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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	06/22/2021
Attachments	2021-06-22 ON Motion for Leave to Amend re Aff Defense.pdf(326299 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

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ONEIDA NATION,	)	
	)	CANCELLATION NO. 92066411
Petitioner/Counterclaim Defendant,	)	
	)	Registration No. 2,309,491
v.	)	Serial No. 75/978,733
	)	Mark: ONEIDA INDIAN NATION
ONEIDA INDIAN NATION	)	
	)	Registration No. 4,808,677
Respondent/Counterclaim Plaintiff.	)	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
	)	

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**PETITIONER/COUNTERCLAIM DEFENDANT’S MOTION FOR LEAVE TO AMEND  
ITS ANSWER TO COUNTERCLAIM TO ASSERT AFFIRMATIVE DEFENSE**

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Pursuant to Federal Rule of Civil Procedure 15, Section 507 of the Trademark Trial and Appeals Board Manual of Procedure (“TBMP”), and 37 C.F.R. § 2.115, Petitioner/Counterclaim Defendant Oneida Nation (“Counterclaim Defendant”), through its undersigned counsel, moves to amend its Answer (33 TTABVUE) to the Counterclaim of Abandonment (28 TTABVUE 31-32) of Registrant/Counterclaim Plaintiff Oneida Indian Nation (“Counterclaim Plaintiff”) in the above

referenced proceedings to assert the affirmative defense of continuing commercial impression.<sup>1</sup> “Petitioner’s First Amended Answer to Counterclaim” is attached in redline as Exhibit A and a clean version is attached as Exhibit B pursuant to TBMP § 507.01.

An amendment to a pleading should be freely given when justice so requires, unless the amendment would result in prejudice to the non-moving party, would violate law or not serve a useful purpose. *See* Fed. R. Civ. P. 15(a); TBMP § 507; *see also Am. Optical Corp. v. Am. Olean Tile Co., Inc.*, 168 USPQ 471, 473 (TTAB 1971) (stating that leave to amend “should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing party”). The Board has consistently held that motions to amend filed during the pre-trial stage of the proceeding are permitted and not prejudicial. *See, e.g., U.S. Olympic Comm. v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993) (granting motion to amend and finding applicant was not prejudiced because proceeding still in pre-trial phase); *Focus 21 International Inc. v. Pola Kasei Kowo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992) (granting motion for leave to amend filed before opening of testimony period); *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976) (granting motion for leave to amend before either party had taken testimony); *Cool-Ray, Inc. v. Eve Care, Inc.*, 183 USPQ 618, 621 (TTAB 1974) (granting motion for leave to amend filed before opening of the testimony period).

In this case, Counterclaim Defendant has not sought any prior amendments to its pleadings responsive to the counterclaim. The Parties have filed a consent motion (35 TTABVUE) to extend the close of discovery to October 7, 2021, and there is sufficient time remaining in the discovery

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<sup>1</sup> Counterclaim Defendant does not concede that continuing commercial impression is an affirmative defense that must affirmatively be stated pursuant to Fed. R. Civ. P. 8(c), but brings this motion for avoidance of doubt and to avoid future disputes on that issue.

period for Counterclaim Plaintiff to adequately investigate and defend itself against the new allegations presented in Counterclaim Defendant's First Amended Answer to Counterclaim without the need to further extend the close of the discovery period or any other current deadlines in the proceeding. Thus, Counterclaim Plaintiff will not suffer prejudice if this motion is granted.

Moreover, Counterclaim Defendant previously disclosed its contentions regarding continuing commercial impression in interrogatory responses served April 1, 2021, and now seeks to conform its pleading accordingly to ensure Counterclaim Plaintiff is provided due notice of potential defenses that may be raised. *See The H.D. Lee Company, Inc. v. Maidenform, Inc.*, 87 USPQ.2d 1715 (TTAB 2008). Justice would not be served, and in fact, Counterclaim Defendant would be severely prejudiced if it were prohibited from relying on such defense. Such a decision would effectively deny Counterclaim Defendant the right to fully defend itself against Counterclaim Plaintiff's counterclaim.

Accordingly, Counterclaim Defendant's Motion for Leave to Amend its Answer to Counterclaim and its First Amended Answer to Counterclaim attached as Exhibits A and B conform with Fed. R. Civ. P. 15, and granting the motion will not prejudice Counterclaim Plaintiff, violate any law, or serve no purpose. As such, Counterclaim Defendant respectfully requests that the Board grant its Motion for Leave to Amend and enter the attached First Amended Answer to Counterclaim as the operative pleading in this proceeding.

Respectfully submitted,

Date: June 22, 2021

/Christopher R. Liro/  
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Andrus Intellectual Property Law, LLP  
790 North Water Street, Suite 2200

Milwaukee, WI 53202  
Phone: (414) 271-7590

*Attorneys for Petitioner Oneida Nation*

## **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Petitioner/Counterclaim Defendant's Motion For Leave to Amend Its Answer to Counterclaim to Assert Affirmative Defense has been served on counsel for Respondent Oneida Indian Nation by forwarding said copy on June 22, 2021, via email to:

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/Christopher R. Liro/  
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Andrus Intellectual Property Law, LLP  
790 North Water Street, Suite 2200  
Milwaukee, WI 53202

# Exhibit A

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
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	)	
	)	Counterclaim re:
	)	
	)	Registration No. 3,016,505
	)	Serial No. 75/575,398
	)	Mark: ONEIDA
	)	

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**PETITIONER'S FIRST AMENDED 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 Petitioner's claims are barred, in whole or in part, because Counterclaim

Respondent Oneida Nation has not abandoned the



mark of its Registration

No. 3,016,505 at least because it has used and is using the



mark, which gives

the same, continuing commercial impression as the



mark, with respect to at

least the goods and services of retail store services featuring convenience store items and gasoline;  
casinos; and hotel and restaurant services.

## ~~THIRD~~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: ~~June 22~~ ~~January 8~~, 2021

/Christopher R. Liro/  
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790 North Water Street, Suite 2200  
Milwaukee, WI 53202  
Phone: (414) 271-7590

*Attorneys for Petitioner Oneida Nation*

## CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Petitioner's First Amended Answer to Counterclaim has been served on counsel for Registrant Oneida Indian Nation by forwarding said copy on June 22~~January 8~~, 2021, via email to:

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# Exhibit B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

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Date: June 22, 2021

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