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Filing date: **06/27/2017**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Oneida Nation		
Entity	sovereign Indian Tribe	Citizenship	US
Address	N7210 Seminary Road PO Box 365 Oneida, WI 54155 UNITED STATES		

Attorney information	Christopher Liro Andrus Intellectual Property Law, LLP 100 E Wisconsin Ave Suite 1100 Milwaukee, WI 53202 UNITED STATES Email: chris.liro@andruslaw.com, mariem@andruslaw.com, cathy@andruslaw.com, aarono@andruslaw.com Phone: 4142717590
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Registrations Subject to Cancellation

Registration No.	2309491	Registration date	01/18/2000
Registrant	ONEIDA INDIAN NATION OF NEW YORK 2037 Dream Catcher Plaza Oneida, NY 13421 UNITED STATES		

Additional Registrant Information

Additional registrant information provided by the petitioner	Oneida Indian Nation of New York 5218 Patrick Road Verona, NY 13478 UNITED STATES Email: tmdocketing@oneida-nation.org, mbeakman@oneida-nation.org
Additional registrant information provided by the petitioner	Oneida Indian Nation of New York 2037 Dreamcatcher Plaza Oneida, NY 13421 UNITED STATES Email: mbeakman@oneida-nation.org
Additional registrant information provided by the petitioner	Oneida Indian Nation of New York 5218 Patrick Road Verona, NY 13478 UNITED STATES Email: tmdocketing@oneida-nation.org

Goods/Services Subject to Cancellation

Class 006. First Use: 1993/06/06 First Use In Commerce: 1993/06/06 All goods and services in the class are subject to cancellation, namely: [metal key fobs]
Class 014. First Use: 1992/07/00 First Use In Commerce: 1992/07/00 All goods and services in the class are subject to cancellation, namely: ornamental pins
Class 016. First Use: 1991/05/00 First Use In Commerce: 1991/05/00 All goods and services in the class are subject to cancellation, namely: [decals;] Christmas cards; [nation directory of member services,] newsletters pertaining to nation's events and issues; [folders,] stationery
Class 018. First Use: 1993/12/00 First Use In Commerce: 1993/12/00 All goods and services in the class are subject to cancellation, namely: tote bags
Class 024. First Use: 1991/06/00 First Use In Commerce: 1991/06/00 All goods and services in the class are subject to cancellation, namely: cloth flags
Class 025. First Use: 1992/08/00 First Use In Commerce: 1992/08/00 All goods and services in the class are subject to cancellation, namely: clothing, namely T-shirts, hats, sweatshirts, sports shirts
Class 035. First Use: 1974/00/00 First Use In Commerce: 1974/00/00 All goods and services in the class are subject to cancellation, namely: [government services, namely, vital statistics services]
Class 036. First Use: 1988/04/20 First Use In Commerce: 1988/04/20 All goods and services in the class are subject to cancellation, namely: 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]
Class 037. First Use: 1986/00/00 First Use In Commerce: 1986/00/00 All goods and services in the class are subject to cancellation, namely: construction [and home maintenance] services
Class 041. First Use: 1974/00/00 First Use In Commerce: 1974/00/00 All goods and services in the class are subject to cancellation, namely: 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
Class 042. First Use: 1980/00/00 First Use In Commerce: 1980/00/00 All goods and services in the class are subject to cancellation, namely: 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

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)		
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)		
Registration No.	4808677	Registration date	09/08/2015
Registrant	Oneida Indian Nation of New York 2037 Dream Catcher Plaza Oneida, NY 13421 UNITED STATES		

Additional Registrant Information

Additional registrant information provided by	Oneida Indian Nation of New York 2037 Dreamcatcher Plaza
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the petitioner	Oneida, NY 13421 UNITED STATES Email: mbeakman@oneida-nation.org
Additional registrant information provided by the petitioner	Oneida Indian Nation of New York 5218 Patrick Road Verona, NY UNITED STATES Email: tmdocketing@oneida-nation.org

