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Filing date: **09/14/2020**

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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Signature	/Linda K. McLeod/
Date	09/14/2020
Attachments	Answer and Counterclaim.pdf(65000 bytes)

Registration Subject to the filing

Registration No.	3016505	Registration date	11/22/2005
Registrant	Oneida Tribe of Indians of Wisconsin N7210 SEMINARY ROAD POST OFFICE BOX 365 ONEIDA, WI 54155 UNITED STATES Email: kmcandre@oneidanation.org		

Goods/Services Subject to the filing

Class 035. First Use: 1992/00/00 First Use In Commerce: 1992/00/00 All goods and services in the class are requested, namely: Retail store services featuring convenience store items and gasoline
Class 041. First Use: 1992/00/00 First Use In Commerce: 1992/00/00 All goods and services in the class are requested, namely: Casinos
Class 042. First Use: 1992/00/00 First Use In Commerce: 1992/00/00 All goods and services in the class are requested, namely: Hotel and restaurant services; retail and commercial printing and graphics art design services

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ONEIDA NATION, Petitioner, v. ONEIDA INDIAN NATION, Registrant.	Cancellation No. 92066411 Mark: ONEIDA INDIAN NATION Registration No.: 2309491 Registered: January 18, 2000 Mark: ONEIDA Registration No.: 4808677 Registered: September 8, 2015 Mark: ONEIDA Registration No.: 4813028 Registered: September 15, 2015
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REGISTRANT’S ANSWER AND COUNTERCLAIM

Oneida Indian Nation (“Registrant”) hereby answers Oneida Nation’s (“Petitioner”) First Amended Consolidated Petition for Cancellation¹ filed on September 12, 2017 (“First Amended Petition”). (8 TTABVUE.)

With respect to the unnumbered preamble paragraph in the First Amended Petition, Registrant denies that Petitioner is being, and will continue to be, damaged by Registrant’s Trademark Registration Nos. 2309491, 4808677, and 4813028. Registrant admits that it owns Trademark Registration Nos. 2309491, 4808677, and 4813028. Registrant denies the listed owner for Trademark Registration Nos. 2309491, 4808677, and 4813028 is Oneida Indian Nation of New York, which is Registrant’s prior name. Registrant’s federally recognized name is now Oneida Indian Nation,² and Registrant

¹ The Board denied Petitioner’s Motion for Leave to File Second Amended Petition (17 TTABVUE) because the motion was filed while the proceedings were suspended. (21 TTABVUE 1, n. 1.)

² See Indian Entities Recognized by and Eligible To Receive Services From the United States Bureau of Indian Affairs, 85 Fed. Reg. 5462, 5464 (Jan. 30, 2020).

has filed a change of name for Trademark Registration Nos. 2309491, 4808677, and 4813028 with the Patent and Trademark Office's ("PTO") Assignments Recordation Branch and is concurrently filing a Motion to Change Title of Proceeding with this Answer. Registrant lacks sufficient information to form a belief as to the truth or falsity of the remaining allegations in the unnumbered preamble paragraph to the First Amended Petition and therefore denies them. In regard to the numbered paragraphs in the First Amended Petition, Registrant's Answer corresponds to the number of those paragraphs set forth below.

1. Registrant admits that it is a federally recognized sovereign Indian Nation. Registrant denies the allegation in footnote 1 that it "identifies" itself as Oneida Indian Nation of New York for Trademark Registration Nos. 2309491, 4808677, and 4813028. The listed owner for Trademark Registration Nos. 2309491, 4808677, and 4813028 is Oneida Indian Nation, and Registrant is concurrently filing a Motion to Change Title of Proceeding with this Answer. Registrant denies the allegations in footnote 1 that its federally recognized name is Oneida Indian Nation of New York. Registrant's federally recognized name is Oneida Indian Nation. Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 1 and footnote 1 and therefore denies them.

2. Registrant admits that the Oneida Indian Nation was and is a member of the Confederacy, which consisted of some of the most powerful Indian tribes in the

northeastern United States at the time of the American Revolution, and that through the Revolutionary period Oneidas inhabited millions of acres of land in what is now central New York State. Registrant admits that it is located on the Oneida reservation in New York, which the United States recognized to be the Oneida Indian Nation's reservation and property in the 1794 Treaty of Canandaigua, the treaty that recognizes the Oneida Indian Nation. Registrant admits that Petitioner is recognized as an Indian tribe in the 1838 treaty between Petitioner and the United States, a treaty that acknowledges the tribe's reservation in Wisconsin. To the extent that Paragraph 2 contains further allegations, Registrant denies such allegations.

3. Registrant admits that during the Revolutionary War the Oneida supported the colonies and served in General George Washington's army, that Oneida Indian Nation lands were to be protected forever under the 1794 Treaty of Canandaigua and earlier treaties between the Oneida Indian Nation and United States, and that through a series of unlawful land transactions and treaties the Oneida Indian Nation was illegally dispossessed of most of its lands. Registrant denies the remaining allegations in Paragraph 3, including that only 32 acres remained in Oneida possession by the 1820s.

