

Bukrinsky

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

July 13, 2022

Cancellation No. 92074759

*Chief Troy Kerry, For And On Behalf Of The
Apalachee Indians Of Louisiana, Talamali
Band*

v.

*Talimali Band Of The Apalachee Indians Of
Louisiana*

**Before Zervas, Lynch, and Dunn,
Administrative Trademark Judges.**

By the Board:

This proceeding comes before the Board on Petitioner's motion, filed March 7, 2022, for judgment on the pleadings. Respondent filed a cross-motion for judgment on the pleadings. Petitioner's motion is fully briefed, and Respondent's motion is opposed.

We have considered the parties' briefs, and we address the record only to the extent necessary to set forth our analysis and findings. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Background

Respondent alleges ownership of Registration No. 5915019 for the standard character mark TALIMALI BAND THE APALACHEE INDIANS OF LOUISIANA for “Association services, namely, promoting the interests of the Talimali Band of the Apalachee Indians of Louisiana; Club services, namely, promoting the interests of the Talimali Band of the Apalachee Indians of Louisiana” in International Class 35.¹

In his third amended petition for cancellation, Petitioner alleges that Respondent is not the rightful owner of the mark, and fraud based on the underlying allegations of non-ownership. 20 TTABVUE. *See also* 22 TTABVUE 3-4 (finding these claims sufficiently pleaded).

On July 28, 2021, the Board struck Respondent’s affirmative defenses of (1) acquiescence, (2) estoppel, (3) laches, (4) unclean hands, and (5) failure to state a claim, but permitted the factual allegations set forth in the fourth and fifth defenses to remain as amplification of Respondent’s denials. 22 TTABVUE 4-9. The Board allowed Respondent time to file an amended answer that “sufficiently pleaded affirmative defenses of acquiescence, estoppel, laches, and/or unclean hands, provided it has a good faith basis for asserting these defenses.” *Id.* at 15.

On August 17, 2021, Respondent filed an amended answer wherein it admitted some of the allegations of the petition for cancellation and denied others. 24 TTABVUE. Respondent also alleged the same five affirmative defenses. *Id.* at 8.

¹ The underlying use-based application was filed on July 9, 2019 pursuant to Trademark Act Section 1(a), 15 U.S.C. § 1051(a). Respondent alleged first use and use in commerce at least as early as June 17, 1996. The registration issued on November 19, 2019.

II. Review of Respondent's Amended Affirmative Defenses

We first exercise our discretion to review Respondent's amended affirmative defenses. *See* Fed. R. Civ. P. 12(f).

With respect to acquiescence, estoppel, and laches, Respondent alleges only that it "reserves the right to amend" these defenses. Such a reservation of rights is improper under the Federal Rules of Civil Procedure because it does not give Petitioner fair notice of the alleged defenses. *See Topco Holdings, Inc. v. Hand 2 Hand Indus., LLC*, 2022 USPQ2d 54, at *12 (TTAB 2022). Accordingly, these defenses are **stricken**.²

With respect to unclean hands, Respondent's allegations are largely the same as in its prior answer, though Respondent alleges several additional facts. *See* 24 TTABVUE 9-12. Nonetheless, the allegations fail to state a claim for unclean hands for the reasons previously explained by the Board during the parties' discovery conference and in its order striking this defense. *See* 22 TTABVUE 7-8. In view thereof, the defense of unclean hands is again **stricken**.

III. Judgment on the Pleadings

We note that Petitioner's motion for judgment on the pleadings is timely inasmuch as it was filed after the close of pleadings, but prior to the day of the deadline for pretrial disclosures for the first testimony period. *See Shared, LLC v. Shared Space of Atlanta, LLC*, 125 USPQ2d 1143, 1144 (TTAB 2017); Fed. R. Civ. P. 12(c). We

² Whether Respondent may, at some future point, assert these affirmative defenses would be resolved by way of a motion for leave to amend. *See* Fed. R. Civ. P. 15(a).

further find that Respondent's cross-motion is germane to Petitioner's motion, and is timely. *See* Trademark Rule 2.127(d).