Goods/Services Subject to Cancellation

Class 016. First Use: 1989/08/00 First Use In Commerce: 1989/08/00 All goods and services in the class are subject to cancellation, namely: Newsletters pertaining to Oneida IndianNation events and issues
Class 036. First Use: 1988/04/20 First Use In Commerce: 2015/07/20 All goods and services in the class are subject to cancellation, namely: Charitable services, namely, providing financial assistance to families and individuals; providing educational scholarships
Class 044. First Use: 1980/00/00 First Use In Commerce: 2015/07/20 All goods and services in the class are subject to cancellation, namely: 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
Class 045. First Use: 1980/00/00 First Use In Commerce: 2015/07/20 All goods and services in the class are subject to cancellation, namely: Police protection services; governmental services, namely, family counseling inthe nature of marriage counseling and providing emotional support

Grounds for Cancellation

Priority and likelihood of confusion		Trademark Act Sections 14(1) and 2(d)	
No use of mark in commerce before application, amendment to allege use, or statement of use was filed		Trademark Act Sections 14(1) and 1(a), (c), and (d)	
Abandonment		Trademark Act Section 14(3)	
Failure to function as a mark		Trademark Act Sections 14(1) and 1,2 and 45	
Fraud on the USPTO		Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)	
Registration No.	4813028	Registration date	09/15/2015
Registrant	Oneida Indian Nation of New York 2037 Dream Catcher Plaza Oneida, NY 13421 UNITED STATES		

Additional Registrant Information

Additional registrant information provided by the petitioner	Oneida Indian Nation of New York 2037 Dreamcatcher Plaza Oneida, NY 13421 UNITED STATES Email: mbeakman@oneida-nation.org
Additional registrant information provided by the petitioner	Oneida Indian Nation of New York 5218 Patrick Road Verona, NY 13478 UNITED STATES

Email: tmdocketing@oneida-nation.org

Goods/Services Subject to Cancellation

Class 041. First Use: 1974/00/00 First Use In Commerce: 2015/07/20

All goods and services in the class are subject to cancellation, namely: Conducting sporting events, namely, boxing, yoga, lacrosse, golf; entertainmentservices, namely, live musical performances, live comedy performances, and cooking demonstrations; golf instruction; conducting seminars, work-shops, lectures, and classes relating to the culture, heritage, and language of the Oneida IndianNa-tion; and museum and cultural center services

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
No use of mark in commerce before application, amendment to allege use, or statement of use was filed	Trademark Act Sections 14(1) and 1(a), (c), and (d)
Abandonment	Trademark Act Section 14(3)
Failure to function as a mark	Trademark Act Sections 14(1) and 1,2 and 45
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3016505	Application Date	10/23/1998
Registration Date	11/22/2005	Foreign Priority Date	NONE
Word Mark	ONEIDA		
Design Mark			
Description of Mark	The mark consists in part of an eagle and stylized sun design.		
Goods/Services	Class 035. First use: First Use: 1992/00/00 First Use In Commerce: 1992/00/00 Retail store services featuring convenience store items and gasoline Class 041. First use: First Use: 1992/00/00 First Use In Commerce: 1992/00/00 Casinos Class 042. First use: First Use: 1992/00/00 First Use In Commerce: 1992/00/00 Hotel and restaurant services; retail and commercial printing and graphics art design services		
U.S. Application/ Registra-	NONE	Application Date	NONE

tion No.			
Registration Date	NONE		
Word Mark	ONEIDA		
Goods/Services	IC016 - Newsletters pertaining to Oneida Indian Nation events and issues; IC036 - Charitable services, namely, providing financial assistance to families and individuals; providing educational scholarships; IC041 - 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; IC044 - 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; IC045 - Police protection services; governmental services, namely, family counseling in the nature of marriage counseling and providing emotional support		

Attachments	75575398#TMSN.png(bytes) 2017-06-27 FINAL Petition for ONEIDA Cancellations.pdf(543840 bytes)
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Signature	/Christopher R. Liro/
Name	Christopher R. Liro
Date	06/27/2017

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

ONEIDA NATION,)	
)	
Petitioner)	CANCELLATION NO. _____
)	
v.)	Registration No. 2,309,491
)	Serial No. 75/978,733
ONEIDA INDIAN NATION OF NEW YORK)	Mark: ONEIDA INDIAN NATION
)	
)	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

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).