4. Registrant admits that several hundred Oneidas sold parts of the Oneida reservation in New York and moved to Wisconsin during the 1820s where they treated with the United States as a separate tribe, the ultimate treaty being the referenced 1838 treaty that federally recognized Registrant as an Indian tribe with sovereignty over its

reservation in Wisconsin. Registrant admits that the Wisconsin tribe chose the name Oneida Tribe of Indians of Wisconsin at some point, which the United States recognized, and that it changed its name later to Oneida Nation, which the United States recognized. To the extent that Paragraph 4 contains other allegations, Registrant denies such allegations.

5. Registrant denies the allegations in Paragraph 5. Registrant's name is now Oneida Indian Nation, which the United States recognizes. Registrant admits that for well over 100 years, it has identified itself, and the public has identified Registrant, as Oneida, Oneida Nation, Oneida Indian Nation, and Oneida Nation of New York.

6. Registrant admits it has identified itself as Oneida, Oneida Indian Nation, and Oneida Nation for well over 100 years. Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 6 and therefore denies them.

7. Registrant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 7 and therefore denies them.

8. Paragraph 8 asserts legal arguments and conclusions to which no response is required. To the extent the TTAB believes there are allegations that require a response, Registrant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 8 and therefore denies them.

9. Registrant denies the allegations in Paragraph 9.

10. Registrant admits that Petitioner has members whose ancestors were members of the Oneida Indian Nation, who lived on the Treaty of Canandaigua reservation in New York, and who moved to Wisconsin and formed an Indian tribe there, confirmed by the 1838 treaty as a tribe with its reservation in Wisconsin. Registrant denies any other allegations that may be contained in Paragraph 10.

11. Registrant admits that regulations titled "Procedures for Establishing That an American Indian Group Exists as an Indian Tribe" appear in 43 Fed. Reg. 39361 (Sept. 5, 1978) and speak for themselves. Registrant admits that regulations listed at 43 Fed. Reg. 39362-63, to be added as 25 C.F.R. §§ 54.3 and 54.6(b), state that the Bureau of Indian Affairs must publish an internal list of recognized tribes, and the regulations speak for themselves. Registrant admits that Oneida Tribe of Wisconsin appears in 44 Fed. Reg. 7235, 7236 (Feb. 6, 1979). Registrant admits that Oneida Tribe of Indians of Wisconsin appears in 67 Fed. Reg. 46328, 46330 (July 12, 2002). Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 11 and therefore denies them.

12. Registrant admits that Oneida Nation appears in 81 Fed. Reg. 26826, 26827 (May 4, 2016). Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 12 and therefore denies them.

13. Registrant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 13 and therefore denies them.

14. Registrant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 14 and therefore denies them.

15. Registrant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 15 and therefore denies them.

16. Registrant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 16 and therefore denies them.

17. Registrant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 17 and therefore denies them, and the First Amended Petition does not include any exhibits.

18. Registrant admits that it was aware of the LPGA's October 20, 2015 press release identified in Paragraph 17 above. Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 18 and therefore denies them.

19. Registrant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 19 and therefore denies them.

20. Registrant admits it owns Trademark Registration Nos. 2309491, 4808677, and 4813028. Registrant denies the record owner of Trademark Registration Nos. 2309491, 4808677, and 4813028 is Oneida Indian Nation of New York. The record

owner of Trademark Registration Nos. 2309491, 4808677, and 4813028 is Oneida Indian Nation.

21. Registrant admits the allegations in Paragraph 21.

22. Registrant admits that Petitioner has members whose ancestors were members of the Oneida Indian Nation, who lived on the Treaty of Canandaigua reservation in New York, and who moved to Wisconsin and formed an Indian tribe there, confirmed by the 1838 treaty as a tribe with its reservation in Wisconsin. Registrant denies any other allegations that may be contained in Paragraph 22.

23. Registrant denies its federally recognized name is Oneida Nation of New York. Registrant's federally recognized name is Oneida Indian Nation. Registrant admits regulations titled "Procedures for Establishing That an American Indian Group Exists as an Indian Tribe" appear in 43 Fed. Reg. 39361 (Sept. 5, 1978) and speak for themselves. Registrant admits regulations listed at 43 Fed. Reg. 39362-63, to be added as 25 C.F.R. §§ 54.3 and 54.6(b), state that the Bureau of Indian Affairs must publish an internal list of recognized tribes, and the regulations speak for themselves. Registrant admits its previously recognized name Oneida Nation of New York appears in 44 Fed. Reg. 7235, 7236 (Feb. 6, 1979). Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 23 and therefore denies them.

