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

Proceeding	92066411
Party	Plaintiff Oneida Nation
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Date	01/08/2018
Attachments	2018-01-08 Response Motion to Suspend with Exhibit A.pdf(444526 bytes)

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

Petitioner filed its original Petition for Cancellation on June 27, 2017, and the Board initiated the cancellation proceeding on July 6, 2017. Rather than answer, on August 17, 2017 Registrant filed a Combined Motion to Dismiss and Motion to Suspend (Dkt. 4) this proceeding. Petitioner filed a First Amended Petition for Cancellation (Dkt. 8) on September 12, 2017. The Board denied Registrant's Motion to Dismiss and accepted Petitioner's First Amended Petition for Cancellation (Dkt. 10) on December 18, 2017. Registrant now files a Motion for Suspension (Dkt. 11) pending disposition of an Administrative Procedure Act case that Registrant brought against a third party, the U.S. Department of the Interior ("DOI"), *Oneida Indian Nation v. United States Department of the Interior*, 5:17-cv-00913-MAD-TWD (the "DOI Action"), currently pending in the U.S. District Court for the Northern District of New York. Petitioner is not a party to the DOI Action, and the DOI action has no bearing on the cancellation proceeding. For the reasons that follow, the Board should deny the motion for suspension.

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

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

Registrant’s motion is grounded in the disingenuous assertion that “[i]t is clear that Petitioner relies on Interior’s decision to recognize Petitioner as ‘Oneida Nation’ when raising claims against Registrant in this Board proceeding.” (Dkt. 11 at 2.)² To be sure, Petitioner noted within its background allegations in the Petition that in 2015 it amended its Constitution to

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

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

change its name from Oneida Tribe of Indians of Wisconsin to Oneida Nation, and that the Bureau of Indian Affairs of the DOI approved this amendment. (Dkt. 8 ¶ 12.) But none of the grounds for cancellation rely on either of these events that occurred in 2015.

The grounds directed at Registration No. 2,309,491 for ONEIDA INDIAN NATION, which registered in January 2000, relate to Registrant's *own* conduct, namely fraud and abandonment. Order Denying Motion to Dismiss, Dkt. 10, at 4. And the grounds directed at Registration Nos. 4,808,677 and 4,813,028, both for ONEIDA, and both registering in 2015, relate to Registrant's *own* conduct and *Petitioner's extensive use of ONEIDA before Registrant filed its applications for registration in January 2006*. Dkt. 10, at 4. Petitioner's Constitutional amendment in 2015 that changed its name, the DOI's approval of that and other Constitutional amendments in 2015, and the update to the new name when the DOI next published its periodic list of federally recognized Indian tribes in 2016 are not referenced within any of the enumerated grounds of the Amended Petition (Dkt. 8 ¶¶ 131-216) beyond a general reference to the background section. Nor did the Board rely on them when it denied Registrant's motion to dismiss (Dkt. 10). Petitioner's own "rights" are based on Petitioner's historical use. The DOI did not "give" Petitioner any rights to a name, and Petitioner never alleged that.

Registrant also insinuates that standing somehow relates to the DOI Action, noting that Petitioner identified harm to it because the registrations limited its use of its name, Oneida Nation. (Dkt. 11 at 2.) Registrant ignores that Petitioner's allegation of harm also included the fact that Registrant has engaged in "efforts directed at limiting the Petitioner's own use of the name Oneida that it has used for hundreds of years." (Dkt. 8 ¶¶ 12.) As such, the registrations also would limit Petitioner's previous name, Oneida Tribe of Indians of Wisconsin, as well as general use of the name Oneida. None of the harm relates to the fact that the DOI approved a

Constitutional amendment effecting the name change, or that the DOI periodically publishes a list, by name, of federally recognized Indian tribes—which is the conduct at issue in the DOI Action. As such, the Board did not rely on the 2015 name change or conduct by the DOI when it found standing. (Dkt. 10 at 3-4.) The harm to Petitioner, and Petitioner’s standing, does not rely on the 2015 name change or conduct by the DOI, and those events do not bear on the cancellation proceeding.

