scams, *Invention Submission Corp.*, 357 F.3d at 459. Similarly, the D.C. Circuit rejected challenges to a Federal Communications Commission publication regarding the public-service responsibility of broadcast licensees, *Hearst Radio*, 167 F.2d at 227, and to a joint report of the EPA and the National Institute for Occupational Safety and Health addressing the efficacy of certain respirators, *Industrial Safety Equip. Ass’n v. EPA*, 837 F.2d 1115 (D.C. Cir. 1988). The plaintiff in each case alleged that the agency publication caused a reputational or other harm but the courts found no agency action.

commands, it requires, it orders, it dictates,” *Appalachian Power Co. v. EPA*, 208 F.3d 1015, 1023 (D.C. Cir. 2000). The list here at issue does none of those things. As in the foregoing cases, publishing the Oneida Nation’s name on the List is not final agency action and for this reason Plaintiff’s first claim must be dismissed for lack of jurisdiction.

B. Updating the List is committed to the Department’s discretion

Even if the Department’s changing of a Tribe’s name on the List were a final agency action, it would not be reviewable under the APA for the additional reason that how Tribes’ names appear on the Department’s list is committed to the Department’s discretion as there are no standards governing how the Department should list them. As such it is not reviewable under the APA.

The statute provides only that the Department “shall publish in the Federal Register a list of all Indian tribes which the Secretary recognizes to be eligible...” but provides no standards or “law to apply.” 25 U.S.C. § 5131. Unable to find “law to apply” in the List Act itself, the Plaintiff turns to other authorities: 25 U.S.C. § 5123(f) and the general trust relationship between the United States and all Tribes.⁸ Based on these authorities the Plaintiff asserts that the United States cannot undertake a “decision-making process favoring one tribe over another...” ECF No. 19 at 19. However, any such limitation is not contained in the List Act, and “§ 701(a)(2) requires careful examination of *the statute on which the claim of agency illegality is based.*” *Webster v. Doe*, 486 U.S. 592, 600 (1988) (emphasis added). Moreover, the United States’ general trust relationship with Tribes provides no standards itself—it is black letter law that “[t]he Government assumes Indian trust responsibilities only to the extent it expressly accepts those responsibilities by statute.” *United States v. Jicarilla Apache Nation*, 564 U.S. 162, 177 (2011).

Plaintiff can identify no express assumption of a trust responsibility, nor any “law to apply” in the List Act and on this basis its first claim should be dismissed. *See, e.g., Parsons v. U.S. Dep’t of Justice (Parsons*

⁸ Plaintiff also seeks to find “law to apply” in the APA itself, ECF No. 19 at 19. This kind of circular reasoning would eliminate § 701(a)(2)’s discretionary exception altogether. *See Lunney v. United States*, 319 F.3d 550, 559 n.5 (2d Cir. 2003) (“If agency actions could be challenged as ‘arbitrary and capricious,’ without reference to any other standard, then § 701(a)(2)’s limitation on APA review would amount to no limitation at all, and nothing would ever be ‘committed to agency discretion by law.’”).

I), 211 F. Supp. 3d 994, 1003 (E.D. Mich. 2016), *aff'd*, 878 F.3d 162 (6th Cir. 2017). While Plaintiff seeks additional process in updating the List, the law leaves updating the List to the Department's discretion and the Supreme Court has held that a reviewing court may not impose upon an agency procedural requirements beyond those set forth by Congress or by the agency itself. *See Vt. Yankee Nuclear Power Corp. v. Nat. Res. Def. Council, Inc.*, 435 U.S. 519, 524, 543–44 (1978).

III. PLAINTIFF FAILS TO STATE A CLAIM

In order to state a claim, a plaintiff must be within the “zone of interests” of a statute, that is, they must fall “within the class of plaintiffs whom Congress has authorized to sue” under that statute. *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377, 1387–88 (2014). A plaintiff fails the “zone of interests” test “when a plaintiff's interests are so marginally related to or inconsistent with the purposes implicit in the statute that it cannot reasonably be assumed that Congress authorized that plaintiff to sue.” *Id.* (marks and citations omitted). Such is the case here.

This Plaintiff is not within the “zone of interests” of 25 U.S.C. § 5123, which begins: “Any Indian tribe shall have the right to organize for *its* common welfare, and may adopt an appropriate constitution and bylaws, and any amendments thereto.” 25 U.S.C § 5123(a) (emphasis added). Plaintiff is not seeking to organize or to adopt a constitution; Plaintiff is seeking to challenge another Tribe's constitutional amendment. The Act was not meant to allow one Tribe to interfere in the elections of a separate Tribe. This is confirmed by the regulations which provide for only persons “listed on the Eligible Voters List and who submitted a voter registration form” to “challenge the results of the Secretarial election.” 25 C.F.R. § 81.43. It would be inconsistent with the Indian Reorganization Act's goals of supporting tribal self-government if other entities—tribes, businesses, third parties—could sue to challenge a Tribe's governing processes.

In response, the Plaintiff asserts that its Complaint “does not mention Section 5123(a)” ECF No. 19 at 21. However, section 5123(a), like all of section 5123's subparts, is contained within the larger provision that Plaintiff cites numerous times in its second claim. *See, e.g.*, Compl. ¶¶ 66, 68. Regardless, it is appropriate to read the provision as a whole rather than reading specific subparts in isolation when determining whether “a plaintiff's interests are so marginally related to or inconsistent with the purposes implicit in the statute. . . .” *Lexmark Int'l, Inc.*, 134 S.Ct. at 1389 (marks and citations omitted).

Plaintiff focuses on 25 U.S.C. § 5123(f), which provides that the federal government “shall not promulgate any regulation or make any decision or determination . . . with respect to a federally recognized Indian tribe that classifies, enhances, or diminishes the privileges and immunities available to the Indian tribe relative to other federally recognized tribes by virtue of their status as Indian tribes.”

Subparts 5123(f) and (g) were enacted to correct Interior's determination that there were two categories of tribes with different governmental powers: “historic” tribes and “created” tribes. *See* F. Cohen, Handbook of Federal Indian Law 130 n. 67 (3d ed. 1942). According to the Senator who introduced the provisions, their purpose is to ensure that, regardless of when or how they became federally recognized, “Indian tribes recognized by the Federal Government stand on an equal footing to each other.” 140 Cong. Rec. 11,235 (statement of Sen. Inouye). “[W]ithout regard to the manner in which the Indian tribe became recognized by the United States,” the provisions entitle “[e]ach federally recognized Indian tribe . . . to the same privileges and immunities as other federally recognized tribes” and “the right to exercise the same inherent and delegated authorities.” *Id.*; *see also* 140 Cong. Rec. 11,376 (1994) (Statement of Rep. Richardson); 140 Cong. Rec. 11,235 (1994) (Statement of Sen. McCain).

Courts have therefore interpreted this provision to bar regulations that would “exclu[de] Alaska Natives - and only Alaska Natives - from” being able to petition to take land into trust. *Akiachak Native Cmty. v. Salazar*, 935 F. Supp. 2d 195, 197 (D.D.C. 2013); *Akiachak Native Cmty. v. Jewell*, 995 F. Supp. 2d 1, 5 (D.D.C. 2013) (*Akiachak II*). Similarly, it has been construed to mean that the Secretary cannot grant tribes different rights with respect to land in trust based on whether they are “historic” or “created” tribes, as determined by their date of federal recognition. *Akiachak II*, 995 F. Supp. 2d at 5. *See also Alexander v. Sandoval*, 532 U.S. 275 (2001); *cf. Villa v. Jewell*, No. 2:16-CV-00503, 2017 WL 1093938, at *2 (E.D. Cal. Mar. 23, 2017).

The Department’s challenged action in this case does not remotely resemble the type of conduct Section 5123(f) was intended to address. Plaintiff does not suggest that the Department awarded or denied it privileges based on a categorization or classification of the type contemplated by Section 5123(f). Rather, its argument is simply that the Departments actions in approving a separate Tribe’s constitution had the effect of creating “confusion.” Even if that were true, it would not state a violation of Section 5123(f). *See*

Sandoval, 532 U.S. at 286; *cf. Villa*, 2017 WL 1093938, at *2 (plaintiff had no cause of action for claim requesting “the Court to order the BIA to be law abiding and not to violate 25 U.S.C. § [5123](f)” (citation omitted)).

Ultimately, Plaintiff’s concerns over its trademark and general “confusion” stemming from a separate Tribe changing its name have nothing to do with the purposes for which Congress enacted 25 U.S.C § 5123 and Plaintiff is not within the zone of interests of this provision.

IV. PLAINTIFFS CLAIMS ARE NOT REVIEWABLE UNDER THE APA BECAUSE THERE IS AN “ADEQUATE REMEDY” ELSEWHERE

Plaintiff’s claims fail for the additional reason that relief for the harms they allege may be sought through suits against the third parties directly responsible for those injuries. The APA provides a cause of action only where there is “no other adequate remedy in a court” 5 U.S.C. § 704. The APA limits judicial review to cases without an adequate alternative remedy: “Agency action made reviewable by statute and final agency action for *which there is no other adequate remedy in a court* are subject to judicial review.” *Id.* (emphasis added). This limitation affects the scope of the APA’s waiver of sovereign immunity, and it is jurisdictional. *See Bowen v. Massachusetts*, 487 U.S. 879, 903 (1988). An alternative remedy is adequate as long as it would remedy the plaintiff’s injury; it need not have a direct effect upon the challenged agency action. *See Coker v. Sullivan*, 902 F.2d 84, 90 & n.5 (D.C. Cir. 1990); *Gillis v. U.S. Dep’t of Health & Human Servs.*, 759 F.2d 565, 575 (6th Cir. 1985).

Plaintiffs allege they were injured by confusion caused by the Oneida Nation’s decision to refer to itself as the Oneida Nation. Insofar as Plaintiffs have suffered a cognizable injury, they may seek relief by filing suit against the relevant third parties, including before the Trademark Board as is currently occurring. The Courts of Appeals have repeatedly held that lawsuits against non-federal entities can provide an adequate alternative to APA review in appropriate circumstances, therefore precluding suit under the APA. *See, e.g., Turner v. Sec’y of U.S. Dep’t of Hous. & Urban Dev.*, 449 F.3d 536, 541 (3d Cir. 2006); *Jersey Heights Neighborhood Ass’n v. Glendening*, 174 F.3d 180, 191-92 (4th Cir. 1999); *Wash. Legal Found. v. Alexander*, 984 F.2d 483, 486 (D.C. Cir. 1993); *Gillis*, 759 F.2d at 575. Here, the available “[a]ctions directly against [third parties] are not merely adequate; they are also more suitable avenues for plaintiffs to pursue the relief

they seek” because those parties “are the immediate cause of the injuries of which [plaintiffs] complain”
Coker, 902 F.2d at 90.

V. CONCLUSION

For the foregoing reasons, Plaintiff’s suit should be dismissed. Plaintiff has not shown that its injury—if indeed it has identified one—is caused by the Department. But even if it were, there is no indication that it could be remedied in this suit, where the Oneida Nation is not a party. But, even had Plaintiff shown a sufficiently redressable injury and demonstrated standing, its claims still suffer fatal jurisdictional defects. The case should be dismissed for lack of standing, jurisdiction, and failure to state a claim upon which relief can be granted.

Respectfully submitted February 23, 2018,

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Acting Assistant Attorney General

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Attorneys for Department

CERTIFICATE OF SERVICE

I hereby certify that on February 23, 2018, I caused a copy of the foregoing to be served through the Court's CM/ECF System to all parties.

/s/ Reuben S. Schiffman

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Attorneys for Department

Exhibit A

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

wbc

Mailed: December 18, 2017

Cancellation No. 92066411

Oneida Nation

v.

Oneida Indian Nation of New York

By the Trademark Trial and Appeal Board:

This case comes before the Board on the following:¹

1. Respondent's motion to dismiss under Fed. R. Civ. P. 12(b)(6), filed in lieu of an answer, 4 TTABVUE; and
2. Petitioner's response and motion to file an amended petition to cancel, 7 TTABVUE; 8 TTABVUE.

Pursuant to Fed. R. Civ. P. 15(a)(1)(B), a party may amend its pleading once as a matter of course within twenty-one days after service of a responsive pleading, if the pleading is one to which a responsive pleading is required. *See* TBMP § 507.02 (June 2017). Although Petitioner's amended pleading was filed after twenty-one days,² it was also accompanied by a motion seeking leave to file the amended pleading to "add further particularity and to be abundantly

¹ The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motions, and does not recount the facts or arguments here, except as necessary to explain the Board's order. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019-20 (TTAB 2015).

² The Board notes the consented motion, granted by the Board, giving Petitioner additional time to file its response to the motion to dismiss. *See* 5 TTABVUE; 6 TTABVUE.

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clear” in its allegations. 7 TTABVue 2. Inasmuch as the parties’ agreed to allow Petitioner additional time to respond to the motion to dismiss and because Respondent has not contested the motion for leave to amend, Petitioner’s amended pleading is hereby made of record and will serve as the operative pleading. See 8 TTABVue.

The Board now considers the motion to dismiss as it relates to the amended pleading. See *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1537 (TTAB 2007); Wright, Miller & Kane, 6 *Fed. Prac. & Proc. Civ.* § 1476 (3d ed., Apr. 2017 Update) (“[D]efendants should not be required to file a new motion to dismiss simply because an amended pleading was introduced while their motion was pending.”); TBMP § 503.03.

To state a claim upon which relief can be granted, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, a complaint must contain sufficient factual matter, accepted as true, that states a claim to relief that is plausible on its face. See *Ashcroft v. Iqbal*, 556 U.S. 662 (2009). In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the plaintiff pleads factual content that allows the Board to draw a reasonable inference that the plaintiff has standing and that a valid ground for the opposition or cancellation exists. Cf. *Bell Atlantic Corp. v.*

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Twombly, 550 U.S. 544, 556 (2007). In particular, a plaintiff need only allege “enough factual matter ... to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. United States*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). “The elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice.” *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAAB 2007); *citing* Fed. R. Civ. P. 8(e)(1); *see also Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (since function of pleadings is to give fair notice of claim, a party is allowed reasonable latitude in its statement of its claims). “The purpose of a Rule 12(b)(6) motion is to challenge ‘the legal theory of the complaint, not the sufficiency of any evidence that might be adduced’ and ‘to eliminate actions that are fatally flawed in their legal premises and destined to fail ...’” *Fair Indigo LLC*, 85 USPQ2d at 1538; *quoting Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, *supra* at 26 USPQ2d 1041.