24. Registrant admits its outside counsel sent a letter dated November 25, 2015 to Ms. Liz Moore with the title Chief Legal Officer of the Ladies Professional Golf Association, and the letter included the sentence: “We represent the Oneida Nation of New York (the “Oneida Nation”).” Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 24 and therefore denies them, and the First Amended Petition does not include any exhibits.

25. Registrant admits its outside counsel sent a letter dated November 25, 2015 to Ms. Liz Moore with the title Chief Legal Officer of the Ladies Professional Golf Association, and the letter included the sentences: “Our client has continuously used and been recognized as the ONEIDA and the ONEIDA NATION for hundreds of years. The Indian nation located in Wisconsin is federally recognized as the Oneida Tribe of Indians of Wisconsin.” Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 25 and therefore denies them.

26. Registrant admits its outside counsel sent a letter dated November 25, 2015 to Ms. Liz Moore with the title Chief Legal Officer of the Ladies Professional Golf Association, and the letter included the sentence: “In addition to its long history and use of the ONEIDA and ONEIDA NATION names, the Oneida Nation owns numerous federal trademarks for the ONEIDA trademark, including U.S. Reg. No. 4813028 for ‘conducting sporting events, namely boxing, yoga, lacrosse, and golf,’ among others.”

Indeed, Registrant has long-standing common law and registration trademark rights in ONEIDA and ONEIDA INDIAN NATION marks covering a wide range of products and services, including conducting sporting events, golf instruction, golf courses, entertainment services, casinos, restaurant and bar services, hotel services, education services, governmental services, medical services, financial services, and a variety of merchandise, among others. Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 26 and therefore denies them.

27. Registrant admits its outside counsel sent a letter dated November 25, 2015 to Ms. Liz Moore with the title Chief Legal Officer of the Ladies Professional Golf Association, and the letter included the sentence: “The Oneida Nation is understandably concerned about the LPGA’s Press Release for the ‘Oneida LPGA Classic’ because consumers are likely to be confused to believe that the tournament is licensed by, sponsored by, endorsed by, or otherwise connected to the Oneida Nation, when in fact, it is not.” Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 27 and therefore denies them.

28. Registrant admits its outside counsel sent a letter dated November 25, 2015 to Ms. Liz Moore with the title Chief Legal Officer of the Ladies Professional Golf Association, and the letter included the sentences: “(1) immediately and permanently cease all use of the ONEIDA and ONEIDA NATION name and mark in connection with

the 'Oneida LPGA Classic;' (2) cease all use, distribution, posting, display and dissemination of the Press Release, including without limitation removing it from all websites; and (3) refrain from any use of the Press Release or similar statements and/or advertisements in the future that, among other things, falsely suggest that the Oneida Nation is associated or affiliated in any way with the 'Oneida LPGA Classic.'" Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 28 and therefore denies them.

29. Registrant denies the allegations in Paragraph 29.

30. Registrant denies the allegations in Paragraph 30.

31. Registrant admits it filed Serial No. 74548930 on July 13, 1994 for the mark ONEIDA INDIAN NATION, which is the parent application (after dividing) for Serial No. 75978733 that matured into Registration No. 2309491.

32. Registrant admits the allegations in Paragraph 32.

33. Registrant admits that Application Serial No. 74548930 contains the statements in Paragraph 33.

34. Registrant admits that Application Serial No. 74548930 contains the statements in Paragraph 34.

35. Registrant denies the allegations in Paragraph 35.

36. Registrant denies the allegations in Paragraph 36.

37. Registrant admits its July 13, 1994 application contains the sentence: “Three (3) specimens showing the mark as currently used for goods and services in each of the classes set forth herein are presented herewith.” Registrant admits the PTO’s online records do not show such specimens. Registrant denies the remaining allegations in Paragraph 37.

38. Registrant admits the PTO issued an Office Action dated February 27, 1995 for Serial Number 75978733, child to Serial Number 74548930, and the February 27, 1995 Office Action contains the quoted language in Paragraph 38. Registrant admits the February 27, 1995 Office Action noted that if Registrant added Classes 6, 18, or 20, that additional specimens of use were required. Registrant denies the remaining allegations in Paragraph 38.

39. Registrant admits on August 25, 1995 it requested an amendment to Serial Number 75978733, child to Serial Number 74548930, in response to the PTO’s February 27, 1995 Office Action, and that the August 25, 1995 Amendment stated it included photocopies of specimens for classes 6, 14, and 35. Registrant admits the PTO’s online records do not show such specimens. Registrant denies the remaining allegations in Paragraph 39.

40. Registrant admits the August 25, 1995 request to amend Serial Number 74548930 parent to Serial Number 75978733, included the text quoted in Paragraph 40. Registrant denies the remaining allegations in Paragraph 40.

