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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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Attachments	Opposition to Motion for Reconsideration.pdf(19398 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 OPPOSITION TO PETITIONER’S MOTION FOR
RECONSIDERATION OF THE BOARD’S ORDER SUSPENDING PROCEEDINGS**

I. INTRODUCTION

In response to the Board’s January 23, 2018 Order suspending this proceeding pending disposition of a civil action (Dkt. 13) (the “Suspension Order”), Petitioner Oneida Nation (“Petitioner”) has filed a Motion for Reconsideration, (Dkt. 14). There, Petitioner makes a host of unfounded allegations against the Board, asserting that the Board: “ignored and failed to consider Petitioner’s arguments, the relevant evidence, and the correct legal standards,” (Dkt. 14 at 2); did not “ever consider[the] points [presented in Petitioner’s prior filing] in the first place,” (*id.*); took a “‘rubber stamp’ approach to the motion [for suspension,]” (*id.*); “[p]lainly . . . did not ‘scrutinize’ the civil action or its pleadings,” (*id.* at 3); and “abused [its] discretion,” (*id.* at 8). Petitioner then ignores the TBMP’s admonition against “a reargument of the points presented in a brief on the original motion,” TBMP § 518, reproducing almost verbatim its prior arguments.

In both the present motion and its original opposition to Registrant Oneida Indian Nation of New York's ("Registrant") motion for suspension, Petitioner tries to disavow its clear reliance in the pleadings and elsewhere on a decision by the U.S. Department of the Interior ("the Department"), which Registrant challenges in the civil action for which this proceeding was suspended, *Oneida Indian Nation v. United States Department of the Interior*, 5:17-cv-00913-MAD-TWD (N.D.N.Y.) (the "DOI Action"). Petitioner has presented no proper basis to reconsider the Suspension Order, and Petitioner's motion should be denied.

II. ARGUMENT

A. Petitioner's Motion Fails to Meet the Standard for Reconsideration Because It Merely Reargues the Points from Petitioner's Prior Opposition Brief

A motion for reconsideration "is limited to a demonstration that on the basis of the facts before the Board and applicable law, the Board's ruling was in error and requires appropriate change." *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). *See also Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005) (reconsideration denied because Board did not err in considering disputed evidence). A motion for reconsideration should not "be devoted simply to a reargument of the points presented in a brief on the original motion." TBMP § 518. Yet Petitioner does exactly that. Pages 3 to 8 of Petitioner's motion for reconsideration (Dkt. 14) are an almost exact copy of Petitioner's opposition brief to Registrant's original motion for suspension (Dkt. 12)—arguing again that the Board got it wrong. Petitioner justifies this improper tactic with its belief that "the Board completely ignored and failed to consider Petitioner's arguments." (Dkt. 14 at 2.) Petitioner provides no basis for this unfounded accusation, the motion for reconsideration is improper, and it should be denied on this basis alone.

B. Registrant's Motion to Suspend Was Properly Granted

Petitioner also insinuates that it was wrong for a Paralegal Specialist to rule on Registrant's motion for suspension. *See, e.g., id.* at 2 ("Notwithstanding the Paralegal Specialist's 'rubber stamp' approach to the motion, it is not the law of the Board that any attenuated connection that does not relate in any manner to the issues to be decided by the Board means that the civil action has 'a bearing on' the Board proceeding supporting suspension."); *id.* at 3 ("Plainly, the Paralegal Specialist did not 'scrutinize' the civil action or its pleadings here."); *id.* at 8 ("[T]he Board, acting through a Paralegal Specialist, abused this discretion. . . ."). But Petitioner ignores clear legal authority for doing so: "Interlocutory motions, requests, conceded matters, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Administrative Trademark Judge of the Trademark Trial and Appeal Board or by an Interlocutory Attorney or ***Paralegal of the Board*** to whom authority to act has been delegated, or by ESTTA." 37 CFR § 2.127(c) (emphasis added).