Standing

Respondent has not argued that Petitioner has not pleaded standing. Inasmuch as Petitioner has alleged it that it has used the terms “Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify itself and the source of various goods and services”; that it is the owner of Registration No. 3016505; and that it will be damaged by continued registration of Respondent’s registration, the Board finds that Petitioner has

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set forth the requisite personal interest in the outcome of this proceeding and reasonable belief of damage from the registration of Respondent's mark necessary to plead its standing to maintain the cancellation. 8 TTABVUE 4-5. *See e.g., Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Petroleos Mexicanos v. Intermix S.A.*, 97 USPQ2d 1403, 1406 (TTAB 2010); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995).

In the amended petition to cancel, for each of Respondent's registrations, Petitioner identifies the following grounds for cancellation:

1. Registration No. 2309491 – ONEIDA INDIAN NATION
 - a. Fraud in the procurement of the registration;
 - b. Fraud in the first renewal of the registration;
 - c. Fraud in the second renewal of the registration;
 - d. Abandonment;
2. Registration No. 4808677 – ONEIDA
 - a. Lack of bona fide intent to use;
 - b. No bona fide use in commerce;
 - c. Fraud in the procurement of the registration;
 - d. Fraud in filing the statement of use;
 - e. Abandonment;
 - f. Failure to use as a trademark;
 - g. Likelihood of Confusion;
3. Registration No. 4813028 – ONEIDA
 - a. Lack of bona fide intent to use;
 - b. Fraud in the procurement of the registration;
 - c. No bona fide use in commerce;
 - d. Fraud in filing the statement of use;
 - e. Abandonment;
 - f. Failure to use as a trademark; and
 - g. Likelihood of Confusion.

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Fraud

To plead a claim of fraud, Petitioner must identify a specific false statement of material fact that Respondent or its predecessor-in-interest made in obtaining or maintaining the involved registration and that such false statement was made with the intent to deceive the USPTO into issuing or maintaining that registration. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Under *Bose*, “a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO.” *Id.* at 1941. When faced with an allegation of fraud and non-use, the question is whether the mark was in use in commerce as of the filing of the use-based application or declaration of use. *See Hiraga v. Arena*, 90 USPQ2d 1102, 1107 (TTAB 2009) (the critical issue is whether the mark was in use in commerce in connection with the identified goods as of the filing date of the use-based application); *Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1907 (TTAB 2006). Pursuant to Fed. R. Civ. P. 9(b), any allegations based on “information and belief” must be accompanied by a statement of facts upon which the belief is based. *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1422 (TTAB 2016); *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478-1479 (TTAB 2009), *citing Exergen Corp. v. Wal-Mart Stores Inc.*, 91 USPQ2d 1656, 1670 n.7 (Fed. Cir. 2009).

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Upon review of Petitioner's allegations, as to each claim of fraud, Petitioner includes allegations regarding the purportedly false statements made, intent to deceive the USPTO and a set of facts upon which its claim is based. *See* 8 TTABVUE 31-36, 39-41, 44-46. In view thereof, the claims of fraud are adequately pleaded. Respondent's motion to dismiss the fraud claims found in the amended petition to cancel is **denied**.

Lack of Bona Fide Intent to Use

In evaluation of a party's bona fide intent to use a mark in commerce, certain circumstances may support or confirm the bona fide nature of an applicant's intent while others may cast doubt thereon or even completely disprove it. *See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha Opposition*, 26 USPQ2d 1503, 1507 (TTAB 1993). In pleading a ground of lack of intent to use, a party should set forth facts which would give applicant fair notice of why opposer believes that applicant lacked a bona fide intent. *See Commodore Electronics*, 26 USPQ2d at 1506.

Petitioner alleges that Respondent did not have a bona fide intent to use its marks for certain goods listed in some of its underlying applications. *See* 8 TTABVUE 39, 44. Inasmuch as Petitioner has alleged facts which give Respondent fair notice of why Petitioner believes Respondent did not have the requisite intent to use its marks when it filed the underlying applications, Petitioner has adequately pleaded each of its claims of lack of bona fide intent

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to use. In view thereof, Respondent's motion to dismiss these claims as found in the amended petition to cancel is **denied**.

No Bona Fide Use in Commerce

Trademark Act § 45, 15 U.S.C. § 1127, states in relevant part as follows:

[A] mark shall be deemed to be in use in commerce ... on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

A registration is subject to cancellation if, at the time the application or allegation of use is filed, the mark is not in use on goods sold or transported in commerce or in connection with services being rendered in commerce.³ *Avakoff v. Southern Pacific Co.*, 765 F.2d 1097, 1098, 226 USPQ 435, 436 (Fed. Cir. 1985) ("The evidence of subsequent sales of programs bearing the marks is not relevant in the absence of use in commerce prior to filing."). Nonuse in connection with some, but not all, of the identified goods and services as of the filing date of a Statement of Use or a Section 1(a) application is a basis for denial of registration only as to those goods and services on which the mark was not in use.

³ A date of first use is not material to the Office's decision to issue a registration. As such, even if the first use dates claimed in Respondent's underlying applications are incorrect, this would not necessarily constitute fraud. *See Hiraga v. Arena*, 90 USPQ2d 1102, 1107 (TTAB 2009); *Standard Knitting, Ltd.*, 77 USPQ2d at 1926; *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 76 (TTAB 1983).

Cancellation No. 92066411

Petitioner asserts no use in commerce for Registration Nos. 4808677 and 4813028. In its amended petition to cancel, Petitioner alleges that Respondent has not used these marks in commerce for certain goods and services and that “by virtue of the false and material claims ... the registration was invalidly obtained and should be cancelled on that basis.” 8 TTABVUE 39, 45-46. In short, Petitioner appears to assert that Respondent’s Registration Nos. 4808677 and 4813028 are void ab initio based on non-use. To the extent Petitioner is asserting Respondent’s registrations are void ab initio based on non-use in commerce, the allegations provide Respondent with fair notice of the claim asserted. *See Johnson v. City of Shelby*, 135 S. Ct. 346, 347 (2014) (per curiam); *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). Therefore, Respondent’s motion to dismiss, in this instance, is **denied**.

Notwithstanding the foregoing, because Petitioner uses terms such as “false and material” and “invalidly obtained,” it is unclear if Petitioner is also attempting to assert a claim of fraud. To the extent Petitioner is asserting fraud, because Petitioner has not alleged an intent to deceive the USPTO amongst other things, the claim is insufficiently pleaded. To the extent Petitioner is attempting to assert an additional claim of fraud, the claim is not properly pleaded and Respondent’s motion to dismiss, in this instance, is **granted**.

Cancellation No. 92066411

Abandonment

Petitioner alleges Respondent has either never used or there has been a three consecutive years of non-use with respect to certain goods and services of Respondent, coupled with an intent not to resume use. *See* 8 TTABVUE 36-37, 41, 47-48. *See* Trademark Act § 45, 15 U.S.C. § 1127; *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861 (TTAB 2007); *see also Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990). In view thereof, the claims of abandonment are adequately pleaded and therefore, Respondent's motion to dismiss these claims in the amended petition to cancel is **denied**.

Likelihood of Confusion

Petitioner sufficiently pleads a claim of likelihood of confusion with its allegedly previously used and registered pleaded marks under Trademark Act § 2(d), 15 U.S.C. § 1052(d), alleging that the parties' marks are similar and for similar goods and services such that a likelihood of confusion exists causing Petitioner damage. *See* 8 TTABVUE 42-43, 49. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); TMEP § 1207.01 *et seq* (2017).

In view thereof, Respondent's motion to dismiss this claim in the amended petition to cancel is **denied**.

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Failure to Use as a Trademark

Petitioner alleges that Respondent has “never used in commerce or completely ceased using ONEIDA as a mark”; and that Respondent’s specimens are insufficient to show use in commerce. 8 TTABVUE 42, 48. It is unclear what claim Petitioner is asserting in connection with these allegations.

To the extent Petitioner is attempting to assert a claim based on the insufficiency of Respondent’s specimen, per se, that is not a proper basis for a claim. *See, e.g., General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1273 n. 6 (TTAB 1992) (“[T]he question of the sufficiency is not a proper ground for opposition [or, in this case, cancellation]”); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358 (TTAB 1989) (“[T]he insufficiency of the specimens, per se, does not constitute grounds for cancelling a registration.”). To the extent Petitioner is attempting to assert the insufficiency of Respondent’s specimens, per se, Respondent’s motion to dismiss is **granted**.

Notwithstanding the foregoing, to the extent Petitioner is attempting to assert that Respondent has not used its marks as a trademark or service mark, that is a proper ground for cancellation. *See Marshall Field & Co.*, 11 USPQ2d at 1359. Because Petitioner alleges that Respondent’s mark has never been used or has ceased being used “as a mark to identify and distinguish its goods and services,” to the extent Petitioner is asserting a claim that Respondent has not used its mark as a trademark or service mark, the claim is adequately

Cancellation No. 92066411

pleaded and Respondent's motion to dismiss this claim is **denied**. 8 TTABVue 43, 48.

Proceedings herein are resumed. Dates are reset as follows:

Time to Answer	January 15, 2018
Deadline for Discovery Conference	February 14, 2018
Discovery Opens	February 14, 2018
Initial Disclosures Due	March 16, 2018
Expert Disclosures Due	July 14, 2018
Discovery Closes	August 13, 2018
Plaintiff's Pretrial Disclosures Due	September 27, 2018
Plaintiff's 30-day Trial Period Ends	November 11, 2018
Defendant's Pretrial Disclosures Due	November 26, 2018
Defendant's 30-day Trial Period Ends	January 10, 2019
Plaintiff's Rebuttal Disclosures Due	January 25, 2019
Plaintiff's 15-day Rebuttal Period Ends	February 24, 2019

BRIEFS SHALL BE DUE AS FOLLOWS:

Plaintiff's Main Brief Due	April 25, 2019
Defendant's Main Brief Due	May 25, 2019
Plaintiff's Reply Brief Due	June 9, 2019

In each instance, a copy of the transcript of any oral testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Exhibit B

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

ONEIDA NATION,)	
)	
Petitioner)	CANCELLATION NO. 92066411
)	
v.)	Registration No. 2,309,491
)	Serial No. 75/978,733
ONEIDA INDIAN NATION OF NEW)	Mark: ONEIDA INDIAN NATION
YORK)	
)	Registration No. 4,808,677
Registrant)	Serial No. 78/978,999
)	Mark: ONEIDA
)	
)	Registration No. 4,813,028
)	Serial No. 78/978,992
)	Mark: ONEIDA

FIRST AMENDED CONSOLIDATED PETITION FOR CANCELLATION

Oneida Nation (“Petitioner”), a federally recognized sovereign Indian Tribe, having a reservation located within the borders of the State of Wisconsin, and doing business at N7210 Seminary Road, PO Box 365, Oneida, WI 54155, believes that it is being, and will continue to be, damaged by U.S. Trademark Registration Nos. 2,309,491 (“the ’491 Registration”), 4,808,677 (“the ’677 Registration”), and 4,813,028 (“the ’028 Registration”) on the Principal Register and owned by Oneida Indian Nation of New York, and hereby petitions to cancel these registrations. In support thereof, Petitioner states as follows:

Introduction

1. Petitioner, Oneida Nation, and Registrant, Oneida Indian Nation of New York, are both federally recognized sovereign Indian Tribes.¹

2. Petitioner and Registrant are direct descendants of and successors-in-interest to the original Oneida Indian Nation, one of the six nations of the Iroquois Confederacy, which were the most powerful Indian tribes in the northeastern United States at the time of the American Revolution. Through the Revolutionary period, the Oneidas inhabited millions of acres of land in what is now central New York State.²

3. During the Revolutionary War, the Oneida supported the colonies and served in General George Washington's army. For that service, the Oneida lands in New York were to be protected forever, a promise reflected in the 1794 Treaty of Canandaigua between the Oneida and United States. However, through the 1785 Treaty of Fort Herkimer and the 1788 Treaty of Fort Schuyler with the State of New York, the Oneida lost more than 5 million acres of their ancestral homelands to the State of New York. The State of New York continued to enter into a series of illegal land transactions with the Oneida, until only 32 acres remained in Oneida possession by the 1820s.

4. During the 1820s, several hundred Oneidas relocated to what would become the State of Wisconsin, with only a small number remaining in New York. The emigrating Oneidas became recognized as the Oneida Tribe of Indians of Wisconsin, now recognized as the Oneida

¹ While Registrant identifies itself on its registrations as Oneida Indian Nation of New York, its federally recognized name is Oneida Nation of New York. 82 F.R. 4915, 4917 (Jan. 17, 2017). Registrant indicates in its August 14, 2017 Motion to Dismiss that it changed its official name to Oneida Indian Nation as of March 2017.

² For further background *see, e.g., County of Oneida v. Oneida Indian Nation of New York State*, 470 U.S. 226, 229-231 (1985); *Oneida Indian Nation of New York v. County of Oneida*, 414 U.S. 661, 663-665 (1974); *New York Indians v. United States*, 170 U.S. 1 (1898); *Oneida Indian Nation of New York v. City of Sherrill*, 337 F.3d 139, 144-152 & n.1 (2d Cir. 2003), and historical sources cited therein.

Nation, who entered their final treaty with the United States in 1838, ten years before Wisconsin entered statehood.

5. The Oneidas that remained in New York became recognized as the Oneida Nation of New York.

6. For well over 100 years, both tribes have functioned as sovereign Indian Tribes, using the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify themselves.

7. Petitioner, for well over 100 years, has used the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify itself and the source of various goods and services provided by it to its members and members of the general public.

8. Petitioner submits that in light of this history and longstanding use of these terms by both entities, both tribes should be able to use and continue to use the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify themselves.

