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

Proceeding	92066411
Party	Defendant Oneida Indian Nation of New York
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Submission	Motion to Dismiss - Rule 12(b)
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Signature	/Linda K. McLeod/
Date	08/14/2017
Attachments	Motion to Dismiss - Oneida Wisconsin.pdf(171563 bytes )

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

ONEIDA NATION,  Petitioner,  v.  ONEIDA INDIAN NATION OF NEW YORK,  Registrant.	Cancellation No. 92066411  Mark: ONEIDA INDIAN NATION Registration No.: 2309491 Registered: January 18, 2000  Mark: ONEIDA Serial No.: 4808677 Registered: September 8, 2015  Mark: ONEIDA Serial No.: 4813028 Registered: September 15, 2015
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**REGISTRANT’S COMBINED MOTION TO DISMISS AND MOTION TO SUSPEND**

Oneida Indian Nation of New York (“Registrant”)<sup>1</sup> moves to dismiss Oneida Nation’s (“Petitioner”) Consolidated Petition for Cancellation (the “Petition”) under Federal Rule of Civil Procedure 12(b)(6) for failure to state a claim upon which relief can be granted. Registrant also moves to suspend all proceedings pending disposition of this potentially dispositive motion.

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<sup>1</sup> As of March 2017, Registrant’s official name is “Oneida Indian Nation.” The challenged registrations also list various DBA and AKA names for Registrant. Specifically, Registration No. 2309491 lists “DBA The Oneida Indian Nation of New York, The Oneida Indian Nation, Oneida Indian Nation, The Oneida Nation, or Oneida Nation;” and Registration Nos. 4808677 and 4813028 list “AKA The Oneida Indian Nation of New York, The Oneida Indian Nation, Oneida Indian Nation, The Oneida Nation, or Oneida Nation,” all of which Registrant has operated under.

As an initial matter, it is difficult (if not impossible) to determine the exact grounds for cancellation against each of the three registrations at issue. Petitioner failed to set forth independent counts or claim headings for each registration. In some instances, the underlying pleading contains allegations that appear to relate to grounds that are not listed on the ESTTA form and vice-a-versa. Registrant has attempted to parse and decipher both the ESTTA form and attached pleading, which contain vague and unconventional terminology, in an attempt to piece together all of the grounds. Despite Registrant's good-faith efforts, however, the pleadings are nonetheless so vague and legally deficient that Registrant cannot determine all the grounds at issue, nor can it reasonably prepare an answer and defense to such claims.

Even if the Board can determine what grounds are asserted, Petitioner has failed to state valid claims for relief, including alleged claims of fraud, abandonment, and likelihood of confusion. Indeed, Petitioner has failed to plead intent to deceive and other particular facts required for fraud under Federal Rule of Civil Procedure 9(b) and *Bose*. Similarly, Petitioner has failed to state abandonment and likelihood of confusion beyond threadbare allegations. Indeed, Petitioner failed to allege priority for likelihood of confusion, including what marks, goods and services, and dates of prior use support Petitioner's alleged priority. To the extent Petitioner raises other claims of non-use and lack of *bona fide* intent, which is unclear, these pleadings are likewise legally deficient. For these reasons, and those stated below, the Petition should be dismissed under Federal Rule of Civil Procedure 12(b)(6).

## I. PETITION FOR CANCELLATION

On June 27, 2017, Petitioner filed a Petition for Cancellation (Dkt. 1) against three registrations owned by Registrant:

- Registration No. 2309491 for ONEIDA INDIAN NATION for various goods and services in Classes 14, 16, 18, 24, 25, 36, 37, 41, and 42.
- Registration No. 4808677 for ONEIDA for various goods and services in Classes 16, 36, 44, and 45.
- Registration No. 4813028 for ONEIDA for various services in Class 41.

