

ESTTA Tracking number: **ESTTA1242278**Filing date: **10/18/2022**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	92066411
Party	Plaintiff Oneida Nation
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Date	10/18/2022
Attachments	2022-10-18 Renewed ON Motion for PO.pdf(227806 bytes) 2022-10-18 CRL Decl re Renewed MPO.pdf(82656 bytes) MPO Ex A 2022-04-06 Oneida Nation 30b6 Deposition Notice.pdf(322162 bytes) MPO Ex B 2022-04-08 Email string.pdf(267904 bytes) MPO Ex C 2022-04-15 ON Objections to 30b6 Deposition Notice.pdf(164812 bytes) MPO Ex D 2022-04-25 Email string.pdf(339688 bytes) MPO Ex E 2022-05-04 Email string.pdf(245961 bytes) MPO Ex F 2022-05-13 Revised 30b6 Topics.pdf(130786 bytes) MPO Ex G 2022-05-13 Email string.pdf(292339 bytes) MPO Ex H 2022-05-24 Oneida Nation Objections to Revised 30b6 Deposition Notice.pdf(177278 bytes) MPO Ex I 2022-06-08 Email string.pdf(354841 bytes) MPO Ex J 2022-10-14 Email string.pdf(220447 bytes)

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

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
)	

**PETITIONER/COUNTERCLAIM DEFENDANT’S
MOTION FOR PROTECTIVE ORDER RE RULE 30(b)(6) DEPOSITION**

Pursuant to Fed. R. Civ. P. 26(c), 37 CFR § 2.120(g), and TBMP § 526, Oneida Nation (“Petitioner”) respectfully moves the Board for entry of a protective order limiting the scope of the deposition of Petitioner to be conducted under Oneida Indian Nation’s (“Respondent”) Notice of Deposition under Rule 30(b)(6) to subject matter allowed under the Federal Rules of Civil Procedure and related rules and procedures of the Board. The supporting Declaration of Christopher R. Liro, with exhibits, is filed herewith. In support of this Motion, Petitioner states as follows:

BACKGROUND

Respondent served its Notice to Take Deposition of Petitioner Pursuant to Fed. R. Civ. P. 30(b)(6) on April 6, 2022. (Ex. A.) The notice included a Schedule A including 22 topics for deposition. Thereafter, Petitioner served a set of written objections (see Ex. C), the parties conducted a telephone conference, and Respondent served a revised Schedule A containing a revised set of 26 topics on May 13, 2022 (see Ex. F). The revised set deleted topics 1, 2, 3 and 6 from the original set, renumbered original topics 4, 5, and 7-22 as revised topics 1-18, and added new topics 19-26. Petitioner served objections to the revised set on May 24, 2022 (see Ex. H), including incorporating clarifications and revisions to its original objections made during the meet-and-confer process.

Counsel for Petitioner and Respondent also conducted telephone conferences to discuss scheduling and the scope of the Rule 30(b)(6) depositions on April 14, 2022, May 3, 2022, and May 25, 2022, and exchanged email correspondence. (Liro Decl. ¶¶ 4, 5, 7, 8, 9, 12, 13.) On June 8, 2022, Respondent wrote Petitioner to clarify that it was unwilling to further narrow the topics in its revised set. (*See* Ex. I.)

On June 21, 2022, Petitioner initially filed a motion to compel directed to Respondent's Rule 30(b)(6) deposition (50 TTABVUE), but thereafter withdrew the motion without prejudice (51 TTABVUE) in light of the then-current suspension pending disposition of Petitioner's motion to compel. The Board decided the motion to compel and lifted the suspension on August 23, 2022. (52 TTABVUE.) Subsequently, Petitioner and Respondent conferred by email and were able to resolve some issues, but confirmed that certain other issues remained ripe for resolution by the Board. (Liro Decl. ¶ 15.)

The discovery period in this matter is currently scheduled to close on December 30, 2022. (54 TTABVUE.)

ARGUMENT

The instant motion requests that the Board enter a protective order limiting the scope of the Rule 30(b)(6) witness testimony to the scope defined by Petitioner's narrowing and clarifying objections and Petitioner's further clarifications on the revised topics. Rule 30(b)(6) requires that a notice for a deposition under the rule must describe with "reasonable particularity the matters on which examination is requested." "Courts have strictly enforced that requirement, sometimes characterizing the 'reasonable particularity' requirement as mandating that the topics be designated 'with painstaking specificity.'" *British Telecomms. PLC v. IAC/Interactivecorp.*, 2020 WL 1043974 *2 (D. Del. Mar. 4, 2020) (Bryson, Cir. J.) (quoting *Kalis v. Colgate-Palmolive Co.*, 231 F.3d 1049, 1057 n.5 (7th Cir. 2020) & *Prokash v. Catalina Lighting, Inc.*, 193 F.R.D. 633, 638 (D. Minn. 2000)); *see also Memory Integrity, LLC v. Intel Corp.*, 308 F.R.D. 656, 661 (D. Or. 2015); *Sprint Commc'ns Co. L.P. v. Theglobe.com, Inc.*, 236 F.R.D. 524, 528 (D. Kan. 2006) (To allow Rule 30(b)(6) "to effectively function, the requesting party must take care to designate, with painstaking specificity, the particular subject areas that are intended to be questioned."); *Red Wing Co. v. J.M. Smucker Co.*, 59 U.S.P.Q.2d 1861 (T.T.A.B. 2001) (granting motion for protective order and sustaining objections to certain topics based on inadequate specificity and relevance).

In addition, "[p]arties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit." Fed. R. Civ. P. 26(b)(1); *see also* 37 C.F.R. § 2.120(b)(1). "[T]he scope of discovery in Board proceedings is generally narrower than in court proceedings." *Frito-Lay N. Am. Inc. v. Princeton Vanguard, LLC*, 100 USPQ2d 1904, 1907 (TTAB 2011). Thus, the Board should look

to whether Respondent seeks discovery “that is proportional to the nature and complexity of the case and the history of the proceeding.” *Emilio Pucci Int’l BV v. Sachdev*, 118 USPQ2d 1383, 1386-87 (TTAB 2016). As the party seeking discovery, Respondent has “the burden of showing that its need for the discovery outweighs the burdens and costs of locating, retrieving, and producing the information.” Fed. R. Civ. P. 26(b)(2) (advisory committee’s note to 2006 amendment).

A. Revised Topics 4 and 5 Are Overbroad and Seek Irrelevant Information

Revised Topics 4 and 5 seek testimony on “Petitioner’s knowledge and awareness of Respondent and Respondent’s Marks” and “Petitioner’s knowledge and awareness of any third-party marks comprised of or containing ONEIDA.” (Ex. F.)

As set forth in its objections (Ex. H), Petitioner is willing to provide a witness regarding its general knowledge in these areas, *i.e.*, the knowledge of the individual witnesses. Respondent, however, is not satisfied with general knowledge or witness knowledge and instead seeks comprehensive and unfettered discovery into any knowledge concerning Respondent and “Respondent’s Marks,” defined as the alleged marks ONEIDA, ONEIDA NATION, and ONEIDA INDIAN NATION.

As an initial matter, Respondent seeks broad discovery related to any and all uses of ONEIDA by any party, including Petitioner’s institutional tribal knowledge of such use. What is at issue here, however, are three specific registrations of Respondent for ONEIDA and ONEIDA INDIAN NATION for certain goods and services in certain classes, and one specific registration of Petitioner for a logo incorporating the word ONEIDA for certain goods and services in certain classes. *Petitioner’s knowledge* of uses by Respondent and third parties, however, is not relevant to any party’s claim or defense, and the requests impose an undue burden to prepare a witness that is not proportional to the needs of the case.

While TBMP 414(9) provides, “[i]nformation concerning a party’s awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an involved mark, is discoverable to the extent that the responding party has actual knowledge thereof (without performing an investigation) and that the information appears to be reasonably calculated to lead to the discovery of admissible evidence,” here, Petitioner’s knowledge is not relevant or reasonably calculated to lead to the discovery of admissible evidence. It also is critical that the scope of the topics does not represent a standard commercial situation of reasonable temporal scope, but a truly historical examination of Respondent’s use of ONEIDA and Petitioner’s knowledge of the same going back hundreds of years. Indeed, Petitioner asserts that it would be impossible to somehow investigate and prepare a witness on Petitioner’s entire institutional knowledge of Respondent, Respondent’s use of ONEIDA and related marks, and all other uses by third parties. Accordingly, the Board should enter a protective order limiting the scope of discovery to only general information on these topics known by the individual witnesses, as proposed by Petitioner. (See Ex. H, J.)

B. Revised Topic 6 is Overbroad and Seeks Irrelevant Information

Revised Topic 6 seeks all information related to Petitioner’s U.S. Application No. 88/129469 for ONEIDA DOWNS and “all uses of the ONEIDA DOWNS mark in connection with any goods or services.” (Ex. F.)

The Board should enter a protective order striking this topic. As set forth in its objections (Ex. H), the topic is overbroad as seeking information and details that are not relevant to any party’s claim or defense and imposing a burden that is not proportional to the needs of the case. Critically, this application and the mark ONEIDA DOWNS—which is used as the name of a bingo game offered by Petitioner at its bingo hall—is not relevant to any claim or defense at issue in the

case. Nor does the rest of the scope of the topic, including “all uses of the ONEIDA DOWNS mark in connection with any goods or services,” have any relevance.

Respondent asserts that “Topic 6 is relevant, including because Petitioner's awareness of others’ uses of ONEIDA-formative marks when Petitioner applied for ONEIDA-formative marks tends to disprove Petitioner’s fraud claims.” (Ex. J.) But again, **Petitioner’s** knowledge is not relevant to the question of whether **Respondent** committed fraud when it filed its applications for the registrations at issue years earlier. The Board had consistently acknowledged that there is a material legal distinction between a “false” representation and a “fraudulent” one, the latter involving an intent to deceive. *In re Bose Corp.*, 580 F. 3d 1240, 1243 (Fed. Cir. 2009). Of course, the relevant intent is that of the affiant in the applications for the marks accused of being fraudulently obtained. Here, that affiant is Respondent’s representatives; Petitioner’s knowledge simply is not relevant. *See Oneida Indian Nation v. U.S. Dept. of the Interior*, 336 F. Supp. 3d 37, 46 (N.D.N.Y. 2018) (“The material issue in resolving these trademark fraud claims will be determining whether **Plaintiff** made a ‘false statement with the intent to deceive the [United States Patent and Trademark Office] into issuing or maintaining that registration...’ Here, the Department's decision to approve the OTIW's constitutional amendment to change its name has no bearing on **whether Plaintiff was aware** of the OTIW's use of “Oneida Nation.””) (Emphasis added.)



Petitioner's awareness of others’ uses of ONEIDA-formative marks when Petitioner applied for ONEIDA-formative marks is simply not relevant. Accordingly, the Board should enter a protective order striking this topic.

C. Revised Topics 16 and 17 Are Overbroad and Seek Irrelevant Information

Revised Topics 16 and 17 seek testimony on objections that Petitioner has made against any third party’s use or registration of any names or marks based on “Petitioner’s Marks” and

objections that Petitioner has received from any third party concerning Petitioner's use and/or registration of "Petitioner's Marks." (Ex. F.)

As discussed above, Respondent's definition of "Petitioner's Marks" extends to any and all uses by Petitioner of ONEIDA and any goods and services related to any such uses—far beyond the scope of the relevant registrations at issue in this matter. Further, objections to or from third parties also seeks information not relevant to any party's claims or defense because such objections are not pertinent to either parties' claims at issue, and providing testimony on this subject matter imposes a burden on Petitioner that is not proportional to the needs of the case.

During discussions, Respondent clarified that the topics are directed to Petitioner's Marks (defined only to include ONEIDA, , and ) , and asserted that the topics are relevant to Petitioner's likelihood of confusion claims. (Ex. J.) In light of that, Petitioner offered to provide witnesses as follows, to narrow to the marks and goods and services at issue in the likelihood of confusion claims:

16. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner regarding objections Petitioner has made against any third party's use and/or registration in Petitioner's Goods and Services of any names or marks based in whole or in part on Petitioner's Marks.

17. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner regarding objections Petitioner has received from any third party concerning Petitioner's use and/or registration of Petitioner's Marks in Petitioner's Goods and Services.

(Ex. J.)

Respondent, however, was not willing to accept this more focused scope. (Ex. J.) Accordingly, the Board should enter a protective order either striking these two topics, or limiting to the more-focused subject matter proposed by Petitioner as set forth above.

CONCLUSION AND REQUEST FOR RELIEF

Petitioner respectfully moves the Board to enter a protective order limiting the scope of the noticed Rule 30(b)(6) deposition of Petitioner to that allowed under the federal rules and rules and guidance of the Board, as set forth above.

Petitioner further moves the Board for any other relief it deems appropriate.

Respectfully submitted,

Date: October 18, 2022

/Christopher R. Liro/
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Attorneys for Petitioner Oneida Nation

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served on counsel for Respondent Oneida Indian Nation by forwarding said copy on October 18, 2022, via email to:

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

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
)	

DECLARATION OF CHRISTOPHER R. LIRO

I, Christopher R. Liro, declare as follows:

1. I am an attorney at Andrus Intellectual Property Law, LLP and represent Petitioner Oneida Nation in this matter.
2. I have knowledge of the facts set forth herein and in Petitioner's Motion to Compel.
3. On April 6, 2022, Respondent served its Notice to Take Deposition of Petitioner Pursuant to Red. R. Civ. P. 30(b)(6), attached as Exhibit A.
4. On April 8, 2022, I sent email correspondence to Respondent's counsel, attached as Exhibit B, raising issues regarding deposition scheduling and stating that Petitioner would be providing written objections to the Rule 30(b)(6) topics.

5. On April 14, 2022, my co-counsel representing Petitioner, Aaron Olejniczak, and I conducted a telephone conference with Respondent's counsel Ms. Linda McLeod and Mr. Jason Joyal to discuss deposition scheduling, and I informed Respondent's counsel that Petitioner would provide written objections to the Rule 30(b)(6) topics for further discussion.

