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July 23, 2018

The 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 plaintiff Oneida Indian Nation (the Nation), I write to submit a recent decision of the U.S. Trademark Trial and Appeals Board (TTAB). The TTAB decision reaffirms its suspension, pending the outcome of the above-referenced APA case, of all proceedings in the TTAB case seeking cancellation of the Nation's registered trademark "Oneida Nation." The Oneida Tribe of Indians of Wisconsin filed the TTAB trademark-cancellation case after the Department of the Interior decided to recognize "Oneida Nation" as the Wisconsin tribe's new name. The Nation previously submitted an earlier TTAB suspension order (ECF 24).

Both the new and the earlier TTAB orders are relevant to the Department of the Interior's defense (ECF 23 at 4 & ECF 29 at 7) that its decision to recognize "Oneida Nation" as the Wisconsin tribe's name did not harm the Nation, and that the Nation thus lacks standing in its APA challenge to the Department's decision, on the theory that the Department's name-change decision had and has nothing to do with the Wisconsin tribe's TTAB petition to cancel "Oneida Nation" as a registered trademark of the Nation.

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

wbc

Mailed: July 18, 2018

Cancellation No. 92066411

Oneida Nation

v.

Oneida Indian Nation of New York

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes up on Petitioner's request for reconsideration ("RFR") of the Board's order ("Prior Order") suspending these proceedings for Civil Action No. 5:17-CV-0913 involving Respondent in the United States District Court for the Northern District of New York (the "Court Action"). *See* 16 TTABVUE; 18 TTABVUE. The motion is fully briefed.¹

A request for reconsideration requires that the Board consider whether "based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued." TBMP § 518 (June 2018). A request for reconsideration "may not be used to introduce additional evidence, nor should it be devoted simply to reargument of the points presented in a brief on the original motion." *Id.*

¹ Petitioner also filed a motion to amend its pleading. *See* 17 TTABVUE. In view of the Board's order herein and because proceedings were suspended at the time of filing the motion to amend, the motion will be given no consideration. Upon any resumption of these proceedings, Petitioner may file a new motion to amend, as appropriate and in accordance with Board rules. The Board notes that consideration of the motion to amend would not change the Board's order herein.

Cancellation No. 92066411

As noted in the Prior Order, “[i]t 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.” 16 TTABVUE 2; *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); *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011); TBMP § 510.02(a). Further, “[f]ollowing from the Board’s inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon motion, or upon stipulation of the parties approved by the Board.” TBMP § 510.01; *see* Trademark Rule 2.117; *Schering-Plough Animal Health Corp. v. Aqua Gen AS*, 90 USPQ2d 1184, 1185 (TTAB 2009); *Carrini, Inc. v. Carla Carini, S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000).

Petitioner’s RFR is based, in large part, on the assertion that the Board failed to scrutinize the civil action filings and did not consider the parties’ arguments, arguing that the Prior Order “lacks any explanation or rationale for its decision.” 18 TTABVUE 2. In its RFR, Petitioner also includes additional evidence and reargument of its points made in its prior brief. *See id.* The Board also notes that Petitioner includes rearguments related to the merits of the Court Action, relying on its briefing filed after the Prior Order in the Court Action. *See* 18 TTABVUE 3.

Contrary to Petitioner’s assertions, the Board noted that its decision was made “after consideration of the parties’ submissions”; and further, the Board cited to portions of the Court Action noting, in particular, that although the Court Action

Cancellation No. 92066411

names only Respondent as a party, the Court Action seeks “judgment ‘[e]njoining the Department from approving ‘Oneida Nation’ as the name of [Petitioner].” 16 TTABVUE 2. The Prior Order also explains that Petitioner specifically pleads rights in the name ONEIDA NATION, the name at issue in the Court Action, with Petitioner arguing that Respondent’s use of ONEIDA and ONEIDA INDIAN NATION will harm Petitioner’s use of ONEIDA NATION. 8 TTABVUE 4; 16 TTABVUE 2 n.2.

The Prior Order suspending this proceeding for the Court Action cited the legal standard for determining if suspension is appropriate, the pertinent portions of the Court Action, and portions of the parties’ submissions involved in the Board’s determination. Nothing more was necessary to explain the Board’s decision. *Cf. Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). While the Board considered all the arguments made by both parties, “there is no requirement that the [Prior Order] repeat or discuss irrelevant arguments.” *Id.*

After carefully considering all of the parties’ arguments and submissions, the Board finds no error in its Prior Order suspending these proceedings pending final disposition of the Court Action. Accordingly, Petitioner’s request for reconsideration is **denied**.

Proceedings remain suspended.

Within twenty days after the final determination of the Court Actions, the parties shall so notify the Board in writing, including a copy of the court’s final order(s).

Cancellation No. 92066411

During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.