The grounds for cancellation are far from clear. The Petition fails to set forth independent counts or claim headings for each registration. In some instances, the underlying pleading contains allegations that appear to relate to grounds that are not listed on the ESTTA form and vice-a-versa. For Registration No. 2309491, for example, Petitioner lists claims of abandonment and fraud on the ESTTA form. In the attached pleading, however, Petitioner seems to include other vague allegations of non-use (see Petition ¶ 77) and failure to function as a mark (*id.* ¶ 94), with no underlying factual allegations.

For Registration Nos. 4808677 and 4813028, Petitioner lists the following claims on the ESTTA form: (1) priority and likelihood of confusion; (2) no use of mark in commerce before statement of use was filed; (3) abandonment; (4) failure to function as a mark; and (5) fraud. Here again, in the attached pleading, Petitioner seems to allege additional grounds of a lack of *bona fide* intent to use, along with other naked

allegations. (See Petition ¶¶ 96, 97, 115, 116.)<sup>2</sup> Several of Petitioner's claims, as detailed below, are legally deficient and should be dismissed.

On July 6, 2017, the Board instituted the cancellation proceeding and allowed Registrant forty days up to and including August 15, 2017 to file an Answer or otherwise plead. (Dkt. 2.) In lieu of an Answer, Registrant files this motion to dismiss.

## **II. MOTION TO DISMISS**

A motion to dismiss for failure to state a claim upon which relief can be granted tests the legal sufficiency of a complaint. Fed. R. Civ. P. 12(b)(6). To withstand such a motion, a pleading must allege such facts as would, if proven, establish that plaintiff is entitled to the relief sought, *i.e.*, that Petitioner has standing to maintain the proceeding, and that a valid ground exists for cancelling the subject registrations. *Young v. AGB Corp.*, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); TBMP § 503.02 (2015). For fraud claims, moreover, Trademark Rule 2.116(a) incorporates the heightened pleading standard set forth in Federal Rule of Civil Procedure 9(b).

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<sup>2</sup> To the extent these additional allegations are pleaded as the basis for, or an element of, another count, they do not constitute separate grounds for cancellation. See *O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1329 (TTAB 2010) ("We will not parse an asserted ground to see if any of the elements that go to pleading that ground would independently state a separate ground.").

### **A. Petitioner Failed to State a Claim of Fraud**

Petitioner failed to state a claim of fraud regarding any of Registrant's three registrations at issue. In particular, Petitioner failed to set forth any specific allegation that Registrant intended to deceive the U.S. Patent and Trademark Office ("PTO") (which it did not) when applying to register the ONEIDA INDIAN NATION and ONEIDA marks, a required element of any fraud claim. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939–41 (Fed. Cir. 2009); *Wolverine Outdoors, Inc. v. Marker Vokl (Int'l) GmbH*, Opposition Nos. 91161363, 91177732, 91177736, 2010 WL 9597362, at \*2 (TTAB June 21, 2010) ("[I]ntent to deceive the USPTO to obtain or maintain a registration is a required element in pleading a fraud claim. . . .") (Attached as Exhibit 1.)

"[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." *In re Bose Corp.*, 91 USPQ2d at 1941. "[T]he preferred practice for a party alleging fraud in a Board . . . cancellation proceeding is to specifically allege the adverse party's intent to deceive the USPTO, so that there is no question that this indispensable element has been pled." *DaimlerChrysler Corp. v. Am. Motors Corp.*, 94 USPQ2d 1086, 1089 (TTAB 2010). While intent may be averred generally under Federal Rule of Civil Procedure 9(b), "the pleadings must nonetheless allege sufficient underlying facts from which a court may reasonably infer that a party acted with the requisite state of mind." *Asian & W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009).

Here, Petitioner's fraud claims are premised only on vague allegations. For example, for Registration No. 2309491, Petitioner alleges that:

- Registrant filed a Section 8 and 15 declaration “reciting [an] 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,” and that “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.” (Petition ¶ 85.)
- “[N]either Registrant nor any related company was using ONEIDA INDIAN NATION on all the goods and services set forth in the” Section 8 and 15 declaration “at the time 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.” (Petition ¶ 86; *see also id.* ¶ 45.)
- “Registrant would not have received the renewal of” Registration No. 2309491 “for all the goods and services identified in the” Section 8 and 15 declaration “but for the willful material misrepresentation in the Declaration.” (Petition ¶ 87.)
- The Section 8 and 15 declaration “constituted fraud on the U.S. Patent and Trademark. . . .” (Petition ¶ 88.)<sup>3</sup>

Petitioner thus failed to allege a specific intent by Registrant to deceive the PTO as required under Federal Rule of Civil Procedure 9(b) and *Bose*.