41. Registrant admits that the declaration contains the statements set forth in Paragraph 41.

42. Registrant admits the first September 24, 1996 publication notice for Serial No. 74548930, parent to Serial No. 75978733, included the quoted text in Paragraph 42. Registrant denies the remaining allegations in Paragraph 42.

43. Registrant admits it filed an Amendment After Publication for Serial No. 74548930, parent to Serial No. 75978733, on December 16, 1997, which stated, in part, "The Applicant has amended its application to remove any exception to the registration of its mark throughout the United States. Nothing else has changed." Registrant denies the remaining allegations in Paragraph 43.

44. Registrant admits the December 16, 1997 Amendment After Publication included a document titled Third Substitute Statement and Declaration for Trademark and Service Mark Registration, which states "The ONEIDA portion of the Applicant's Mark has become distinctive as a result of its substantially exclusive and continuous use in commerce within the Indian Nation since as early as 1492 in connection with the applicant's goods and services." Registrant admits this document does not reference Petitioner. Registrant denies the remaining allegations in Paragraph 43.

45. Registrant admits the December 16, 1997 Amendment After Publication included a declaration dated December 9, 1997 by Mr. Ray Halbritter as Nation Representative. The remaining allegations in Paragraph 45 set forth legal arguments

and conclusions that require no response. To the extent the TTAB believes there are any allegations that would require a response, Registrant denies the remaining allegations in Paragraph 45.

46. Registrant denies the allegations in Paragraph 46.

47. Registrant admits Serial No. 74548930, parent to Serial No. 75978733, re-published for opposition on March 10, 1998, and the publication notice does not reference Petitioner. Registrant denies the remaining allegations in Paragraph 47.

48. Registrant admits the allegations in Paragraph 48.

49. Registrant admits the allegations in Paragraph 49.

50. Registrant admits that the '491 Registration bears an issue date of January 18, 2000. Registrant denies the remaining allegations in Paragraph 50.

51. Registrant admits the allegations in Paragraph 51.

52. Registrant admits it filed on January 18, 2006 a Declaration under Sections 8 and 15 executed by Mr. Ray Halbritter as Nation Representative, which stated that Registrant is using the mark in commerce on or in connection with all of the goods and services in Trademark Registration No. 2309491, except for metal key fobs in International Class 6, which Registrant requested to be deleted from the registration. Registrant admits the Declaration included ten specimens (one per class) showing the mark as used in commerce as of the filing date of the Declaration. Registrant admits the Declaration included a statement that Registrant has used the mark in commerce for

over five consecutive years immediately preceding the execution of the Declaration on or in connection with the goods and services recited in the registration, except for metal key fobs in International Class 6. Registrant denies the remaining allegations in Paragraph 52.

53. Registrant admits the January 18, 2006 Declaration under Sections 8 and 15 included ten specimens (one per class) consistent with the PTO's rules. The PTO's rules do not require that specimens for every product or service identified in the Registration be included in a Declaration under Section 8 and 15. Registrant denies the remaining allegations in Paragraph 53.

54. Paragraph 54 asserts legal argument and conclusions to which no response is required. PTO rules did not require that the January 18, 2006 Declaration include a statement that to the best of the signatory's knowledge and belief, no other persons, firm, corporation, or association has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. Registrant denies the remaining allegations in Paragraph 54.

55. Registrant denies the allegations in Paragraph 55.

56. Registrant denies the allegations in Paragraph 56.

57. Registrant denies the allegations in Paragraph 57.

58. Registrant denies the allegations in Paragraph 58.

59. Registrant admits it filed on July 19, 2010 a Declaration under Sections 8 and 9 executed by Peter D. Carmen, Petitioner's Chief Operating Officer, declaring that Registrant is using the mark in commerce on or in connection with all of the goods and services in Trademark Registration No. 2309491, except for decals, nation directory of member services, and folders in Class 16, government services, namely vital statistics services in Class 35, providing housing agency services and providing home repair financial assistance services in Class 36, home maintenance services in Class 37, and child care services, heating assistance services, and home visit services in Class 42. Registrant admits the Declaration included nine specimens (one per class) showing the mark as used in commerce as of the filing date of the Declaration. Registrant denies the remaining allegations in Paragraph 59.

60. Registrant admits the July 19, 2010 Declaration under Sections 8 and 9 included nine specimens (one per class) consistent with the PTO's rules. The PTO rules do not require that specimens for every product or service identified in the Registration be included in a Declaration under Section 8 and 9. Registrant denies the remaining allegations in Paragraph 60.