9. Registrant Oneida Indian Nation of New York, however, has turned to the Trademark Laws of the United States in an effort to claim nationwide exclusivity over the marks ONEIDA and ONEIDA INDIAN NATION, including efforts directed at limiting the Petitioner's own use of the name Oneida that it has used for hundreds of years, and limiting Petitioner's own use of its federally recognized name—Oneida Nation, thereby harming Petitioner.

Petitioner

10. As set forth above, Petitioner traces its origins to parties of the original Oneida Indian Nation who relocated to what is now Wisconsin in the 1820s, and who entered their final treaty with the United States in 1838.³

³ The text of this treaty may be found at <http://digital.library.okstate.edu/Kappler/vol2/treaties/one0517.htm>.

11. In 1978, the U.S. Department of the Interior adopted regulations setting out “Procedures for Establishing That an American Indian Group Exists as an Indian Tribe.” 43 F.R. 39361 (Sept. 5, 1978). The regulations expressly exempted tribes that were already recognized from these procedures, and required the Bureau of Indian Affairs to publish an initial list of tribes that were already recognized. 43 F.R. 39362-63 (25 CFR §§ 54.3 and 54.6(b)). This initial list of recognized tribes was published in 1979, and included the Oneida Tribe of Wisconsin. 44 F.R. 7235, 7236 (Feb. 6, 1979). In 2002, the federally recognized name was amended to Oneida Tribe of Indians of Wisconsin. 67 F.R. 46328, 46330 (July 12, 2002).

12. On May 2, 2015, Petitioner conducted an election adopting several amendments to its Constitution, including an amendment to change its name from Oneida Tribe of Indians of Wisconsin to Oneida Nation. The Bureau of Indian Affairs approved this amendment on June 16, 2015, and this change was published in 2016. 81 F.R. 26826, 26827 (May 4, 2016).

13. Petitioner owns U.S. Trademark Reg. No. 3,016,505 for the mark ONEIDA within a stylized design:



14. Petitioner’s U.S. Trademark Reg. No. 3,016,505 registered on November 22, 2005, from Application Serial No. 75/575,398 filed on October 23, 1998, for IC 035 / US 100, 101, and 102: Retail store services featuring convenience store items and gasoline; IC 041 / US 100, 101, and 107: Casinos; and IC 042 / US 100 and 101: Hotel and restaurant services; retail

and commercial printing and graphics art design services. The '505 Registration recites a first use and first use in commerce in 1992.

15. Petitioner owns common law trademark rights in the character mark ONEIDA.

16. Petitioner is the owner of Oneida Golf Enterprises Corporation ("OGEC"), a tribal corporation of the Oneida Nation.

17. In October 2015, OGEC reached an agreement with the Ladies Professional Golf Association ("LPGA") to host and sponsor an LPGA golf tournament at the Thornberry Creek at Oneida golf course, a golf course owned by Petitioner and operated by OGEC. On October 20, 2015, the LPGA issued a press release titled "Oneida Nation to Sponsor New LPGA Tour Event in Green Bay in 2017." Ex. A. The press release stated, in part: "The [LPGA] announced today that the Oneida Nation has agreed to title sponsor a new event in 2017, the Oneida LPGA Classic, on the Oneida Reservation immediately near Green Bay, Wisconsin. The tournament will take place at Thornberry Creek at Oneida, a course owned by Oneida Nation and managed by the Oneida Golf Enterprises Corporation."

18. This press release apparently caught the eye of Registrant, as discussed below.

19. Petitioner has used in the past and has a bona fide intent to use the ONEIDA and ONEIDA INDIAN NATION marks, or similar marks, for the same or related goods and services identified in the '491 Registration, the '677, Registration, and the '028 Registration.

Registrant

20. On information and belief, Registrant Oneida Indian Nation of New York is the owner of record of the '491 Registration, the '677, Registration, and the '028 Registration.

21. On information and belief, Registrant's address and email information is 2037 Dreamcatcher Plaza, Oneida, NY 13421; 5218 Patrick Road, Verona, NY 13478; tmdocketing@oneida-nation.org; and mbeakman@oneida-nation.org.

22. As set forth above, on information and belief, Registrant traces its origins to the Oneidas who remained in New York following the relocation of other Oneidas to what is now Wisconsin in the 1820s.

23. In 1978, the U.S. Department of the Interior adopted regulations setting out “Procedures for Establishing That an American Indian Group Exists as an Indian Tribe.” 43 F.R. 39361 (Sept. 5, 1978). The regulations expressly exempted tribes that were already recognized from the procedures, and required the Bureau of Indian Affairs to publish an initial list of tribes that were already recognized. 43 F.R. 39362-63 (25 CFR §§ 54.3 and 54.6(b)). This initial list of recognized tribes was published in 1979, and included the Oneida Nation of New York. 44 F.R. 7235, 7236 (Feb. 6, 1979). Oneida Nation of New York remains Registrant’s federally recognized name. 82 F.R. 4915, 4917 (Jan. 17, 2017).

24. On November 25, 2015, legal counsel for Registrant sent a letter to Ms. Elizabeth Moore, the Chief Legal Officer of the LPGA, attached as Exhibit B. The letter noted “We represent the Oneida Nation of New York (the “Oneida Nation”). Attached to the letter was a copy of the October 20, 2015 press release attached herein as Ex. A.

25. The letter asserted: “Our client has continuously used and been recognized as the ONEIDA and the ONEIDA NATION for hundreds of years. The Indian nation located in Wisconsin is federally recognized as the Oneida Tribe of Indians of Wisconsin.”

26. The letter further asserted: “In addition to its long history and use of the ONEIDA and ONEIDA NATION names, the Oneida Nation owns numerous federal trademarks for the ONEIDA trademark, including U.S. Reg. No. 4813028 for ‘conducting sporting events, namely boxing, yoga, lacrosse, and golf,’ among others.”

27. The letter further asserted: “The Oneida Nation is understandably concerned about the LPGA’s Press Release for the ‘Oneida LPGA Classic’ because consumers are likely to

be confused to believe that the tournament is licensed by, sponsored by, endorsed by, or otherwise connected to the Oneida Nation, when in fact, it is not.”

28. The letter further demanded that the LPGA “(1) immediately and permanently cease all use of the ONEIDA and ONEIDA NATION name and mark in connection with the ‘Oneida LPGA Classic;’ (2) cease all use, distribution, posting, display and dissemination of the Press Release, including without limitation removing it from all websites; and (3) refrain from any use of the Press Release or similar statements and/or advertisements in the future that, among other things, falsely suggest that the Oneida Nation is associated or affiliated in any way with the ‘Oneida LPGA Classic.’”

29. Because of the threats and business interference from Registrant to Petitioner’s business partner the LPGA, Petitioner acted to change the name of the LPGA tournament, to be conducted July 6-9, 2017, to Thornberry Creek LPGA Classic. In doing so, Petitioner was forced to avoid using its own name in order to avoid potential business losses and disruption intentionally caused by Registrant.

30. Based on Registrant’s acts, Petitioner believes that it has been and will be damaged by the ’491 Registration, the ’677, Registration, and the ’028 Registration, and therefore has a real interest in this cancellation proceeding.

Registrant’s ’491 Registration

31. The application for what issued as the ’491 Registration was filed on July 13, 1994 as Serial Number 74/548,930 for the mark ONEIDA INDIAN NATION.

32. The July 13, 1994 application stated that Registrant has adopted and is using the mark shown on the accompanying drawing for the following recitation of goods and services:

Class 14: Key fobs, pins

Class 16: Decals; Christmas cards; directories, newsletters, folders, stationary

Class 18: Tote bags

Class 21: Mugs; drinking glasses

Class 24: Flags

Class 25: Clothing – namely, t-shirts, hats, sweatshirts, sport shirts

Class 35: Governmental services – namely, vital statistics services, police services, medical care services, family care services; legal services; youth corps services; housing services

Class 36: Scholarship and educational financial assistance

Class 37: Construction and home maintenance services

Class 41: Entertainment services – namely, gaming services, live entertainment services; educational services relating to the culture, heritage and language of the Oneida Indian nation; providing recreational facilities and programs; information center services; information and referral services and

Class 42: Restaurant and non-alcoholic bar services; retail gift shop services; retail smoke shop services.

33. The July 13, 1994 application contained the following statements:

An exception to the applicant's exclusive use of ONEIDA as part of the mark shown on the accompanying drawing is The Oneida Tribe of Indians of Wisconsin, Inc., Oneida, Wisconsin, which is a tribe incorporated under the law of the United States and recognized by the United States as separate and distinct from the applicant Nation. The Oneida Tribe of Indians of Wisconsin, Inc. has used The Oneida Tribe of Indians of Wisconsin, Inc. since May 1, 1937 to identify itself, its goods and its services in Wisconsin. On information and belief, prior to May 1, 1937, the Oneida Tribe of Indians of Wisconsin, Inc. was also known as The Oneida Tribe of Wisconsin and/or The Oneida Tribe of Indians of the Oneida Reservation in Wisconsin.

The applicant disclaims "Indian Nation" separate and apart from the mark on the accompanying drawing.

34. The July 13, 1994 application further included a sworn declaration dated June 21, 1994 by Mr. Ray Halbritter as Nation Representative. The declaration certified that, to the best of his knowledge and belief, no other persons, firm, corporation, or association except as stated in the Statement, has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such

other person, to cause confusion or mistake, or to deceive; that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the warning that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom.

35. On information and belief, Registrant was not using the ONEIDA INDIAN NATION mark on all the goods and services recited in the July 13, 1994 application.

36. On information and belief, Registrant was not using the ONEIDA INDIAN NATION mark on at least the following goods and services at the time of the July 13, 1994 application: key fobs, Christmas cards, folders, stationary, hats, sweatshirts, sport shirts, and construction and home maintenance services.

37. Although the application stated “Three (3) specimens showing the mark as currently used for goods and services in each of the classes set forth herein are presented herewith”, the official record available to Petitioner does not include such specimens.

38. In an Office Action dated February 27, 1995, the Trademark Office stated:

The specimens of record are acceptable for all classes except Class 14, pins, and Class 35, vital statistics services. None of the specimens for services appear to reference vital statistics services, and it is not clear from the record that specimens for pins have been presented. The requirements for these specimens are stated below.

The specimens do not show use of the mark for any goods in Class 14 identified in the application. The applicant must submit three specimens demonstrating use of the mark for the goods specified' 37 C.F.R.. Sections 2.56 and 2.58. The applicant must verify, with an affidavit or a declaration under 37 C.F.R. Section 2.20 that the substitute specimens were in use in commerce at least as early as the filing date of the application. 37 C.F.R. Section 2.59(a); TMEP section 905.1 0.

The specimens do not show use of the mark for any services in Class 35 identified in the application. The applicant must submit three specimens showing use of the mark for the services specified. 37 C.F.R. Sections 2.56 and 2.58. The applicant

must verify, with an affidavit or a declaration under 37 C.F.R. Section 2.20, that the substitute specimens were in use in commerce at least as early as the filing date of the application. 37 C.F.R. Section 2.59(a); TMEP section 905.10.

The Office Action further noted that if Registrant added class 6, 18 or 20 to the application that additional specimens of use were required.

39. Registrant submitted an Amendment to the application on August 25, 1995, which included a substitute statement and declaration. The Amendment also included photocopies of specimens for classes 6, 14, and 35. The official record available to Petitioner, however, does not include such specimens.

40. The August 1995 statement also stated:

An exception to the applicant's exclusive use of ONEIDA as part of the mark shown on the accompanying drawing is The Oneida Tribe of Indians of Wisconsin, Inc., Oneida, Wisconsin, which is a tribe incorporated under the law of the United States and recognized by the United States as separate and distinct from the applicant Nation. The Oneida Tribe of Indians of Wisconsin, Inc. has used The Oneida Tribe of Indians of Wisconsin, Inc. since May 1, 1937 to identify itself, its goods and its services in Wisconsin. On information and belief, prior to May 1, 1937, the Oneida Tribe of Indians of Wisconsin, Inc. was also known as The Oneida Tribe of Wisconsin and/or The Oneida Tribe of Indians of the Oneida Reservation in Wisconsin. . . .

The applicant disclaims "Indian Nation" separate and apart from the mark on the accompanying drawing.

41. The August 1995 amendment further included a sworn declaration dated August 30, 1995 by Mr. Ray Halbritter as Nation Representative. The declaration certified that, to the best of his knowledge and belief, no other persons, firm, corporation, or association except as stated in the Statement, has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

42. Application 74/548,930 published for opposition on September 24, 1996. The publication notice stated:

SUBJECT TO CONCURRENT USE PROCEEDING WITH THE ONEIDA
TRIBE OF INDIANS OF WISCONSIN ONEIDA RESERVATION
WISCONSIN APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE
MARK IN THE ENTIRE UNITED STATES WITH THE EXCEPTIONS OF
WISCONSIN

43. On December 16, 1997, Registrant filed an Amendment After Publication for Application 74/548,930. The remarks stated, in part, the “Applicant has amended its application to remove any exception to the registration of its mark throughout the United States. Nothing else has changed.” The December 1997 amendment contained no explanation as to why the previously identified exception was incorrect or inapplicable, or why removal of the exception was otherwise appropriate.

44. The December 1997 amendment contained a substitute statement and declaration. The substitute statement omitted the prior reference to Petitioner’s prior use of ONEIDA, while asserting that the ONEIDA portion of the mark was distinctive in light of Registrant’s “substantially exclusive and continuous use in commerce within the Indian Nation since as early as 1492 in connection with the applicant’s goods and services.” The December 1997 statement contained no explanation as to why the previously identified exception was incorrect or inapplicable, or why removal of the exception was otherwise appropriate.

45. The December 1997 amendment further included a sworn declaration dated December 9, 1997 by Mr. Ray Halbritter as Nation Representative. The declaration certified that, to the best of his knowledge and belief, no other persons, firm, corporation, or association has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The December 1997 declaration contained no explanation as to why the previously identified exception was incorrect or inapplicable, or why removal of the exception was otherwise appropriate.

46. On or before December 9, 1997, Registrant knew that Petitioner was using and had used the mark ONEIDA in conjunction with at least the following goods and services: newsletters pertaining to nation's events and issues; government services; entertainment services, namely casino services, bingo services; lottery services; and retail smoke shop services.