Moreover, Petitioner alleges only generally, for example, that Registrant was not using the registered mark on *all* the goods and services identified in the Section 8 and 15 declaration. But Petitioner alleges no facts to establish which specific goods or services are or were allegedly not in use. Therefore, Petitioner fails to “allege sufficient

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<sup>3</sup> Petitioner makes identical vague allegations regarding a subsequent Section 8 and 9 declarations filed for Registration No. 2309491 (Petition ¶¶ 46–47, 89–92), and declarations filed for Registration No. 4808677 (*id.* ¶¶ 58–61, 101–10) and Registration No. 4813028 (*id.* ¶¶ 72–75, 119–28).

underlying facts from which [the Board] may reasonably infer that [Registrant] acted with the requisite state of mind.” *Asian & W. Classics B.V.*, 92 USPQ2d at 1479.

Petitioner’s allegations that Registrant filed declarations “for the purpose of obtaining” registration rights to which it supposedly was not entitled also fall short. Merely filing declarations to obtain a registration does not establish an intent to deceive, nor does it lead to that inference. *See In re Bose Corp.*, 91 USPQ2d at 1941 (the allegations must be alleged with particularity, rather than by implied expression, and must allege that the applicant knowingly made a false, material representation in the subject application with the intent to deceive the Office); *King Auto., Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981) (“[T]he pleadings [must] contain explicit rather than implied expression of the circumstances constituting fraud.”). Without any specific intent to deceive, alleged misrepresentations in a declaration do not constitute fraud. *See King Auto., Inc.*, 212 USPQ at 803 n.4 (holding that absent the requisite intent to mislead the U.S. Patent and Trademark Office, even a material misrepresentation does not qualify as fraud that would warrant cancellation of the registration).

Petitioner’s conclusory allegations that Registrant was “aware of rights by others” when filing its ONEIDA and ONEIDA INDIAN NATION applications and statements of use are likewise legally deficient. (See, e.g., Petition ¶ 53 (“On information and belief, when [Registrant’s declarant] 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.”); *id.* at ¶¶ 54, 59, 60, 105, 108.)<sup>4</sup> To plead fraud, mere knowledge of another party’s use of a mark is not equivalent to knowledge of another party’s superior rights to that mark. *See Metro Traffic Control v. Shadow Network Inc.*, 104 F.3d 336, 41 USPQ2d 1369, 1373 (Fed. Cir. 1997); *accord Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1909 (TTAB 2006); *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1207 (TTAB 1997). A fraud claim based on an alleged false oath regarding the rights of others to use the mark is only viable when the other party’s rights were “clearly established, [such as] by court decree or a prior agreement of the parties.” *Intellimedia Sports Inc.*, 43 USPQ2d at 1207. Petitioner has failed to allege such facts, nor can it do so in this case.

Although Petitioner broadly alleges that Registrant was aware of Petitioner’s use of the ONEIDA mark, Petitioner has not alleged particular facts showing that Registrant knew Petitioner had “clearly established” and superior rights in ONEIDA as a trademark, whether by agreement, consent decree, court order, or otherwise. Petitioner has failed to adequately plead any fraud claim premised on supposedly fraudulent declarations about the trademark rights of others.

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<sup>4</sup> Petitioner makes identical vague allegations regarding declarations filed for Registration No. 2309491 (Petition ¶ 79), and declarations filed for Registration No. 4813028 (*id.* ¶¶ 67, 68, 73, 74).

Accordingly, Petitioner's fraud claims should be dismissed for failure to state the elements for such claims, including intent to deceive, required under *Bose* and the cited authorities above.