C. Petitioner's Repeated Arguments Do Not Defeat Registrant's Motion For Suspension or Justify Reconsideration

Even if the Board considers Petitioner arguments for a second time, they provide no basis for reconsideration. The Board properly suspended the proceeding pending the DOI Action. "Whenever it shall come to the attention of the Trademark Trial and Appeal Board that ***a party*** or parties to a pending case are engaged in a civil action or another Board proceeding 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) (emphasis added). Accordingly, the TBMP explains that "the Board may also, in its

discretion, suspend a proceeding pending . . . another proceeding in which only one of the parties is involved.” TBMP § 510.02(a).

Petitioner nevertheless asserts that the Suspension Order should be reconsidered because it is not a party to the DOI Action. (*See, e.g.*, Dkt. 14 at 1 (“Petitioner is not a party to the DOI Action. . . .”).) But the rule makes clear that the Board may suspend a proceeding pending disposition of a civil action involving only one party, and the Board has suspended actions under such circumstances. *See, e.g., Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366 (TTAB 1975) (suspended pending state court action that did not involve opposer); *NY-Exotics, Inc. v. Exotics.com, Inc.*, Cancellation No. 9204097, Dkt. 17 at 7–8, 2004 WL 950921, at *3 (TTAB Apr. 29, 2004) (suspended pending state court action that did not involve petitioner).

The Board was also correct to find that the DOI Action may “have a bearing on the Board case,” (Dkt. 13 at 1), because Petitioner itself has taken legal positions that reflect its belief that the DOI Action has a bearing. Indeed, Petitioner injected the Department’s decision into this proceeding through its pleadings, and Petitioner uses that decision to support its claims. For example, in the Petition for Cancellation, Petitioner alleges that:

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).

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).

(Dkt. 8 ¶¶ 11–12; *see also* Dkt. 1 at ¶¶ 10–11.)

Petitioner has also attempted to use the Department’s decision to limit Registrant’s *use* of its longstanding ONEIDA NATION name and mark. In a January 16, 2017 letter that Petitioner sent to Registrant, Petitioner stated the following:

Further, unless and until the parties have a coexistence agreement, I remind you that your client’s federally recognized name is Oneida Nation of New York, and that your client should not abbreviate that as Oneida Nation or otherwise refer to itself as the Oneida Nation, which is the federally recognized name of my client.

(Dkt. 11 Ex. A, Civil Action Complaint Ex. C at 2.) The record thus shows that Petitioner has taken the position that the Department’s decision, in which the Department recognized Petitioner as “Oneida Nation,” gave Petitioner rights to that name and mark. These supposed rights, Petitioner asserts, bear on Registrant’s ability to use, register, and enforce ONEIDA and ONEIDA-formative marks, and thus on this cancellation proceeding.

Petitioner cannot now disavow that position. While Petitioner asserts that “none of the grounds for cancellation rely on” the Department’s decision, (Dkt. 14 at 4), and that “Registrant’s use of ONEIDA NATION would not be relevant to or bear on the issues . . . raised in the cancellation proceeding,” (*id.* at 6), Petitioner has not amended its pleading to remove the allegations quoted above, and has not stipulated that the

Department's decision gives it no substantive rights to the ONEIDA NATION name or mark. As long as Petitioner keeps these allegations in the case, the Board properly chose to await a resolution of the DOI Action before taking up Petitioner's cancellation claims.

III. CONCLUSION

Petitioner should not be heard to rely on the Department's decision in its petition and then to informally disavow that reliance just to avoid a sensible stay. The Board properly suspended the proceeding pending disposition of the DOI Action, and it made no error in the Suspension Order. Petitioner's improper motion for reconsideration—which unjustly accuses the Board of shirking its duties and improperly repeats Petitioner's prior arguments—should be denied.

Respectfully submitted,

ONEIDA INDIAN NATION OF NEW YORK

Dated: February 21, 2018

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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing REGISTRANT'S
OPPOSITION TO PETITIONER'S MOTION FOR RECONSIDERATION OF THE
BOARD'S ORDER SUSPENDING PROCEEDINGS was served by email on this 21st
day of February 2018, upon Applicant at the following email addresses of record:

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