6. On April 15, 2022, Petitioner served its written Objections to Respondent's Notice to Take Deposition of Petitioner Pursuant to Red. R. Civ. P. 30(b)(6), attached as Exhibit C.

7. On April 22, 2022, Respondent's counsel sent email correspondence to me regarding the Rule 30(b)(6) deposition, and I responded on April 25, 2022, attached as Exhibit D.

8. On May 3, 2022, Aaron Olejniczak and I conducted a telephone conference with Respondent's counsel Ms. Linda McLeod, Mr. Jason Joyal, and Mr. Saul Cohen to discuss the Rule 30(b)(6) deposition topics and objections thereto.

9. On May 4, 2022, I sent email correspondence to Respondent's counsel, clarifying and revising certain objections to the Rule 30(b)(6) deposition topics, attached as Exhibit E.

10. On May 13, 2022, Respondent served a revised set of Rule 30(b)(6) deposition topics, attached as Exhibit F, forwarded by email, attached as Exhibit G.

11. On May 24, 2022, Petitioner served its written Objections to Respondent's Revised Notice to Take Deposition of Petitioner Pursuant to Red. R. Civ. P. 30(b)(6), attached as Exhibit H.

12. On May 25, 2022, Aaron Olejniczak and I conducted a telephone conference with Respondent's counsel Ms. Linda McLeod, Mr. Jason Joyal, and Mr. Saul Cohen to discuss the revised Rule 30(b)(6) deposition topics and objections thereto.

13. On June 6, 2022, I sent email correspondence to Respondent's counsel requesting further information from Respondent regarding the Rule 30(b)(6) topics, and Respondent's

counsel responded on June 8, 2022, stating that it was not further narrowing any topics, attached as Exhibit I.

14. Notwithstanding the efforts above, the parties were not in agreement regarding the scope of the Rule 30(b)(6) deposition of Petitioner, and Petitioner filed a Motion for Protective Order to address these disputes on June 21, 2022. (50 TTABVUE.) Petitioner thereafter withdrew the motion without prejudice (51 TTABVUE) in light of the then-current suspension pending disposition of Petitioner's earlier-filed motion to compel.

15. The Board decided Petitioner's motion to compel and lifted the suspension on August 23, 2022. (52 TTABVUE.) On August 31, 2022, September 1, 2022, September 12, 2022, September 15, 2022, September 21, 2022, September 29, 2022, October 7, 2022, and October 14, 2022 (see Exhibit J), Petitioner and Respondent conferred by email and were able to resolve some but not all of the issues previously identified and addressed in the withdrawn Motion for Protective Order. This renewed Motion to for Protective Order followed to address the unresolved issues.

16. Pursuant to 37 C.F.R. § 2.120(f) and TBMP § 523.02, Petitioner has made a good faith effort, by conference and correspondence, to resolve with Respondent the issues presented in Petitioner's Motion for Protective Order, as set forth above, but the parties have been unable to reach agreement.

I declare under penalty of perjury that all of the foregoing is true and correct.

Date: October 18, 2022

/Christopher R. Liro/
Christopher R. Liro

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served on counsel for Respondent Oneida Indian Nation by forwarding said copy on October 18, 2022, via email to:

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Exhibit A

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

ONEIDA NATION, Petitioner/Counterclaim Defendant, v. ONEIDA INDIAN NATION, Respondent/Counterclaim Plaintiff.	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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**RESPONDENT/COUNTERCLAIM PLAINTIFF'S NOTICE TO TAKE DEPOSITION OF
PETITIONER/COUNTERCLAIM DEFENDANT
PURSUANT TO FED. R. CIV. P. 30(b)(6)**

PLEASE TAKE NOTICE that pursuant to Fed. R. Civ. P. 30(b)(6), Oneida Indian Nation ("Respondent") will take the deposition by oral examination of Petitioner/Counterclaim Defendant Oneida Nation ("Petitioner"), by and through the owners, officers, directors, agents, or other persons designated as being competent to testify on its behalf with respect to the matters set forth in the attached Schedule A, before a Notary Public or another person qualified by law to administer oaths.

The deposition will commence at 9:30 a.m. on April 22, 2022 at the Hotel Northland, 304 North Adams Street, Green Bay, Wisconsin 54301 or, upon stipulation, by remote audio-video conference via Zoom or other remote audio-video conference means. The deposition will continue from day to day and after hours until completed, and will be recorded by stenographic and/or other means.

Respectfully Submitted,

ONEIDA INDIAN NATION

Dated: April 6, 2022

By: /Linda McLeod/
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Nation

SCHEDULE A

DEFINITIONS AND INSTRUCTIONS

A. As used herein, the words “and,” as well as “or,” shall be construed disjunctively or conjunctively as necessary in order to bring within the scope of the topic all information which might otherwise be construed to be outside its scope.

B. The term “commerce” signifies commerce that the U.S. Congress may lawfully regulate. The phrase “use in commerce” is defined in Section 45 of the Trademark Act, 15 U.S.C. § 1127, to mean that a mark shall be deemed to be in use in commerce “(1) on goods when - (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce, and (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.” The phrase “the date of first use in commerce” is the date when the goods or services were first sold, rendered, offered, or transported in commerce.

C. As used herein, the term “document” includes, but is not limited to, all notes, notations, correspondence, e-mails, web pages, htm/html pages, instant messages, memoranda, invoices, contracts, purchase orders, pamphlets, publications, studies, reports, labels, hang tags, packaging, books, writings, displays, photographs, pictures, drawings, artwork, tear sheets, proofs, sketches, illustrative materials, video

tapes, models, films, magnetic recording tapes, microfilms, electronic data, electronic data compilations and electronic data banks, computer data, computer data compilations and computer data banks, digital documents, digital media, scanned images, and other storage means by which information is retained in retrievable form and all other materials, whether printed, typewritten, handwritten, recorded or reproduced by any mechanical, electronic or magnetic process.


D. The term “person” includes any corporation, division, partnership, association, subsidiary, trust, agency, or other entity, as well as any individual.

E. The term “Petition for Cancellation” refers to the Second Amended Consolidated Petition for Cancellation that Petitioner filed with the Board on March 22, 2018 (Dkt. No. 8).

F. The term “Petitioner” shall mean Petitioner/Counterclaim Defendant Oneida Nation and any division, subsidiary, affiliate, or successor thereof and officers, directors, employees, agents, and representatives thereof.

G. The term “Petitioner’s Answer to Counterclaim” refers to Petitioner’s Answer to Respondent’s Second Amended Counterclaim filed with the Board on October 1, 2021. (Dkt. 41).

H. The term “Petitioner’s Goods and Services” refers to the goods and services identified by Petitioner in response to Interrogatory No. 3 in Respondent’s First Set of Interrogatories.

I. The term “Petitioner’s New Logo” refers to  and variations thereof.

J. The term “Petitioner’s Registered Mark” means the ONEIDA and design



mark shown in Registration No. 3016505, unless otherwise indicated.

K. The term “Petitioner’s Registration” refers to Registration No. 3016505, unless otherwise indicated.

L. The term “Petitioner’s Marks” refers to the marks identified by Petitioner in response to Interrogatory No. 2 in Respondent’s First Set of Interrogatories.

M. The term “referring to” or “relating to” means referring to, relating to, constituting, comprising, concerning, regarding, mentioning, containing, setting forth, showing, disclosing, describing, explaining, summarizing, evidencing, supporting, discussing, either directly or indirectly, in whole or in part, and should be given the broadest possible scope consistent with the Federal Rules of Civil Procedure.

N. The term “Respondent” shall mean Respondent/Counterclaim Plaintiff Oneida Indian Nation and any division, subsidiary, or affiliate thereof and officers, directors, employees, agents, and representatives thereof.

O. The term “Respondent’s Marks” refer to Respondent’s trademarks ONEIDA, ONEIDA NATION, and ONEIDA INDIAN NATION, including the ONEIDA and ONEIDA-formative marks as shown in U.S. Registration Nos. 2309491, 4808677, and 4813028.

P. The term “Respondent’s Second Amended Counterclaim” refers to Respondent’s Second Amended Answer, Affirmative Defenses and Counterclaim filed by Respondent on July 12, 2021 (Dkt. 39) and accepted by the Board as the operative

pleading in this proceeding on September 9, 2021 (Dkt. 40).

Q. As used herein, the singular shall include the plural, and the present tense shall include the past tense, and vice versa.

R. For any term used herein which is not otherwise specifically defined, the common and usual meaning of such term is intended.

Schedule A

TOPICS FOR EXAMINATION

1. Petitioner's responses to Respondent's:
 - a. First Set of Requests for the Production of Documents and Things;
 - b. Second Set of Requests for the Production of Documents and Things;
 - c. First Set of Interrogatories;
 - d. First Set of Requests for Admission; and
 - e. Second Set of Requests for Admission.
2. Petitioner's claims against Respondent for cancellation of Registration Nos. 2309491, 4808677, and 4813028 in the Petition for Cancellation.
3. Petitioner's Answer to Counterclaim, including all affirmative defenses and allegations therein.
4. Petitioner's allegation in Paragraph 188 of the Petition for Cancellation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '677 Registration since before January 26, 2006, the application date of the '677 Registration."
5. Petitioner's allegation in Paragraph 215 of the Petition for Cancellation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '028 Registration since before January 26, 2006, the application date of the '028 Registration."
6. All documents produced by Petitioner in this proceeding.
7. Petitioner's Registration, including all filings, specimens, signatures, declarations, and statements of Petitioner before the USPTO in connection with the prosecution of U.S. Application Serial No. 75575398 and the resulting Registration No. 3016505.
8. Petitioner's knowledge and awareness of Respondent and Respondent's Marks.
9. Petitioner's knowledge and awareness of any third-party marks comprised of or containing ONEIDA.

10. Petitioner's U.S. Application No. 88129469 for ONEIDA DOWNS, including all filings, signatures, specimens, declarations and statements of Petitioner before the USPTO in connection with the prosecution of this application, and all use of the ONEIDA DOWNS mark in connection with any goods or services.
11. Petitioner's decision to transition from use of Petitioner's Registered Mark to Petitioner's New Logo. This topic includes, but is not limited to:
 - a. The reasons and circumstances for creating Petitioner's New Logo;
 - b. The goods and services for which Petitioner has transitioned from Petitioner's Registered Mark to Petitioner's New Logo;
 - c. The goods and services for which Petitioner has not transitioned from Petitioner's Registered Mark to the New Logo; and
 - d. All documents produced by Petitioner regarding (a)-(c) above.
12. Petitioner's allegations in the Petition for Cancellation and Petitioner's Answer to Counterclaim that Petitioner's New Logo gives the same continuing commercial impression as Petitioner's Registered Mark.
13. Petitioner's first use of each of Petitioner's Marks in connection with each of Petitioner's Goods and Services.
14. Petitioner's use, intent to use, and any non-use of Petitioner's Marks in commerce. This topic includes, but is not limited to:
 - a. Each product and service ever advertised, promoted, offered for sale, sold, or intended to be advertised, promoted, offered for sale, or sold in connection with each of Petitioner's Marks;
 - b. The nature and extent of use of Petitioner's Marks; and
 - c. Any periods of non-use of any of Petitioner's Marks.
15. All types of media (e.g., newspapers, magazines, trade journals, direct mail advertising, radio, television, and the Internet) in which Petitioner has promoted or advertised Petitioner's Goods and Services in connection with Petitioner's Marks or any other name or mark containing "ONEIDA."
16. All types of media (e.g., newspapers, magazines, trade journals, direct mail advertising, radio, television, and the Internet) in which Petitioner is currently promoting or advertising Petitioner's Goods and Services in connection with Petitioner's Marks or any other name or mark containing "ONEIDA."

17. Petitioner's sales revenues and advertising expenses related to Petitioner's Goods and Services offered under or in connection with Petitioner's Marks.
18. The nature and extent of advertising and promotion related to Petitioner's Goods and Services offered under or in connection with Petitioner's Marks.
19. Agreements between Petitioner and any third party concerning the use and/or registration of Petitioner's Marks.
20. Objections Petitioner has made against any third party's use and/or registration of any names or marks based in whole or in part on Petitioner's Marks.
21. Objections Petitioner has received from any third party concerning Petitioner's use and/or registration of Petitioner's Marks.
22. Petitioner's efforts to comply with Respondent's discovery requests. This topic includes, but is not limited to:
 - a. Petitioner's searches for documents responsive to Respondent's Requests for the Production of Documents and Things.
 - b. Investigations conducted by Petitioner to answer Respondent's Interrogatories and Requests for Admission.

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing RESPONDENT/
COUNTERCLAIM PLAINTIFF'S NOTICE TO TAKE DEPOSITION OF PETITIONER/
COUNTERCLAIM DEFENDANT PURSUANT TO FED. R. CIV. P. 30(b)(6) was served
by email on this 6th day of April, 2022 upon Petitioner's counsel at the following email
addresses of record:

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

/Saul Cohen/
Saul Cohen

Exhibit B

Chris Liro

From: Chris Liro
Sent: Friday, April 8, 2022 2:04 PM
To: Linda McLeod; Jason Joyal
Cc: Rob Litowitz; Lauren Jancuska; Larry White; Aaron Olejniczak; Marie Mikolainis; Saul Cohen
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Linda and Jason,

We are in receipt of Oneida Indian Nation's deposition notice served August 6, 2022, purporting to notice a Rule 30(b)(6) deposition of Oneida Nation on April 22, 2022.

We note that contrary to Board guidance (TBMP 404.05 ("It is strongly recommended that the deposing party contact the party sought to be deposed (or whose officer, director, etc., is sought to be deposed) well in advance of the proposed deposition in order to arrange a mutually convenient time for the deposition.")), you made no attempt to schedule the deposition before sending the notice.

Regardless, due to scheduling conflicts of both Aaron and I and Oneida Nation's in-house counsel, as well as the short notice period provided to identify and prepare appropriate witness(es), Oneida Nation cannot produce a responsive witness or witnesses on April 22. We will serve a formal set of objections, addressing both the date and the topics' compliance with Rule 30(b)(6), next week.