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 and the source of various goods and services provided by each tribe to their members and members of the general public.

7. 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 and the source of various good and services provided by each tribe to their members and members of the general public.

8. 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

9. 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>.

10. 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).

11. 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).

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



13. 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.

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

15. Petitioner is the owner of Oneida Golf Enterprises Corporation (“OGEC”), a tribal corporation of the Oneida Nation.

16. 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.”

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

18. 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

19. 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.

20. 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.

21. 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.

22. 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).

23. 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.

24. 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.”

25. 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.”

26. 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.”

27. 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.’”

28. 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.

29. 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

30. 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.

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

32. The application for what issued as the '491 Registration was filed on July 13, 1994 as Serial Number 74/548,930. 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.

33. 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.

34. Registrant submitted an Amendment to the application on August 25, 1995, which included a substitute statement and declaration. 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.

35. 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.

36. 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

37. 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.

38. 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.

39. 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.

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

41. 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.

42. 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.

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

44. On January 18, 2006, Registrant filed a Declaration under Sections 8 and 15. 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.

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

46. On July 19, 2010, Registrant filed a Declaration under Sections 8 and 9. 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 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.

47. On information and belief, Registrant has never used the ONEIDA INDIAN NATION mark of the '491 Registration in commerce in connection with all of the goods and services currently listed in the registration.

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

Registrant's '677 Registration

49. 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.

50. Registrant's application for what issued as the '677 Registration was filed on January 26, 2006 as Serial Number 78/800,006 under Section 1(b), including 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.

51. Registrant's January 26, 2006 Application further included a Declaration by Registrant's counsel Christine Baty Heinze, certifying that to the best of her 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.

52. 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.

53. On information and belief, 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.

54. On information and belief, 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.

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

56. 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.

57. 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.

58. 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). Registrant also filed a Declaration at that time executed by Registrant's General Counsel Megan Murphy Beakman, 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.

59. On information and belief, 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.

60. On information and belief, 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.

61. 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.

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

Registrant's '028 Registration

63. 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.

64. The application for what issued as the '028 Registration was filed on January 26, 2006 as Serial Number 78/799,982 under Section 1(b), including 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.

65. Registrant's January 26, 2006 Application further included a Declaration by Registrant's counsel Christine Baty Heinze, certifying that to the best of her 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.

66. 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.

67. On information and belief, 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.

68. On information and belief, 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.

69. 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.

70. 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, 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.

71. 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.

72. 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 showing, balloon rides, and basketball (Class 41). Registrant also filed a declaration at that time executed by Registrant's General Counsel Megan Murphy Beakman, 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.

73. On information and belief, 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.

74. On information and belief, 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.

75. 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.

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

Cancellation of the '491 Registration

77. On information and belief, the ONEIDA INDIAN NATION mark of the '491 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 application dated July 13, 1994 as of the date of the application.

78. By virtue of the false and material claims regarding use of the mark ONEIDA INDIAN NATION in United States commerce in connection with all of the goods and services listed in the July 13, 1994 application and the resulting issue of the '491 Registration, the registration was invalidly obtained and should be cancelled on that basis.

79. Alternatively, on information and belief, when 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.

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

81. Alternatively, on information and belief, the ONEIDA INDIAN NATION mark of the '491 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 Declaration of January 18, 2006, and had not used for five consecutive years before the January 18, 2006 Declaration the ONEIDA INDIAN NATION mark in connection with all of the goods and services listed in the Declaration.

82. By virtue of the false and material claims regarding use of the mark ONEIDA INDIAN NATION in United States commerce in connection with all of the goods and services listed in the January 18, 2006 Declaration and the resulting renewal of the '491 Registration, the registration was invalidly renewed and should be cancelled on that basis.

83. Alternatively, on information and belief, the ONEIDA INDIAN NATION mark of the '491 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 Declaration of July 19, 2010.