A. Legal Standard

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board takes judicial notice. *See Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008). *See also* TBMP § 504.02 and cases cited therein. For purposes of the motion, all well-pleaded factual allegations of the non-moving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b)(6), because no responsive pleading thereto is required or permitted) are deemed false. *Id.* All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. *Id.*

Judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved and the moving party is entitled to judgment on the substantive merits of the controversy as a matter of law. *Id.* Accordingly, a motion for judgment on the pleadings has utility when all the material allegations are admitted in the pleadings and only questions of law remain. *See Leeds Techs. Ltd. v. Topaz Commc'ns, Ltd.*, 65 USPQ2d 1303, 1305 (TTAB 2002); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784, 1787 (TTAB 1992). A party may not obtain a judgment on the pleadings if the nonmoving party's pleading raises issues of fact, which, if proved, would establish the nonmoving party's entitlement to judgment. *Baroid Drilling Fluids Inc. v. Sun Drilling Prods.*, 24 USPQ2d 1048, 1049

(TTAB 1992); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 504.02 (2022).

B. Analysis and Decision

Petitioner argues that because Respondent “is neither a federally-recognized nor a state-recognized tribe, . . . Petitioner is entitled to judgment as a matter of law in that [Respondent] is not an entity that is entitled to register a mark that is the name of a Native-American tribe in connection with services purportedly performed to promote the interests of the tribe.” 27 TTABVUE 4.

In response, Respondent argues that its use of the registered mark has been exclusive for over 20 years, which entitles it to its registration. 29 TTABVUE 3. Respondent cross-moves for judgment on the pleadings based on its allegations that Petitioner Troy Kerry was not rightfully elected Chief of the Apalachee Indians of Louisiana, Talimali Band, and that accordingly he is not entitled to bring this proceeding, and furthermore cannot prove the merits of his claims. *Id.* at 11-13.³

In reply, Petitioner points out that the facts Respondent asserts in support of its cross-motion for judgment on the pleadings are disputed. 30 TTABVUE 4.

A motion for judgment on the pleadings is decided with reference to the claims pleaded in the complaint. *See Media Online*, 88 USPQ2d at 1288 (entering judgment on the pleadings because petitioner could not prevail *on its pleaded claim* as a matter

³ We do not construe either party’s motion as one for summary judgment, and accordingly give no consideration to the evidence attached to Respondent’s response. *See Western Worldwide Enters Grp. Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 n.5 (TTAB 1990); *see also* TBMP § 504.03.

of law); *Baroid Drilling Fluids Inc.*, 24 USPQ2d at 1049 (same). As mentioned above, Petitioner has pleaded (1) that Respondent was not the rightful owner of the registered mark at the time it submitted its underlying application, and (2) fraud based on the same underlying allegations of non-ownership. 20 TTABVUE 5-7; *see also* 22 TTABVUE 5 (Board order).

Under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), only the owner of a mark may file an application for registration. *See also Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 7 USPQ2d 1335, 1336 (Fed. Cir. 1988). A use-based application filed by a person who does not own the mark at the time of filing is void ab initio. *See Lyons v. Am. Coll. of Veterinary Sports Med. & Rehab.*, 859 F.3d 1023, 123 USPQ2d 1024, 1027 (Fed. Cir. 2017); *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1303 (TTAB 2015); Trademark Rule 2.71(d), 37 C.F.R. § 2.71(d) (“An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.”).

Ownership of a mark generally is predicated on priority of use in commerce. *Lyons*, 123 USPQ2d at 1029; *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 n.6 (CCPA 1976) (“It is fundamental that ownership of a mark is acquired by use, not by registration.”). In cases where the parties have either a prior or current relationship, the question of which party is the owner of the mark “must be determined on a case by case basis dependent on the particular facts adduced in each case.” *Wonderbread 5*, 115 USPQ2d at 1303 (quoting *In re Briggs*, 229 USPQ 76, 77 (TTAB 1986)) (internal citation omitted).