We also note that Jason's March 29 email suggested, with respect to deposition scheduling, "regrouping on a workable schedule for the involved witnesses and counsel" and "if need be, OIN will consent to continue the discovery cutoff for the limited purpose of completing noticed depositions." Also, while we appreciate that Oneida Nation's recently filed motion to compel does not automatically stay the noticed depositions, we believe it would be more efficient for both parties to defer the depositions until after the motion is decided. Would you be available for a call next week to discuss, in general terms, scheduling of the noticed depositions?

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Saul Cohen <Saul.Cohen@kelly-ip.com>
Sent: Wednesday, April 6, 2022 7:01 PM
To: Chris Liro <chris.liro@andruslaw.com>; Marie Mikolainis <mariem@andruslaw.com>; Cathy MacArthur <cathym@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>
Cc: Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Larry White <Larry.White@kelly-ip.com>
Subject: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Counsel,

Please see the attached deposition notice in the above-referenced matter.

Best regards,
Saul

Saul Cohen | *Associate*
1300 19th Street, NW, Suite 300
Washington, DC 20036
202-808-3570 (Main)
202-908-4785 (Direct)
202-210-8323 (Cell)
202-354-5232 (Fax)

saul.cohen@kelly-ip.com
www.kelly-ip.com



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Exhibit C

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

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
)	

**PETITIONER/COUNTERCLAIM DEFENDANT’S OBJECTIONS TO
RESPONDENT/COUNTERCLAIM PLAINTIFF’S
NOTICE TO TAKE DEPOSITION OF
PETITIONER/COUNTERCLAIM DEFENDANT
PURSUANT TO FED. R. CIV. P. 30(b)(6)**

Pursuant to Fed. R. Civ. P. 26 and 30(b)(6), and TBMP § 404.08, and Oneida Nation (“Petitioner”) provides its objections to Oneida Indian Nation’s (“Respondent”) Notice to Take Deposition of Petition/Counterclaim Defendant Pursuant to Fed. R. Civ. P. 30(b)(6), served April 6, 2022 (“Respondent’s 30(b)(6) Notice”), as follows:

GENERAL OBJECTIONS

Petitioner objects to Respondent’s 30(b)(6) Notice in general as calling for information that is subject to attorney-client privilege and/or attorney work product doctrine.

Petitioner objects to Respondent's 30(b)(6) Notice to the extent that it imposes burdens on Petitioner beyond those encompassed by the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Federal Rules of Civil Procedure.

Petitioner objects to Respondent's 30(b)(6) Notice to the extent that the listed topics seek information that is not relevant to any party's claim or defense and proportional to the needs of the case.

Petitioner objects to Respondent's 30(b)(6) Notice to the extent that the listed topics are overly broad and unduly burdensome or seek information that is extraneous to this lawsuit.

Petitioner objects to Respondent's 30(b)(6) Notice to the extent that the listed topics are vague, ambiguous and worded in such a manner that Petitioner is unable to make an appropriate response.

Petitioner objects to Respondent's 30(b)(6) Notice to the extent that the listed topics are misleading, presume the existence of facts not in evidence, or attempt to mischaracterize the evidence.

Petitioner objects to Respondent's definition of "Petitioner's Marks" as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case, as further set forth in Petitioner's response to Interrogatory No. 2.

Petitioner objects to Respondent's definition of "Petitioner's Goods and Services" as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case, as further set forth below in Petitioner's response to Interrogatory No. 3.

In making these objections, Petitioner does not waive, but on the contrary, expressly preserves all questions of competency, relevancy, materiality, privilege and admissibility of

evidence; the right to object on any ground through the use of any response or the subject matter thereof; and the right to object on any ground at any time, to a demand for further responses to these or other discovery requests.

Petitioner's responses to Respondent's 30(b)(6) Notice shall not be deemed to constitute admissions that any particular information is relevant, non-privileged or admissible in evidence; and any statement or characterization in Respondent's 30(b)(6) Notice is accurate or complete; or that any statement contained in that document is true.

INCORPORATION OF GENERAL OBJECTIONS

The general objections noted above are hereby incorporated in full in each of the individual responses below. Petitioner does not waive the above noted general objections in response to any specific request propounded. Further, a specific objection made by Petitioner does not limit or modify the general objections stated herein.

TIME AND PLACE

Petitioner objects to producing witness(es) on April 22, 2022 for failure to provide reasonable written notice. The parties conferred on April 14, 2022, and have agreed to schedule depositions and mutually agreeable times.

RESPONSES AND OBJECTIONS TO TOPICS FOR EXAMINATION

1. Petitioner's responses to Respondent's:
 - a. First Set of Requests for the Production of Documents and Things;
 - b. Second Set of Requests for the Production of Documents and Things;
 - c. First Set of Interrogatories;
 - d. First Set of Requests for Admission; and
 - e. Second Set of Requests for Admission.

RESPONSE: Petitioner objects to topic 1 as failing to comply with Rule 30(b)(6) for failing to describe with reasonable particularity the matters for examination and for being vague and over-broad.

2. Petitioner's claims against Respondent for cancellation of Registration Nos. 2309491, 4808677, and 4813028 in the Petition for Cancellation.

RESPONSE: Petitioner objects to topic 2 as failing to comply with Rule 30(b)(6) for failing to describe with reasonable particularity the matters for examination and for being vague and over-broad.

3. Petitioner's Answer to Counterclaim, including all affirmative defenses and allegations therein.

RESPONSE: Petitioner objects to topic 3 as failing to comply with Rule 30(b)(6) for failing to describe with reasonable particularity the matters for examination and for being vague and over-broad.

4. Petitioner's allegation in Paragraph 188 of the Petition for Cancellation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '677 Registration since before January 26, 2006, the application date of the '677 Registration."

RESPONSE: Petitioner objects to topic 4 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to

testify regarding facts known to Petitioner related to Petitioner's use and priority regarding relevant marks and relevant goods and services.

5. Petitioner's allegation in Paragraph 215 of the Petition for Cancellation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '028 Registration since before January 26, 2006, the application date of the '028 Registration."

RESPONSE: Petitioner objects to topic 5 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner's use and priority regarding relevant marks and relevant goods and services.

6. All documents produced by Petitioner in this proceeding.

RESPONSE: Petitioner objects to topic 6 as failing to comply with Rule 30(b)(6) for failing to describe with reasonable particularity the matters for examination and for being vague and over-broad.

7. Petitioner's Registration, including all filings, specimens, signatures, declarations, and statements of Petitioner before the USPTO in connection with the prosecution of U.S. Application Serial No. 75575398 and the resulting Registration No. 3016505.

RESPONSE: Petitioner objects to topic 7 to the extent it calls for subject matter protected by the attorney-client privilege. Subject to its general and specific objections, Petitioner will

present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner's use and priority regarding relevant marks and goods and services.

8. Petitioner's knowledge and awareness of Respondent and Respondent's Marks.

RESPONSE: Petitioner objects to topic 8 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case.

9. Petitioner's knowledge and awareness of any third-party marks comprised of or containing ONEIDA.

RESPONSE: Petitioner objects to topic 9 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case.

10. Petitioner's U.S. Application No. 88129469 for ONEIDA DOWNS, including all filings, signatures, specimens, declarations and statements of Petitioner before the USPTO in connection with the prosecution of this application, and all use of the ONEIDA DOWNS mark in connection with any goods or services.

RESPONSE: Petitioner objects to topic 10 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case.

11. Petitioner's decision to transition from use of Petitioner's Registered Mark to Petitioner's New Logo. This topic includes, but is not limited to:

- a. The reasons and circumstances for creating Petitioner's New Logo;
- b. The goods and services for which Petitioner has transitioned from Petitioner's Registered Mark to Petitioner's New Logo;
- c. The goods and services for which Petitioner has not transitioned from Petitioner's Registered Mark to the New Logo; and
- d. All documents produced by Petitioner regarding (a)-(c) above.

RESPONSE: Subject to its general objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to this topic.

12. Petitioner's allegations in the Petition for Cancellation and Petitioner's Answer to Counterclaim that Petitioner's New Logo gives the same continuing commercial impression as Petitioner's Registered Mark.

RESPONSE: Petitioner objects to topic 12 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to this topic.

13. Petitioner's first use of each of Petitioner's Marks in connection with each of Petitioner's Goods and Services.

RESPONSE: Petitioner objects to topic 13 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks and Petitioner's Goods and Services are applied, and specifically incorporates its objections to such definitions. Subject to its general and specific objections, Petitioner will

present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner's first use regarding relevant marks and relevant goods and services.

14. Petitioner's use, intent to use, and any non-use of Petitioner's Marks in commerce.

This topic includes, but is not limited to:

- a. Each product and service ever advertised, promoted, offered for sale, sold, or intended to be advertised, promoted, offered for sale, or sold in connection with each of Petitioner's Marks;
- b. The nature and extent of use of Petitioner's Marks; and
- c. Any periods of non-use of any of Petitioner's Marks.

RESPONSE: Petitioner objects to topic 14 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definition of Petitioner's Marks is applied, and specifically incorporates its objections to such definition, and for seeking information on goods and services beyond those relevant to this proceeding. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner's use of relevant marks in relevant goods and services

15. All types of media (e.g., newspapers, magazines, trade journals, direct mail advertising, radio, television, and the Internet) in which Petitioner has promoted or advertised Petitioner's Goods and Services in connection with Petitioner's Marks or any other name or mark containing "ONEIDA."

RESPONSE: Petitioner objects to topic 15 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not

proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks and Petitioner's Goods and Services are applied, and specifically incorporates its objections to such definitions, and for seeking information on "any other name or mark containing "ONEIDA." Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to types of media in which Petitioner has promoted relevant goods and services under the relevant marks.

16. All types of media (e.g., newspapers, magazines, trade journals, direct mail advertising, radio, television, and the Internet) in which Petitioner is currently promoting or advertising Petitioner's Goods and Services in connection with Petitioner's Marks or any other name or mark containing "ONEIDA."

RESPONSE: Petitioner objects to topic 16 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks and Petitioner's Goods and Services are applied, and specifically incorporates its objections to such definitions, and for seeking information on "any other name or mark containing "ONEIDA." Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to types of media in which Petitioner has promoted relevant goods and services under the relevant marks.

17. Petitioner's sales revenues and advertising expenses related to Petitioner's Goods and Services offered under or in connection with Petitioner's Marks.

RESPONSE: Petitioner objects to topic 17 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not

proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks and Petitioner's Goods and Services are applied, and specifically incorporates its objections to such definitions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner's sales revenues and advertising expenses for relevant goods and services under the relevant marks.

18. The nature and extent of advertising and promotion related to Petitioner's Goods and Services offered under or in connection with Petitioner's Marks.

RESPONSE: Petitioner objects to topic 18 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks and Petitioner's Goods and Services are applied, and specifically incorporates its objections to such definitions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the nature and extent of advertising and promotion for relevant goods and services under the relevant marks.

19. Agreements between Petitioner and any third party concerning the use and/or registration of Petitioner's Marks.

RESPONSE: Petitioner objects to topic 19 to the extent it calls for subject matter protected by the attorney-client privilege, and as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks is applied, and specifically incorporates its objections to such definition. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known

to Petitioner related to Agreements between Petitioner and any third party concerning the use and/or registration of relevant marks.

20. Objections Petitioner has made against any third party's use and/or registration of any names or marks based in whole or in part on Petitioner's Marks.

RESPONSE: Petitioner objects to topic 20 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case.

21. Objections Petitioner has received from any third party concerning Petitioner's use and/or registration of Petitioner's Marks.

RESPONSE: Petitioner objects to topic 21 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case.

22. Petitioner's efforts to comply with Respondent's discovery requests. This topic includes, but is not limited to:

- a. Petitioner's searches for documents responsive to Respondent's Requests for the Production of Documents and Things.
- b. Investigations conducted by Petitioner to answer Respondent's Interrogatories and Requests for Admission.

RESPONSE: Petitioner objects to topic 22 to the extent it calls for subject matter protected by the attorney-client privilege, and as overbroad as seeking information and details that

are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case.

Respectfully submitted,

Date: April 15, 2022

/Christopher R. Liro/
Christopher R. Liro
chris.liro@andruslaw.com
Aaron T. Olejniczak
aaron@andruslaw.com
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 has been served on counsel for Respondent Oneida Indian Nation by forwarding said copy on April 15, 2022, via email to:

Linda K. McLeod
linda.mcleod@kelly-ip.com
Robert D. Litowitz
rob.litowitz@kelly-ip.com
Jason Joyal
jason.joyal@kelly-ip.com
Saul Cohen
saul.cohen@kelly-ip.com
Lauren Jancuska,
lauren.jancuska@kelly-ip.com
Kelly IP, LLP
1300 19th St., N.W., Suite 300
Washington, D.C. 20036

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

Exhibit D

Chris Liro

From: Chris Liro
Sent: Monday, April 25, 2022 9:11 AM
To: Jason Joyal; Saul Cohen; Linda McLeod; Rob Litowitz; Lauren Jancuska
Cc: Larry White; Marie Mikolainis; Aaron Olejniczak
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Jason,

Thank you for your email. However, your civil procedure tutorial is unnecessary. I certainly already understand that if the parties do not come to an agreement on the scope of the 30(b)(6) deposition, the appropriate procedure will be for Oneida Nation to seek a protective order from the Board. I already indicated on the phone when we spoke that I expected that the parties would need to confer on this. And contrary to your assertion that the written objections are "improper," such written objections are a common mechanism for documenting a party's objections and positions in advance of such discussions.

We will get back to you regarding a proposed time to discuss the topics.

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Jason Joyal <Jason.Joyal@kelly-ip.com>
Sent: Friday, April 22, 2022 6:00 PM
To: Chris Liro <chris.liro@andruslaw.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>
Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aaron@andruslaw.com>
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Chris,

We write regarding discovery in the above-referenced case.