47. Application 74/548,930 re-published for opposition on March 10, 1998, omitting the exception related to Petitioner's use in Wisconsin.

48. On March 8, 1999, third party Oneida Ltd. filed a Notice of Opposition, requesting that registration of the ONEIDA INDIAN NATION mark by Registrant be denied with respect to Class 21.

49. On April 1, 1999, Registrant filed a Motion to Divide Application with the Trademark Trial and Appeal Board, requesting that Application 74/548,930 be divided into one application covering Class 21, at issue in the instituted Opposition, and a second application covering the unopposed classes. The Trademark Trial and Appeal Board granted the motion on June 7, 1999. On August 14, 1999, the Patent and Trademark Office issued a letter confirming that the divisional request had been completed, and that all classes other than Class 21 had been placed in newly created Application 75/978,733.

50. Application 75/978,733 matured as the '491 Registration on January 18, 2000.

51. Accordingly, on January 18, 2000, Registrant obtained the '491 Registration for the trademark and service mark ONEIDA INDIAN NATION for the following goods and services:

IC 006. US 002 012 013 014 023 025 050. G & S: metal key fobs.

IC 014. US 002 027 028 050. G & S: ornamental pins.

IC 016. US 002 005 022 023 029 037 038 050. G & S: decals; Christmas cards; nation directory of member services, newsletters pertaining to nation's events and issues; folders, stationery.

IC 018. US 001 002 003 022 041. G & S: tote bags.

IC 024. US 042 050. G & S: cloth flags.

IC 025. US 022 039. G & S: clothing, namely T-shirts, hats, sweatshirts, sports shirts.

IC 035. US 100 101 102. G & S: government services, namely, vital statistics services.

IC 036. US 100 101 102. G & S: providing educational, scholarship, welfare and personal financial assistance services to families and individuals in the form of check disbursements; providing personal loan services; providing housing agency services; providing home repair financial assistance services.

IC 037. US 100 103 106. G & S: construction and home maintenance services.

IC 041. US 100 101 107. G & S: entertainment services, namely casino services, bingo services, lottery services, live variety entertainment services in the nature of musical performances, seminars, workshops, lectures and classes relating to the culture, heritage and language of the Oneida Indian nation; providing recreational facilities and programs.

IC 042. US 100 101. G & S: restaurant and non-alcoholic bar services; retail smoke shop services; medical care services; legal services, police protection services, providing temporary housing accommodations, child care services, family counseling services, heating assistance services, financial assistance services, mental health assistant services, home visit services, nutrition program services, youth counseling services regarding alcohol and other substance abuse.

The '491 Registration further provides: "NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE 'INDIAN NATION' APART FROM THE MARK AS SHOWN."

52. On January 18, 2006, Registrant filed a Declaration under Sections 8 and 15 executed by Mr. Ray Halbritter. The Declaration certified under oath that Registrant is using the mark in commerce on or in connection with all of the goods and services recited in the existing registration, except for metal key fobs in International Class 6. The Declaration further included 10 specimens, which it asserted showed use of the ONEIDA INDIAN NATION mark as used in commerce in each of ten different classes. The Declaration further certified that Registrant has used the mark in commerce for over five consecutive years immediately preceding the execution

of the Declaration on or in connection with the goods and services recited in the registration, except for metal key fobs in International Class 6.

53. The January 18, 2006 specimens did not include specimens purporting to demonstrate use on at least: Christmas cards; nation directory of member services, newsletters pertaining to nation's events and issues; folders; stationery; hats; sweatshirts; providing personal loan services; construction and home maintenance services; casino services; bingo services; lottery services; workshops, lecturers and classes relating to the culture, heritage and language of the Oneida Indian nation; providing recreational facilities and programs; restaurant and non-alcoholic bar services; retail smoke shop services; legal services; police protection services; child care services; family counseling services; heating assistance services; financial assistance services; mental health assistant services; home visit services; nutrition program services; youth counseling services regarding alcohol and other substance abuse.

54. The January 18, 2006 Declaration did not include a statement certifying that to the best of his knowledge and belief, no other persons, firm, corporation, or association has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

55. Registrant was not using on January 18, 2006 and had not for five consecutive years before the January 18, 2006 Declaration exclusively used the ONEIDA INDIAN NATION mark of the '491 Registration in commerce in connection with all of the goods and services listed in the registration.

56. On or before January 18, 2006, Registrant knew that Petitioner was using and had used the mark ONEIDA in conjunction with at least the following goods and services: Newsletters, casino services; bingo services; lottery services; workshops, lecturers and classes

relating to the culture, heritage and language of the Oneida Indian nation; and retail smoke shop services.

57. When Mr. Halbritter executed the declaration filed on January 18, 2006, he was aware of rights by others, including but not limited to Petitioner, to use the ONEIDA mark in connection with the identified goods and services.

58. When Mr. Halbritter executed the declaration filed on January 18, 2006, he was aware that an exception to Registrant's exclusive use of ONEIDA was Petitioner, which is a tribe organized under the law of the United States and recognized by the United States as separate and distinct from Registrant.

59. On July 19, 2010, Registrant filed a Declaration under Sections 8 and 9. The Declaration was executed by Peter D. Carmen, Chief Operating Officer, and certified under oath that Registrant is using the mark in commerce on or in connection with all of the goods and services recited in the existing registration, except for decals (Class 16), nation directory of member services (Class 16), folders (Class 16), government services, namely vital statistics services (Class 35), providing housing agency services (Class 36), providing home repair financial assistance services (Class 36), home maintenance services (Class 37), child care services (Class 42), heating assistance services (Class 42), and home visit services (Class 42). The Declaration further included nine specimens, which it asserted showed use of the ONEIDA INDIAN NATION mark as used in commerce in each of nine different classes.

60. The July 19, 2010 specimens did not include specimens purporting to demonstrate use on at least: Christmas cards; stationary; cloth flags; clothing, namely T-shirts, hats, sweatshirts, sports shirts; providing personal loan services; construction services; casino services; lottery services; workshops, lectures and classes relating to the culture, heritage and language of the Oneida Indian nation; providing recreational facilities and programs; restaurant

and non-alcoholic bar services; retail smoke shop services; legal services; police protection services; family counseling services; financial assistance services; nutrition program services; youth counseling services regarding alcohol and other substance abuse.

61. The July 19, 2010 Declaration did not include a statement certifying that to the best of his knowledge and belief, no other persons, firm, corporation, or association has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

62. On or before July 19, 2010, Registrant knew that Petitioner was using and had used the mark ONEIDA in conjunction with at least the following goods and services: Newsletters, casino services; bingo services; lottery services; workshops, lectures and classes relating to the culture, heritage and language of the Oneida Indian nation; and retail smoke shop services.

63. When Mr. Carmen executed the declaration filed on July 19, 2010, he was aware of rights by others, including but not limited to Petitioner, to use the ONEIDA mark in connection with the identified goods and services.

64. When Mr. Carmen executed the declaration filed on July 19, 2010, he was aware that an exception to Registrant's exclusive use of ONEIDA was Petitioner, which is a tribe organized under the law of the United States and recognized by the United States as separate and distinct from Registrant.

65. Registrant was not using on July 19, 2010 and had not for five consecutive years before the July 19, 2010 Declaration exclusively used the ONEIDA INDIAN NATION mark of the '491 Registration in commerce in connection with all of the goods and services listed in the registration.

66. Registrant's use, if any, and registration of the ONEIDA INDIAN NATION mark is without Petitioner's consent or permission.

Registrant's '677 Registration

67. Registrant's application for what issued as the '677 Registration was filed on January 26, 2006 as Serial Number 78/800,006 for the mark ONEIDA.

68. The January 26, 2006 application was filed under Section 1(b), and included the certification that the "applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services":

IC 016. G & S: Newsletters pertaining to Oneida Indian Nation events and issues; newspapers and magazines of general circulation about Indian issues; decals; greeting cards; stationery.

IC 018. G & S: Bags.

IC 025. G & S: Clothing, headwear, and footwear.

IC 030. G & S: Sauces, seasonings.

IC 035. G & S: Promoting tourism in and to the Oneida Indian Nation and its environs.

IC 036. G & S: Charitable services, namely, providing financial assistance to families and individuals; providing educational scholarships.

IC 037. G & S: Construction and home maintenance services; automobile service station services.

IC 039. G & S: Marina services; air transportation services.

IC 042. G & S: Legal services.

IC 043. G & S: Child care services; providing temporary housing accommodations.

IC 044. G & S: Medical services; governmental services, namely, heating assistance services, mental health assistance services, home nursing aid services, family counseling services, nutrition counseling services, providing food, counseling services in the fields of alcohol and substance abuse, housing agency services, vital statistics services.

IC 045. G & S: Police protection services.

69. Registrant's January 26, 2006 Application further included a Declaration by Registrant's counsel Christine Baty Heinze on behalf of Registrant, certifying that to the best of her knowledge and belief, no other persons, firm, corporation, or association has the right to use the mark ONEIDA in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

70. On or before January 26, 2006, Registrant knew that Petitioner was using and had used the mark ONEIDA in conjunction with at least the following goods and services: Newsletters pertaining to Oneida Indian Nation events and issues; automobile service station services; and governmental services.

71. On information and belief, when Registrant submitted its application on January 26, 2016, it had no bona fide intent to use the ONEIDA mark in all of the identified goods and services.

72. When Ms. Heinze executed the declaration filed on January 26, 2006, she was aware of rights by others, including but not limited to Petitioner, to use the ONEIDA mark in connection with the identified goods and services.

73. When Ms. Heinze executed the declaration filed on January 26, 2006, she was aware that an exception to Registrant's exclusive use of ONEIDA was Petitioner, which is a tribe organized under the law of the United States and recognized by the United States as separate and distinct from Registrant.

74. Following issue of an office action, on July 6, 2007, Registrant submitted a response including amendments and a request to divide. Registrant requested that certain services be divided out and placed in a newly created child application. Registrant asserted that

the divided services were identical to a subset of the original application, when in fact the division enlarged the goods and services.

75. The Patent and Trademark Office completed the divisional request on August 23, 2007, including the divided goods and services within Serial Number 78/978,999:

IC 016. G & S: Newsletters pertaining to Oneida Indian Nation events and issues; newspapers and magazines of general circulation about Indian issues; decals; greeting cards; stationery.

IC 018. G & S: Bags, namely, tote bags, sports bags, gym bags, shopping bags, and golf bags.

IC 030. G & S: Sauces, seasonings.

IC 035. G & S: Promoting tourism in and to the Oneida Indian Nation and its environs; and governmental services, namely, vital statistics services.

IC 036. G & S: Charitable services, namely, providing financial assistance to families and individuals; providing educational scholarships; governmental services, namely, providing financial assistance for payment of heating services and providing housing agency services in the nature of financial assistance for housing, and family counseling in the areas of financial and budgeting skills..

IC 037. G & S: Construction and home maintenance services.

IC 039. G & S: Marina services; air transportation services.

IC 042. G & S: Legal services.

IC 043. G & S: Child care services; providing temporary housing accommodations; governmental services, namely, providing food to needy persons.

IC 044. G & S: Medical services; governmental services, namely, mental health assistance services, home nursing aid services, family mental health and psychological counseling services, nutrition counseling services, counseling services in the fields of alcohol and substance abuse.

IC 045. G & S: Police protection services; governmental services, namely, family counseling in the nature of marriage counseling and providing emotional support.

76. The application published for opposition on October 30, 2007. On February 26, 2008, third party Oneida Ltd. filed a Notice of Opposition, requesting that registration of the ONEIDA mark by Registrant be denied. On June 11, 2012, Oneida Ltd. and Registrant filed a

joint stipulated request to withdraw the opposition. On July 31, 2012, the Patent and Trademark Office issued a Notice of Allowance.

77. On January 31, 2013, Registrant submitted an Extension of Time to File a Statement of Use. This Extension Request deleted from the application the following goods or services: governmental services, namely, vital statistics services (Class 35); providing financial assistance for payment of heating services and providing housing agency services in the nature of financial assistance for housing (Class 36); home maintenance services (Class 37); air transportation services (Class 39); Child care services (Class 43); governmental services, namely, providing food to needy persons (Class 43); and home nursing aid services (Class 44).

78. The Trademark Office approved the January 31, 2013 Extension of Time to File a Statement of Use on February 13, 2013, and deleted the following goods or services from the application: governmental services, namely, vital statistics services (Class 35); home maintenance services (Class 37); air transportation services (Class 39); Child care services (Class 43); governmental services, namely, providing food to needy persons (Class 43); and home nursing aid services (Class 44).

79. Registrant filed a Second Extension of Time to File a Statement of Use on July 26, 2013 without amendment to the recited goods and services. The Second Extension of Time to File a Statement of Use was approved by the Trademark Office on August 7, 2013.

80. Registrant filed a Third Extension of Time to File a Statement of Use on January 21, 2014 without amendment to the recited goods and services. The Third Extension of Time to File a Statement of Use was approved by the Trademark Office on January 30, 2014.

81. Registrant filed a Fourth Extension of Time to File a Statement of Use on July 10, 2014. The Fourth Extension of Time to File a Statement of Use deleted from the application the

following goods or services: Sauces, seasonings (Class 30); Construction services (Class 37); and Legal services (Class 42).

82. The Trademark Office approved the Fourth Extension of Time to File a Statement of Use on July 12, 2014, and deleted the following goods or services from the application: Sauces, seasonings (Class 30); Construction services (Class 37); and Legal services (Class 42).

83. Registrant filed a Fifth Extension of Time to File a Statement of Use on February 2, 2015. The Fifth Extension of Time to File a Statement of Use deleted from the application the following goods or services: Promoting tourism in and to the Oneida Indian Nation and its environs (Class 35); Marina services (Class 39); and providing temporary housing accommodations (Class 43).

84. The Trademark Office approved the Fourth Extension of Time to File a Statement of Use on February 6, 2015, and deleted the following goods or services from the application: Promoting tourism in and to the Oneida Indian Nation and its environs (Class 35); Marina services (Class 39); and providing temporary housing accommodations (Class 43).