With that in mind, we consider the allegations and admissions in the parties’

pleadings. Petitioner makes, inter alia, the following allegations in support of his non-ownership claim:

- 21) Registrant was never authorized by the Apalachee Tribe to claim ownership of the Mark.
- 22) The Mark was never assigned by the Apalachee Tribe to Registrant.
- 23) Even if the Letter of Consent authorized Registrant to use the Mark on behalf of the Apalachee Tribe, such authorization would be in the nature of a license, and not a transfer of ownership of the Mark. However, the Letter of Consent contains no provisions for control of the quality of the goods or services provided by Registrant or, for that matter, for any control over use of the mark by Registrant and, as such, was a naked license and invalid.
- 24) Registrant is not and never has been the owner of the Mark.

20 TTABVUE 5-6. Respondent denies each of these allegations as follows:

21. The allegations of Paragraph 21 of the Third Amended Petition are denied because the rightful trademark owner does not need either the authorization of Troy Kerry or his entity "Apalachee Indians of Louisiana, Talimali Band" to file a service mark application in its own name and to obtain the registration for the Service Mark.
22. The allegations of Paragraph 22 of the Third Amended Petition are denied because the Respondent, being the only rightful owner of the registered Service Mark, does not need an assignment from anyone to register its own Service Mark.
23. The allegations of Paragraph 23 of the Third Amended Petition are denied; the Letter of Consent did not concern the Service Mark at issue in these proceedings, and the legal arguments advanced in Paragraph 23 of the Third Amended Complaint are irrelevant. Furthermore, the legal arguments of Paragraph 23 do not require any response.
24. The allegations of Paragraph 24 of the Third Amended Petition are denied.

24 TTABVUE 24.

In view of Respondent's denials of each of Petitioner's salient allegations, there are no undisputed facts that could sustain a judgment on the pleadings as to the non-ownership claim. *See Scotch Whisky Ass'n v. U.S. Distilled Prods. Co.*, 13 USPQ2d

1711, 1713 n.1 (TTAB 1989) (“In view of the denials in the answer, the motion for judgment on the pleadings is denied.”). And, inasmuch as Petitioner’s fraud claim depends on Petitioner establishing his non-ownership claim, judgment on the pleadings as to fraud is foreclosed for the same reason. Petitioner’s motion for judgment on the pleadings is accordingly denied.

Before turning to Respondent’s cross-motion, we briefly address the contention in Petitioner’s reply brief that “[t]he issuance of the trademark registration at issue herein is an acknowledgement by the Trademark Office that Registrant is the true representative of the Tribe,” and that this determination is outside the province of the USPTO. 30 TTABVUE 3.4 “A certificate of registration of a mark upon the principal register ... [is] prima facie evidence of ... the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate” Trademark Act Section 7(b), 15 U.S.C. § 1057(b). As Petitioner acknowledges in his brief, he offers no authority requiring tribal recognition as a condition of ownership of a trademark registration for a tribal mark.⁵ In addition, the pleadings as deemed admitted do not

⁴ Petitioner does not represent that the parties are seeking resolution of the question of tribal representation before any other tribunal. *See* Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a) (proceeding may be suspended pending determination of related proceeding); *see also* TBMP § 510.02(a). Further, although Petitioner states in its motion that “Petitioner’s request for recognition is currently pending before the Louisiana legislature” (30 TTABVUE 7), and Respondent represents in its response that it has a “long-pending petition for federal recognition” (29 TTABVUE 5), neither party has requested suspension of this proceeding.