**B. Petitioner Failed to Plead Fraud with Particularity**

Petitioner also failed to plead fraud with particularity under Federal Rule of Civil Procedure 9(b). As shown above, Petitioner's fraud allegations are too vague to meet the heightened pleading standard under Rule 9(b). Although Petitioner alludes to certain goods and services for which it believes Registrant has not used the registered marks, (*see, e.g.*, Petition ¶¶ 45, 86), Petitioner never states the specific goods or services at issue. It is well-settled that a proper pleading of fraud requires specific and detailed factual allegations concerning the elements of fraud. *See Asian and W. Classics B.V.*, 92 USPQ2d at 1479 (“[A] petitioner must allege the elements of fraud with particularity in accordance with Fed. R. Civ. P. 9(b), made applicable to Board proceedings by Trademark Rule 2.116(a).”).

Further, all of Petitioner's fraud allegations—*e.g.*, those concerning Registrant's alleged fraud in connection with its applications, declarations, and statements of use filings—are pleaded only on “information and belief.” (*See, e.g.*, ¶¶ 52, 53, 54, 59, 60, 66, 67, 68, 73, 74, 79, 85, 89, 101, 105, 108, 119, 123, 126.) “Pleadings of fraud ‘based on information and belief’ without allegations of specific facts upon which the belief is reasonably based are insufficient.” *NSM Res. Corp. v. Huck Doll, LLC*, 113 USPQ2d 1029, 1034 (TTAB 2014) (citing *Asian and W. Classics B.V.*, 92 USPQ2d at 1479). Allegations like Petitioner's based solely on information and belief raise only the mere possibility that supporting evidence may be uncovered and do not constitute pleading of fraud with particularity. *See Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 91

USPQ2d 1656, 1670 n.7 (Fed. Cir. 2009) (citing *Kowal v. MCI Commc'ns Corp.*, 16 F.3d 1271, 1279 n.3 (D.C. Cir. 1994) (“[P]leadings on information and belief [under Rule 9(b)] require an allegation that the necessary information lies within the defendant’s control, and . . . such allegations must also be accompanied by a statement of the facts upon which the allegations are based.”) (citation omitted)).

Accordingly, Petitioner’s fraud claims should be dismissed for failure to state such claims with particularity under Federal Rule of Civil Procedure 9(b).

### **C. Petitioner Failed to Allege Detailed Facts for Abandonment**

Petitioner failed to plead sufficient factual details to give Registrant and the Board fair notice of Petitioner’s abandonment claims. The Petition includes vague allegations concerning the three challenged registrations:

- “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.” (Petition ¶ 93.)
- “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.” (Petition ¶ 111.)
- “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.” (Petition ¶ 129.)

But the Supreme Court has made clear that, “to survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). “A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Iqbal*, 556 U.S. at 678 (citing *Twombly*, 550 U.S. at 556). “Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice.” *Iqbal*, 556 U.S. at 678 (citing *Twombly*, 550 U.S. at 555). Instead, “[f]actual allegations must be enough to raise a right to relief above the speculative level . . . .” *Twombly*, 550 U.S. at 545. See also TBMP § 309.03(a)(2).

Petitioner has failed to meet the Supreme Court’s pleading requirements. As explained above, the Petition contains no factual allegations regarding the specific goods or services for which Registrant allegedly has failed to use its registered marks; the specific time periods during which Registrant allegedly did not use such marks; or any circumstances supporting Petitioner’s vague allegations of “abandonment.” Petitioner only speculates that Registrant has not used its registered marks on “all” the identified goods and services. Such naked allegations are exactly the type that, according to the Supreme Court, fail to support valid claims and fail to provide defendants fair notice of the claims at issue. Without detailed factual support, neither the Board nor Registrant can determine whether Petitioner’s abandonment claims are plausible, and Registrant is unable to answer and prepare its defenses.

Accordingly, Petitioner's abandonment claims should be dismissed for failure to state a claim under Federal Rule of Civil Procedure 12(b)(6).