61. Paragraph 61 asserts legal arguments and conclusions to which no response is required. PTO rules did not require that the July 19, 2010 Declaration include a statement that to the best of the signatory's knowledge and belief, no other persons, firm, corporation, or association has the right to use the mark in commerce,

either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. Registrant denies the remaining allegations in Paragraph 61

62. Registrant denies the allegations in Paragraph 62.

63. Registrant denies the allegations in Paragraph 63.

64. Registrant denies the allegations in Paragraph 64.

65. Registrant denies the allegations in Paragraph 65.

66. This paragraph sets forth legal argument to which no response is required.

To the extent that a response is required, Registrant affirmatively states that it does not require Petitioner's consent or permission to use or register Registrant's mark ONEIDA INDIAN NATION. To the extent Paragraph 66 alleges Registrant has not used Registrant's ONEIDA mark, Registrant denies such allegations.

67. Registrant admits it filed Serial Number 78800006 on January 26, 2006 for the mark ONEIDA, which is the parent application (after dividing) for Serial Number 78978999 that matured in Registration Number 4808677.

68. Registrant admits the allegations in Paragraph 68.

69. Registrant denies the allegations in Paragraph 69. Registrant's January 26, 2006 Application for Serial Number 78800006 did not include a Declaration, and the PTO on June 5, 2006 issued an Office Action requiring Registrant to submit a Declaration.

70. Registrant denies the allegations in Paragraph 70.
71. Registrant denies the allegations in Paragraph 71.
72. Registrant denies the allegations in Paragraph 72.
73. Registrant denies the allegations in Paragraph 73.
74. Registrant admits it filed a request to divide Serial Number 78800006 on July 6, 2007. Registrant denies the remaining allegations in Paragraph 74.
75. Registrant admits the allegations in Paragraph 75.
76. Registrant admits the allegations in Paragraph 76.
77. Registrant admits the allegations in Paragraph 77.
78. Registrant admits the allegations in Paragraph 78.
79. Registrant admits the allegations in Paragraph 79.
80. Registrant admits the allegations in Paragraph 80.
81. Registrant admits the allegations in Paragraph 81.
82. Registrant admits the allegations in Paragraph 82.
83. Registrant admits the allegations in Paragraph 83.
84. Registrant admits the allegations in Paragraph 84.
85. Registrant admits it filed a Statement of Use on July 31, 2015. To the extent Paragraph 85 alleges that July 31, 2015 is the dates of first use in commerce for the goods and services included in Registrant's July 31, 2015 Statement of Use, Registrant denies the allegations.

86. Paragraph 86 asserts legal arguments and conclusions to which no response is required. To the extent a response is required, Registrant admits the July 31, 2015 Statement of Use included a specimen for each class included in the Statement of Use consistent with the PTO's rules. The PTO rules do not require that specimens for every product or service identified in the Application be included in a Statement of Use. Registrant denies the remaining allegations in Paragraph 86.

87. Registrant admits the allegations in Paragraph 87.

88. Registrant denies the allegations in Paragraph 88.

89. Registrant denies the allegations in Paragraph 89.

90. Registrant denies the allegations in Paragraph 90.

91. Registrant admits that the '677 Registration bears an issue date of September 8, 2015. Registrant denies the remaining allegations in Paragraph 91.

92. Registrant admits the allegations in Paragraph 92.

93. Registrant denies the allegations in Paragraph 93.

94. Paragraph 94 asserts legal arguments and conclusions to which no response is required. To the extent a response is required, Registrant affirmatively states that it has priority and prior rights in the marks ONEIDA, ONEIDA NATION, and ONEIDA INDIAN NATION and does not require Petitioner's consent or permission to use or register Registrant's mark ONEIDA. To the extent Paragraph 94 alleges Registrant has not used Registrant's ONEIDA mark, Registrant denies such allegations.

95. Registrant admits that filed Serial Number 78799982 on January 26, 2006 for the mark ONEIDA, which is the parent application (after dividing) for Serial Number 78978992 that matured in Registration No. 4813021.

96. Registrant admits the allegations in Paragraph 96.

97. Registrant denies the allegations in Paragraph 97. Registrant's January 26, 2006 Application Serial Number 78799982 did not include a Declaration, and the PTO on June 5, 2006 issued an Office Action requiring Registrant to submit a Declaration.

98. Registrant denies the allegations in Paragraph 98.

99. Registrant denies the allegations in Paragraph 99.

100. Registrant denies the allegations in Paragraph 100.

101. Registrant denies the allegations in Paragraph 101.

102. Registrant denies the allegations in Paragraph 102.

103. Registrant admits the allegations in Paragraph 103.

104. Registrant admits the PTO on August 22, 2017 issued a Notice of Divisional Request Completed and divided services into child Serial No. 78978992, but Registrant denies the allegations in Paragraph 104 regarding the list of services in child Serial No. 78978992 after the August 22, 2017 completion of the divisional request. The PTO's August 22, 2017 notice divided the following services within child Serial No. 78978992: conducting sporting events; entertainment services, namely, live musical

performances, live comedy performances, and cooking demonstrations; golf instruction; conducting seminars, workshops, lectures, and classes relating to the culture, heritage, and language of the Oneida Indian Nation; and museum and culture center only in Class 41.