Discovery deadlines

As discussed on our April 14th call last week, the parties agreed to suspend all noticed depositions until the TTAB rules on the pending motion to compel. We will agree to work together to find mutually agreeable deposition dates when the time comes. This also confirms that we consented to an extension of time for the Wisconsin to respond to our discovery letter up to and including April 26th, and that you consented to a two-week extension of time for our client to serve responses and objections to outstanding discovery requests up to and including May 11, 2022.

Respondent's 30(b)(6) deposition notice to Petitioner

We served a 30(b)(6) deposition notice on your client on April 6. Last Friday, you sent us objections to that notice. The objections make clear that your client intends not to produce any witness to testify regarding Topics 1-3, 6, 8-10, and 20-

22. (With respect to other topics, Petitioner says that it “will present one or more witnesses” and states the bounds that Petitioner is purporting to impose on those other topics. With respect to Topics 1-3, 6, 8-10, and 20-22, Petitioner simply objects.) And Petitioner is purporting to modify the scope of every other topic with the exceptions of Topics 11 and 12.

These objections and purported modifications are improper and have no legal effect. Unlike with objections to requests for production, interrogatories, or requests for admission, “there is no provision in the rules which provides for a party whose deposition is noticed to serve objections so as to be able to avoid providing the requested discovery until an order compelling discovery is issued.” *New England Carpenters Health Benefits Fund v. First DataBank, Inc.*, 242 F.R.D. 164, 165-66 (D. Mass. 2007) (footnote omitted)). Petitioner thus “cannot make its objections [to a 30(b)(6) deposition notice] and then provide a witness that will testify only within the scope of its objections.” *Beach Mart, Inc. v. L&L Wings, Inc.*, 302 F.R.D. 396, 406 (E.D.N.C. 2014). Unless and until Petitioner receives a Board order excusing its compliance with any portion of the deposition notice, Petitioner is obligated to “designate a person to testify regarding each topic” that Petitioner propounded. See *Talon Transaction Techs., Inc. v. Stoneeagle Servs., Inc.*, 2014 WL 6819846, at *2 (N.D. Tex. Dec. 4, 2014) (emphasis added).

Instead of dictating objections and modifications, your client has a duty to “confer in good faith about the matters for examination.” Fed. R. Civ. P. 30(b)(6). Accordingly, please let us know when you are available to discuss the topics designated in the 30(b)(6) notice.

Regards,

Jason

Jason M. Joyal | Partner

202-559-1498 (Direct)

202-302-9155 (Cell)

jason.joyal@kelly-ip.com

The logo for Kelly IP, featuring the word "Kelly" in a red serif font and "IP" in a smaller, red sans-serif font.

From: Chris Liro <chris.liro@andruslaw.com>

Sent: Friday, April 15, 2022 4:31 PM

To: Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>

Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Counsel,

Please find attached petitioner’s objections to the April 6 deposition notice.

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Saul Cohen <Saul.Cohen@kelly-ip.com>

Sent: Wednesday, April 6, 2022 7:01 PM

To: Chris Liro <chris.liro@andruslaw.com>; Marie Mikolainis <mariem@andruslaw.com>; Cathy MacArthur <cathym@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>

Cc: Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Larry White <Larry.White@kelly-ip.com>

Subject: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Counsel,

Please see the attached deposition notice in the above-referenced matter.

Best regards,
Saul

Saul Cohen | Associate
1300 19th Street, NW, Suite 300
Washington, DC 20036
202-808-3570 (Main)
202-908-4785 (Direct)
202-210-8323 (Cell)
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Exhibit E

Chris Liro

From: Chris Liro
Sent: Wednesday, May 4, 2022 2:02 PM
To: Jason Joyal; Saul Cohen; Linda McLeod
Cc: Larry White; Marie Mikolainis; Aaron Olejniczak; Rob Litowitz; Lauren Jancuska
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Dear Linda, Jason, and Saul,

Per our May 3 telephone conference, I'm writing regarding several of the Rule 30(b)(6) topics that we discussed.

1. As discussed, there are a number of topics for which Petitioner objected to the topic as overbroad, and responded that we would provide a witness to testify regarding "relevant marks and relevant goods and services." As noted in the general objections, this response relates to objections to the defined terms "Petitioner's Marks" and "Petitioner's Goods and Services." Our objections to the notice refer to our objections to Interrogatories Nos. 2 and 3, as the definitions in the notice expressly refer to those interrogatories. As stated in the interrogatory answers, "the full scope of products and services ever advertised, promoted, offered for sale, sold, or intended to be advertised, promoted, offered for sale, or sold in connection with the relevant marks is not relevant to this case other than with respect to the specific marks, goods and services, and time period material to Petitioner's Section 2(d) claims against Respondent's Registration Nos. 4,808,677 and 4,813,028 and Respondent's abandonment claim against Petitioner's Registration No. 3,016,505." As such, by "relevant marks and relevant goods and services," we mean (1) Oneida Nation's "eagle logo" of the '505 registration, including the updated version of the logo, relative to the goods and services recited in the '505 registration, and (2) ONEIDA and ONEIDA-formative marks more generally with respect to the recited goods and services of the '677 and '028 registrations.

2. Petitioner revises its responses to Topics 4, 5, and 7 as follows:

Revised Response to Topic 4: Petitioner objects to topic 4 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the allegation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '677 Registration since before January 26, 2006, the application date of the '677 Registration."

Revised Response to Topic 5: Petitioner objects to topic 4 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the allegation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '028 Registration since before January 26, 2006, the application date of the '028 Registration."

Revised Response to Topic 7: Petitioner objects to topic 7 to the extent it calls for subject matter protected by the attorney-client privilege. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner's Registration, including all filings, specimens, signatures, declarations, and statements of Petitioner before the USPTO in connection with the prosecution of U.S. Application Serial No. 75575398 and the resulting Registration No. 3016505.

We look forward to hearing from you regarding any remaining areas of dispute.

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Jason Joyal <Jason.Joyal@kelly-ip.com>

Sent: Friday, April 29, 2022 12:40 PM

To: Chris Liro <chris.liro@andruslaw.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>

Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Thanks, Chris. How about Tuesday at 1pm?

Jason M. Joyal | *Partner*

202-559-1498 (Direct)

202-302-9155 (Cell)

jason.joyal@kelly-ip.com

The logo for Kelly IP, featuring the word "Kelly" in a red serif font and "IP" in a smaller, red sans-serif font.

From: Chris Liro <chris.liro@andruslaw.com>

Sent: Thursday, April 28, 2022 10:34 AM

To: Jason Joyal <Jason.Joyal@kelly-ip.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>

Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Jason and Linda,

We are mostly available next Monday and Tuesday for a meet and confer on the 30(b)(6) notice, if you have time available then.

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

Exhibit F

SCHEDULE A

DEFINITIONS AND INSTRUCTIONS

A. As used herein, the words “and,” as well as “or,” shall be construed disjunctively or conjunctively as necessary in order to bring within the scope of the topic all information which might otherwise be construed to be outside its scope.

B. The term “commerce” signifies commerce that the U.S. Congress may lawfully regulate. The phrase “use in commerce” is defined in Section 45 of the Trademark Act, 15 U.S.C. § 1127, to mean that a mark shall be deemed to be in use in commerce “(1) on goods when - (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce, and (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.” The phrase “the date of first use in commerce” is the date when the goods or services were first sold, rendered, offered, or transported in commerce.

C. As used herein, the term “document” includes, but is not limited to, all notes, notations, correspondence, e-mails, web pages, htm/html pages, instant messages, memoranda, invoices, contracts, purchase orders, pamphlets, publications, studies, reports, labels, hang tags, packaging, books, writings, displays, photographs, pictures, drawings, artwork, tear sheets, proofs, sketches, illustrative materials, video

tapes, models, films, magnetic recording tapes, microfilms, electronic data, electronic data compilations and electronic data banks, computer data, computer data compilations and computer data banks, digital documents, digital media, scanned images, and other storage means by which information is retained in retrievable form and all other materials, whether printed, typewritten, handwritten, recorded or reproduced by any mechanical, electronic or magnetic process.

D. The term “person” includes any corporation, division, partnership, association, subsidiary, trust, agency, or other entity, as well as any individual.

E. The term “Petition for Cancellation” refers to the Second Amended Consolidated Petition for Cancellation that Petitioner filed with the Board on March 22, 2018 (Dkt. No. 8).

F. The term “Petitioner” shall mean Petitioner/Counterclaim Defendant Oneida Nation and any division, subsidiary, affiliate, or successor thereof and officers, directors, employees, agents, and representatives thereof.

G. The term “Petitioner’s Answer to Counterclaim” refers to Petitioner’s Answer to Respondent’s Second Amended Counterclaim filed with the Board on October 1, 2021. (Dkt. 41).

H. The term “Petitioner’s Goods and Services” refers to the goods and services identified by Petitioner in response to Interrogatory No. 3 in Respondent’s First Set of Interrogatories.

I. The term “Petitioner’s New Logo” refers to



and variations

thereof.

J. The term “Petitioner’s Registered Mark” means the ONEIDA and design



mark shown in Registration No. 3016505, unless otherwise indicated.

K. The term “Petitioner’s Registration” refers to Registration No. 3016505, unless otherwise indicated.

L. The term “Petitioner’s Marks” refers to the marks identified by Petitioner in response to Interrogatory No. 2 in Respondent’s First Set of Interrogatories.

M. The term “referring to” or “relating to” means referring to, relating to, constituting, comprising, concerning, regarding, mentioning, containing, setting forth, showing, disclosing, describing, explaining, summarizing, evidencing, supporting, discussing, either directly or indirectly, in whole or in part, and should be given the broadest possible scope consistent with the Federal Rules of Civil Procedure.

N. The term “Respondent” shall mean Respondent/Counterclaim Plaintiff Oneida Indian Nation and any division, subsidiary, or affiliate thereof and officers, directors, employees, agents, and representatives thereof.

O. The term “Respondent’s Marks” refer to Respondent’s trademarks ONEIDA, ONEIDA NATION, and ONEIDA INDIAN NATION, including the ONEIDA and ONEIDA-formative marks as shown in U.S. Registration Nos. 2309491, 4808677, and 4813028.

P. The term “Respondent’s Second Amended Counterclaim” refers to Respondent’s Second Amended Answer, Affirmative Defenses and Counterclaim filed by Respondent on July 12, 2021 (Dkt. 39) and accepted by the Board as the operative

pleading in this proceeding on September 9, 2021 (Dkt. 40).

Q. As used herein, the singular shall include the plural, and the present tense shall include the past tense, and vice versa.

R. For any term used herein which is not otherwise specifically defined, the common and usual meaning of such term is intended.

Schedule A

TOPICS FOR EXAMINATION

1. Petitioner's allegation in Paragraph 188 of the Petition for Cancellation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '677 Registration since before January 26, 2006, the application date of the '677 Registration."
2. Petitioner's allegation in Paragraph 215 of the Petition for Cancellation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '028 Registration since before January 26, 2006, the application date of the '028 Registration."
3. Petitioner's Registration, including all filings, specimens, signatures, declarations, and statements of Petitioner before the USPTO in connection with the prosecution of U.S. Application Serial No. 75575398 and the resulting Registration No. 3016505.
4. Petitioner's knowledge and awareness of Respondent's use of Respondent's Marks.
5. Petitioner's knowledge and awareness of any third-party marks comprised of or containing ONEIDA.
6. Petitioner's U.S. Application No. 88129469 for ONEIDA DOWNS, including all filings, signatures, specimens, declarations and statements of Petitioner before the USPTO in connection with the prosecution of this application, and all use of the ONEIDA DOWNS mark in connection with any goods or services.
7. Petitioner's decision to transition from use of Petitioner's Registered Mark to Petitioner's New Logo. This topic includes, but is not limited to:
 - a. The reasons and circumstances for creating Petitioner's New Logo;
 - b. The goods and services for which Petitioner has transitioned from Petitioner's Registered Mark to Petitioner's New Logo;
 - c. The goods and services for which Petitioner has not transitioned from Petitioner's Registered Mark to the New Logo; and
 - d. All documents produced by Petitioner regarding (a)-(c) above.

8. Petitioner's allegations in the Petition for Cancellation and Petitioner's Answer to Counterclaim that Petitioner's New Logo gives the same continuing commercial impression as Petitioner's Registered Mark.
9. Petitioner's first use of each of Petitioner's Marks in connection with each of Petitioner's Goods and Services.
10. Petitioner's use, intent to use, and any non-use of Petitioner's Marks in commerce. This topic includes, but is not limited to:
 - a. Each product and service ever advertised, promoted, offered for sale, sold, or intended to be advertised, promoted, offered for sale, or sold in connection with each of Petitioner's Marks;
 - b. The nature and extent of use of Petitioner's Marks; and
 - c. Any periods of non-use of any of Petitioner's Marks.
11. All types of media (e.g., newspapers, magazines, trade journals, direct mail advertising, radio, television, and the Internet) in which Petitioner has promoted or advertised Petitioner's Goods and Services in connection with Petitioner's Marks or any other name or mark containing "ONEIDA."
12. All types of media (e.g., newspapers, magazines, trade journals, direct mail advertising, radio, television, and the Internet) in which Petitioner is currently promoting or advertising Petitioner's Goods and Services in connection with Petitioner's Marks or any other name or mark containing "ONEIDA."
13. Petitioner's sales revenues and advertising expenses related to Petitioner's Goods and Services offered under or in connection with Petitioner's Marks.
14. The nature and extent of advertising and promotion related to Petitioner's Goods and Services offered under or in connection with Petitioner's Marks.
15. Agreements between Petitioner and any third party concerning the use and/or registration of Petitioner's Marks.
16. Objections Petitioner has made against any third party's use and/or registration of any names or marks based in whole or in part on Petitioner's Marks.
17. Objections Petitioner has received from any third party concerning Petitioner's use and/or registration of Petitioner's Marks.
18. Petitioner's efforts to comply with Respondent's discovery requests. This topic includes, but is not limited to:
 - a. Petitioner's searches for documents responsive to Respondent's

Requests for the Production of Documents and Things.