⁵ Petitioner cites to cases addressing Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). However, Petitioner has not asserted a Section 2(a) claim. *See* 20 TTABVUE. Moreover, none of the cases cited by Petitioner stand for the asserted proposition.

establish the absence of a genuine dispute of material fact that Respondent is *not* affiliated with a recognized tribe.⁶

Moreover, the Board “is an administrative tribunal with jurisdiction over the question of registrability of U.S. trademarks.” *Hu v. TJ Food Serv., LLC*, 123 USPQ2d 1777, 1779 (TTAB 2017) (citing Section 17 of the Trademark Act, 15 U.S.C. § 1067). The Board is empowered to determine the right to register. *See* Trademark Act §§ 17–18, 20, 15 U.S.C. §§ 1067–68, 1070. In exercising its jurisdiction, the Board may, and often does, decide competing claims of ownership. *See, e.g., Lyons*, 123 USPQ2d at 1029; *Wonderbread 5*, 115 USPQ2d at 1303.

Finally, as the record owner of the involved registration, Respondent is entitled to the presumptions of Section 7 of the Trademark Act, including the “validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.” 15 U.S.C. § 1057(b). Petitioner, as the party seeking cancellation of Respondent’s registration, has the burden of proving the merits of its claims before it can obtain the relief it seeks.

⁶ Petitioner cites to paragraph 22 of Respondent’s affirmative defenses in support of its assertion that Respondent admits that it is not recognized by the federal government or any state as a tribe. *See* 27 TTABVUE 7 and n. 8 and 9. However, paragraph 22 states only:

On January 6, 2020, Troy Kerry and four other individuals formed a non-profit corporation “Apalachee Indians Talimali Band.” A true and correct copy of a print dated June 25, 2021 of Louisiana Secretary of State’s records for said entity of Petitioner is attached hereto as Exhibit D.

24 TTABVUE 11.

With respect to Respondent’s cross-motion, the salient allegations upon which Respondent relies are deemed denied pursuant to Fed. R. Civ. P. 8(b)(6), or constitute matters outside the pleadings that are not considered.⁷ *See* TBMP § 504.03 and cases cited therein. Accordingly, there are no admitted allegations upon which we could enter judgment on the pleadings in favor of Respondent with respect to either Petitioner’s entitlement to a statutory cause of action or claims. Respondent’s cross-motion for judgment on the pleadings is accordingly denied.

In sum, inasmuch as, on the facts as deemed admitted, there remain genuine issues of material fact to be resolved with respect to Petitioner’s entitlement to a statutory cause of action and pleaded claims, neither party is entitled to judgment on the substantive merits of the controversy as a matter of law. Accordingly, Petitioner’s motion for judgment on the pleadings, and Respondent’s cross-motion, are **denied**.

IV. Proceeding Resumed; Dates Reset

This proceeding is resumed. Remaining discovery and trial dates are reset as follows:

Expert Disclosures Due	7/16/2022
Discovery Closes	8/15/2022
Plaintiff's Pretrial Disclosures Due	9/29/2022
Plaintiff's 30-day Trial Period Ends	11/13/2022
Defendant's Pretrial Disclosures Due	11/28/2022
Defendant's 30-day Trial Period Ends	1/12/2023
Plaintiff's Rebuttal Disclosures Due	1/27/2023
Plaintiff's 15-day Rebuttal Period Ends	2/26/2023
Plaintiff's Opening Brief Due	4/27/2023
Defendant's Brief Due	5/27/2023

⁷ In addition, Petitioner denies Respondent’s allegations in its reply. *see* 30 TTABVUE 4-5.

Plaintiff's Reply Brief Due	6/11/2023
Request for Oral Hearing (optional) Due	6/21/2023

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125, 37 C.F.R. §§ 2.121-2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a), 37 C.F.R. § 2.129(a).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126.

Submissions failing to meet all of the criteria above may require re-filing. **Note:** Parties are strongly encouraged to check the entire document before filing.⁸ The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the [ESTTA help](#) webpage.

⁸ To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.