**D. Petitioner Failed to Allege Detailed Facts for Other Allegations of Non-Use and Lack of *Bona Fide* Intent to Use**

For the same reasons that Petitioner's abandonment claims are deficient, its vague allegations of non-use and lack of *bona fide* intent (to the extent they are actually raised) should be dismissed. The Petition contains broad allegations of non-use for all three challenged registrations, and statements of lack of *bona fide* intent to use for at least Registration Nos. 4808677 and 4813028.<sup>5</sup> But these vague allegations are not stated separately as a count in the Petition, so it is unclear whether such allegations form the basis for a separate claim or whether they relate to other alleged claims. For example, regarding non-use, the Petition includes vague allegations such as:

- "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." (Petition ¶ 47; *see also id.* ¶¶ 45, 77, 81, 83, 86, 90, 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." (Petition ¶ 61; *see also id.* ¶¶ 99, 102, 111.)
- "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." (Petition ¶ 75; *see also id.* ¶¶ 117, 120, 129.)

Regarding lack of *bona fide* intent, the Petition contains similar vague allegations:

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<sup>5</sup> As explained above in Section I, it is not clear that Petitioner raises these grounds separately from its fraud and abandonment grounds.

- “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.” (Petition ¶ 52; *see also id.* ¶¶ 96, 97.)
- “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.” (Petition ¶ 66; *see also id.* ¶¶ 115, 116.)

Because Petitioner only vaguely speculates that Registrant has not used its registered marks on all the identified goods and services, or surmises that Registrant had no *bona fide* intent to do so at the time it filed the applications for Registration Nos. 4808677 and 4813028, Petitioner has failed to meet the requisite pleading standard. *See Ashcroft v. Iqbal*, 556 U.S. at 678; TBMP § 309.03(a)(2). Neither the Board nor Registrant can parse through Petitioner’s vague allegations to determine if these non-use and lack of *bona fide* intent allegations are plausible, separate claims. Accordingly, the allegations should be dismissed under Federal Rule of Civil Procedure 12(b)(6).

#### **E. Petitioner Failed to State Priority and Likelihood of Confusion**

Petitioner asserts likelihood of confusion against Registration No. 4808677 and Registration No. 4813028. To plead a valid claim for likelihood of confusion, Petitioner must allege it has priority for the challenged goods and services, and that Registrant’s mark so resembles Petitioner’s mark as to be likely to cause confusion. *See Lanham Act* Section 2(d), 15 U.S.C. § 1052(d); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 n.2 (CCPA 1981). Petitioner has failed to adequately plead priority in this case.

The Petition includes a vague allegation that “Petitioner owns common law trademark rights in the character mark ONEIDA.” (Petition ¶ 14.) And on the ESTTA cover sheet, Petitioner lists unregistered rights in ONEIDA for the exact goods and

services designated in Registrant's Registration Nos. 4808677 and 4813028 in Classes 16, 36, 41, 44, and 45. Finally, the Petition includes the following allegations for Registration Nos. 4808677 and 4813028:

- "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." (Petition ¶ 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." (Petition ¶ 132.)

Petitioner has failed to allege priority as to specific marks, dates of first use, and particular goods or services forming the bases for its priority and likelihood of confusion claims. Nor does Petitioner allege common law rights for specific marks and goods and services that predate Registrant's prior registration rights. The Board has granted motions to dismiss likelihood of confusion claims where, as here, priority was not adequately pleaded. *See, e.g., Adv. Mktg. Plus, Corp v. North*, Opposition No. 91157976, 2005 WL 2747606, at \*1 (TTAB Oct. 19, 2005) (Attached as Exhibit 2.).

Accordingly, Petitioner's likelihood of confusion claims should be dismissed under Federal Rule of Civil Procedure 12(b)(6).

### **III. MOTION TO SUSPEND**

Trademark Rule 2.117 provides that proceedings may be suspended pending disposition of a potentially dispositive motion or upon a showing of good cause.