105. Registrant admits the allegations in Paragraph 105.

106. Registrant admits it filed a Request for Extension of Time to File a Statement of Use on January 21, 2014, but Registrant denies the allegations in Paragraph 106 that the January 21, 2014 request deleted from the application the following goods or services: Conducting sporting events, namely, jousting.

107. Registrant admits the PTO on February 1, 2014 approved Registrant's Request for Extension of Time to File a Statement of Use, but Registrant denies the allegations in Paragraph 107 that the PTO's February 1, 2014 approval deleted the following goods or services from the application: Conducting sporting events, namely, jousting.

108. Registrant admits it filed a Request for Extension of Time to File a Statement of Use on July 10, 2014 without amendment to the recited goods or services, and that the PTO approved Registrant's request on July 17, 2014. Registrant denies the allegation in Paragraph 108 that the July 10, 2014 request was a second request.

109. Registrant admits it filed a Request for Extension of Time to File a Statement of Use on February 16, 2015 without amendment to the recited goods or

services, and that the PTO approved Registrant's request on February 25, 2015.

Registrant denies the allegation in Paragraph 109 that the February 16, 2015 request was a third request.

110. Registrant admits it filed a Statement of Use on August 10, 2015. To the extent Paragraph 110 alleges that August 10, 2015 is the date of first use in commerce for the services included in Registrant's August 10, 2015 Statement of Use, Registrant denies the allegations.

111. Paragraph 111 sets forth legal arguments and conclusions to which no response is required. To the extent a response is required, Registrant admits the August 10, 2015 Statement of Use included a specimen for each class included in the Statement of Use consistent with the PTO's rules. The PTO rules do not require that specimens for every product or service identified in the Application be included in a Statement of Use..

112. Registrant admits the allegations in Paragraph 112.

113. Registrant denies the allegations in Paragraph 113.

114. Registrant denies the allegations in Paragraph 114.

115. Registrant admits that the '028 Registration bears an issue date of September 8, 2015. Registrant denies the remaining allegations in Paragraph 115.

116. Registrant admits the allegations in Paragraph 116.

117. Registrant denies the allegations in Paragraph 117.

118. Paragraph 118 asserts legal arguments and conclusions to which no response is required. To the extent a response is required, Registrant affirmatively states that it has priority and prior rights in the marks ONEIDA, ONEIDA NATION, and ONEIDA INDIAN NATION and does not require Petitioner's consent or permission to use or register Registrant's mark ONEIDA. To the extent Paragraph 118 alleges Registrant has not used Registrant's ONEIDA mark, Registrant denies such allegations.

119. Registrant admits it filed Serial Nos. 78978999 and 78978992 on January 26, 2006. The remaining allegations of Paragraph 119 are so vague that Registrant is without sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 119 and therefore denies them.

120. Registrant admits the allegations in Paragraph 120.

121. Registrant admits the allegations in Paragraph 121.

122. Registrant admits the PTO issued a Notice of Abandonment for Serial No. 78799982 on April 21, 2008. The remaining allegations assert legal arguments and conclusions to which no response is required. To the extent a response is required, Registrant denies the remaining allegations in Paragraph 122.

123. Registrant admits the allegations in Paragraph 123.

124. Registrant admits the allegations in Paragraph 124.

125. Registrant admits the PTO issued a Notice of Abandonment for Serial No. 78800006 on April 21, 2008. The remaining allegations assert legal arguments and

conclusions to which no response is required. To the extent a response is required, Registrant denies the remaining allegations in Paragraph 125.

126. Registrant admits the allegations in Paragraph 126.

127. Registrant admits the allegations in Paragraph 127.

128. Registrant admits it filed a Statement of Use for Serial No. 78800981 on May 21, 2009 with a date of first use in commerce as early as January 27, 2009 for all goods and services.

129. Registrant admits that Registration No 3667888 bears an issue date of August 11, 2009. Registrant denies the remaining allegations in Paragraph 129.

130. Registrant admits the PTO cancelled Registration No. 3667888 on March 18, 2016. Registrant denies the remaining allegations in Paragraph 130.

131. Registrant incorporates by reference its responses to Paragraphs 1-130 as stated above.

Registrant denies the allegations in the subheading labeled "Ground 1."

132. Registrant denies the allegations in Paragraph 132.

133. Registrant denies the allegations in Paragraph 133.

134. Registrant denies the allegations in Paragraph 134.

135. Registrant denies the allegations in Paragraph 135.

Registrant denies the allegations in the subheading labeled "Ground 2."

136. Registrant denies the allegations in Paragraph 136.

- 137. Registrant denies the allegations in Paragraph 137.
- 138. Registrant denies the allegations in Paragraph 138.
- 139. Registrant denies the allegations in Paragraph 139.
- 140. Registrant admits its Registration No. 2309491 includes a disclaimer of “INDIAN NATION.” The remaining allegations of Paragraph 140 assert legal arguments and conclusions to which no response is required.