85. On July 31, 2015, Registrant filed a Statement of Use declaring under oath use of all goods and services of the application in U.S. commerce as of July 31, 2015, except for newspapers and magazines of general circulation about Indian issues (Class 16), greeting cards (Class 16), stationary (Class 16); bags, namely, tote bags, sports bags, gym bags, shopping bags, and golf bags (Class 18); governmental services, namely, family counseling in the areas of financial and budgeting skills (Class 36).

86. The July 31, 2015 specimens did not include specimens purporting to demonstrate use on at least: Charitable services, namely, providing financial assistance to families and individuals; nutrition counseling services; Police protection services; governmental services, namely, family counseling in the nature of marriage counseling and providing emotional support.

87. Registrant also filed a Declaration on July 31, 2015 executed by Registrant's General Counsel Megan Murphy Beakman on behalf of Registrant, certifying that to the best of her knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive.

88. On or before January 26, 2006, Registrant knew that Petitioner was using and had used the mark ONEIDA in conjunction with at least the following goods and services: Newsletters pertaining to Oneida Indian Nation events and issues; and governmental services.

89. When Ms. Beakman executed the declaration filed on July 31, 2015, she was aware of rights by others, including but not limited to Petitioner, to use the ONEIDA mark in connection with the identified goods and services.

90. When Ms. Beakman executed the declaration filed on July 31, 2015, she was aware that an exception to Registrant's exclusive use of ONEIDA was Petitioner, which is a tribe organized under the law of the United States and recognized by the United States as separate and distinct from Registrant.

91. Application 78/978,999 matured as the '677 Registration on September 8, 2015.

92. On September 8, 2015, Registrant obtained the '677 Registration for the trademark and service mark ONEIDA (standard character mark) for the following goods and services:

IC 016. US 002 005 022 023 029 037 038 050. G & S: Newsletters pertaining to Oneida Indian Nation events and issues.

IC 036. US 100 101 102. G & S: Charitable services, namely, providing financial assistance to families and individuals; providing educational scholarships.

IC 044. US 100 101. G & S: Medical services; governmental services, namely, mental health assistance services, family mental health and psychological counseling services, nutrition counseling services, counseling services in the fields of alcohol and substance abuse.

IC 045. US 100 101. G & S: Police protection services; governmental services, namely, family counseling in the nature of marriage counseling and providing emotional support.

93. Registrant has never used the ONEIDA mark of the '677 Registration in commerce in connection with all of the goods and services listed in the registration.

94. Registrant's use, if any, and registration of the ONEIDA mark is without Petitioner's consent or permission.

Registrant's '028 Registration

95. The application for what issued as the '028 Registration was filed on January 26, 2006 as Serial Number 78/799,982 for the mark ONEIDA.

96. The January 26, 2006 application was filed under Section 1(b), and included the certification that the "applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services":

IC 009. G & S: Gaming machines; computer hardware and software for gaming machines; computer hardware and software for making reservations at hotels, resorts, and casinos; computer hardware and software for communications between various amenities in hotels, resorts, and casinos.

IC 016. G & S: Identification cards for accessing casino games and casino game playing machines

IC 035. G & S: Retail clothing stores, retail convenience stores, retail smoke shops.

IC 041. G & S: Casinos; bingo services; lottery services; conducting casino and gaming contests, tournaments, and sporting events; entertainment services, namely, live musical performances, live comedy performances, and cooking demonstrations;; golf club services; golf courses; golf instruction; health club services, namely providing instruction and equipment in the field of physical exercise; conducting seminars, workshops, lectures, and classes relating to the

culture, heritage, and language of the Oneida Indian Nation; museum and cultural center services; entertainment services.

IC 043. G & S: Resort lodging services; hotel, bar, and restaurant services; banquet and social function facilities; catering services; conference, exhibition and meeting facilities services.

IC 044. G & S: Health spa services, namely, cosmetic body care services; hairdressing salons.

97. Registrant's January 26, 2006 Application further included a Declaration by Registrant's counsel Christine Baty Heinze on behalf of Registrant, certifying that to the best of her knowledge and belief, no other persons, firm, corporation, or association has the right to use the mark ONEIDA in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

98. On or before January 26, 2006, Registrant knew that Petitioner was using and had used the mark ONEIDA in conjunction with at least the following goods and services: Gaming machines; Identification cards for accessing casino games and casino game playing machines; retail convenience stores, retail smoke shops; Casinos; bingo services; lottery services; conducting casino and gaming contests conducting seminars, workshops, lectures, and classes relating to the culture, heritage, and language of the Oneida Indian Nation; museum and cultural center services.

99. On information and belief, on or before January 26, 2006, Registrant knew that Oneida Community Golf Club of Oneida, New York, was using and had used the mark ONEIDA in conjunction with at least the following goods and services: golf club services, golf courses, golf instruction.

100. On information and belief, when Registrant submitted its application on January 26, 2006, it had no bona fide intent to use the ONEIDA mark in all of the identified goods and services.

101. When Ms. Heinze executed the declaration filed on January 26, 2006, she was aware of rights by others, including but not limited to Petitioner, to use the ONEIDA mark in connection with the identified goods and services.

102. When Ms. Heinze executed the declaration filed on January 26, 2006, she was aware that an exception to Registrant's exclusive use of ONEIDA was Petitioner, which is a tribe organized under the law of the United States and recognized by the United States as separate and distinct from Registrant.

103. Following issue of an office action, on July 6, 2007, Registrant submitted a response including amendments and a request to divide. Registrant requested that certain services be divided out and placed in a newly created child application.

104. The Patent and Trademark Office completed the divisional request on August 22, 2007, including the divided goods and services within Serial Number 78/978,992:

IC 041. G & S: Conducting sporting events, namely, boxing, bull riding, snowmobile races, figure skating, jousting, snow shoeing, balloon rides, yoga, lacrosse, golf, and basketball; entertainment services, namely, live musical performances, live comedy performances, and cooking demonstrations; golf instruction; conducting seminars, workshops, lectures, and classes relating to the culture, heritage, and language of the Oneida Indian Nation; and museum and cultural center services.

105. The application published for opposition on December 5, 2007. On April 22, 2008, third party Oneida Ltd. filed a Notice of Opposition, requesting that registration of the ONEIDA mark by Registrant be denied. On June 11, 2012, Oneida Ltd. and Registrant filed a joint stipulated request to withdraw the opposition, which was consolidated with the opposition

to the application for the '677 Registration discussed above. On August 14, 2012, the Patent and Trademark Office issued a Notice of Allowance.

106. On January 21, 2014, Registrant submitted an Extension of Time to File a Statement of Use. This Extension Request deleted from the application the following goods or services: Conducting sporting events, namely, jousting.

107. On February 1, 2014, the Trademark Office approved the Extension of Time to File a Statement of Use, and deleted the following goods or services from the application: Conducting sporting events, namely, jousting.

108. Registrant filed a Second Extension of Time to File a Statement of Use on July 10, 2014 without amendment to the recited goods and services. The Second Extension of Time to File a Statement of Use was approved by the Trademark Office on July 17, 2014.

109. Registrant filed a Third Extension of Time to File a Statement of Use on February 16, 2015 without amendment to the recited goods and services. The Third Extension of Time to File a Statement of Use was approved by the Trademark Office on February 25, 2015.

110. On August 10, 2015, Registrant filed a Statement of Use declaring under oath use of all goods and services of the application in U.S. commerce as of August 10, 2015, except for bull riding, snowmobile races, figure skating, snow shoeing, balloon rides, and basketball (Class 41).

111. The specimens accompanying the August 10, 2015 Statement of Use did not purport to demonstrate use of the ONEIDA mark on the following services: Conducting sporting events, namely, boxing, yoga, lacrosse, golf; entertainment services, namely, live musical performances, live comedy performances, and cooking demonstrations; golf instruction.

112. Registrant also filed a declaration on August 10, 2015 executed by Registrant's General Counsel Megan Murphy Beakman on behalf of Registrant, certifying that to the best of

her knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive.

113. When Ms. Beakman executed the declaration filed on August 10, 2015, she was aware of rights by others, including but not limited to Petitioner and Oneida Community Golf Club of Oneida, New York, to use the ONEIDA mark in connection with the identified goods and services.

114. When Ms. Beakman executed the declaration filed on August 10, 2015, she was aware that an exception to Registrant's exclusive use of ONEIDA was Petitioner, which is a tribe organized under the law of the United States and recognized by the United States as separate and distinct from Registrant.

115. Application 78/978,992 matured as the '028 Registration on September 8, 2015.

116. Accordingly, on September 15, 2015, Registrant obtained the '028 Registration for the service mark ONEIDA (standard character mark) for the following goods and services:

IC 041. US 100 101 107. G & S: Conducting sporting events, namely, boxing, yoga, lacrosse, golf; entertainment services, namely, live musical performances, live comedy performances, and cooking demonstrations; golf instruction; conducting seminars, workshops, lectures, and classes relating to the culture, heritage, and language of the Oneida Indian Nation; and museum and cultural center services.

117. Registrant has never used the ONEIDA mark of the '028 Registration in commerce in connection with all of the goods and services listed in the registration.

118. Registrant's use, if any, and registration of the ONEIDA mark is without Petitioner's consent or permission.

Other January 2006 Applications of Registrant

119. In addition to Application 78/978,999 for the '677 Registration and Application 78/978,992 for the '028 Registration, both filed on January 26, 2006, Registrant filed several other applications in January 2006.

120. Registrant filed Application 78/799,982 on January 26, 2006 for the mark ONEIDA.

121. Application 78/799,982 was filed under Section 1(b), and included the certification that the “applicant has a bona fide intention to use or use through the applicant’s related company or licensee the mark in commerce on or in connection with the identified goods and/or services”:

IC 009: Gaming machines; computer hardware and software for gaming machines; computer hardware and software for making reservations at hotels, resorts, and casinos; computer hardware and software for communications between various amenities in hotels, resorts, and casinos

IC 016: Identification cards for accessing casino games and casino game playing machines

IC 035: Retail clothing stores, retail convenience stores, retail smoke shops

IC 041: Casinos; bingo services; lottery services; conducting casino and gaming contests, tournaments, and sporting events; entertainment services, namely, live musical performances, live comedy performances, and cooking demonstrations; golf club services; golf courses; golf instruction; health club services, namely providing instruction and equipment in the field of physical exercise; conducting seminars, workshops, lectures, and classes relating to the culture, heritage, and language of the Oneida Indian Nation; museum and cultural center services; entertainment services

IC 043: Resort lodging services; hotel, bar, and restaurant services; banquet and social function facilities services; catering services; conference, exhibition and meeting facilities services

IC 044: Health spa services, namely, cosmetic body care services; hairdressing salons

122. Registrant abandoned Application 78/799,982 on March 25, 2008.

123. Registrant filed Application 78/800,006 on January 26, 2006 for the mark ONEIDA.

124. Application 78/800,006 was filed under Section 1(b), and included the certification that the “applicant has a bona fide intention to use or use through the applicant’s related company or licensee the mark in commerce on or in connection with the identified goods and/or services”:

IC 016: Newsletters pertaining to Oneida Indian Nation events and issues; newspapers and magazines of general circulation about Indian issues; decals; greeting cards; stationery

IC 018: Bags

IC 025: Clothing, headwear, and footwear

IC 030: Sauces, seasonings

IC 035: Promoting tourism in and to the Oneida Indian Nation and its environs

IC 036: Charitable services, namely, providing financial assistance to families and individuals; providing educational scholarships

IC 037: Construction and home maintenance services; automobile service station services

IC 039: Marina services; air transportation services

IC 042: Legal services

IC 043: Child care services; providing temporary housing accommodations

IC 044: Medical services; governmental services, namely, heating assistance services, mental health assistance services, home nursing aid services, family counseling services, nutrition counseling services, providing food, counseling services in the fields of alcohol and substance abuse, housing agency services, vital statistics services

IC 045: Police protection services

125. Registrant abandoned Application 78/800,006 on March 25, 2008.

126. Registrant filed Application 78/800,981 on January 27, 2006 for the mark ONEIDA.

127. Application 78/800,981 was filed under Section 1(b), and included the certification that the “applicant has a bona fide intention to use or use through the applicant’s related company or licensee the mark in commerce on or in connection with the identified goods and/or services”:

IC 014. G & S: Ornamental pins.

IC 024. G & S: Cloth flags.

128. Registrant filed a statement of use on May 21, 2009, asserting first use in all goods and services by January 27, 2009.

129. Application 78/800,006 matured as Registration No. 3,667,888 on August 11, 2009.

130. Registration No. 3,667,888 was cancelled on March 18, 2016 for failure to file an acceptable declaration under Section 8.

Cancellation of the ’491 Registration

131. The allegations of paragraphs 1-130 are incorporated by reference as if stated in full.

Ground 1: Registrant committed fraud in the procurement of its registration or during the prosecution of its application for registration.

132. When the December 16, 1997 Amendment After Publication and substitute statement and declaration were filed, Registrant and its declarant Mr. Halbritter were aware of rights by others to use ONEIDA as part of the ONEIDA INDIAN NATION in connection with the identified goods and services, and the statements contained therein to the contrary, including the statement that the “ONEIDA portion of the Applicant’s mark has become distinctive as a result of its substantially exclusive and continuous use in commerce,” were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining

rights to which Registrant was not entitled, and therefore were intended to deceive the USPTO when applying to register the ONEID INDIAN NATION mark.

133. Mr. Halbritter was aware that Petitioner, for well over 100 years, has used the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify itself and the source of various goods and services provided by it to its members and members of the general public, including services recited in the application for the '491 Registration.

134. Registrant would not have received the '491 Registration for the exclusive right to use all of the goods and services identified in application but for the willful material misrepresentation in the Declaration.

135. Petitioner accordingly alleges that the December 16, 1997 Declaration that resulted in the registration of the '491 Registration constituted fraud on the U.S. Patent and Trademark Office and the '491 Registration should be cancelled on that basis.

Ground 2: Registrant committed fraud in the first renewal of its registration.