- b. Investigations conducted by Petitioner to answer Respondent's Interrogatories and Requests for Admission.

19. All facts that Petitioner contends support its claims for fraud. This topic includes, but is not limited to:

- a. All facts that Petitioner contends support its claims that "Registrant committed fraud in the procurement of its registration or during the prosecution of its application for registration" for the '491 Registration, the '677 Registration, and the '028 Registration.
- b. All facts that Petitioner contends support its claims that "Registrant committed fraud in the ... renewal[s] of its registration" for the '491 Registration.
- c. All facts that Petitioner contends support its claims that "Registrant committed fraud when filing its Statement of Use" for the '677 Registration and the '028 Registration.

20. All facts that Petitioner contends support its claims for abandonment regarding the '491 Registration, the '677 Registration, and the '028 Registration.

21. All facts that Petitioner contends support its claims "there was no bona fide intent to use of the ONEIDA mark in commerce prior to the filing of the intent-to-use-based application" for the '677 Registration and the '028 Registration.

22. All facts that Petitioner contends support its claims that "there was no bona fide use of the ONEIDA mark in commerce at the time Registrant filed its Statement of Use" for the '677 Registration and the '028 Registration.

23. All facts that Petitioner contends support its claims for "[n]o [u]se as a [t]rademark" of the '677 Registration and the '028 Registration.

24. All facts that Petitioner contends support its claims "[t]hat defendant's mark so resembles a mark registered in the Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive" with respect to the '677 Registration and the '028 Registration.

25. All facts that Petitioner contends support its allegation that Respondent's "claims are barred, in whole or in part, based on the doctrines of laches, acquiescence, waiver, and/or estoppel."

26. All facts that Petitioner contends support its allegation that Petitioner has not

abandoned Petitioner's Registered Mark.

Exhibit G

Chris Liro

From: Saul Cohen <Saul.Cohen@kelly-ip.com>
Sent: Friday, May 13, 2022 12:11 PM
To: Chris Liro; Jason Joyal; Linda McLeod
Cc: Larry White; Marie Mikolainis; Aaron Olejniczak; Rob Litowitz; Lauren Jancuska; Jill Jansen
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)
Attachments: Revised 30(b)(6) Topics (1526048xD1162).pdf

Chris,

A revised set of 30(b)(6) deposition topics is attached.

Best,
Saul

Saul Cohen | *Associate*
1300 19th Street, NW, Suite 420
Washington, DC 20036
202-808-3570 (Main)
202-908-4785 (Direct)
202-210-8323 (Cell)
202-354-5232 (Fax)

saul.cohen@kelly-ip.com
www.kelly-ip.com



From: Saul Cohen <Saul.Cohen@kelly-ip.com>
Sent: Wednesday, May 11, 2022 1:16 PM
To: Chris Liro <chris.liro@andruslaw.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>
Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aaron@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Jill Jansen <Jillj@andruslaw.com>
Subject: Re: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Chris,

We're planning to provide a revised set of topics soon.

Best,
Saul

Saul Cohen | *Associate*
1300 19th Street, NW, Suite 420
Washington, DC 20036
202-808-3570 (Main)
202-908-4785 (Direct)
202-210-8323 (Cell)
202-354-5232 (Fax)



From: Chris Liro <chris.liro@andruslaw.com>
Sent: Wednesday, May 11, 2022 11:30 AM
To: Jason Joyal <Jason.Joyal@kelly-ip.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>
Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Jill Jansen <Jillj@andruslaw.com>
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Linda, Jason, and Saul,

With respect to the 30(b)(6) notice, do you have any reactions to the below, adjustments to the topics, acceptance of the scope set forth in our objections to any of the topics, or other feedback that would potentially focus the scope of any dispute and potential motion for protective order? We also are available for another telephone conference if helpful.

Chris

Christopher R. Liro
Attorney
Andrus Intellectual Property Law, LLP
p 414.271.7590 m 414.308.2466

From: Chris Liro
Sent: Wednesday, May 4, 2022 2:02 PM
To: Jason Joyal <Jason.Joyal@kelly-ip.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>
Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Dear Linda, Jason, and Saul,

Per our May 3 telephone conference, I'm writing regarding several of the Rule 30(b)(6) topics that we discussed.

1. As discussed, there are a number of topics for which Petitioner objected to the topic as overbroad, and responded that we would provide a witness to testify regarding "relevant marks and relevant goods and services." As noted in the general objections, this response relates to objections to the defined terms "Petitioner's Marks" and "Petitioner's Goods and Services." Our objections to the notice refer to our objections to Interrogatories Nos. 2 and 3, as the definitions in the notice expressly refer to those interrogatories. As stated in the interrogatory answers, "the full scope of products and services ever advertised, promoted, offered for sale, sold, or intended to be advertised, promoted, offered for sale, or sold in connection with the relevant marks is not relevant to this case other than with respect to the specific marks, goods and services, and time period material to Petitioner's Section 2(d) claims against Respondent's Registration Nos. 4,808,677 and 4,813,028 and Respondent's abandonment claim against Petitioner's Registration No. 3,016,505." As such, by "relevant marks and relevant goods and services," we mean (1) Oneida Nation's "eagle logo" of the '505

registration, including the updated version of the logo, relative to the goods and services recited in the '505 registration, and (2) ONEIDA and ONEIDA-formative marks more generally with respect to the recited goods and services of the '677 and '028 registrations.

2. Petitioner revises its responses to Topics 4, 5, and 7 as follows:

Revised Response to Topic 4: Petitioner objects to topic 4 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the allegation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '677 Registration since before January 26, 2006, the application date of the '677 Registration."

Revised Response to Topic 5: Petitioner objects to topic 4 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the allegation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '028 Registration since before January 26, 2006, the application date of the '028 Registration."

Revised Response to Topic 7: Petitioner objects to topic 7 to the extent it calls for subject matter protected by the attorney-client privilege. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner's Registration, including all filings, specimens, signatures, declarations, and statements of Petitioner before the USPTO in connection with the prosecution of U.S. Application Serial No. 75575398 and the resulting Registration No. 3016505.

We look forward to hearing from you regarding any remaining areas of dispute.

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Jason Joyal <Jason.Joyal@kelly-ip.com>

Sent: Friday, April 29, 2022 12:40 PM

To: Chris Liro <chris.liro@andruslaw.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>

Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Thanks, Chris. How about Tuesday at 1pm?

Jason M. Joyal | *Partner*

202-559-1498 (Direct)

202-302-9155 (Cell)

jason.joyal@kelly-ip.com

Kelly^{IP}

From: Chris Liro <chris.liro@andruslaw.com>
Sent: Thursday, April 28, 2022 10:34 AM
To: Jason Joyal <Jason.Joyal@kelly-ip.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>
Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Jason and Linda,
We are mostly available next Monday and Tuesday for a meet and confer on the 30(b)(6) notice, if you have time available then.
Chris

Christopher R. Liro
Attorney
Andrus Intellectual Property Law, LLP
p 414.271.7590 m 414.308.2466

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Exhibit H

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

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
)	

**PETITIONER/COUNTERCLAIM DEFENDANT’S OBJECTIONS TO
RESPONDENT/COUNTERCLAIM PLAINTIFF’S
REVISED NOTICE TO TAKE DEPOSITION OF
PETITIONER/COUNTERCLAIM DEFENDANT
PURSUANT TO FED. R. CIV. P. 30(b)(6)**

Pursuant to Fed. R. Civ. P. 26 and 30(b)(6), and TBMP § 404.08, and Oneida Nation (“Petitioner”) provides its objections to Oneida Indian Nation’s (“Respondent”) Notice to Take Deposition of Petition/Counterclaim Defendant Pursuant to Fed. R. Civ. P. 30(b)(6), served April 6, 2022 and revised May 13, 2022 (“Respondent’s 30(b)(6) Notice”), as follows:

GENERAL OBJECTIONS

Petitioner objects to Respondent’s 30(b)(6) Notice in general as calling for information that is subject to attorney-client privilege and/or attorney work product doctrine.

Petitioner objects to Respondent's 30(b)(6) Notice to the extent that it imposes burdens on Petitioner beyond those encompassed by the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Federal Rules of Civil Procedure.

Petitioner objects to Respondent's 30(b)(6) Notice to the extent that the listed topics seek information that is not relevant to any party's claim or defense and proportional to the needs of the case.

Petitioner objects to Respondent's 30(b)(6) Notice to the extent that the listed topics are overly broad and unduly burdensome or seek information that is extraneous to this lawsuit.

Petitioner objects to Respondent's 30(b)(6) Notice to the extent that the listed topics are vague, ambiguous and worded in such a manner that Petitioner is unable to make an appropriate response.

Petitioner objects to Respondent's 30(b)(6) Notice to the extent that the listed topics are misleading, presume the existence of facts not in evidence, or attempt to mischaracterize the evidence.

Petitioner objects to Respondent's definition of "Petitioner's Marks" as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case, as further set forth in Petitioner's response to Interrogatory No. 2.

Petitioner objects to Respondent's definition of "Petitioner's Goods and Services" as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case, as further set forth below in Petitioner's response to Interrogatory No. 3.

As stated in the responses to Interrogatory Nos. 2 and 3, "the full scope of products and services ever advertised, promoted, offered for sale, sold, or intended to be advertised, promoted,

offered for sale, or sold in connection with the relevant marks is not relevant to this case other than with respect to the specific marks, goods and services, and time period material to Petitioner's Section 2(d) claims against Respondent's Registration Nos. 4,808,677 and 4,813,028 and Respondent's abandonment claim against Petitioner's Registration No. 3,016,505." As such, by "relevant marks and relevant goods and services" set forth below, Petitioner means (1) Oneida Nation's "eagle logo" of the '505 registration, including the updated version of the logo, relative to the goods and services recited in the '505 registration, and (2) ONEIDA and ONEIDA-formative marks more generally with respect to the recited goods and services of the '677 and '028 registrations.

In making these objections, Petitioner does not waive, but on the contrary, expressly preserves all questions of competency, relevancy, materiality, privilege and admissibility of evidence; the right to object on any ground through the use of any response or the subject matter thereof; and the right to object on any ground at any time, to a demand for further responses to these or other discovery requests.

Petitioner's responses to Respondent's 30(b)(6) Notice shall not be deemed to constitute admissions that any particular information is relevant, non-privileged or admissible in evidence; and any statement or characterization in Respondent's 30(b)(6) Notice is accurate or complete; or that any statement contained in that document is true.

INCORPORATION OF GENERAL OBJECTIONS

The general objections noted above are hereby incorporated in full in each of the individual responses below. Petitioner does not waive the above noted general objections in response to any specific request propounded. Further, a specific objection made by Petitioner does not limit or modify the general objections stated herein.

TIME AND PLACE

Petitioner objects to producing witness(es) on April 22, 2022 for failure to provide reasonable written notice. The parties conferred on April 14, 2022, and have agreed to schedule depositions and mutually agreeable times.

RESPONSES AND OBJECTIONS TO REVISED TOPICS FOR EXAMINATION

1. Petitioner's allegation in Paragraph 188 of the Petition for Cancellation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '677 Registration since before January 26, 2006, the application date of the '677 Registration."

RESPONSE: Petitioner objects to topic 1 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the allegation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '677 Registration since before January 26, 2006, the application date of the '677 Registration."

2. Petitioner's allegation in Paragraph 215 of the Petition for Cancellation that "Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant's [Respondent's] '028 Registration since before January 26, 2006, the application date of the '028 Registration."

RESPONSE: Petitioner objects to topic 2 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to

testify regarding facts known to Petitioner related to the allegation that “Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant’s [Respondent’s] ‘028 Registration since before January 26, 2006, the application date of the ‘028 Registration.”

3. Petitioner’s Registration, including all filings, specimens, signatures, declarations, and statements of Petitioner before the USPTO in connection with the prosecution of U.S. Application Serial No. 75575398 and the resulting Registration No. 3016505.

RESPONSE: Petitioner objects to topic 3 to the extent it calls for subject matter protected by the attorney-client privilege. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner’s Registration, including all filings, specimens, signatures, declarations, and statements of Petitioner before the USPTO in connection with the prosecution of U.S. Application Serial No. 75575398 and the resulting Registration No. 3016505.

4. Petitioner’s knowledge and awareness of Respondent and Respondent’s Marks.

RESPONSE: Petitioner objects to topic 4 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden to prepare a witness that is not proportional to the needs of the case. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding Petitioner’s general knowledge of Respondent’s use of Respondent’s Marks.

5. Petitioner's knowledge and awareness of any third-party marks comprised of or containing ONEIDA.

RESPONSE: Petitioner objects to topic 5 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden to prepare a witness that is not proportional to the needs of the case. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding Petitioner's general knowledge of third-party marks comprised of or containing ONEIDA.

6. Petitioner's U.S. Application No. 88129469 for ONEIDA DOWNS, including all filings, signatures, specimens, declarations and statements of Petitioner before the USPTO in connection with the prosecution of this application, and all use of the ONEIDA DOWNS mark in connection with any goods or services.

RESPONSE: Petitioner objects to topic 6 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case.

7. Petitioner's decision to transition from use of Petitioner's Registered Mark to Petitioner's New Logo. This topic includes, but is not limited to:

- a. The reasons and circumstances for creating Petitioner's New Logo;
- b. The goods and services for which Petitioner has transitioned from Petitioner's Registered Mark to Petitioner's New Logo;
- c. The goods and services for which Petitioner has not transitioned from Petitioner's Registered Mark to the New Logo; and
- d. All documents produced by Petitioner regarding (a)-(c) above.

RESPONSE: Subject to its general objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to this topic.

8. Petitioner's allegations in the Petition for Cancellation and Petitioner's Answer to Counterclaim that Petitioner's New Logo gives the same continuing commercial impression as Petitioner's Registered Mark.

RESPONSE: Petitioner objects to topic 8 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to this topic.

