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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	01/08/2021
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

ONEIDA NATION,)	
)	CANCELLATION NO. 92066411
Petitioner)	
)	Registration No. 2,309,491
v.)	Serial No. 75/978,733
)	Mark: ONEIDA INDIAN NATION
ONEIDA INDIAN NATION)	
)	Registration No. 4,808,677
Registrant.)	Serial No. 78/978,999
)	Mark: ONEIDA
)	
)	Registration No. 4,813,028
)	Serial No. 78/978,992
)	Mark: ONEIDA
)	
)	Counterclaim re:
)	
)	Registration No. 3,016,505
)	Serial No. 75/575,398
)	Mark: ONEIDA
)	

PETITIONER’S ANSWER TO COUNTERCLAIM

Original petitioner and counterclaim respondent Oneida Nation, through its counsel, hereby answers the Counterclaim (Dkt. 28) filed on behalf of original respondent and counterclaim petitioner Oneida Indian Nation in connection with the above-identified matter as follows:

Oneida Nation denies, generally and specifically, each and every allegation, matter and thing contained in the Counterclaim, except as hereinafter expressly admitted or qualified in response to the numbered paragraphs below.

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.

ANSWER: Counterclaim Respondent admits that Counterclaim Petitioner has counterclaimed for cancellation of Counterclaim Respondent's U.S. Trademark Registration No. 3016505, and set forth alleged bases for such cancellation. Counterclaim Respondent denies that Counterclaim Petitioner is and will be damaged by Registration No. 3016505, and denies the alleged bases for cancellation. Counterclaim Respondent lacks knowledge of Counterclaim Petitioner's alleged beliefs and knowledge, and so denies those allegations.

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

ANSWER: Counterclaim Respondent admits that Counterclaim Petitioner appears on the list of Indian entities recognized by and eligible to receive services from the United States Bureau of Indian Affairs as Oneida Indian Nation, and that it has a 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.

ANSWER: Admitted.

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”).

ANSWER: Admitted.

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.

ANSWER: Denied.

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

ANSWER: Denied.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

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

SECOND AFFIRMATIVE DEFENSE

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

Respectfully submitted,

Date: January 8, 2021

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer to Counterclaims has been served on counsel for Registrant Oneida Indian Nation by forwarding said copy on January 8, 2021, via email to:

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