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

Proceeding no.	92063134
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Attachments	Supplemental Brief on Tribal Immunity -- REDACTED.pdf(3249839 bytes)

In the matter of Trademark
Registration No. 3172861
Mark: CROSSROADS & Design
Filed: February 28, 2005
Registered: November 21, 2006

In the matter of Trademark
Registration No. 4218677
Mark: CARPE DIEM & Design
Filed: February 15, 2011
Registered: October 2, 2012

PHILIP MORRIS USA INC.,

Petitioner,

v.

IP SERVICES INTERNATIONAL, INC. and
SYCUAN TRIBAL DEVELOPMENT
CORPORATION,

Respondents.

**REDACTED –
PUBLIC VERSION**

Petitioner Philip Morris USA Inc. (“Petitioner”), by and through the undersigned counsel, files this Supplemental Response in Opposition to Respondent Sycuan Tribal Development Corporation’s (“Sycuan” or “STDC”) Motion for Summary Judgment Based on Tribal Immunity (“Motion”) (53 & 54 TTABVUE). Pursuant to the Board’s March 2, 2025 Order, this supplemental response is “limited in scope to address the issue of whether Sycuan Tribal Development Corporation is an entity that may claim tribal sovereign immunity and, if so, whether there has been a waiver of that immunity in this proceeding.” 98 TTABVUE 1.

This Supplemental Response addresses three reasons why Sycuan is not an entity that can claim tribal immunity in this proceeding. First, Sycuan is not entitled to sovereign immunity as its acquisition of the disputed marks was a sham “attempt to avoid the . . . proceedings that are currently pending in the PTO by invoking the Tribe’s sovereign immunity as a bar to those proceedings.” *Allergan, Inc. v. Teva Pharmaceuticals USA, Inc.*, 2:15-cv-1455-WCB, 2017 WL 4619790 (E.D. Tex. 2017). Second, Sycuan is not entitled to claim sovereign immunity because it is a distinct corporate entity that is separate from the Sycuan Band of the Kumeyaay Nation (the “Tribe”) and is not covered by the arm of the tribe doctrine. Third, Sycuan waived any immunity it might otherwise been entitled to claim when it stepped into the shoes of IP Services International, Inc. (“IP Services”) and voluntarily accepted assignment of the registrations for the disputed marks (the “Registrations”) knowing that they were the subject of a pending cancellation proceeding.¹

I. SYCUAN CANNOT CLAIM TRIBAL IMMUNITY BECAUSE THE ASSIGNMENT IS A SHAM INTENDED TO AVOID THIS PROCEEDING

There is no reason for any tribunal “to countenance destruction of jurisdiction by the use of a straw part[y],” *Attorneys Trust v. Videotape Computer Products, Inc.*, 93 F.3d 593, 598 (9th Cir. 1996), including Indian tribes. After all, it is well established that tribes have “no legitimate interest in selling an opportunity to evade [the] law,” *Otoe-Missouria Tribe of Indians v. N.Y. State Dept. of Fin. Servs.*, 769 F.3d 105, 114, 116 (2d Cir. 2014), and non-tribal entities cannot cloak themselves in tribal immunity as a way to “circumvent” the law, *Barona Band of Mission Indians v. Yee*, 528 F.3d 1184, 1187, 1190 (9th Cir. 2008). *See also Washington v. Confederated Tribes of the Colville Indian Reservation*, 447 U.S. 134, 155 (1980) (“[i]t is painfully apparent that the

¹ Sycuan’s tribal immunity defense also fails for numerous reasons that are not addressed here in accordance with the Board’s March 2, 2025 Order, including that abandoned registrations cannot be revived by assignment, 57 TTABVue at 6-7, and tribal immunity does not apply in cancellation proceedings pending before the Trademark Trial and Appeal Board, *id.* at 13-17.

value marketed by the” tribes, “and what is not available elsewhere, is solely an exemption” from otherwise-applicable law). As a result, courts disregard assignments from non-tribal commercial entities to tribal entities when those transactions are shams. *See, e.g., Attorney Trusts*, 93 F.3d at 599-600; *see also In re: BP P.L.C. Securities Litig.*, MDL No. 4:10-md-2185, 2016 WL 29300, at *6 (S.D. Tex. Jan. 4, 2016) (“sham assignments raise a host of potentially problematic issues and are not necessarily protected by the general rule of assignability”).