9. Petitioner's first use of each of Petitioner's Marks in connection with each of Petitioner's Goods and Services.

RESPONSE: Petitioner objects to topic 9 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks and Petitioner's Goods and Services are applied, and specifically incorporates its objections to such definitions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner's first use regarding relevant marks and relevant goods and services.

10. Petitioner's use, intent to use, and any non-use of Petitioner's Marks in commerce. This topic includes, but is not limited to:

- a. Each product and service ever advertised, promoted, offered for sale, sold, or intended to be advertised, promoted, offered for sale, or sold in connection with each of Petitioner's Marks;
- b. The nature and extent of use of Petitioner's Marks; and
- c. Any periods of non-use of any of Petitioner's Marks.

RESPONSE: Petitioner objects to topic 10 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definition of Petitioner's Marks is applied, and specifically incorporates its objections to such definition, and for seeking information on goods and services beyond those relevant to this proceeding. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner's use of relevant marks in relevant goods and services.

11. All types of media (e.g., newspapers, magazines, trade journals, direct mail advertising, radio, television, and the Internet) in which Petitioner has promoted or advertised Petitioner's Goods and Services in connection with Petitioner's Marks or any other name or mark containing "ONEIDA."

RESPONSE: Petitioner objects to topic 11 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks and Petitioner's Goods and Services are applied, and specifically incorporates its objections to such definitions, and for seeking information on "any other name or mark containing "ONEIDA." Subject to its general and specific objections, Petitioner will present one

or more witnesses to testify regarding facts known to Petitioner related to types of media in which Petitioner has promoted relevant goods and services under the relevant marks.

12. All types of media (e.g., newspapers, magazines, trade journals, direct mail advertising, radio, television, and the Internet) in which Petitioner is currently promoting or advertising Petitioner's Goods and Services in connection with Petitioner's Marks or any other name or mark containing "ONEIDA."

RESPONSE: Petitioner objects to topic 12 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks and Petitioner's Goods and Services are applied, and specifically incorporates its objections to such definitions, and for seeking information on "any other name or mark containing "ONEIDA." Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to types of media in which Petitioner has promoted relevant goods and services under the relevant marks.

13. Petitioner's sales revenues and advertising expenses related to Petitioner's Goods and Services offered under or in connection with Petitioner's Marks.

RESPONSE: Petitioner objects to topic 13 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks and Petitioner's Goods and Services are applied, and specifically incorporates its objections to such definitions. Subject to its general and specific objections, Petitioner will

present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner's sales revenues and advertising expenses for relevant goods and services under the relevant marks.

14. The nature and extent of advertising and promotion related to Petitioner's Goods and Services offered under or in connection with Petitioner's Marks.

RESPONSE: Petitioner objects to topic 14 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks and Petitioner's Goods and Services are applied, and specifically incorporates its objections to such definitions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the nature and extent of advertising and promotion for relevant goods and services under the relevant marks.

15. Agreements between Petitioner and any third party concerning the use and/or registration of Petitioner's Marks.

RESPONSE: Petitioner objects to topic 15 to the extent it calls for subject matter protected by the attorney-client privilege, and as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case to the extent Respondent's overbroad definitions of Petitioner's Marks is applied, and specifically incorporates its objections to such definition. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to Agreements between Petitioner and any third party concerning the use and/or registration of relevant marks.

16. Objections Petitioner has made against any third party's use and/or registration of any names or marks based in whole or in part on Petitioner's Marks.

RESPONSE: Petitioner objects to topic 16 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case.

17. Objections Petitioner has received from any third party concerning Petitioner's use and/or registration of Petitioner's Marks.

RESPONSE: Petitioner objects to topic 17 as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case.

18. Petitioner's efforts to comply with Respondent's discovery requests. This topic includes, but is not limited to:

- a. Petitioner's searches for documents responsive to Respondent's Requests for the Production of Documents and Things.
- b. Investigations conducted by Petitioner to answer Respondent's Interrogatories and Requests for Admission.

RESPONSE: Petitioner objects to topic 18 to the extent it calls for subject matter protected by the attorney-client privilege, and as overbroad as seeking information and details that are not relevant to any party's claim or defense and imposing a burden that is not proportional to the needs of the case.

19. All facts that Petitioner contends support its claims for fraud. This topic includes, but is not limited to:

- a. All facts that Petitioner contends support its claims that “Registrant committed fraud in the procurement of its registration or during the prosecution of its application for registration” for the ‘491 Registration, the ‘677 Registration, and the ‘028 Registration.
- b. All facts that Petitioner contends support its claims that “Registrant committed fraud in the ... renewal[s] of its registration” for the ‘491 Registration.
- c. All facts that Petitioner contends support its claims that “Registrant committed fraud when filing its Statement of Use” for the ‘677 Registration and the ‘028 Registration.

RESPONSE: Petitioner objects to topic 19 as tendered after the close of discovery, seeking legal conclusions, imposing a burden to prepare a witness that is not proportional to the needs of the case, directed to attorney work product, and not providing appropriate Rule 30(b)(6) testimony. This topic is not directed to discovery of facts known to Petitioner outside the context of this proceeding, but rather to Petitioner’s legal contentions regarding facts entirely related to Respondent’s own conduct.

20. All facts that Petitioner contends support its claims for abandonment regarding the ‘491 Registration, the ‘677 Registration, and the ‘028 Registration.

RESPONSE: Petitioner objects to topic 20 as tendered after the close of discovery, seeking legal conclusions, imposing a burden to prepare a witness that is not proportional to the needs of the case, directed to attorney work product, and not providing appropriate Rule 30(b)(6) testimony. This topic is not directed to discovery of facts known to Petitioner outside the context of this proceeding, but rather to Petitioner’s legal contentions regarding facts entirely related to Respondent’s own conduct.

21. All facts that Petitioner contends support its claims “there was no bona fide intent to use of the ONEIDA mark in commerce prior to the filing of the intent-to-use-based application” for the ‘677 Registration and the ‘028 Registration.

RESPONSE: Petitioner objects to topic 21 as tendered after the close of discovery, seeking legal conclusions, imposing a burden to prepare a witness that is not proportional to the needs of the case, directed to attorney work product, and not providing appropriate Rule 30(b)(6) testimony. This topic is not directed to discovery of facts known to Petitioner outside the context of this proceeding, but rather to Petitioner’s legal contentions regarding facts entirely related to Respondent’s own conduct.

22. All facts that Petitioner contends support its claims that “there was no bona fide use of the ONEIDA mark in commerce at the time Registrant filed its Statement of Use” for the ‘677 Registration and the ‘028 Registration.

RESPONSE: Petitioner objects to topic 22 as tendered after the close of discovery, seeking legal conclusions, imposing a burden to prepare a witness that is not proportional to the needs of the case, directed to attorney work product, and not providing appropriate Rule 30(b)(6) testimony. This topic is not directed to discovery of facts known to Petitioner outside the context of this proceeding, but rather to Petitioner’s legal contentions regarding facts entirely related to Respondent’s own conduct.

23. All facts that Petitioner contends support its claims for “[n]o [u]se as a [t]rademark” of the ‘677 Registration and the ‘028 Registration.

RESPONSE: Petitioner objects to topic 23 as tendered after the close of discovery, seeking legal conclusions, imposing a burden to prepare a witness that is not proportional to the needs of the case, directed to attorney work product, and not providing appropriate Rule 30(b)(6) testimony. This topic is not directed to discovery of facts known to Petitioner outside the context of this proceeding, but rather to Petitioner's legal contentions regarding facts entirely related to Respondent's own conduct.

24. All facts that Petitioner contends support its claims "[t]hat defendant's mark so resembles a mark registered in the Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive" with respect to the '677 Registration and the '028 Registration.

RESPONSE: Petitioner objects to topic 24 as tendered after the close of discovery and for seeking legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the allegations "[t]hat defendant's mark so resembles a mark registered in the Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive" with respect to the '677 Registration and the '028 Registration.

25. All facts that Petitioner contends support its allegation that Respondent's "claims are barred, in whole or in part, based on the doctrines of laches, acquiescence, waiver, and/or estoppel.

RESPONSE: Petitioner objects to topic 25 as tendered after the close of discovery and for seeking legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the allegation that Respondent's "claims are barred, in whole or in part, based on the doctrines of laches, acquiescence, waiver, and/or estoppel."

26. All facts that Petitioner contends support its allegation that Petitioner has not abandoned Petitioner's Registered Mark.

RESPONSE: Petitioner objects to topic 26 as tendered after the close of discovery and for seeking legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the allegation that Petitioner has not abandoned Petitioner's Registered Mark.

Respectfully submitted,

Date: May 24, 2022

/Christopher R. Liro/
Christopher R. Liro
chris.liro@andruslaw.com
Aaron T. Olejniczak
aaron@andruslaw.com
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 has been served on counsel for Respondent Oneida Indian Nation by forwarding said copy on May 24, 2022, via email to:

Linda K. McLeod
linda.mcleod@kelly-ip.com
Robert D. Litowitz
rob.litowitz@kelly-ip.com
Jason Joyal
jason.joyal@kelly-ip.com
Saul Cohen
saul.cohen@kelly-ip.com
Lauren Jancuska,
lauren.jancuska@kelly-ip.com
Kelly IP, LLP
1300 19th St., N.W., Suite 300
Washington, D.C. 20036

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

Exhibit I

Chris Liro

From: Saul Cohen <Saul.Cohen@kelly-ip.com>
Sent: Wednesday, June 8, 2022 4:03 PM
To: Chris Liro; Linda McLeod
Cc: Jason Joyal; Larry White; Marie Mikolainis; Aaron Olejniczak; Rob Litowitz; Lauren Jancuska; Jill Jansen; cathym@andruslaw.com
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)
Attachments: Respondent's Supplemental Objections and Responses to Second Set of Document Requests (1538338xD1162).pdf

Chris,

We respond substantively below, but first briefly address some of your statements.

- It is not correct that OIN only "identified a single example" of a compound RFA on our May 25 call. In addition to identifying language that rendered RFA No. 7 compound (which also appeared in multiple other RFAs), we also identified the "was using and had used" language, which did not appear in RFA No. 7 but which did appear in 43 other RFAs, rendering them compound. You have since remedied these issues.
- Our recap of the call was not a "self-serving characterization rather than an objective description of the call." It would have been premature to discuss limitations to the 30(b)(6) deposition topics before you had responded regarding whether ON would be willing to provide interrogatory answers in lieu of deposition testimony for any topics. We also never suggested that our May 25 email was a complete summary of the call. Rather, it was a follow-up email on issues we wanted to discuss further.
- It is incorrect to say that our email is "misleading[]" because 30(b)(6) topics 19 through 26 "clearly are new and not 'modifications' of the original topics." Topics 19 through 26 seek information about ON's claims and defenses, with each category of claim and defense broken out into its own topic. They replace topics 2 and 3 from OIN's original set, which also sought information about ON's claims and defenses, but did so without listing out each category.

Requests for Admission

We have reviewed the amended set of RFAs. OIN will not object on the ground that they exceed the permissible number of requests allowed under 37 C.F.R. § 2.120(i) and TBMP § 407.05(a).

30(b)(6) Deposition Topics

OIN believes that its 30(b)(6) deposition topics are proper and declines to narrow them further.

Further, your objection that OIN's modified deposition topics were "tendered after the close of discovery" along with your refusal to commit to refrain from arguing that any modified topics were "tendered too late" places OIN in a catch-22. If OIN revises its topics further in an effort to compromise, it risks that ON will argue that such a revised set is too late. For example, if OIN were to argue that ON's amended RFAs were served too late after inducing ON to amend them, you would rightly see that as unfair gamesmanship.

Request for Production No. 23

On our May 25 call, you discussed ON's position on OIN's objections to RFP 23. In an effort to avoid any further dispute on this issue, OIN serves the attached supplemental response to RFP 23 and will produce responsive documents, to the extent any responsive, non-privileged documents exist that OIN has not already produced.

Best,
Saul

Saul Cohen | *Associate*
1300 19th Street, NW, Suite 420
Washington, DC 20036
202-808-3570 (Main)
202-908-4785 (Direct)
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202-354-5232 (Fax)

saul.cohen@kelly-ip.com
www.kelly-ip.com

The logo for Kelly IP, featuring the word "Kelly" in a large, red, serif font, with "IP" in a smaller, red, sans-serif font to its upper right.

From: Chris Liro <chris.liro@andruslaw.com>
Sent: Monday, June 6, 2022 5:15 PM
To: Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>
Cc: Jason Joyal <Jason.Joyal@kelly-ip.com>; Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Jill Jansen <Jillj@andruslaw.com>
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Saul,

With respect to ON's requests for admission, we note that OIN identified a single example during our discussion, number 7. We also disagree that most of ON's requests contained multiple subparts. Nonetheless, in an effort to resolve the dispute, please find attached an amended set together with a redline showing the changes made. Please confirm this resolves the issue and promptly provide your responses.

With respect to the 30(b)(6) topics, during the May 25 call OIN represented that it had not had an opportunity to fully consider ON's written objections to OIN's revised set of topics, and would let us know if OIN agreed to limit the scope of testimony for any of the topics subject to the objection for the topic. You did not include that in the summary of the call below, which seems to be OIN's self-serving characterization rather than an objective description of the call. Please let us know if OIN agrees to limit the scope of testimony for any of the topics.

With respect to the written objections that certain topics were tendered after the close of discovery, we note that that objection was not stated for all of the revised topics as your email misleadingly suggests, but only for topics 19 through 26, which clearly are new and not "modifications" of the original topics. As I further explained on the call, the objection would have been more clearly stated as tendered too late in the discovery period such that a response cannot reasonably be provided before the close of discovery. As I mentioned during the call, we do not expect to raise that point with the Board if we move for a protective order. However, we see no need to make a binding commitment to the content of any motion we may file, or understand OIN's conditioning its "continued participation in the meet and confer process" on such a commitment.

With respect to the topics directed to contentions related to OIN's conduct, we do not agree to substitute an interrogatory response.