Registrant also asserts that Petitioner has used DOI’s decision to try to limit Registrant’s “use of its longstanding ‘Oneida Nation’ name and mark.” (Dkt. 11 at 2.) First, this assertion is false. Regardless of how Registrant interpreted the letter that Petitioner’s counsel sent in January 2017, Petitioner explained in subsequent correspondence in May 2017—before either the original or the DOI Action were filed—that Petitioner “has never claimed that it has exclusive rights to use of the terms ONEIDA and ONEIDA NATION, nor made any effort to limit the use of those terms by Oneida Nation of New York” and that Petitioner “believes that in light of the longstanding use of the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation by both entities, both should be able to use and continue to use these terms to identify themselves and the source of various good and services provided by each tribe to their members and members of the general public.” (May 16, 2017 Correspondence, attached as Exhibit A.) Indeed, the Amended Petition itself states: “Petitioner submits that in light of this history and longstanding use of these terms by both entities, both tribes should be able to use and continue to use the terms Oneida, Oneida Tribe, Oneida Indian Tribe, Oneida Nation, and Oneida Indian Nation to identify themselves.” (Dkt. 8 ¶ 8.) Regardless, Registrant’s use of ONEIDA NATION would not be relevant to or bear on the issues of Registrant’s rights to registration of

registrations for ONEIDA INDIAN NATION and ONEIDA raised in the cancellation proceeding.

The only TTAB decision cited in Registrant's motion, *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, Opp. No. 91/198,708 Dkt. 9 (TTAB 2011), certainly does not hold that any attenuated connection that does not relate in any manner to the issues to be decided by the Board means that the civil action has "a bearing on" the Board proceeding. *New Orleans Saints* involved a typical case where the "parties to this opposition are in reversed positions in a civil action pending in the District Court for the Eastern District of Louisiana." *Id.*, Dkt. 9 at 6. The Board stated that, "[i]f the parties to an opposition are involved in a district court action involving the same mark or the opposed application, the Board will scrutinize the pleadings in the civil action to determine if the issues before the court may have a bearing on the Board's decision in the opposition." *Id.* at 5-6. It observed that the civil action complaint "alleges, among other claims, trademark infringement of applicant's WHO DAT mark [the subject of the opposition], and seeks, among other remedies, to enjoin use of the term WHO DAT by all the defendants." *Id.* at 7. The Board accordingly concluded that "the decision by the district court to enjoin use of the WHO DAT mark by opposers would have a bearing on this proceeding, each party has moved to suspend proceedings pending the disposition of the above-reference" and so suspended the proceeding. *Id.* The Board's observation that the civil action "does not have to be dispositive" meant that it did not need to resolve the entire case, not that the final determination in the civil action could have no legal bearing at all.

Further, while Rule 2.117 does not mandate that both parties to the Board proceeding also be parties to a civil action, the civil action between Registrant and the DOI has no bearing on the present case. *See also* TBMP § 510.02(a). As evident from the cases cited at the TBMP

§ 510.02(a) n.6, a civil action involving only one of the parties might nonetheless have a bearing on the Board proceeding when the civil action involves a foreign affiliate (if it was a separate party at all) challenging the validity of a related foreign mark, *see Birlinn Ltd. v. Stewart*, Opp. 91/214145, Dkt. 15 at 5 (TTAB Dec. 31, 2014) (“A determination of the validity of the foreign registration may, under certain circumstances, have a bearing on the registrability of the mark in the United States”), or a state court action between the applicant and a third party to determine ownership of applicant’s mark, *see Argo & Co. v. Carpetsheen Mfg., Inc.*, 187 USPQ 366, 367 (TTAB 1975). Suspension is not warranted based on any relation at all. Indeed, the “Board seldom grants a motion to suspend a particular proceeding pending disposition of other opposition or cancellation proceedings brought by unrelated plaintiffs against the same application or registration,” TBMP § 510.02(a), even though such a proceeding might entirely moot such a proceeding. *New Orleans Saints*, Dkt. 9 at 3 (“a motion to suspend an opposition on the ground that another opposition against the same application may be successful, making the movant’s opposition moot, in most cases will be denied”). In any event, here it is not clear in any respect how the DOI Action could possibly moot, or even affect, this proceeding.

“Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board.” TBMP § 510.02(a); *Birlinn*, Dkt. 15 at 4. Petitioner is not a party to the DOI Action, and Petitioner’s claims in this cancellation proceeding do not rely or depend on the agency actions challenged under the Administrative Procedure Act in the DOI Action. Accordingly, Petitioner respectfully requests that the Board exercise its discretion and deny the motion here.

Date: January 8, 2018

Respectfully submitted,

/Christopher R. Liro/

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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing was served by email on this 8th day of January, 2018, upon Registrant at the following email addresses of record:

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Exhibit A



Email: chris.liro@andruslaw.com

May 16, 2017

VIA EMAIL

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

Re: ONEIDA Trademark Registrations
Andrus Ref. 6363-00001

Dear Meghan:

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

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

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

May 16, 2017

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

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

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

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

Yours truly,

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

Christopher R. Liro

CRL/mgm