Outside the context of tribal immunity, sham assignments are also routinely rejected when they are simply a way to manipulate subject matter jurisdiction. For example, in *Farmington Village Corporation v. Pillsbury*, 114 U.S. 138, 146 (1885), the Supreme Court refused to permit an assignment that was “a mere contrivance, a pretense, [and] the result of a collusive arrangement” to alter federal court jurisdiction. Similarly, in *Kramer v. Caribbean Mills, Inc.*, 394 U.S. 823, 827-29 (1969), the Supreme Court held that an assignment that was made in substantial part to alter jurisdiction could not do so. “[T]he nature of the assignment must be considered when it is argued that jurisdiction has been destroyed.” *Attorneys Trust*, 93 F.3d at 598.

Among “the classic elements of an assignment which does not affect jurisdiction” are (1) whether the purported assignee “had no prior interest” in the matter prior to the assignment; (2) whether the assignment was close in time to the commencement of the litigation; (3) whether the purported assignor retained significant control and most of the profits; (4) whether the assignee paid little if any consideration; (5) whether the same counsel represented both parties; and (6) whether there is evidence the “real motive” was to destroy jurisdiction. *See Attorneys Trust*, 93 F.3d at 598-99.

Sham transactions to misuse tribal immunity and manipulate the jurisdiction of the Patent and Trademark Office are also prohibited. *Allergan*, 2017 WL 4619790, at *2-3. Permitting a

party to avoid Patent and Trademark Office proceedings by merely purporting to assign the relevant intellectual property to a tribe or an arm of the tribe poses obvious problems. As the court in *Allergan* explained:

This is not a situation in which the patentee was entitled to sovereign immunity in the first instance. Rather, Allergan, which does not enjoy sovereign immunity, has invoked the benefits of the patent system and has obtained valuable patent protection for its product, *Restasis*. But when faced with the possibility that the PTO would determine that those patents should not have been issued, Allergan has sought to prevent the PTO from reconsidering its original issuance decision. What Allergan seeks is the right to continue to enjoy the considerable benefits of the U.S. patent system without accepting the limits that Congress has placed on those benefits through the administrative mechanism for canceling invalid patents.

If that ploy succeeds, any patentee facing IPR proceedings would presumably be able to defeat those proceedings by employing the same artifice.

Id. at *2.

Similarly, IP Services' purported assignment to Sycuan should be disregarded because it is a sham. As an initial matter, although there is a purported written assignment of the Registrations to Sycuan, it does not include any terms of a purchase, such as a purchase price, or any evidence whatsoever of consideration that IP Services received for the assignment, *see generally* Ex. 1.² The purported written assignment likewise contains no provision identifying

² In its Supplemental Brief, Sycuan does not address the validity of the assignment from IP Services to Sycuan, even though it clearly understood that Petitioner challenged its validity. *See* 58 TTABVue at 10 (entire section of brief entitled "Sycuan's Acquisition of the Trademarks Is Not A 'Ploy'"). The Board should not consider any new arguments or evidence that Sycuan raises for the first time in its reply brief. *See Spanishtown Enters. v. Transcent Res., Inc.*, 2020 TTAB LEXIS 481 at *14-15 n.12, 2020 U.S.P.Q.2d 11388 (Nov. 23, 2023) ("With respect to the new document submitted with Respondent's reply brief, we note that the submission of evidence that should have been filed with the main brief on the motion is improper.") (citing *Kellogg Co. v. Pack'Em Enters. Inc.*, 14 U.S.P.Q.2d 1545, 1549 n.9 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991) (evidence supporting a motion for summary judgment must be submitted with the motion)).

