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February 26, 2018

Hon. Mae A. D'Agostino
United States District Judge
U.S. District Court for the
Northern District of New York
James T. Foley U.S. Courthouse
445 Broadway
Albany, NY 12207

Re: *Oneida Indian Nation v. U.S. Dep't of Interior*, No. 17-cv-0913 (MAD/TWD)

Dear Judge D'Agostino:

On behalf of the Oneida Indian Nation, I write to submit the Trademark Trial & Appeal Board's order suspending proceedings on a petition to cancel the Nation's trademarks. The order, just issued February 22, 2018, resolves the motion for reconsideration discussed at page 4 of Defendant's February 23, 2018 Reply in Support of Its Motion to Dismiss, ECF Document 23. The order suspends TTAB proceedings through judgment and completion of all appeals in this case based on the determination that it "may have a bearing on" the TTAB proceeding.

Pursuant to the Court's Individual Rule 2(d), the Nation also requests that the Court exercise its discretion to hear argument on the motion to dismiss. Defendant filed an over-length reply to "allow the complex issues to be more fully developed." ECF Doc. 22. The reply discusses 34 previously uncited cases and also attaches new exhibits. The reply includes a new argument (page 11) about the anti-discrimination statute, 25 U.S.C. § 5123(f), that was alleged in the Nation's complaint. The reply also includes a new argument (pages 12-13) concerning the existence of an adequate remedy at law, an argument that was presented only obliquely in footnote 3 of Defendant's original memorandum. *See Tomassini v. FCA US LLC*, 2015 WL 3868343 n.4 (N.D.N.Y. 2015) (disregarding argument first made in reply); *Wandering Dago, Inc. v. N.Y. State Office of Gen. Servs.*, 992 F. Supp.2d 102, 134 (N.D.N.Y. 2014) (disregarding argument made in footnote), *rev'd on other grounds*, 879 F.3d 20 (2d Cir. 2018).

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Because a surreply is disfavored, the Nation requests argument so that the foregoing matters and others can be fully developed for the Court.

Respectfully submitted,

/s/ Michael R. Smith

Michael R. Smith

cc: All Counsel

Enclosure

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

wbc

Mailed: February 22, 2018

Cancellation No. 92066411

Oneida Nation

v.

Oneida Indian Nation of New York

Wendy Boldt Cohen, Interlocutory Attorney:

Now before the Board is Respondent's motion to suspend proceedings pending disposition of a civil action. 11 TTABVUE. The motion is contested.

As a preliminary matter, inasmuch as the Board's order found at 13 TTABVUE did not address the contested motion on its merits, it is hereby vacated.¹

Motion to Suspend

Respondent moves to suspend this Board proceeding pending final determination of Civil Action No. 5:17-CV-0913 involving Respondent in the United States District Court for the Northern District of New York. Upon review of the pleadings from the civil action, the Board determines that the outcome of the civil action may have a bearing on this cancellation proceeding. One of the issues in the civil action is whether Petitioner's name change from Oneida Tribe of Indians of Wisconsin to Oneida Nation

¹ The Board was unable to mail the instant order before Petitioner's filing of the request for reconsideration. Because Petitioner's request for reconsideration is based on the now vacated order found at 13 TTABVUE, it will be given no further consideration. Petitioner may, as appropriate, renew its motion.

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was proper with Respondent seeking judgment “[e]njoining the Department from approving ‘Onieda Nation’ as the name of [Petitioner].” *See* 11 TTABVUE 8, 37. Because the issues involved in the Board action² as well as the civil action involve Respondent and similar issues, namely, Petitioner’s name, the court decision may have bearing on this proceeding.

It is the policy of the Board to suspend a proceeding before it whenever it becomes aware that a party to that proceeding is involved in a civil action which may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117(a); *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983) (state court infringement decision gave rise to issue preclusion in Board proceeding); *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011); TBMP § 510.02(a) (June 2017). “A civil action may involve other matters outside Board jurisdiction and may consider broader issues beyond right to registration and, therefore, judicial economy is usually served by suspension.” TBMP § 510.02(a); *see, e.g., B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 U.S. 1293, 135 S. Ct. 1293, 113 USPQ2d 2045, 2048, 2053, 2056 (2015). In view of this policy and after consideration of the parties’ submissions, judicial economy is served by suspending this proceeding. Respondent’s motion to suspend is **granted**.

This proceeding is suspended pending final disposition, including any appeals or remands, of the civil action. Within **thirty days** after the final determination of the

² Petitioner pleads rights in the name ONEIDA NATION in its amended pleading. 8 TTABVUE 4 (Petitioner argues that Respondent’s use of ONEIDA and ONEIDA INDIAN NATION will harm “Petitioner’s own use of its federally recognized name-Oneida Nation.”).

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civil action, the parties must so notify the Board so that this proceeding may be called up for appropriate action. Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.³

During the suspension period, the parties must notify the Board of any address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period.

³ A proceeding is considered to have been finally determined when a decision on the merits of the case (*i.e.*, a dispositive ruling that ends litigation on the merits) has been rendered and no appeal has been filed therefrom or all appeals filed have been decided. *See* TBMP § 510.02(b).