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Mailed: December 18, 2017

Cancellation No. 92066411

Oneida Nation

v.

Oneida Indian Nation of New York

By the Trademark Trial and Appeal Board:

This case comes before the Board on the following:¹

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

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

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

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

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

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

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

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

Standing

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

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

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

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

Fraud

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

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

Lack of Bona Fide Intent to Use

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

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

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

No Bona Fide Use in Commerce

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

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

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

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

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

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

Abandonment

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

Likelihood of Confusion

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

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

Failure to Use as a Trademark

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

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

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

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

Proceedings herein are resumed. Dates are reset as follows:

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

BRIEFS SHALL BE DUE AS FOLLOWS:

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

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