Registrant's motion to dismiss is potentially dispositive of several of Petitioner's claims. Accordingly, Registrant respectfully requests that all proceedings not germane to the motion to dismiss be suspended pending disposition of the motion.

### **IV. CONCLUSION**

For the foregoing reasons and authorities, Registrant respectfully requests that its Combined Motion to Dismiss Petition for Cancellation and Motion to Suspend be granted.

Respectfully submitted,

ONEIDA INDIAN NATION OF NEW YORK

Dated: August 14, 2017

By: /Linda K. McLeod/

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**CERTIFICATE OF SERVICE**

I certify that a true and accurate copy of the foregoing REGISTRANT'S  
COMBINED MOTION TO DISMISS AND MOTION TO SUSPEND was served by email  
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## EXHIBIT 1

2010 WL 9597362 (Trademark Tr. & App. Bd.)

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

WOLVERINE OUTDOORS, INC.

v.

MARKER VOLKL (INTERNATIONAL) GMBH

MARKER VOLKL (INTERNATIONAL) GMBH

v.

WOLVERINE OUTDOORS, INC.

Opposition No. 91161363

Opposition No. 91177732

Opposition No. 91177736

June 21, 2010

\*1 Before Bucher, Taylor and Wellington  
Administrative Trademark Judges

**(parent case)**

By the Board:

On March 17, 2010, the Board granted Marker Volkl (International) GmbH's ("Marker") uncontested motion to amend its counterclaims to cancel Wolverine Outdoors, Inc.'s ("Wolverine") Registration Nos. 2772456 and 2860830 on the ground of fraud, filed in Opposition No. 91161363.

In lieu of filing an answer to the counterclaims, as amended, Wolverine moved to dismiss them under Fed. R. Civ. P. 12(b) (6). By way of its motion to dismiss, Wolverine asserts that Marker's counterclaims fail to plead fraud with particularity, as required by Fed. R. Civ. P. 9(b), because Paragraphs 10 through 12 allege, based solely "upon information and belief," that Wolverine made false statements in its statements of use, and because the two articles referenced in Paragraphs 13 and 14 cannot form a reasonable belief that Wolverine intentionally committed fraud by submitting knowingly false statements in its statements of use. Wolverine also asserts that the counterclaims fail to allege facts to support an inference of deceptive intent, and fail to satisfy the requirement to plead intent to deceive the USPTO, as this requirement is set forth in *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).

In response, Marker points to its allegations, in Paragraph 13 of its counterclaims, that Wolverine has not produced a single document that shows use of the mark on the goods, and asserts that its allegations are supported by the articles identified in Paragraphs 14 and 15, and thus are not based solely on information and belief. It asserts that intent may be alleged generally under Fed. R. Civ. P. 9(b), and that it has alleged "enough facts from which the TTAB may reasonably infer the requisite state of mind by alleging that Wolverine lacks evidence to support its claim of use and identifying the two articles that are directly contrary to Wolverine's claim of use."

Analysis

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of the complaint. To withstand a motion to dismiss for failure to state a claim in a Board proceeding, Marker need only allege such facts as would, if proved, establish that (1) it has standing, and (2) a valid ground exists for opposing applicant's application for registration. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations which, if proved, would entitle Marker to the relief sought. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); and TBMP 503.02 (2d ed. rev. 2004).

**\*2** For purposes of determining the motion, all of Marker's well-pleaded allegations must be accepted as true, and the pleading must be construed in the light most favorable to Marker. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); *Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976).

Fed. R. Civ. P. 9(b) requires that pleadings of fraud contain an explicit rather than implied expression of the circumstances constituting fraud. See *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 802 (CCPA 1981). The factual basis for an allegation of fraudulent misrepresentation to the PTO must be stated with sufficient specificity. *Id.* Here, upon review of all of the allegations in the counterclaims, Marker's assertions, as presently set forth in Paragraphs 11 and 12, could reasonably be construed as allegations that Wolverine had not used the mark, on or prior to the date of first use claimed in the respective statements of use, on only one good or certain particular identified goods, or could be construed as allegations that Wolverine had not so used the mark on *any* of the identified goods. If the former, pleading with factual specificity requires that the allegations state the good or goods to which Marker's assertions of non-use pertain; if the latter, the pleading must clearly state an allegation of non-use as to all of the goods. Due to their current ambiguity, Marker's amended counterclaims do not set forth with sufficient specificity the alleged factual misrepresentation(s) underlying the fraud claim. As such, the allegations also fail to place Wolverine on adequate notice of the factual basis for the claim. See Fed. R. Civ. P. 8(a); Trademark Rule 2.112(a).<sup>1</sup>