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Saul Cohen <Saul.Cohen@kelly-ip.com>

Sent: Wednesday, May 25, 2022 8:26 PM

To: Chris Liro <chris.liro@andruslaw.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>

Cc: Jason Joyal <Jason.Joyal@kelly-ip.com>; Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Jill Jansen <Jillj@andruslaw.com>

Subject: Re: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Chris,

As we discussed earlier today, please let us know whether there are any 30(b)(6) deposition topics for which ON would be willing to provide interrogatory answers in lieu of deposition testimony, and OIN will assess whether it is willing to substitute an interrogatory for a deposition topic.

We also discussed ON's contention that OIN's modified 30(b)(6) topics are "tendered after the close of discovery." As we noted, that is wrong, as discovery has not closed. That contention was also particularly surprising given that OIN modified its topics in an attempt to resolve ON's objections as to the purported overbreadth of OIN's topics. ON should not use OIN's good faith participation in the meet and confer process as a "gotcha" to claim OIN's deposition topics are late. You suggested on the call that ON would not assert in a motion that OIN's modified topics are late. For avoidance of doubt, and to facilitate OIN's continued participation in the meet and confer process regarding the 30(b)(6) topics, please confirm that, if OIN decides to modify any deposition topics in response to ON's objections, ON will deem those modified topics to have been served on April 6, 2022, when OIN initially served its deposition notice.

We also discussed OIN's objection that ON's RFAs exceed the 75 RFA limit, and gave examples of ON's compound RFAs. In response to your suggestion that OIN also served compound RFAs, we explained that even if we agreed (which we do not), OIN only served seven RFAs and thus could not have exceeded the 75 RFA limit even if some of OIN's RFAs had contained multiple subparts. ON, by contrast, served (nominally) 64 RFAs, most of which contain multiple subparts. As we noted, ON may serve revised RFAs to resolve OIN's objection, and OIN will tell you promptly if it believes ON has not cured the issue.

Best regards,
Saul

Saul Cohen | Associate

1300 19th Street, NW, Suite 420

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Kelly^{IP}

From: Saul Cohen <Saul.Cohen@kelly-ip.com>
Sent: Friday, May 20, 2022 4:57 PM
To: Chris Liro <chris.liro@andruslaw.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>
Cc: Jason Joyal <Jason.Joyal@kelly-ip.com>; Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Jill Jansen <jillj@andruslaw.com>
Subject: Re: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

That works.

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From: Chris Liro <chris.liro@andruslaw.com>
Sent: Friday, May 20, 2022 4:40 PM
To: Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>
Cc: Jason Joyal <Jason.Joyal@kelly-ip.com>; Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Jill Jansen <jillj@andruslaw.com>
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Saul,
We have another meeting that will conflict with Wednesday at 2 Eastern. Can you do Wednesday at 3 Eastern?
Chris

Christopher R. Liro
Attorney
Andrus Intellectual Property Law, LLP
p 414.271.7590 m 414.308.2466

From: Saul Cohen <Saul.Cohen@kelly-ip.com>
Sent: Friday, May 20, 2022 3:23 PM
To: Linda McLeod <Linda.McLeod@kelly-ip.com>; Chris Liro <chris.liro@andruslaw.com>
Cc: Jason Joyal <Jason.Joyal@kelly-ip.com>; Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Jill Jansen <jillj@andruslaw.com>
Subject: Re: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Chris,

We're available on Wednesday at 2pm eastern. If that works for you, please send us a calendar invite.

Thanks,
Saul

Saul Cohen | Associate
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From: Linda McLeod <Linda.McLeod@kelly-ip.com>
Sent: Friday, May 20, 2022 7:08 AM
To: Chris Liro <chris.liro@andruslaw.com>
Cc: Saul Cohen <Saul.Cohen@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Jill Jansen <Jillj@andruslaw.com>
Subject: Re: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Chris,

We received your message and will circle back on proposed time/date.

Best regards,

Linda K. McLeod
Attorney at Law
Kelly IP, LLP
1300 19th Street, NW
Suite 300
Washington, DC 20036
(202) 808-3574 | Office
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linda.mcleod@kelly-ip.com
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On May 19, 2022, at 4:25 PM, Chris Liro <chris.liro@andruslaw.com> wrote:

Linda, Jason, and Saul,

I'm writing to request a "meet and confer" next week on several discovery issues. Specifically:

1. OIN's revised Rule 30(b)(6) topics.
2. OIN's "general objection" to Petitioner's first set of requests for admission.
3. OIN's response and objections to Petitioner's request for production no. 23.

Please let us know your availability any of Monday afternoon, Tuesday, or Wednesday afternoon. Thank you.

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Saul Cohen <Saul.Cohen@kelly-ip.com>

Sent: Friday, May 13, 2022 12:11 PM

To: Chris Liro <chris.liro@andruslaw.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>

Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Jill Jansen <Jillj@andruslaw.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Chris,

A revised set of 30(b)(6) deposition topics is attached.

Best,
Saul

Saul Cohen | *Associate*

1300 19th Street, NW, Suite 420

Washington, DC 20036

202-808-3570 (Main)

202-908-4785 (Direct)

202-210-8323 (Cell)

202-354-5232 (Fax)

saul.cohen@kelly-ip.com

www.kelly-ip.com

The logo for Kelly IP, featuring the word "Kelly" in a large, red, serif font, with "IP" in a smaller, red, sans-serif font to its upper right.

From: Saul Cohen <Saul.Cohen@kelly-ip.com>

Sent: Wednesday, May 11, 2022 1:16 PM

To: Chris Liro <chris.liro@andruslaw.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>

Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Jill Jansen <Jillj@andruslaw.com>

Subject: Re: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Chris,

We're planning to provide a revised set of topics soon.

Best,
Saul

Saul Cohen | Associate
1300 19th Street, NW, Suite 420
Washington, DC 20036
202-808-3570 (Main)
202-908-4785 (Direct)
202-210-8323 (Cell)
202-354-5232 (Fax)

saul.cohen@kelly-ip.com
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From: Chris Liro <chris.liro@andruslaw.com>
Sent: Wednesday, May 11, 2022 11:30 AM
To: Jason Joyal <Jason.Joyal@kelly-ip.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>
Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; Jill Jansen <Jillj@andruslaw.com>
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Linda, Jason, and Saul,

With respect to the 30(b)(6) notice, do you have any reactions to the below, adjustments to the topics, acceptance of the scope set forth in our objections to any of the topics, or other feedback that would potentially focus the scope of any dispute and potential motion for protective order? We also are available for another telephone conference if helpful.

Chris

Christopher R. Liro
Attorney
Andrus Intellectual Property Law, LLP
p 414.271.7590 m 414.308.2466

From: Chris Liro
Sent: Wednesday, May 4, 2022 2:02 PM
To: Jason Joyal <Jason.Joyal@kelly-ip.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>
Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>
Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Dear Linda, Jason, and Saul,

Per our May 3 telephone conference, I'm writing regarding several of the Rule 30(b)(6) topics that we discussed.

1. As discussed, there are a number of topics for which Petitioner objected to the topic as overbroad, and responded that we would provide a witness to testify regarding “relevant marks and relevant goods and services.” As noted in the general objections, this response relates to objections to the defined terms “Petitioner’s Marks” and “Petitioner’s Goods and Services.” Our objections to the notice refer to our objections to Interrogatories Nos. 2 and 3, as the definitions in the notice expressly refer to those interrogatories. As stated in the interrogatory answers, “the full scope of products and services ever advertised, promoted, offered for sale, sold, or intended to be advertised, promoted, offered for sale, or sold in connection with the relevant marks is not relevant to this case other than with respect to the specific marks, goods and services, and time period material to Petitioner’s Section 2(d) claims against Respondent’s Registration Nos. 4,808,677 and 4,813,028 and Respondent’s abandonment claim against Petitioner’s Registration No. 3,016,505.” As such, by “relevant marks and relevant goods and services,” we mean (1) Oneida Nation’s “eagle logo” of the ‘505 registration, including the updated version of the logo, relative to the goods and services recited in the ‘505 registration, and (2) ONEIDA and ONEIDA-formative marks more generally with respect to the recited goods and services of the ‘677 and ‘028 registrations.

2. Petitioner revises its responses to Topics 4, 5, and 7 as follows:

Revised Response to Topic 4: Petitioner objects to topic 4 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the allegation that “Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant’s [Respondent’s] ‘677 Registration since before January 26, 2006, the application date of the ‘677 Registration.”

Revised Response to Topic 5: Petitioner objects to topic 4 to the extent it calls for legal conclusions. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to the allegation that “Petitioner has priority in the ONEIDA mark because it has continuously used the ONEIDA mark to identify the source of goods and services the same as and/or highly related to the goods and services of Applicant’s [Respondent’s] ‘028 Registration since before January 26, 2006, the application date of the ‘028 Registration.”

Revised Response to Topic 7: Petitioner objects to topic 7 to the extent it calls for subject matter protected by the attorney-client privilege. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner related to Petitioner’s Registration, including all filings, specimens, signatures, declarations, and statements of Petitioner before the USPTO in connection with the prosecution of U.S. Application Serial No. 75575398 and the resulting Registration No. 3016505.

We look forward to hearing from you regarding any remaining areas of dispute.

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Jason Joyal <Jason.Joyal@kelly-ip.com>

Sent: Friday, April 29, 2022 12:40 PM

To: Chris Liro <chris.liro@andruslaw.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>

Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Thanks, Chris. How about Tuesday at 1pm?

Jason M. Joyal | *Partner*

202-559-1498 (Direct)

202-302-9155 (Cell)

jason.joyal@kelly-ip.com



From: Chris Liro <chris.liro@andruslaw.com>

Sent: Thursday, April 28, 2022 10:34 AM

To: Jason Joyal <Jason.Joyal@kelly-ip.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>

Cc: Larry White <Larry.White@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation (Cancellation No. 92066411)

Jason and Linda,

We are mostly available next Monday and Tuesday for a meet and confer on the 30(b)(6) notice, if you have time available then.

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

Disclaimer

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Disclaimer

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Exhibit J

Chris Liro

From: Chris Liro
Sent: Friday, October 14, 2022 1:59 PM
To: 'Saul Cohen'; 'Linda McLeod'; 'Rob Litowitz'; 'Jason Joyal'; 'Lit Docketing'
Cc: Aaron Olejniczak; Andrus Litigation; 'Larry White'; 'Lauren Jancuska'; 'OneidaTTAB'; Andrus Litigation
Subject: RE: Oneida Nation v. Oneida Indian Nation, Cancellation No. 92066411 (TTAB) - Discovery Requests

Saul,

We agree that the parties are at an impasse as to Topics 4-6 and 16-17, but that there is no longer a dispute as to Revised Topics 1-3, 6, 9-15, and 18, and New Topics 19-23.

We feel that the parties have adequately discussed the still-unresolved issues and the matters do not need further direct discussions, but if you do not agree please let us know. Otherwise, we'll proceed to file on Topics 4-6 and 16-17.

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Chris Liro
Sent: Wednesday, October 12, 2022 2:05 PM
To: 'Saul Cohen' <Saul.Cohen@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Lit Docketing <lit-docketing@kelly-ip.com>
Cc: Aaron Olejniczak <aarono@andruslaw.com>; Andrus Litigation <litigation@andruslaw.com>; Larry White <Larry.White@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; OneidaTTAB <OneidaTTAB@kelly-ip.com>
Subject: RE: Oneida Nation v. Oneida Indian Nation, Cancellation No. 92066411 (TTAB) - Discovery Requests

Thank you Saul. I will get back to you this week if I have any questions or believe it would be helpful to directly discuss further. Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Saul Cohen <Saul.Cohen@kelly-ip.com>
Sent: Friday, October 7, 2022 3:41 PM
To: Chris Liro <chris.liro@andruslaw.com>; Marie Mikolainis <mariem@andruslaw.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Lit Docketing <lit-docketing@kelly-ip.com>
Cc: Aaron Olejniczak <aarono@andruslaw.com>; Andrus Litigation <litigation@andruslaw.com>; Larry White

<Larry.White@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; OneidaTTAB <OneidaTTAB@kelly-ip.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation, Cancellation No. 92066411 (TTAB) - Discovery Requests

Chris,

Your edits under the Topics 19-23 heading are acceptable. We believe the parties are at an impasse as to Topics 4-6 and 16-17. Our understanding is that there is no longer a dispute about Original Topics 1-3 and 6, Topics 9-15, and Topic 18.

Let us know if you'd like to discuss further.

Thanks,
Saul

Saul Cohen | *Associate*
1300 19th Street, NW, Suite 420
Washington, DC 20036
202-808-3570 (Main)
202-908-4785 (Direct)
202-210-8323 (Cell)
202-354-5232 (Fax)

saul.cohen@kelly-ip.com
www.kelly-ip.com

The logo for Kelly IP, featuring the word "Kelly" in a serif font and "IP" in a smaller, sans-serif font, both in a dark red color.

From: Chris Liro <chris.liro@andruslaw.com>

Sent: Thursday, September 29, 2022 10:41 AM

To: Saul Cohen <Saul.Cohen@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Lit Docketing <lit-docketing@kelly-ip.com>

Cc: Aaron Olejniczak <aarono@andruslaw.com>; Andrus Litigation <litigation@andruslaw.com>; Larry White <Larry.White@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; OneidaTTAB <OneidaTTAB@kelly-ip.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation, Cancellation No. 92066411 (TTAB) - Discovery Requests

Saul,

Thank you for your comments. In light of your proposals, we can narrow the scope of the motion for protective order, and we provide counterproposals on some of the topics. Our responses with respect to the specific topics are below:

Original Topics 1-3 and 6

In light of your clarification that your client is no longer pursuing these topics, they are moot and we agree would not need to be included in a motion for protective order.

Topics 4 and 5

As explained in the motion, the primary issue is we do not believe it is appropriate to comprehensively investigate tribal knowledge and prepare a witness on the topic. So, as proposed, "general" is a substitute for saying "the witness's or

witnesses' existing knowledge." In order to make this more clear, we are revising the response to: Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding each witness's knowledge of Respondent's use of Respondent's Marks. Please let us know if this resolves the issue.