84. By virtue of the false and material claims regarding use of the mark ONEIDA INDIAN NATION in United States commerce in connection with all of the goods and services listed in the July 19, 2010 Declaration and the resulting renewal of the '491 Registration, the registration was invalidly renewed and should be cancelled on that basis.

85. Alternatively, on information and belief, 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.

86. 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.

87. 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 misrepresentation in the Declaration.

88. Petitioner accordingly alleges that the January 18, 2016 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.

89. Alternatively, on information and belief, 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.

90. 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.

91. 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 misrepresentation in the Declaration.

92. 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.

93. Alternatively, on information and belief, Registrant has either never used the ONEIDA INDIAN NATION mark of the '491 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, and therefore has abandoned the 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.

94. Alternatively, on information and belief, neither Registrant nor any related company was using or uses ONEIDA INDIAN NATION as a trademark 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.

95. Petitioner accordingly alleges that the '491 Registration should be cancelled because it was obtained contrary to the provisions of 15 U.S.C. § 1051, 15 U.S.C. § 1053, and 15 U.S.C. § 1054.

Cancellation of the '677 Registration

96. 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 all of the goods and services included in the application.

97. 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 all of 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.

98. Alternatively, Registrant's July 6, 2007 request to divide improperly enlarged the identified goods and services of the application, and the resulting '677 Registration was invalidly obtained and should be cancelled on that basis.

99. 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.

100. 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.

101. Alternatively, on information and belief, when the July 31, 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.

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

103. Registrant would not have received the renewal of the '677 Registration for all of the goods and services identified in the July 31, 2015 Statement of Use but for the willful material misrepresentation in the Statement of Use.

104. Petitioner accordingly alleges that the July 31, 2015 Statement of Use 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.

105. Alternatively, on information and belief, 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.

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

107. 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.

108. Alternatively, on information and belief, 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.

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

110. 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

111. Alternatively, on information and belief, Registrant has either never used the ONEIDA mark of the '677 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, and therefore has abandoned the 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.

112. Alternatively, on information and belief, neither Registrant nor any related company was using or uses ONEIDA as a trademark 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.

113. Petitioner accordingly alleges that the '677 Registration should be cancelled because it was obtained contrary to the provisions of 15 U.S.C. § 1051, 15 U.S.C. § 1053, and 15 U.S.C. § 1054

114. 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.

Cancellation of the '028 Registration

115. 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 all of the goods and services included in the application.

116. 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 all of 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.

117. 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.

118. 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.

119. Alternatively, on information and belief, 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.

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

121. Registrant would not have received the renewal of the '028 Registration for all of the goods and services identified in the August 10, 2015 Statement of Use but for the willful material misrepresentation in the Statement of Use.

122. Petitioner accordingly alleges that the August 10, 2015 Statement of Use 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.

123. Alternatively, on information and belief, 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.

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

125. 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.

126. Alternatively, on information and belief, 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.

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

128. 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

129. Alternatively, on information and belief, Registrant 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, and therefore has abandoned the 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.

130. Alternatively, on information and belief, neither Registrant nor any related company was using or uses ONEIDA as a trademark 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.

131. Petitioner accordingly alleges that the '028 Registration should be cancelled because it was obtained contrary to the provisions of 15 U.S.C. § 1051, 15 U.S.C. § 1053, and 15 U.S.C. § 1054

132. 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.

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: June 27, 2017

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Exhibit A



ONEIDA NATION TO SPONSOR NEW LPGA TOUR EVENT IN GREEN BAY IN 2017

Tournament will be held at Thornberry Creek at Oneida, the official golf course of the Green Bay Packers

NAPLES, Fla., October 20, 2015 – The Ladies Professional Golf Association (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 Enterprise Corporation. The specific dates for the event will be announced in the coming months.

The event will feature a full field of 144 players who will compete for a \$2 million purse, tied for the largest domestic non-major purse on the LPGA Tour. The Oneida Nation has agreed to a three-year deal with the LPGA Tour starting in the summer of 2017.

"It's exciting to have the Oneida Nation and Thornberry Creek at Oneida on board with over a year and a half to prepare for what I think has the potential to be one of the top stops on Tour," said LPGA Commissioner Mike Whan. "Green Bay is already a great sports town and we hope the community, and all of the cheeseheads, will be out in full force to cheer on the best female golfers on the planet".