whether there is a license of the marks back to IP Services or to any other entity.³

In fact, Sycuan admits that there [REDACTED] Ex. 2, 89:18-25 ([REDACTED]). Sycuan maintains that there is [REDACTED] *see, e.g., id.* at 90:23-1, but there is no admissible evidence [REDACTED] The only “evidence” of this [REDACTED] that Sycuan has presented in this case is the testimony of its Rule 30(b)(6) designee, Troy Graves. But [REDACTED] [REDACTED], *id.* at 92:1-3, 127:9-12, and [REDACTED] [REDACTED], *id.* at 99:22-100:1, 92:11-13; *see also id.* at 95:24-96:2 [REDACTED] [REDACTED] That is classic inadmissible hearsay. *E.g., Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1735 (TTAB 2012) (holding that deponents’ statements regarding information they received from third parties during conversations was inadmissible hearsay); TBMP § 101.02 (“[T]he rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part” (referring to Title 37 of the Code of Federal Regulations Section § 2.122(a)).)

Moreover, Mr. Graves’ recollection of the [REDACTED] is highly unreliable. [REDACTED]

[REDACTED] Ex. 2 at 92:20-22, [REDACTED] *id.* at 93:7-9,

³ Making matters worse, Sycuan refused to disclose facts concerning whether the supposed [REDACTED] Ex. 2 at 100:20-101:19 (deposition transcript of Sycuan’s 30(b)(6) designee, Troy Graves).

[REDACTED] *id.* at 93:10-14, [REDACTED]
[REDACTED], *id.* at 92:4-6, [REDACTED]
[REDACTED] *id.* at 92:7-10, or [REDACTED]
[REDACTED] *id.* at 92:20-93:21. [REDACTED]
[REDACTED] Ex. 2 at 93:23-25, and [REDACTED]
[REDACTED]
[REDACTED] *id.* at 91:2-3, [REDACTED]
[REDACTED] Ex. 3 at STDC000047.
[REDACTED]
[REDACTED] *id.* at STDC000050, but Sycuan never produced any such [REDACTED]. [REDACTED]
[REDACTED]
[REDACTED] Ex.
4 at 149:5-12. As a result, the written record suggests that IP Services assigned the Registrations
to Sycuan [REDACTED]—another telltale sign of a sham
transaction.

Simply put, there is no admissible evidence that the parties ever reached any agreement for
the purchase of the disputed marks or the terms of any such agreement, let alone any credible
evidence regarding those subjects. There is no admissible or credible evidence suggesting that the
transfer of the registrations for the disputed marks was part of a bona fide business transaction or
anything other than a sham to shield those registrations from cancellation.

[REDACTED]
[REDACTED]
[REDACTED]

[REDACTED] Ex. 2 at 103:13-15.⁴

The notion that Sycuan’s acquisition of the Registrations was a bona fide transaction is also undermined by the fact that [REDACTED]
[REDACTED]. Ex. 2 at 78:13-18. Sycuan attempts to downplay the significance of this fact by claiming that [REDACTED]
[REDACTED], *id.* at 12:23-13:2. But Sycuan still has not [REDACTED], strongly suggesting that it never intended to enter the cigarette manufacturing business.

As in *Allergan*, “it is clear that [Sycuan’s] motivation for the assignment was to attempt to avoid the [] proceedings that are currently pending in the PTO by invoking the Tribe’s sovereign immunity as a bar to those proceedings.” *See* 2017 WL 4619790, at *2. And, as in *Allergan*, the assignor—here, IP Services—was not entitled to tribal immunity in the first instance. But when faced with the possibility that the PTO would determine that those registrations should be cancelled, IP Services sought to prevent the PTO from considering cancellation. By doing so, IP Services seeks the right to enjoy the considerable benefits of the U.S. trademark system without accepting the limits that Congress has placed on those benefits through the administration mechanism for cancelling trademark registrations. If this ploy succeeds, any trademark owner facing cancellation proceedings would be able to defeat those proceedings by employing the same artifice. The Board should not endorse or otherwise recognize this sham.