- 141. Registrant denies the allegations in Paragraph 141.
- 142. Registrant denies the allegations in Paragraph 142.
- 143. Registrant denies the allegations in Paragraph 143.
- 144. Registrant denies the allegations in Paragraph 144.
- 145. Registrant denies the allegations in Paragraph 145.

Registrant denies the allegations in the subheading labeled “Ground 3.”

- 146. Registrant denies the allegations in Paragraph 146.
- 147. Registrant denies the allegations in Paragraph 147.
- 148. Registrant denies the allegations in Paragraph 148.
- 149. Registrant denies the allegations in Paragraph 149.
- 150. Registrant denies the allegations in Paragraph 150.
- 151. Registrant denies the allegations in Paragraph 151.
- 152. Registrant denies the allegations in Paragraph 152.
- 153. Registrant denies the allegations in Paragraph 153.

154. Registrant admits its Registration No. 2309491 includes a disclaimer of "INDIAN NATION." The remaining allegations in Paragraph 154 assert legal arguments and conclusions to which no response is required.

155. Registrant denies the allegations in Paragraph 155.

156. Registrant denies the allegations in Paragraph 156.

157. Registrant denies the allegations in Paragraph 157.

158. Registrant denies the allegations in Paragraph 158.

159. Registrant denies the allegations in Paragraph 159.

Registrant denies the allegations in the subheading labeled "Ground 4."

160. Registrant denies the allegations in Paragraph 160.

161. Registrant denies the allegations in Paragraph 161.

162. Registrant denies the allegations in Paragraph 162.

163. Registrant denies the allegations in Paragraph 163.

164. Registrant incorporates by reference its responses to Paragraphs 1-163 as stated above.

Registrant denies the allegations in the subheading labeled "Ground 1."

165. Registrant denies the allegations in Paragraph 165.

166. Registrant admits that in January 2006 it filed applications that matured into Registration Nos. 4808677 and 4813028 and it filed Serial Nos. 78799982,

78800006, and 78800981. Registrant denies the remaining allegations in Paragraph 166.

167. Registrant denies the allegations in Paragraph 167.

168. Registrant denies the allegations in Paragraph 168.

Registrant denies the allegations in the subheading labeled "Ground 2."

169. Registrant denies the allegations in Paragraph 169.

170. Registrant denies the allegations in Paragraph 170.

171. Registrant denies the allegations in Paragraph 171.

Registrant denies the allegations in the subheading labeled "Ground 3."

172. Registrant denies the allegations in Paragraph 172.

173. Registrant denies the allegations in Paragraph 173.

174. Registrant denies the allegations in Paragraph 174.

175. Registrant denies the allegations in Paragraph 175.

Registrant denies the allegations in the subheading labeled "Ground 4."

176. Registrant denies the allegations in Paragraph 176.

177. Registrant denies the allegations in Paragraph 177.

178. Registrant denies the allegations in Paragraph 178.

179. Registrant denies the allegations in Paragraph 179.

Registrant denies the allegations in the subheading labeled "Ground 5."

180. Registrant denies the allegations in Paragraph 180.

181. Registrant denies the allegations in Paragraph 181.

182. Registrant denies the allegations in Paragraph 182.

183. Registrant denies the allegations in Paragraph 183.

Registrant denies the allegations in the subheading labeled "Ground 6."

184. Registrant denies the allegations in Paragraph 184.

185. Registrant denies the allegations in Paragraph 185.

186. Registrant denies the allegations in Paragraph 186.

Registrant denies the allegations in the subheading labeled "Ground 7."

187. Registrant denies the allegations in Paragraph 187.

188. Registrant denies the allegations in Paragraph 188. Registrant affirmatively states that it has priority and prior rights in the marks ONEIDA, ONEIDA NATION, and ONEIDA INDIAN NATION.

189. The allegations in Paragraph 189 assert legal arguments and conclusions to which no response is required.

190. Registrant incorporates by reference its responses to Paragraphs 1-189 as stated above.

Registrant denies the allegations in the subheading labeled "Ground 1."

191. Registrant denies the allegations in Paragraph 191.

192. Registrant admits that in January 2006 it filed applications that matured into Registration Nos. 4808677 and 4813028 and it filed Serial Nos. 78799982,

78800006, and 78800981. Registrant denies the remaining allegations in Paragraph 192.

193. Registrant denies the allegations in Paragraph 193.

Registrant denies the allegations in the subheading labeled "Ground 2."

194. Registrant denies the allegations in Paragraph 194.

195. Registrant denies the allegations in Paragraph 195.

196. Registrant denies the allegations in Paragraph 196.

197. Registrant denies the allegations in Paragraph 197.

Registrant denies the allegations in the subheading labeled "Ground 3."