Turning to the element of intent, while intent to deceive the USPTO to obtain or maintain a registration is a required element in pleading a fraud claim, intent, as a condition of mind of a person, may be averred generally under Fed. R. Civ. P. 9(b). See *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086, 1088 (TTAB 2010). Where a pleading asserts that a known misrepresentation on a material matter is made to procure a registration, the element of intent has been sufficiently pled. *Id.*, at 1089. Marker's allegation that "Registrant's fraudulent representations were made with the intent to induce the U.S. Patent and Trademark Office to register the marks..." is not unlike the pleading in *DaimlerChrysler Corp.*, where the Board found that intent had been sufficiently pled in the allegation that "[R]espondent knowingly made material misrepresentations to the PTO to procure (R)egistration ..." See *Id.*, at 1088-1089. Moreover, Marker indicates that its allegations are based, in part, on matters uncovered during discovery. Thus, we find that Marker's amended counterclaims sufficiently plead the element of intent to deceive the USPTO in the procurement of the two involved registrations.

**\*3** Inasmuch as we have found that the Marker's counterclaims do not specify the goods on which Marker alleges that Wolverine had not used its mark in the filing of its statements of use, and therefore do not set forth with sufficient specificity the alleged misrepresentation(s) underlying its fraud claim, the counterclaims are not sufficiently pled. In view thereof, Wolverine's motion to dismiss Marker's counterclaims is hereby granted.

When granting a motion to dismiss under Fed. R. Civ. P. 12(b)(6), the Board may allow a party in the position of plaintiff an opportunity to replead its complaint in order to address the deficiency or deficiencies therein. In this case, Marker is allowed until thirty (30) days from the mailing date of this order in which to file, if it so elects, second amended counterclaim(s), as appropriate and as warranted, failing which the amended counterclaims filed on September 25, 2009 will be given no further consideration in this consolidated proceeding. In the event that Marker files second amended counterclaim(s), Wolverine is allowed thirty (30) days from the date of service thereof in which to file its answer thereto.

Schedule

Proceedings are resumed. Discovery and trial dates are reset as follows:

DISCOVERY TO CLOSE:	09/03/2010
Testimony period for plaintiff in 91161363 to close:	12/02/2010
Testimony period for defendant in 91161363 and as plaintiff in 91177732 and 91177736, and as counterclaim plaintiff to close:	01/31/2011
Testimony period for defendant in 91177732 and 91177736, and as counterclaim defendant, and its rebuttal testimony as plaintiff in 91161363 to close:	04/01/2011
Rebuttal testimony period for plaintiff in 91177732 and 91177736, and counterclaim plaintiff to close:	05/16/2011

**Briefs shall be due as follows: [Trademark Rule 2.128(a)(2)].**

Brief for plaintiff in 91161363 shall be due:	07/15/2011
Brief for defendant in 91161363 and as plaintiff in 91177732 and 91177736, and counterclaim plaintiff, shall be due:	08/14/2011
Brief for defendant in 91177732 and 91177736 and its reply brief (if any) as plaintiff in 91161363, and counterclaim defendant, shall be due:	09/13/2011
Reply brief (if any) for plaintiff in 91177732 and 91177736, and counterclaim plaintiff, shall be due:	09/28/2011

**\*4** In each instance, a copy of the transcript of 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.

## Footnotes

- 1 While pleadings of fraud made solely “on information and belief,” with no separate indication that the pleader has actual knowledge of the facts supporting its fraud claim, are generally found to be deficient, here, the fact that several of the allegations included in Marker’s counterclaims are stated to be made “on information and belief,” does not, alone, render said allegations insufficiently pled. Moreover, as stated herein, the allegations are based, in part, on matters learned during discovery.