The Oneida LPGA Classic will mark the first time the LPGA, or PGA Tour, has hosted a sanctioned event in the greater Green Bay area. The last time the LPGA stars played in the state of Wisconsin was the 2012 U.S. Women's Open conducted by the USGA at Blackwolf Run in Kohler.

Thornberry Creek at Oneida is the official golf course of the Green Bay Packers. The Green Bay Press Gazette tagged Thornberry as the 2015 Best of the Bay. In 2014, Thornberry served as a qualifying site for the Wisconsin State Open.

"This newfound partnership between the Oneida Nation of Wisconsin and the LPGA couldn't be more exciting," said Joshua R. Doxtator, PGA General Manager at Thornberry Creek at Oneida. "The world will have an opportunity to see what the Oneida Nation has to offer; world class gaming, superior lodging, retail to tourist interests and of course the best golf course in Northeast Wisconsin. We're confident this event will be a favorite amongst the players and spectators alike and we look forward to setting a precedent for entertainment and hospitality in the professional arena."

IMG will operate this new event. In addition to operating the Oneida LPGA Classic, IMG also produces the ANA Inspiration, the RICOH Women's British Open, the Swinging Skirts LPGA Classic, the Coates Golf Championship presented by R+L Carriers and six LPGA tournaments in Asia.

"IMG Golf is the biggest promoter of golf globally and we are delighted to be adding the Oneida LPGA Classic to our North American portfolio," said Grant Slack, Senior Vice President and Head of Golf Events at IMG. "This tournament will be a celebration of the best that women's golf has to offer and we are looking forward to working with Oneida Nation and everyone at Thornberry Creek at Oneida to deliver a new champion to Titledown, USA!"

Topic:

LPGA

NEWS

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Site by Lightmaker

Exhibit B

November 25, 2015

Liz Moore
Chief Legal Officer
Ladies Professional Golf Association
100 International Golf Drive
Daytona Beach, Florida 32124-1092
liz.moore@lpga.com

VIA EMAIL AND FEDEX

RE: 2017 Oneida LPGA Classic

Dear Ms. Moore:

We represent the Oneida Nation of New York (the "Oneida Nation").

It has come to our attention that the Ladies Professional Golf Association ("LPGA") has announced a new tournament planned for 2017 called the "Oneida LPGA Classic." Attached are copies of a LPGA press release stating 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 "Press Release").

Oneida Nation of New York is the federally recognized name of our client, which is located in the federally recognized Oneida Reservation in New York State. 80 Fed. Reg. 1942, 1945 (January 14, 2015). 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.

In addition to its long history and use of the ONEIDA and ONEIDA NATION names, the Oneida Nation owns numerous federal trademark registrations for the ONEIDA trademark, including U.S. Reg. No. 4813028 for "conducting sporting events, namely, boxing, yoga, lacrosse, and golf," among others. The Oneida Nation's Turning Stone Resort has been recognized as a "Most Excellent Golf Resort" by Condé Nast Johansens. Moreover, since at least 2006, the Oneida Nation's Turning Stone Resort has hosted various PGA tournaments in connection with its ONEIDA name and mark, including the PGA Professional National Championship (2006), the B.C. Open (2006), and the Turning Stone Resort Championship on the PGA Tour (2007-2010), and the PGA Professional National Championship is returning to Turning Stone in 2016.

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. This is particularly a concern given the Oneida Nation's long use and registration of ONEIDA in connection with its premier Turning Stone Resort golf resort and tournaments.

Please understand that it is not the Oneida Nation's desire to interfere with the LPGA's business or tournaments, but rather it seeks to maintain and preserve the integrity of its ONEIDA name and mark. To that end, the Oneida Nation respectfully requests that LPGA provide written confirmation by **Monday, December 7, 2015** that it will:

- (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."

We look forward to hearing from you. Thank you in advance for your cooperation.

Sincerely,



Linda K. McLeod

LKM/av

Enclosures: Press Release