198. Registrant denies the allegations in Paragraph 198.

199. Registrant denies the allegations in Paragraph 199.

200. Registrant denies the allegations in Paragraph 200.

Registrant denies the allegations in the subheading labeled "Ground 4."

201. Registrant denies the allegations in Paragraph 201.

202. Registrant denies the allegations in Paragraph 202.

203. Registrant denies the allegations in Paragraph 203.

204. Registrant denies the allegations in Paragraph 204.

205. Registrant denies the allegations in Paragraph 205.

206. Registrant denies the allegations in Paragraph 206.

Registrant denies the allegations in the subheading labeled "Ground 5."

207. Registrant denies the allegations in Paragraph 207.

208. Registrant denies the allegations in Paragraph 208.

209. Registrant denies the allegations in Paragraph 209.

210. Registrant denies the allegations in Paragraph 210.

Registrant denies the allegations in the subheading labeled “Ground 6.”

211. Registrant denies the allegations in Paragraph 211.

212. Registrant denies the allegations in Paragraph 212.

213. Registrant denies the allegations in Paragraph 213.

Registrant denies the allegations in the subheading labeled “Ground 7.”

214. Registrant denies the allegations in Paragraph 214.

215. Registrant denies the allegations in Paragraph 215. Registrant affirmatively states that it has priority and prior rights in the marks ONEIDA, ONEIDA NATION, and ONEIDA INDIAN NATION.

216. The allegations in Paragraph 216 asserts legal arguments and conclusions to which no response is required.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

Petitioner’s claims are barred, in whole or in part, based on the doctrines of laches, acquiescence, waiver, and/or estoppel.

SECOND AFFIRMATIVE DEFENSE


Petitioner's claims are barred, in whole or in part, based on under the prior registration or *Morehouse* defense. Specifically, Registrant's Trademark Registration No. 2309491 for ONEIDA INDIAN NATION covers goods and services that are identical and/or similar to the goods and services in Registration Nos. 4808677 and 4813028.

THIRD AFFIRMATIVE DEFENSE

Petitioner reserves the right to raise and plead additional affirmative defenses as they become known during its ongoing investigation and discovery.

COUNTERCLAIM COUNT 1: ABANDONMENT, Section 45, 15 U.S.C. § 1127

217. Oneida Indian Nation ("Counterclaim Petitioner") believes it is being and will be damaged by Oneida Nation's ("Counterclaim Respondent") registration of the


mark  in U.S. Trademark Registration No. 3016505, and hereby counterclaims to cancel the same. As grounds for its counterclaim, Counterclaim Petitioner alleges the following, upon actual knowledge with respect to Counterclaim Petitioner's own acts, and upon information and belief as to other matters.

218. Counterclaim Petitioner is a federally recognized Indian Nation with its principal place of business at 2037 Dream Catcher Plaza, Oneida, New York 13421.

219. Counterclaim Petitioner has standing because Counterclaim Respondent has asserted its alleged rights in Counterclaim Respondent's Registration in its petition

to cancel Counterclaim Petitioner's U.S. Trademark Registration Nos. 2309491, 4808677, and 4813028.

220. Counterclaim Respondent has alleged that it is the identified owner of U.S. Trademark Registration No. 3016505 ("Counterclaim Respondent's Registration") for

the mark  ("Counterclaim Respondent's Mark") for "retail store services featuring convenience store items and gasoline" in Class 35, "casinos" in Class 41, and "hotel and restaurant services; retail and commercial printing and graphics art design services" in Class 42 ("Counterclaim Respondent's Services").

221. Upon information and belief, Counterclaim Respondent ceased all use of Counterclaim Respondent's Mark for Counterclaim Respondent's Services for at least three consecutive years with intent not to resume such use.

222. Accordingly, Counterclaim Respondent's Registration should be cancelled in its entirety on the ground of abandonment.

WHEREFORE, Respondent/Counterclaim Petitioner prays that the cancellation against its U.S. Trademark Registration Nos. 2309491, 4808677, and 4813028 be denied with prejudice, and that its Counterclaim for Cancellation be sustained and that Counterclaim Respondent's Registration be cancelled.

A filing fee has been submitted electronically. If the filing fee is found to be insufficient for any reason, please charge such deficiency to Deposit Account No. 506154.

Respectfully submitted,

ONEIDA INDIAN NATION

Dated: September 14, 2020

By: /Linda K. McLeod/

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Attorneys for
Registrant/Counterclaim Petitioner

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing REGISTRANT'S ANSWER AND COUNTERCLAIM was served by email on this 14th day of September 2020, upon Petitioner by email at the following addresses of record:

chris.liro@andruslaw.com
mariem@andruslaw.com
cathym@andruslaw.com
aaron@andruslaw.com

/Larry L. White/_____
Larry White
Litigation Case Manager