136. Alternatively, when the January 18, 2006 Declaration reciting the identification of goods and recitation of services that included goods and services on which the trademark ONEIDA INDIAN NATION had not and was not being used was made, the statements contained therein were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining rights to which Registrant was not entitled, and therefore were intended to deceive the USPTO when applying to renew the ONEIDA INDIAN NATION mark.

137. Specifically, neither Registrant nor any related company was using ONEIDA INDIAN NATION on all of the goods and services set forth in the January 18, 2006 Declaration on the date that the Declaration was signed or any prior dates sufficiently close to the date of

signing or filing of the Declaration to be a reasonable basis for a claim of use of the mark, and had not used the mark in commerce for over five consecutive years before that date.

138. Registrant was not using the ONEIDA INDIAN NATION mark on at least the following goods and services at the time of the January 18, 2006 Declaration: stationary and construction and home maintenance services.

139. On January 26, 2006 Registrant admitted in application Serial Number 78/800,006 that it had only an intent to use the mark ONEIDA on stationary and on construction and maintenance services.

140. ONEIDA forms the primary source designation significance of the ONEIDA INDIAN NATION mark as demonstrated by the disclaimer of “INDIAN NATION” in the ‘491 registration.

141. On information and belief, Registrant was not using the ONEIDA INDIAN NATION mark on additional goods and services active in the ‘491 registration at the time the renewal Declaration was filed on January 18, 2006.

142. Alternatively, Registrant knowingly and willfully withheld information from the USPTO that Registrant was aware of rights by others to use the ONEIDA mark in connection with the identified goods and services, and the withholding of such information was done for the purpose of obtaining rights to which Registrant was not entitled, and therefore were intended to deceive the USPTO when applying to renew the ONEIDA INDIAN NATION mark.

143. Specifically, Mr. Halbritter, as Registrant’s representative, was aware that Petitioner, for well over 100 years, has used the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify itself and the source of various goods and services provided by it to its members and members of the general public, including services recited in the ‘491 Registration.

144. Registrant would not have received the renewal of the '491 Registration for all of the goods and services identified in the January 18, 2006 Declaration but for the willful material misrepresentations in the Declaration.

145. Petitioner accordingly alleges that the January 18, 2006 Declaration that resulted in the renewal of the '491 Registration constituted fraud on the U.S. Patent and Trademark Office and the '491 Registration should be cancelled on that basis.

Ground 3: Registrant committed fraud in the second renewal of its registration.

146. Alternatively, when the July 19, 2010 Declaration reciting the identification of goods and recitation of services that included goods and services on which the trademark ONEIDA INDIAN NATION had not and was not being used was made, the statements contained therein were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining rights to which Registrant was not entitled, and therefore were intended to deceive the USPTO when applying to renew the ONEID INDIAN NATION mark.

147. Specifically, neither Registrant nor any related company was using ONEIDA INDIAN NATION on all of the goods and services set forth in the Declaration on the date that the Declaration was signed or any prior dates sufficiently close to the date of signing or filing of the Declaration to be a reasonable basis for a claim of use of the mark.

148. Registrant was not using the ONEIDA INDIAN NATION mark on at least the following goods and services at the time of the July 19, 2010 Declaration: stationary and construction and home maintenance services.

149. On January 26, 2006 Registrant admitted in application Serial Number 78/800,006 that it had only an intent to use the mark ONEIDA on stationary and on construction and maintenance services.

150. On January 31, 2013, Registrant admitted in application Serial Number 78/800,006 that it was not yet using the ONEIDA mark on stationary and on construction services.

151. On July 31, 2013, Registrant admitted it was not using and did not have an intent to use the ONEIDA mark on maintenance service by deleting that service from application Serial Number 78/800,006.

152. On July 10, 2014, Registrant admitted it was not using and did not have an intent to use the mark ONEIDA on construction services by deleting that service from application Serial Number 78/800,006.

153. On July 31, 2015 Registrant admitted it was not using and did not have an intent to use the mark ONEIDA on stationary by deleting that good from application Serial Number 78/800,006.

154. ONEIDA forms the primary source designation significance of the ONEIDA INDIAN NATION mark as demonstrated by the disclaimer of “INDIAN NATION” in the ‘491 registration.

155. On information and belief, Registrant was not using the ONEIDA INDIAN NATION mark on additional goods and services active in the ‘491 registration at the time the renewal Declaration was filed on July 19, 2010.

156. Alternatively, Registrant knowingly and willfully withheld information from the USPTO that Registrant was aware of rights by others to use the ONEIDA mark in connection with the identified goods and services, and the withholding of such information was done for the purpose of obtaining rights to which Registrant was not entitled, and therefore were intended to deceive the USPTO when applying to renew the ONEIDA INDIAN NATION mark.

157. Specifically, Mr. Carmen, as Registrant's representative, was aware that Petitioner, for well over 100 years, has used the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify itself and the source of various goods and services provided by it to its members and members of the general public, including services recited in the '491 Registration.

158. Registrant would not have received the renewal of the '491 Registration for all of the goods and services identified in the July 19, 2010 Declaration but for the willful material misrepresentations in the Declaration.

159. Petitioner accordingly alleges that the July 19, 2010 Declaration that resulted in the renewal of the '491 Registration constituted fraud on the U.S. Patent and Trademark Office and the '491 Registration should be cancelled on that basis.

Ground 4: Abandonment, Trademark Act § 14(3), 15 U.S.C. § 1064(c).

160. Alternatively, on information and belief, Registrant has abandoned the mark because it has either never used the ONEIDA INDIAN NATION mark of the '491 Registration in commerce in connection with the goods and services currently listed in the registration, or completely ceased using the mark in connection with all of the goods and services listed in the registration for a period of at least three consecutive years with an intent not to resume such use.

161. Specifically, specimens filed with the PTO show that Registrant has either never used in commerce or completely ceased using the ONEIDA INDIAN NATION mark on at least the following goods and services: Christmas cards; stationary; cloth flags; clothing, namely T-shirts, hats, sweatshirts, sports shirts; providing personal loan services; construction services; casino services; lottery services; workshops, lectures and classes relating to the culture, heritage and language of the Oneida Indian nation; providing recreational facilities and programs; restaurant and non-alcoholic bar services; retail smoke shop services; legal services; police

protection services; family counseling services; financial assistance services; nutrition program services; youth counseling services regarding alcohol and other substance abuse.

162. Further, specimens filed with the PTO show that Registrant has either never used in commerce or completely ceased using the ONEIDA INDIAN NATION mark on any of the listed goods and services because the specimens purporting to show use do not show use of ONEIDA INDIAN NATION as a trademark, *i.e.*, to identify and distinguish its goods and services from those manufactured or sold by others and to indicate the source of the goods and services.

163. Therefore Registrant has abandoned the ONEIDA INDIAN NATION mark within the meaning of 15 U.S.C. § 1064(3) and 15 U.S.C. § 1127 such that the '491 Registration should be cancelled on that basis.

Cancellation of the '677 Registration

164. The allegations of paragraphs 1-163 are incorporated by reference as if stated in full.

Ground 1: Trademark Act § 1(b), 15 U.S.C. § 1051(b) - there was no bona fide intent to use of the ONEIDA mark in commerce prior to the filing of the intent-to-use-based application for the '677 registration.

165. On information and belief, when Registrant filed its application on January 26, 2006, it had no bona fide intent to use the mark ONEIDA in commerce in connection with the goods and services included in the application.

166. The circumstances of Registrant's applications and their prosecution show merely an intent to reserve a right in the mark rather than an intention to use the mark in the ordinary course of trade. The circumstances include the facts that: The applications for the '677 Registration and the '028 Registration were both filed in January 2006 under Section 1(b), both

identifying expansive listings of goods and services. At the same time, Registrant filed three additional Section 1(b) applications in January 2006 (78/799,982, 78/800,006, 78/800,981), all seeking registration of ONEIDA in various goods and services. Two of those applications were abandoned prior to registration, and one was abandoned after registration. The applications for the '677 Registration, the '028 Registration, and other applications show a pattern of expansive initial identification of goods and services, combined with a substantial postponement (nine years) of the filing of any statement of use, combined with a substantial narrowing of identified goods and services once a statement of use was filed, combined with the failure of the statement of use to show actual trademark use.

167. Further, amendments to the goods and services show that Registrant had no bona fide intent to use the mark ONEIDA in commerce in connection with at least the following goods or services: governmental services, namely, vital statistics services; providing financial assistance for payment of heating services and providing housing agency services in the nature of financial assistance for housing; home maintenance services; air transportation services; Child care services; governmental services, namely, providing food to needy persons; home nursing aid services; Sauces, seasonings; Construction services; Legal services Promoting tourism in and to the Oneida Indian Nation and its environs; Marina services; providing temporary housing accommodations; newspapers and magazines of general circulation about Indian issues; greeting cards, stationary; sports bags, gym bags, shopping bags, and golf bags; and governmental services, namely, family counseling in the areas of financial and budgeting skills.

168. By virtue of the false and material claims regarding a bona fide intent to use the mark ONEIDA in United States commerce in connection with the goods and services listed in the application and the resulting '677 Registration, the registration was invalidly obtained and should be cancelled on that basis.

Ground 2: Trademark Act § 1(c)-(d), 15 U.S.C. § 1051(c)-(d) - there was no bona fide use of the ONEIDA mark in commerce at the time Registrant filed its Statement of Use.

169. Alternatively, on information and belief, the ONEIDA mark of the '677 registration was not used in commerce by Registrant or any company related to Registrant on all of the goods and services set forth in Registrant's Statement of Use of July 31, 2015.

170. Specifically, on information and belief, the ONEIDA mark of the '677 registration was not used in commerce by Registrant or any company related to Registrant on at least the following goods and services set forth in Registrant's Statement of Use of July 31, 2015: Charitable services, namely, providing financial assistance to families and individuals; nutrition counseling services; Police protection services; governmental services, namely, family counseling in the nature of marriage counseling and providing emotional support.

171. By virtue of the false and material claims regarding use of the mark ONEIDA in United States commerce in connection with all of the goods and services listed in the July 31, 2015 Statement of Use and the resulting issue of the '491 Registration, the registration was invalidly obtained and should be cancelled on that basis.

Ground 3: Registrant committed fraud in the procurement of its registration or during the prosecution of its application for registration.

172. Alternatively, when the January 26, 2006 Declaration was filed, the declarant Ms. Heinze was aware of rights by others to use the ONEIDA mark in connection with the identified goods and services, and the statements contained therein to the contrary were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining rights to which Registrant was not entitled, and therefore were intended to deceive the USPTO when applying to register the ONEIDA mark.

173. Specifically, Ms. Heinze, as Registrant's representative, was aware that Petitioner, for well over 100 years, has used the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify itself and the source of various goods and services provided by it to its members and members of the general public, including services recited in the application for the '028 Registration.

174. Registrant would not have received the '677 Registration for exclusive use all of the goods and services identified in application but for the willful material misrepresentation in the Declaration.

175. Petitioner accordingly alleges that the January 26, 2006 Declaration that resulted in the issue of the '677 Registration constituted fraud on the U.S. Patent and Trademark Office and the '677 Registration should be cancelled on that basis.

Ground 4: Registrant committed fraud when filing its Statement of Use.

176. Alternatively, when the July 31, 2015 Declaration was filed, the declarant Ms. Beakman was aware of rights by others to use the ONEIDA mark in connection with the identified goods and services, and the statements contained therein to the contrary were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining rights to which Registrant was not entitled, and therefore were intended to deceive the USPTO when applying to register the ONEIDA mark.

177. Specifically, Ms. Beakman, as Registrant's representative, was aware that Petitioner, for well over 100 years, has used the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify itself and the source of various goods and services provided by it to its members and members of the general public, including services recited in the application for the '677 Registration.

178. Registrant would not have received the '677 Registration for exclusive use of all of the goods and services identified in application but for the willful material misrepresentation in the July 31, 2015 Declaration.

179. Petitioner accordingly alleges that the July 31, 2015 Declaration that resulted in the issue of the '677 Registration constituted fraud on the U.S. Patent and Trademark Office and the '677 Registration should be cancelled on that basis.

Ground 5: Abandonment, Trademark Act § 14(3), 15 U.S.C. § 1064(c).

180. Alternatively, on information and belief, Registrant has abandoned the mark because it either never used the ONEIDA mark of the '677 Registration in commerce in connection with the goods and services currently listed in the registration, or completely ceased using the mark in connection with all of the goods and services listed in the registration for a period of at least three consecutive years with an intent not to resume such use.

181. Specifically, specimens filed with the PTO show that Registrant has either never used in commerce or completely ceased using the ONEIDA mark on at least the following goods and services: Charitable services, namely, providing financial assistance to families and individuals; nutrition counseling services; Police protection services; governmental services, namely, family counseling in the nature of marriage counseling and providing emotional support.

182. On information and belief, Registrant may have abandoned additional goods and services recited in the '677 Registration.

183. Registrant therefore has abandoned the ONEIDA mark within the meaning of 15 U.S.C. § 1064(3) and 15 U.S.C. § 1127 such that the '677 Registration should be cancelled on that basis.

Ground 6: No Use as a Trademark, Trademark Act §§ 14(1) and 1, 2, and 45.

184. Alternatively, on information and belief, neither Registrant nor any related company was using or uses ONEIDA as a trademark, *i.e.*, to identify and distinguish its goods and services from those manufactured or sold by others and to indicate the source of the goods and services.

185. Specifically, specimens filed with the PTO show that Registrant has either never used in commerce or completely ceased using ONEIDA as a mark to identify and distinguish its goods and services from those manufactured or sold by others and to indicate the source of the goods and services on at least the following goods and services: Charitable services, namely, providing financial assistance to families and individuals; nutrition counseling services; Police protection services; governmental services, namely, family counseling in the nature of marriage counseling and providing emotional support.

186. Further, specimens filed with the PTO show that Registrant has either never used in commerce or completely ceased using the ONEIDA mark on any of the listed goods and services because the specimens purporting to show use do not show use of ONEIDA as a trademark, *i.e.*, to identify and distinguish its goods and services from those manufactured or sold by others and to indicate the source of the goods and services.

Ground 7: Trademark Act § 2(d), 15 U.S.C. § 1052(d): That defendant's mark so resembles a mark registered in the Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive.