Topic 6

We disagree that Petitioner's awareness is relevant to whether or not Respondent committed fraud, and so maintain the objection and intention to move for a protective order on this topic.

Topics 9-15



In light of your clarification, we agree there is no dispute and so would not seek a protective order on these topics.

Topics 16 and 17

As an initial matter, topics 16 and 17 of the revised notice state:

16. Objections Petitioner has made against any third party's use and/or registration of any names or marks based in whole or in part on Petitioner's Marks.

17. Objections Petitioner has received from any third party concerning Petitioner's use and/or registration of Petitioner's Marks.

As such, your characterization of the topics as directed to agreements is not accurate. We appreciate your clarification that the topics are directed to Petitioner's Marks (defined only to include ONEIDA, , and ) , and your position that the topics are relevant to Petitioner's likelihood of confusion claims. In light of that, we can revise our responses as follows:

16. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner regarding objections Petitioner has made against any third party's use and/or registration in Petitioner's Goods and Services of any names or marks based in whole or in part on Petitioner's Marks.

17. Subject to its general and specific objections, Petitioner will present one or more witnesses to testify regarding facts known to Petitioner regarding objections Petitioner has received from any third party concerning Petitioner's use and/or registration of Petitioner's Marks in Petitioner's Goods and Services.

Please let us know if this resolves the issue.

Topic 18

In light of your withdrawal, we will not include this topic in any motion for protective order.

Topics 19-23

As explained in the motion, part of the basis for the objection and requested protective order is not simply the inclusion of information Petitioner learned from Respondent, but also information that Petitioner learned from its counsel that

reflects the legal analysis of counsel. We can provide one or more witnesses on your new/amended topics, as further revised:

- Non-privileged information known to Petitioner, not including information that Petitioner learned solely from Respondent through discovery in this matter and/or learned solely from Petitioner's legal counsel, regarding Respondent's purported knowledge of the use of ONEIDA by Petitioner and others.
- Non-privileged information known to Petitioner, not including information that Petitioner learned solely from Respondent through discovery in this matter and/or learned solely from Petitioner's legal counsel, regarding the purported abandonment by Respondent of the marks shown in the '491 Registration, the '677 Registration, and the '028 Registration.
- Non-privileged information known to Petitioner, not including information that Petitioner learned solely from Respondent through discovery in this matter and/or learned solely from Petitioner's legal counsel, regarding Respondent's purported lack of intent to use the ONEIDA mark.
- Non-privileged information known to Petitioner, not including information that Petitioner learned solely from Respondent through discovery in this matter and/or learned solely from Petitioner's legal counsel, regarding Respondent's purported lack of use of ONEIDA as a trademark.

Please let us know if this resolves the issue.

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Saul Cohen <Saul.Cohen@kelly-ip.com>

Sent: Wednesday, September 21, 2022 8:35 AM

To: Chris Liro <chris.liro@andruslaw.com>; Marie Mikolainis <mariem@andruslaw.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Lit Docketing <lit-docketing@kelly-ip.com>

Cc: Aaron Olejniczak <aarono@andruslaw.com>; Andrus Litigation <litigation@andruslaw.com>; Larry White <Larry.White@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; OneidaTTAB <OneidaTTAB@kelly-ip.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation, Cancellation No. 92066411 (TTAB) - Discovery Requests

Chris,

We have reviewed the motion for protective order that Petitioner filed on June 21 and subsequently withdrew. We believe there is some room for compromise and that Petitioner should reconsider some of the positions it took in its withdrawn motion.

Original Topics 1-3 and 6

Petitioner asserts that "[w]hile Respondent deleted [Original Topics 1-3 and 6] from its revised set, respondent subsequently suggested that the topics may not be considered permanently withdrawn." 50 TTABVUE 5.

Respondent is not going to reassert Original Topics 1-3 and 6, and we have never suggested otherwise. In any event, it is not a productive use of the parties' and the Board's time to move for a protective order on subjects that are not included in the operative list of deposition topics. To the extent Petitioner moves for a protective order, there is no reason to include arguments regarding Original Topics 1-3 and 6.

Topics 4 and 5

We don't understand the purpose of the changes to these topics that Petitioner is seeking to have the Board impose – to "limit[] the scope of discovery to only general information on these topics as proposed by Petitioner." 50 TTABVUE 6. We don't know how Petitioner will draw the line between "general" and non-"general" information and don't believe any limitation is warranted. At a minimum, can you explain how you intend to limit the scope of these topics by changing "knowledge and awareness" to "general knowledge"?



Topic 6

Topic 6 is relevant, including because Petitioner's awareness of others' uses of ONEIDA-formative marks when Petitioner applied for ONEIDA-formative marks tends to disprove Petitioner's fraud claims.



Topics 9-15

We don't believe there is actually a dispute as to Topics 9-15.

Petitioner argues that "'Petitioner's Marks' and/or 'Petitioner's Goods and Services' relate to Petitioner's responses to certain interrogatories, which seek discovery related to any and all uses of Petitioner of ONEIDA and any goods and services related to any such uses" and that "the dispute is whether Respondent can take broad discovery related to any and all uses of ONEIDA, or whether discovery should be constrained to the three specific registrations of Respondent for ONEIDA and ONEIDA INDIAN NATION for certain goods and services in certain classes, and one specific registration of Petitioner for a logo incorporating the word ONEIDA for certain goods and services in certain classes." 50 TTABVUE 7.

As we have previously explained, Petitioner's Mark and Petitioner's Goods and Services are defined to reference **Petitioner's responses** to Interrogatories Nos. 2 and 3. Petitioner's responses to those interrogatories already limit the marks (to ONEIDA, , and ) and goods and services to ones you say are relevant. Since the parties appear to agree on these topics, Petitioner should withdraw its objections to them. Let us know if you will agree to do so.

Topics 16 and 17

Topics 16 and 17, which relate to Petitioner's agreements and objections regarding Petitioner's Marks (which we again remind you are defined only to include ONEIDA, , and ) , are relevant to Petitioner's likelihood of confusion claims. *See, e.g.*, TBMP § 414(10) ("Information concerning litigation and controversies including settlement and other contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable.").

Topic 18

Respondent does not concede that Topic 18 is improper but is willing to withdraw it to facilitate a compromise.

Topics 19-23

Again in the interest of facilitating a compromise, we would be willing to withdraw Topics 19-23 provided that Petitioner will agree not to object to the topics listed below:

- Non-privileged information known to Petitioner, not including information that Petitioner learned solely from Respondent through discovery in this matter, regarding Respondent's purported knowledge of the use of ONEIDA by Petitioner and others.
- Non-privileged information known to Petitioner, not including information that Petitioner learned solely from Respondent through discovery in this matter, regarding the purported abandonment by Respondent of the marks shown in the '491 Registration, the '677 Registration, and the '028 Registration.
- Non-privileged information known to Petitioner, not including information that Petitioner learned solely from Respondent through discovery in this matter, regarding Respondent's purported lack of intent to use the ONEIDA mark.
- Non-privileged information known to Petitioner, not including information that Petitioner learned solely from Respondent through discovery in this matter, regarding Respondent's purported lack of use of ONEIDA as a trademark.

We believe these new topics resolve your concerns that the prior topics require application of legal analysis and that "none of these topics relate in any manner to ... facts known to Petitioner outside the existence of this proceeding."

Let us know Petitioner's positions on these issues.

Saul

Saul Cohen | Associate
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Kelly^{IP}

From: Saul Cohen

Sent: Thursday, September 15, 2022 3:33 PM

To: Chris Liro <chris.liro@andruslaw.com>; Marie Mikolainis <mariem@andruslaw.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Lit Docketing <lit-docketing@kelly-ip.com>

Cc: Aaron Olejniczak <aarono@andruslaw.com>; Andrus Litigation <litigation@andruslaw.com>; Larry White <Larry.White@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; OneidaTTAB <OneidaTTAB@kelly-ip.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation, Cancellation No. 92066411 (TTAB) - Discovery Requests

Chris,

We believe there is likely room for compromise on some of the 30(b)(6) topics. We're continuing to work on this and plan to send you our thoughts next week, after which it may be worth having a call to discuss.

Saul

Saul Cohen | Associate

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202-354-5232 (Fax)

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From: Saul Cohen <Saul.Cohen@kelly-ip.com>

Sent: Monday, September 12, 2022 12:39 PM

To: Chris Liro <chris.liro@andruslaw.com>; Marie Mikolainis <mariem@andruslaw.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Clint Taylor <Clint.Taylor@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Lit Docketing <lit-docketing@kelly-ip.com>

Cc: Aaron Olejniczak <aarono@andruslaw.com>; Andrus Litigation <litigation@andruslaw.com>; Larry White <Larry.White@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; OneidaTTAB <OneidaTTAB@kelly-ip.com>

Subject: Re: Oneida Nation v. Oneida Indian Nation, Cancellation No. 92066411 (TTAB) - Discovery Requests

Chris,

We'll get back to you this week on the motion for protective order.

Saul Cohen | Associate

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202-908-4785 (Direct)
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202-354-5232 (Fax)

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From: Chris Liro <chris.liro@andruslaw.com>

Sent: Monday, September 12, 2022 11:56 AM

To: Saul Cohen <Saul.Cohen@kelly-ip.com>; Marie Mikolainis <mariem@andruslaw.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Clint Taylor <Clint.Taylor@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Lit Docketing <lit-docketing@kelly-ip.com>

Cc: Aaron Olejniczak <aarono@andruslaw.com>; Andrus Litigation <litigation@andruslaw.com>; Larry White <Larry.White@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; OneidaTTAB <OneidaTTAB@kelly-ip.com>

ip.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation, Cancellation No. 92066411 (TTAB) - Discovery Requests

Saul,

Following up to see if you think conferring further on the motion for protective order is warranted. Thank you.
Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Saul Cohen <Saul.Cohen@kelly-ip.com>

Sent: Thursday, September 1, 2022 4:21 PM

To: Chris Liro <chris.liro@andruslaw.com>; Marie Mikolainis <mariem@andruslaw.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Clint Taylor <Clint.Taylor@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Lit Docketing <lit-docketing@kelly-ip.com>

Cc: Aaron Olejniczak <aarono@andruslaw.com>; Andrus Litigation <litigation@andruslaw.com>; Larry White <Larry.White@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>; OneidaTTAB <OneidaTTAB@kelly-ip.com>

Subject: Re: Oneida Nation v. Oneida Indian Nation, Cancellation No. 92066411 (TTAB) - Discovery Requests

Chris,

Given that your proposed extension would give us a discovery deadline that falls during the holidays, our client suggests a 120-day extension. If you agree, please prepare a filing for our review.

As for the motion for protective order, we will review your previously filed motion and will get back to you about whether we think conferring further would be warranted.

Thanks,
Saul

Saul Cohen | Associate

1300 19th Street, NW, Suite 420

Washington, DC 20036

202-808-3570 (Main)

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202-210-8323 (Cell)

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The logo for Kelly IP, featuring the word "Kelly" in a red serif font and "IP" in a smaller, red sans-serif font.

From: Chris Liro <chris.liro@andruslaw.com>

Sent: Wednesday, August 31, 2022 5:00 PM

To: Marie Mikolainis <mariem@andruslaw.com>; Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Clint Taylor <Clint.Taylor@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Saul

Cohen <Saul.Cohen@kelly-ip.com>; Lit Docketing <lit-docketing@kelly-ip.com>

Cc: Aaron Olejniczak <aarono@andruslaw.com>; Andrus Litigation <litigation@andruslaw.com>; Larry White <Larry.White@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>

Subject: RE: Oneida Nation v. Oneida Indian Nation, Cancellation No. 92066411 (TTAB) - Discovery Requests

Saul,

Following up on yesterday's phone call, we suggest an agreed motion to extend the schedule by 90 days. That will provide time to address any further issues related to the interrogatory response called for by the recent TTAB order, and the new requests for production served today, which also are based on guidance from the order. Also, as we discussed, we intend to re-file the motion for protective order directed at the Rule 30(b)(6) topics in the near future and, as you pointed out, that does not necessarily result in an automatic suspension. In addition, I am having heart surgery the first week of October, so personally I will at reduced capacity for a few weeks thereafter. Please let us know if your client agrees with this approach, or if you have any other suggestions.

With respect to the motion for protective order, I believe that the parties have sufficiently conferred on the dispute, but please let me know if your client feels that another conference is warranted before a motion is filed, and we can schedule that.

Chris

Christopher R. Liro

Attorney

Andrus Intellectual Property Law, LLP

p 414.271.7590 m 414.308.2466

From: Marie Mikolainis <mariem@andruslaw.com>

Sent: Wednesday, August 31, 2022 3:58 PM

To: Linda McLeod <Linda.McLeod@kelly-ip.com>; Rob Litowitz <Rob.Litowitz@kelly-ip.com>; Clint Taylor <Clint.Taylor@kelly-ip.com>; Jason Joyal <Jason.Joyal@kelly-ip.com>; Saul Cohen <Saul.Cohen@kelly-ip.com>; lit-docketing@kelly-ip.com

Cc: Chris Liro <chris.liro@andruslaw.com>; Aaron Olejniczak <aarono@andruslaw.com>; Andrus Litigation <litigation@andruslaw.com>; Larry White <Larry.White@kelly-ip.com>; Lauren Jancuska <Lauren.Jancuska@kelly-ip.com>

Subject: Oneida Nation v. Oneida Indian Nation, Cancellation No. 92066411 (TTAB) - Discovery Requests

Counsel,

Attached and served on you please find Petitioner's Third Set of Requests for the Production of Documents and Things to Respondent (Nos. 27-29).

Kind regards,

Marie G. Mikolainis

Litigation Paralegal

Andrus Intellectual Property Law, LLP

790 North Water Street, Suite 2200

Milwaukee, WI 53202

p 414.223.3772 (direct) | f 414.271.5770

e mariem@andruslaw.com | w andruslaw.com

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