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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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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’S RESPONSE TO REGISTRANT’S MOTION FOR LEAVE TO AMEND  
ANSWER TO ASSERT AFFIRMATIVE DEFENSES**

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Pursuant to Federal Rule of Civil Procedure 15 and Section 507 of the Trademark Trial and Appeals Board Manual of Procedure (“TBMP”), Oneida Nation (“Petitioner”) respectfully requests that the Board deny Oneida Indian Nation’s (“Registrant”) Motion for Leave to Amend Answer to Assert Affirmative Defenses (34 TTABVUE) (“the Motion”) because the proposed alleged affirmative defense added by the amendment serves no useful purpose because it is inadequately pleaded.

## A. Legal Standards

Petitioner does not dispute Registrant's stated general principle of law that, "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." (34 TTABVUE 2-3.) Petitioner also agrees with Registrant that "Registrant is required to properly plead its affirmative defenses to sufficiently put the Petitioner on notice of potential defenses which may be raised." (34 TTABVUE 4.) Thus, "***where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend.***" TBMP § 507.02 & n.9 (emphasis added).

When a defendant responds to a pleading, it must affirmatively state any affirmative defense. Fed. R. Civ. P. 8(c). Because affirmative defenses are pleadings, they are subject to the pleading requirements of the Federal Rules of Civil Procedure and must set forth a "short and plain statement" of that defense. *See, e.g., Heller Fin., Inc. v. Midwhey Powder Co., Inc.*, 883 F.2d 1286, 1294 (7th Cir. 1989). The Supreme Court has explained that to withstand a motion to dismiss under Rule 12(b)(6) of the Federal Rules of Civil Procedure, a plaintiff must plead sufficient facts to "state a claim to relief that is plausible on its face." *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). Under this plausibility standard, a complaint or defense need not contain "detailed factual allegations," but it must contain "more than labels and conclusions" or a "formulaic recitation of the elements of a cause of action." *Id.* at 555.

The Board follows *Twombly* in *inter partes* proceedings (*see, e.g.,* TBMP § 503.02 n.3), and has followed it explicitly or in effect in the context of affirmative defenses. *See, e.g., Southwest Specialty Food Inc. v. Crazy Uncle Jester's Inferno World, LLC*, Cancellation No. 92060809, 16 TTABVUE 6-7 (TTAB June 24, 2016) (striking affirmative defenses as

insufficiently pleaded); *Fashion TV Programmgesellschaft MBH v. Fashion One Television LLC*, Opp. No. 91216413, 14 TTABVUE 6-7 (TTAB July 29, 2015) (striking affirmative defenses as deficiently pleaded); *Mango's Tropical Café, Inc. v. Paradise Restaurant Group, Inc.*, Opp. No. 92055268, 28 TTABVUE 5 (TTAB Oct. 29, 2013) (“Affirmative defenses, like claims in a petition for cancellation, must be supported by enough factual background and detail to fairly place the petitioner on notice of the basis for the defenses.”); *Castro v. Cartwright*, Opp. No. 91188477, 12 TTABVUE 5-8 (TTAB Sept. 5, 2009) (striking affirmative defenses where the applicant provided insufficient support for the defenses); *Veles Int’l Inc. v. Ringing Cedars Press LLC*, Consolidated Opp. Nos. 91182303 and 91182304, 16 TTABVUE 1-5 (TTAB June 2, 2008) (striking affirmative defenses where the applicant provided no specific allegations of conduct in support of its affirmative that would, if proven, prevent the opposer from prevailing on its claim).

TMBP § 311.02(b)(1) states, “The elements of a defense should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense.” See *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009) (claim or defense must be specific enough to provide fair notice to adverse party of restriction being sought); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (elements of each claim should include enough detail to give fair notice of claim); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings “is to give fair notice of the claims or defenses asserted”).

## **B. Argument**

Registrant’s proposed new Third Affirmative Defense states, in full:

Petitioner’s claims are barred, in whole or in part, because Registrant has priority and prior rights through use in commerce, analogous use, and tacking of the

ONEIDA, ONEIDA NATION, and ONEIDA INDIAN NATION names and marks.

(34 TTABVUE 37-38, 73) Registrant also has proposed amendments to other portions of its Answer that reflect this defense.

The Petition here involves three different registrations, directed to both ONEIDA and ONEIDA INDIAN NATION, different relevant goods and services in each of the different registrations, and different bases for cancellation asserted against each of the different registrations. (8 TTABVUE ¶¶ 131-216) Registrant's short and conclusory defense makes no effort to identify which registrations, goods and services, and bases its "defense" applies to. It is not Petitioner's obligation to guess or attempt to tease out what to what registrations and bases Registrant's proposed affirmative defense might apply. Indeed, the proposed Third Affirmative Defense is completely devoid of any allegation of specific facts that, if proved, would prevent Petitioner from prevailing on any of its claims. Instead, the Third Affirmative Defense is entirely conclusory and devoid of any factual support beyond a generalized statement regarding Registrant's use of the names ONEIDA, ONEIDA NATION, and ONEIDA INDIAN NATION, which hardly puts Petitioner on notice of anything since both parties have been using these names for over 100 years (8 TTABVUE ¶ 6).

Accordingly, the Board should deny Registrant's Motion because its proposed new Affirmative Defense fails to follow *Twombly* and fails to provide fair notice of the alleged defense, and therefore serves no useful purpose.

Respectfully submitted,

Date: June 22, 2021

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## **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing PETITIONER'S RESPONSE TO REGISTRANT'S MOTION FOR LEAVE TO AMEND ANSWER TO ASSERT AFFIRMATIVE DEFENSES 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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