187. Alternatively, to the extent that Registrant is, in fact, using ONEIDA as a trademark to identify and distinguish good and services related to one or more goods and

services identified in the registration from those manufactured or sold by others and to identify the source of the good, Registrant's use of the ONEIDA mark for such goods and services is likely to cause confusion, mistake, or deception with Petitioner's superior rights in the ONEIDA mark for such goods and services, and should be cancelled on that basis.

188. Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's '677 Registration since before January 26, 2006, the application date of the '677 Registration.

189. Petitioner's ONEIDA mark is identical to Applicant's ONEIDA mark, and use of goods and services that are the same and/or highly related is likely to cause confusion, mistake, or deception.

Cancellation of the '028 Registration

190. The allegations of paragraphs 1-189 are incorporated by reference as if stated in full.

Ground 1: Trademark Act § 1(b), 15 U.S.C. § 1051(b) - there was no bona fide intent to use of the ONEIDA mark in commerce prior to the filing of the intent-to-use-based application for the '677 registration.

191. On information and belief, when Registrant filed its application on January 26, 2006, it had no bona fide intent to use the mark ONEIDA in commerce in connection with the goods and services included in the application.

192. The circumstances of Registrant's applications and their prosecution show merely an intent to reserve a right in the mark rather than an intention to use the mark in the ordinary course of trade. The circumstances include the facts that: The applications for the '677 Registration and the '028 Registration were both filed in January 2006 under Section 1(b), both

identifying expansive listings of goods and services. At the same time, Registrant filed three additional Section 1(b) applications in January 2006 (78/799,982, 78/800,006, 78/800,981), all seeking registration of ONEIDA in various goods and services. Two of those applications were abandoned prior to registration, and one was abandoned after registration. The applications for the '677 Registration, the '028 Registration, and other applications show a pattern of expansive initial identification of goods and services, combined with a substantial postponement (nine years) of the filing of any statement of use, combined with a substantial narrowing of identified goods and services once a statement of use was filed, combined with the failure of the statement of use to show actual trademark use.

193. Further, specimens filed with the PTO demonstrate that Registrant had no bona fide intent to use the mark ONEIDA in commerce in connection with at least the following goods or services: Conducting sporting events, namely, bull riding, snowmobile races, figure skating, jousting, snow shoeing, balloon rides, golf, boxing, yoga, lacrosse, and basketball; entertainment services, namely, live musical performances, live comedy performances, and cooking demonstrations; golf instruction. By virtue of the false and material claims regarding a bona fide intent to use the mark ONEIDA in United States commerce in connection with the goods and services listed in the application and the resulting '028 Registration, the registration was invalidly obtained and should be cancelled on that basis.

Ground 2: Registrant committed fraud in the procurement of its registration or during the prosecution of its application for registration.

194. Alternatively, when the January 26, 2006 Declaration was filed, the declarant Ms. Heinze was aware of rights by others to use the ONEIDA mark in connection with the identified goods and services, and the statements contained therein to the contrary were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining

rights to which Registrant was not entitled, and therefore were intended to deceive the USPTO when applying to register the ONEIDA mark.

195. Specifically, Ms. Heinze, as Registrant's representative, was aware that Petitioner, for well over 100 years, has used the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify itself and the source of various goods and services provided by it to its members and members of the general public, including services recited in the application for the '028 Registration.

196. Registrant would not have received the '028 Registration for exclusive use of all of the goods and services identified in application but for the willful material misrepresentation in the Declaration.

197. Petitioner accordingly alleges that the January 26, 2006 Declaration that resulted in the issue of the '028 Registration constituted fraud on the U.S. Patent and Trademark Office and the '028 Registration should be cancelled on that basis.

Ground 3: Trademark Act § 1(c)-(d), 15 U.S.C. § 1051(c)-(d) - there was no bona fide use of the ONEIDA mark in commerce at the time Registrant filed its Statement of Use.

198. Alternatively, on information and belief, the ONEIDA mark of the '028 registration was not used in commerce by Registrant or any company related to Registrant on all of the goods and services set forth in Registrant's Statement of Use of August 10, 2015.

199. Specifically, on information and belief, the ONEIDA mark of the '028 registration was not used in commerce by Registrant or any company related to Registrant on at least the following goods and services set forth in Registrant's Statement of Use of August 10, 2015: Conducting sporting events, namely, boxing, yoga, lacrosse, golf; entertainment services,

namely, live musical performances, live comedy performances, and cooking demonstrations; golf instruction.

200. By virtue of the false and material claims regarding use of the mark ONEIDA in United States commerce in connection with all of the goods and services listed in the August 10, 2015 Statement of Use and the resulting issue of the '028 Registration, the registration was invalidly obtained and should be cancelled on that basis.

Ground 4: Registrant committed fraud when filing its Statement of Use.

201. Alternatively, when the August 10, 2015 Statement of Use reciting the identification of goods and recitation of services that included goods and services on which the trademark ONEIDA had not and was not being used was made, the statements contained therein were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining rights to which Registrant was not entitled, and therefore were intended to deceive the USPTO when applying to register the ONEIDA mark.

202. Further, when the August 10, 2015 Declaration was filed, the declarant Ms. Beakman was aware of rights by others to use the ONEIDA mark in connection with the identified goods and services, and the statements contained therein to the contrary were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining rights to which Registrant was not entitled, and therefore were intended to deceive the USPTO when applying to register the ONEIDA mark

203. Specifically, Ms. Beakman, as Registrant's representative, was aware that Petitioner, for well over 100 years, had used the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify itself and the source of various goods and services provided by it to its members and members of the general public, including services recited in the application for the '028 Registration.

204. Additionally, on information and belief, Ms. Beakman, as Registrant's representative, was aware that Oneida Community Golf Club of Oneida, New York, had used the ONEIDA mark in connection with one or more of the identified goods and services recited in the application for the '028 Registration.

205. Registrant would not have received the '028 Registration for exclusive use of all of the goods and services identified in application but for the willful material misrepresentation in the August 10, 2015 Declaration.

206. Petitioner accordingly alleges that the August 10, 2015 Declaration that resulted in the issue of the '028 Registration constituted fraud on the U.S. Patent and Trademark Office and the '028 Registration should be cancelled on that basis.

Ground 5: Abandonment, Trademark Act § 14(3), 15 U.S.C. §1064(c).

207. Alternatively, on information and belief, Registrant abandoned the mark because it has either never used the ONEIDA mark of the '028 Registration in commerce in connection with all of the goods and services currently listed in the registration, or completely ceased using the mark in connection with all of the goods and services listed in the registration for a period of at least three consecutive years.

208. Specifically, specimens filed with the PTO show that Registrant has either never used in commerce or completely ceased using the ONEIDA mark on at least the following goods and services: Conducting sporting events, namely, boxing, yoga, lacrosse, golf; entertainment services, namely, live musical performances, live comedy performances, and cooking demonstrations; golf instruction.

209. On information and belief, Registrant may have abandoned additional goods and services recited in the '677 Registration.

210. Registrant has therefore has abandoned the ONEIDA mark within the meaning of 15 U.S.C. § 1064(3) and 15 U.S.C. § 1127 such that the '029 Registration should be cancelled on that basis.

Ground 6: No Use as a Trademark, Trademark Act §§ 14(1) and 1, 2, and 45.

211. Alternatively, on information and belief, neither Registrant nor any related company was using or uses ONEIDA as a trademark, *i.e.*, to identify and distinguish its goods and services from those manufactured or sold by others and to indicate the source of the goods and services.

212. Specifically, specimens filed with the PTO show that Registrant has either never used in commerce or completely ceased using ONEIDA as a mark to identify and distinguish its goods and services from those manufactured or sold by others and to indicate the source of the goods and services on at least the following goods and services: Conducting sporting events, namely, boxing, yoga, lacrosse, golf; entertainment services, namely, live musical performances, live comedy performances, and cooking demonstrations; golf instruction.

213. Further, specimens filed with the PTO show that Registrant has either never used in commerce or completely ceased using the ONEIDA mark on any of the listed goods and services because the specimens purporting to show use do not show use of ONEIDA as a trademark, *i.e.*, to identify and distinguish its goods and services from those manufactured or sold by others and to indicate the source of the goods and services.

Ground 7: Trademark Act § 2(d), 15 U.S.C. § 1052(d): That defendant's mark so resembles a mark registered in the Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive.

214. Alternatively, to the extent that Registrant is, in fact, using ONEIDA as a trademark to identify and distinguish good and services related to one or more goods and services identified in the registration from those manufactured or sold by others and to identify the source of the good, Registrant's use of the ONEIDA mark for such goods and services is likely to cause confusion, mistake, or deception with Petitioner's superior rights in the ONEIDA mark for such goods and services, and should be cancelled on that basis.

215. Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's '028 Registration since before January 26, 2006, the application date of the '028 Registration.

216. Petitioner's ONEIDA mark is identical to Applicant's ONEIDA mark, and use of goods and services that are the same and/or highly related is likely to cause confusion, mistake, or deception.

WHEREFORE, Petitioner prays that this Petition For Cancellation be granted, that Registrant's Trademark Registration Nos. 2,309,491, 4,808,677, and 4,813,028 be cancelled.

The required fee is submitted herewith; however, please charge any additional fees that may be due in this cancellation proceeding or credit any overpayments to Deposit Account No. 01.2000.

Respectfully submitted,

Date: September 12, 2017

/Christopher R. Liro/
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Attorneys for Petitioner Oneida Nation

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing was served by email on this 12th day of September 2017, upon Registrant at the following email addresses of record:

linda.mcleod@kelly-ip.com

lit-docketing@kelly-ip.com

mike.chajon@kelly-ip.com

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/Christopher R. Liro/

Christopher R. Liro

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Milwaukee, WI 53202

Exhibit C

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

ONEIDA NATION,

Petitioner,

v.

ONEIDA INDIAN NATION OF NEW
YORK,

Registrant.

)
) CANCELLATION NO. 92066411
)
) Registration No. 2,309,491
) Serial No. 75/978,733
) Mark: ONEIDA INDIAN NATION
)
) Registration No. 4,808,677
) Serial No. 78/978,999
) Mark: ONEIDA
)
) Registration No. 4,813,028
) Serial No. 78/978,992
) Mark: ONEIDA
)

**PETITIONER’S MOTION FOR RECONSIDERATION OF THE BOARD’S
ORDER SUSPENDING PROCEEDINGS**

On January 23, 2018, the Board, acting through a Paralegal Specialist, issued an Order (Dkt. 13), granting Registrant’s December 21, 2017 Motion for Suspension (Dkt. 11) pending disposition of an Administrative Procedure Act case that Registrant brought against a third party, the U.S. Department of the Interior (“DOI”), *Oneida Indian Nation v. United States Department of the Interior*, 5:17-cv-00913-MAD-TWD (the “DOI Action”). The Board’s Order lacked any explanation or rationale for its decision, simply rubber stamping Registrant’s motion and stating merely that the motion “is granted as well taken.” The Order further noted, “It is the policy of the Board to suspend proceedings when the parties are involved in a civil action, which may be dispositive of or have a bearing on a Board case.” The Board’s recitation of its “policy,” however, is inapposite to the cited civil action and fails to justify suspending proceedings, given that the parties here unquestionably are ***not involved*** in a civil action (Petitioner is not a party to the DOI Action), and Registrant’s civil action against third-party DOI ***cannot be dispositive and***

has no bearing on the Board proceeding. While this was fully explained in Petitioner’s response (Dkt. 12) to the motion, the Board completely ignored and failed to consider Petitioner’s arguments, the relevant evidence, and the correct legal standards.

37 C.F.R. § 2.127(b) authorizes a party to request reconsideration of an order or decision issued on a motion. *See also* TBMP § 518. Generally, the premise underlying a motion for reconsideration is that, “based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued.” *Id.*; *see also Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005) (reconsideration denied because Board did not err in considering disputed evidence); *Steiger Tractor Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh’g*, 3 USPQ2d 1708 (TTAB 1984). While Petitioner appreciates that a motion for reconsideration should not be “devoted simply to a reargument of the points presented in a brief on the original motion” (TBMP § 518), here there is no indication that the Board ever considered those points in the first place. As explained below, based on the facts before it and the applicable law, the Board’s prior ruling is in error and requires appropriate change.

Notwithstanding the Paralegal Specialist’s “rubber stamp” approach to the motion, it is not the law of the Board that any attenuated connection that does not relate in any manner to the issues to be decided by the Board means that the civil action has “a bearing on” the Board proceeding supporting suspension. In *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, Opp. No. 91/198,708 Dkt. 9 (TTAB 2011), for example, the Board observed that “[i]f the parties to an opposition are involved in a district court action involving the same mark or the opposed application, the Board will scrutinize the pleadings in the civil action to determine if the issues before the court may have a bearing on the Board’s decision in the opposition.” *Id.*,

Dkt. 9 at 5-6. Thus, even when the civil action involves the same parties or the same mark or application—neither of which are conditions present here—the Board does not rubber stamp motions but is to “scrutinize” the pleadings to assess if the issues before the court may have a bearing on the Board’s decision in the Board proceeding. Plainly, the Paralegal Specialist did not “scrutinize” the civil action or its pleadings here.

Trademark Rule 2.117 provides: “Whenever. . . a party or parties to a pending case are engaged in a civil action. . . which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action. . .” 37 C.F.R. § 2.117(a). TBMP 510.02(a) explains that “[m]ost commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the parties in a federal district court.”

Here, there is not a federal district court action or any other action between the parties. The Defendant in the DOI Action is the U.S. federal government, and the claims arise solely under the Administrative Procedure Act. *See* DOI Action Complaint, filed with Motion for Suspension (Dkt. 11), at ¶ 3 (“The Nation [Registrant] sues the Department under the Administrative Procedure Act to overturn a series of final agency actions taken during the previous administration.”). As Registrant explained, its claims in the DOI Action “are not about what an Indian tribe chooses to call itself. [Its] claims concern official agency action taken by the Department under a federal statute.” *Id.* at ¶ 4. Indeed, the DOI Action does not involve trademark rights at all. It does not involve trademark infringement, any right to registration, or ownership of any registration.¹

¹ The thrust of Registrant’s arguments in the DOI Action is that only it, and not Petitioner, can legitimately be called “Oneida Nation.” *See, e.g.*, DOI Action Complaint ¶¶ 20, 24, 31, 63, 78.