2010 WL 9597362 (Trademark Tr. & App. Bd.)

## EXHIBIT 2

2005 WL 2747606 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

ADVANCED MARKETING PLUS, CORP.

v.

ELLIE ANN NORTH, FRANCISCO GIL, VIVIAN GIL ROVELLI, AND VICTORIA WEINGARTNER

Opposition No. 91157976

October 19, 2005

\*1 Before Quinn, Chapman and Zervas  
Administrative Trademark Judges

**By the Board:**

This case comes up on the parties' motions for summary judgment, and applicants' motion for leave to amend their application. The parties have fully briefed the issues, and we have considered all reply briefs. See Trademark Rule 2.127(a).

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with respect to each motion.

Turning first to the summary judgment issues, a party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to each motion in favor of the nonmoving party, we find that neither party has demonstrated the absence of a genuine issue of material fact for trial. We find that there are genuine issues of fact, at a minimum, with respect to: (i) applicants' asserted intent to defraud the PTO, and the related issue of whether applicants withheld material information from the PTO during prosecution of their involved application; (ii) whether applicants abandoned the involved mark; and (iii) whether applicants had a bona fide intention to use the mark on certain of the goods identified in their involved application. See *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991) (factual question of intent not amenable to disposition on summary judgment).

In view thereof, opposer's motion for summary judgment on its fraud claim (Count 4) is denied, and applicants' motion for summary judgment with respect to the issues of applicants' use (Count 2), abandonment (Count 3) and fraud (Count 4) is likewise denied.<sup>1</sup>

With regard to applicants' summary judgment motion on the issue of likelihood of confusion (Count 1), applicants essentially contend that opposer's pleading is legally insufficient because there is no allegation of opposer's priority. Applicants' summary judgment motion must be construed as to the likelihood of confusion issues as a motion to dismiss

under Fed. R. Civ. P. 12(b)(b). Having carefully reviewed the pleading, it is clear that opposer did not plead priority. Thus, applicant's motion to dismiss as to the likelihood of confusion claim is granted.

**\*2** Notwithstanding the foregoing, opposer is allowed until THIRTY DAYS from the mailing date of this order to file an amended pleading clearly setting forth any and all claims, including, if applicable, a legally sufficient claim under Section 2(d) of the Trademark Act, failing which the proceeding will go forward on Counts 1-3 only.

If opposer files an amended pleading within the allotted thirty days, applicants are then allowed until SIXTY DAYS from the mailing date of this order to file an answer to the amended notice of opposition.

We now turn to applicants' contested motion to amend their application, relating to the filing basis of the application. The Board ordinarily defers consideration of a contested motion to amend an application in substance, such as the instant motion, until final hearing. See *Fort Howard Paper Co. v. C.V. Gamina Inc.*, 4 USPQ2d 1552 (TTAB 1987); and *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985). See also, TBMP § 514.03 (2d ed. rev. 2004). In view thereof, consideration of applicants' proposed amendment to their application is deferred until final hearing.<sup>2</sup>

Proceedings are resumed. Discovery remains closed. Trial dates are reset as follows:

**DISCOVERY PERIOD TO CLOSE:**

**CLOSED**

Thirty-day testimony period for party in position of plaintiff to close: **February 28, 2006**

Thirty-day testimony period for party in position of defendant to close: **April 29, 2006**

Fifteen-day rebuttal testimony period for party in position of plaintiff close: **June 13, 2006**

In each instance, a copy of the transcript of 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 Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**Footnotes**

- 1 The parties should note that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for purposes of the motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. *See, for example, Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).
- 2 If applicants ultimately prevail in this opposition proceeding, the Board may remand the involved application to the examining attorney for further examination. See Trademark Rule 2.131.

2005 WL 2747606 (Trademark Tr. & App. Bd.)