Registrant's motion is grounded in the disingenuous assertion that "[i]t is clear that Petitioner relies on Interior's decision to recognize Petitioner as 'Oneida Nation' when raising claims against Registrant in this Board proceeding." (Dkt. 11 at 2.)² To be sure, Petitioner noted within its background allegations in the Petition that in 2015 it amended its Constitution to change its name from Oneida Tribe of Indians of Wisconsin to Oneida Nation, and that the Bureau of Indian Affairs of the DOI approved this amendment. (Dkt. 8 ¶ 12.) But none of the grounds for cancellation rely on either of these events that occurred in 2015.

The grounds directed at Registration No. 2,309,491 for ONEIDA INDIAN NATION, which registered in January 2000, relate to Registrant's *own* conduct, namely fraud and abandonment. Order Denying Motion to Dismiss, Dkt. 10, at 4. And the grounds directed at Registration Nos. 4,808,677 and 4,813,028, both for ONEIDA, and both registering in 2015, relate to Registrant's *own* conduct and *Petitioner's extensive use of ONEIDA before Registrant filed its applications for registration in January 2006*. Dkt. 10, at 4.

Petitioner's Constitutional amendment in 2015 that changed its name, the DOI's approval of that and other Constitutional amendments in 2015, and the update to the new name when the DOI next published its periodic list of federally recognized Indian tribes in 2016 are not referenced within any of the enumerated grounds of the Amended Petition (Dkt. 8 ¶¶ 131-216) and are mentioned only as a general reference in the background section. Nor did the Board rely on Petitioner's Constitutional amendment when it denied Registrant's motion to dismiss (Dkt.

² See also Dkt. 11 at 3 (asserting "Petitioner has taken the position that Interior's decision to recognize it as 'Oneida Nation' gave Petitioner rights to that name and mark, which, according to Petitioner, bear on Registrant's ability to use, register, and enforce ONEIDA and Oneida-formative marks (such as ONEIDA NATION as a mark and trade name)."), which is equally disingenuous.

10). Petitioner’s own “rights” are based on Petitioner’s historical use. The DOI did not “give” Petitioner any rights to a name, and Petitioner never alleged that.

Registrant also insinuates that standing somehow relates to the DOI Action, noting that Petitioner identified harm to it because the registrations limited its use of its name, Oneida Nation. (Dkt. 11 at 2.) Registrant ignores that Petitioner’s allegation of harm also included the fact that Registrant has engaged in “efforts directed at limiting the Petitioner’s own use of the name Oneida that it has used for hundreds of years.” (Dkt. 8 ¶¶ 12.) As such, the registrations also would limit Petitioner’s previous name, Oneida Tribe of Indians of Wisconsin, as well as general use of the name Oneida. None of the harm relates to the fact that the DOI approved a Constitutional amendment effecting the name change, or that the DOI periodically publishes a list, by name, of federally recognized Indian tribes—which is the conduct at issue in the DOI Action. As such, the Board did not rely on the 2015 name change or conduct by the DOI when it found standing. (Dkt. 10 at 3-4.) The harm to Petitioner, and Petitioner’s standing, does not rely on the 2015 name change or conduct by the DOI, and those events do not bear on the cancellation proceeding.

Registrant also asserts that Petitioner has used DOI’s decision to try to limit Registrant’s “use of its longstanding ‘Oneida Nation’ name and mark.” (Dkt. 11 at 2.) First, this assertion is false. Regardless of how Registrant interpreted the letter that Petitioner’s counsel sent in January 2017, Petitioner explained in subsequent correspondence in May 2017—before either the this action or the DOI Action were filed—that Petitioner “has never claimed that it has exclusive rights to use of the terms ONEIDA and ONEIDA NATION, nor made any effort to limit the use of those terms by Oneida Nation of New York” and that Petitioner “believes that in light of the longstanding use of the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and

Oneida Indian Nation by both entities, both should be able to use and continue to use these terms to identify themselves and the source of various good and services provided by each tribe to their members and members of the general public.” (May 16, 2017 Correspondence, attached as Exhibit A.) Indeed, the Amended Petition itself states: “Petitioner submits that in light of this history and longstanding use of these terms by both entities, both tribes should be able to use and continue to use the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify themselves.” (Dkt. 8 ¶ 8.) Regardless, Registrant’s use of ONEIDA NATION would not be relevant to or bear on the issues of Registrant’s rights to registration of registrations for ONEIDA INDIAN NATION and ONEIDA raised in the cancellation proceeding.

The only TTAB decision cited in Registrant’s motion, *New Orleans Louisiana Saints*, does not hold, as noted above, that any attenuated connection that does not relate in any manner to the issues to be decided by the Board means that the civil action has “a bearing on” the Board proceeding. *New Orleans Saints* involved a typical case where the “parties to this opposition are in reversed positions in a civil action pending in the District Court for the Eastern District of Louisiana.” *Id.*, Dkt. 9 at 6. The Board observed that the civil action complaint “alleges, among other claims, trademark infringement of applicant's WHO DAT mark [the subject of the opposition], and seeks, among other remedies, to enjoin use of the term WHO DAT by all the defendants.” *Id.* at 7. The Board accordingly concluded that “the decision by the district court to enjoin use of the WHO DAT mark by opposers would have a bearing on this proceeding, each party has moved to suspend proceedings pending the disposition of the above-reference” and so suspended the proceeding. *Id.* The Board’s observation that the civil action “does not have to be

dispositive” meant that it did not need to resolve the entire case, not that the final determination in the civil action could have no legal bearing at all.

Further, while Rule 2.117 does not mandate that both parties to the Board proceeding also be parties to a civil action, the civil action between Registrant and the DOI has no bearing on the present case. *See also* TBMP § 510.02(a). As evident from the cases cited at the TBMP § 510.02(a) n.6, a civil action involving only one of the parties might nonetheless have a bearing on the Board proceeding when the civil action involves a foreign affiliate (if it was a separate party at all) challenging the validity of a related foreign mark, *see Birlinn Ltd. v. Stewart*, Opp. 91/214145, Dkt. 15 at 5 (TTAB Dec. 31, 2014) (“A determination of the validity of the foreign registration may, under certain circumstances, have a bearing on the registrability of the mark in the United States”), or a state court action between the applicant and a third party to determine ownership of applicant’s mark, *see Argo & Co. v. Carpetsheen Mfg., Inc.*, 187 USPQ 366, 367 (TTAB 1975). Suspension is not warranted based on any relation at all. Indeed, the “Board seldom grants a motion to suspend a particular proceeding pending disposition of other opposition or cancellation proceedings brought by unrelated plaintiffs against the same application or registration,” TBMP § 510.02(a), even though such a proceeding might entirely moot such a proceeding. *New Orleans Saints*, Dkt. 9 at 3 (“a motion to suspend an opposition on the ground that another opposition against the same application may be successful, making the movant’s opposition moot, in most cases will be denied”). In any event, here it is not clear in any respect how the DOI Action could possibly moot, or even affect, this proceeding.

“Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board.” TBMP § 510.02(a); *Birlinn*, Dkt. 15 at 4. Petitioner is not a party to the DOI Action, and Petitioner’s claims in this cancellation

proceeding do not rely or depend on the agency actions challenged under the Administrative Procedure Act in the DOI Action. Based on the facts before it and the applicable law, the Board, acting through a Paralegal Specialist, abused this discretion, its prior ruling is in error, and it requires appropriate change. The Order provides no support for its conclusion, discusses no facts related to the identified civil action and the Board proceeding, and recites a purported legal standard that cannot rationally be applied to the facts at hand. Thus, the Board should vacate its January 23, 2018 Order and deny the motion for suspension.

Respectfully submitted,

Date: February 1, 2018

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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing was served by email on this 1st day of February, 2018, upon Registrant at the following email addresses of record:

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Exhibit A



Email: chris.liro@andruslaw.com

May 16, 2017

VIA EMAIL

Meghan Murphy Beakman, Esq.
General Counsel
Oneida Nation of New York
5218 Patrick Road
Verona, NY 13478
MBeakman@Oneida-Nation.org

Re: ONEIDA Trademark Registrations
Andrus Ref. 6363-00001

Dear Meghan:

Thank you for your letter of May 5, 2017 responding to my January 16, 2017 letter to Ms. Linda McLeod of Kelly IP, LLP and additional email and telephone communications between you and me.

Our client, the Oneida Nation, previously known as Oneida Tribe of Indians of Wisconsin, appreciates the willingness of Oneida Nation of New York to enter into a coexistence agreement. It cannot, however, agree with your restriction that would allow Oneida Nation to “use ‘Oneida’ in the classes for which the Oneida Indian Nation has federal registrations in connection with commercial endeavors within Wisconsin and its bordering states, but not in connection with commercial endeavors which will be advertised or marketed generally nationally.” For one, the registrations obtained by Oneida Nation of New York include a variety of governmental and non-commercial functions. The proposed additional exception, moreover, essentially defeats the purpose of any agreement. Most of the commercial and governmental operations of the Oneida Nation and its affiliates, including Thornberry Creek at Oneida golf course, Oneida Casino, the Oneida Museum, and even local government services, are advertised on the Internet and so advertised and marketed nationally. And, obviously, the event that triggered the dispute in the first place, the LPGA tournament sponsored by the Oneida Nation to be held at Thornberry Creek at Oneida golf course, is to be held in Wisconsin but directed to a national market.

Notwithstanding the various grievances covered in your correspondence, our client has never claimed that it has *exclusive* rights to use of the terms ONEIDA and ONEIDA NATION, nor made any effort to limit the use of those terms by Oneida Nation of New York. As I previously explained to Ms. McLeod, our client believes that in light of the longstanding use of the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation by *both* entities, *both* should be able to use and continue to use these terms to identify themselves and the source of various good and services provided by each tribe to their members and members of the general public. Thus, we proposed that the parties enter into a coexistence agreement covering these uses, under which our client and its affiliates and partners will have express rights to use

May 16, 2017

Page - 2 -

these terms in Wisconsin and surrounding states without fear of enforcement or litigation by Oneida Nation of New York, together with Oneida Nation of New York's agreement to refrain from use of the marks in this territory. Though the agreement would cover uses in Wisconsin and surrounding states, the goods and services would necessarily include those that could be "advertised or marketed generally nationally."

If Oneida Nation of New York wishes to focus the scope of the agreement to encompass the specific classes covered by its federal trademark registrations, our client can entertain this framework. An agreement would need to cover, however, governmental and any other non-commercial endeavors within the scope of the classes, and cannot exclude goods and services advertised or marketed generally nationally. For avoidance of doubt, our client is unwilling to enter into an agreement that would not expressly permit it to sponsor PGA or other golf events that include the term Oneida in the event name and whose promotion would recognize that the event was sponsored by the Oneida or Oneida Nation.

Our client hopes that the Oneida Nation of New York appreciates the mutual benefit of this approach, and the benefit of avoiding being at cross purposes when non-tribal entities seek to use and expend use of the term ONEIDA and related terms. To help promote discussion, our client suggests a meeting between tribal leadership to attempt to resolve the issues on a direct government-to-government basis. Please further note that time is of the essence. As I expect you are aware, the PGA tournament will occur in July 2017. To militate against any interference with this important event, our client intends to file the cancellation petition if there is no final and executed agreement in place by June 26, 2017.

We look forward to receiving your response in the near future. Of course, please do not hesitate to call if you have any questions or wish to discuss.

Yours truly,

A handwritten signature in blue ink, appearing to read "CRL", followed by a horizontal line.

Christopher R. Liro

CRL/mgm

Exhibit D



ONEIDA NATION

COMMUNICATIONS DEPARTMENT • POST OFFICE BOX 365 • ONEIDA, WI 54155
1-800-236-2214 • (920) 490-2452 • Fax # (920) 490-2453



ONEIDA NATION COMPACT SIGNING AGENDA MAY 8, 1998 1:30 PM

THANKSGIVING PRAYER

Lloyd Schuyler

INTRODUCTIONS

Bobbi Webster, Public Relations Director

OPENING REMARKS

Chairwoman Deborah Doxtator

OPENING REMARKS

Governor Tommy Thompson

SIGNING OF GAMING COMPACT

PRESENTATION TO THE MEDIA

QUESTION & ANSWER



ONEIDA NATION

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Oneida Reservation Site of 1997 National Judicial Conference

For Immediate Release:

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(Oneida, WI) -The Oneida Nation's Radisson Inn is the site for the National American Indian Court Judges Association. Preparing for future challenges facing tribal judiciaries nationwide while allowing Native American tribes and nations to maintain their distinctive tribal cultural heritage, customs and traditions is the theme of the National American Indian Court Judges Association's (NAICJA) 1997 Nation Tribal Judicial Conference which is being hosted by the Oneida Nation. Close to 200 tribal judges, tribal court staff members, and Native American law professionals will convene for the three day Conference which will provide information and training on topics including the expansion of tribal court civil jurisdiction, the increasing complexity of civil litigation occurring in tribal courts, model tribal court civil rules and peacemaker rules, technology innovations for tribal courts, and fostering user friendly court systems.

The Conference will also serve as a training program for the United States Department of Justice's Violence Against Women Grant Office. The focus of this training will be on helping tribal judges to understand the cycle of domestic violence and to develop new approaches to its prevention. NAICJA has been in existence since 1969 and the annual Nation Conference, which is the premier forum for the continuing education of tribal judicial personnel, continues NAICJA's tradition of furthering the development of tribal justice systems.

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The Oneida Nation Appeals Commission will provide a social time featuring traditional singing and dancing, as well as traditional foods, during the Conference. Conference participants will also be able to take advantage of the amenities of the Oneida's casino. In addition to NAICJA and the Oneida Nation, the Conference is being supported by the Mashantucket Pequot Tribal Court, the Stockbridge-Munsee Tribal Court, the Red Cliff Band of Chippewa Indians, the Forest County Potawatomi Tribal Court and the United States Department of Justice Violence Against Women Office. Walk-in registrations will be accepted during the Conference.

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For further information contact:

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