⁴ [REDACTED], Ex. 2 at 102:18-103:12; *see also* Ex. 4 at 163:16-164:17 ([REDACTED]).

II. SYCUAN CANNOT MEET ITS BURDEN OF PROOF THAT IT IS AN ARM OF THE TRIBE ENTITLED TO SOVEREIGN IMMUNITY

When considering claims of tribal immunity under the arm of the tribe doctrine, the Board must determine whether Sycuan is ““analogous to a governmental agency, which should benefit from the defense of sovereign immunity, or whether [it is] more like [a] commercial business enterprise[] instituted solely for the purpose of generating profits for [] private owners.”” *Breakthrough Mgmt. Gp., Inc. v. Chukchansi Gold Casino & Resort*, 629 F.3d 1173, 1184 (10th Cir. 2010) (quoting *Gavle v. Little Six, Inc.*, 555 N.W.2d 284, 293 (Minn. 1996)). If the economic entity is more akin to a governmental agency, then courts deem those entities to be an “arm of the tribe” entitled to share in tribal immunity. *Breakthrough*, 629 F.3d at 1185 n.9.

“Where an entity claims tribal immunity as an ‘arm of the tribe,’ the burden of proving entitlement to tribal sovereign immunity falls to the entity seeking immunity.” 74 TTABVUE 2 (citing *Williams v. Big Picture Loans, LLC*, 929 F.3d 170, 176 (4th Cir. 2019)); accord *People v. Miami Nation Enters.*, 2 Cal. 5th 222, 236 (2016).

The Board and courts frequently consider five factors when assessing a claim that an economic entity is an arm of the tribe: (1) the method of the entity’s creation; (2) its purpose; (3) its structure, ownership, and management, including the amount of control the tribe has over the entities; (4) the tribe’s intent to share its sovereign immunity; and (5) the financial relationship between the tribe and the entity. 74 TTABVUE 2-3 (citing *Williams*, 929 F.3d at 176 (4th Cir. 2019); *White v. Univ. of California*, 765 F.3d 1010, 1025 (9th Cir. 2014); *Breakthrough*, 629 F.3d at 1187; *Solomon v. Am. Web Loan*, 375 F. Supp. 3d 638, 652 (E.D. Va. 2019)).

(1) The method of the entity's creation

“[I]n determining whether a particular Indian tribal organization is an ‘arm’ of the tribe entitled to share the tribe’s common-law sovereign immunity from suit, courts generally consider such factors as whether: the entity is organized under the tribe’s laws or constitution rather than Federal law[.]” *Ransom v. St. Regis Mohawk Educ. & Cmty. Fund*, 86 N.Y.2d 553, 554 (1995); *see also Breakthrough*, 629 F.3d at 1191-92 (holding this factor weighed in favor of immunity because, unlike here, the entity was created under tribal law).

In the present case, Sycuan [REDACTED]

[REDACTED] Ex. 5 at STDC 000010. [REDACTED]

[REDACTED]—prior to the assignment of the Registrations on March 23, 2018, Ex. 1. [REDACTED]

[REDACTED] this factor weighs against extending tribal immunity to Sycuan as an arm of the tribe. *Breakthrough*, 629 F.3d at 1191-92.

(2) The purpose of the economic entity

“This factor encompasses both the stated purpose for which the entity was created and the degree to which the entity actually serves that purpose.” *Miami Nation*, 2 Cal. 5th at 246. While Sycuan’s Supplemental Brief spends two sentences discussing a portion of the stated purpose of Sycuan, Sycuan Supp Br. at 8, it is completely silent on the degree to which Sycuan actually serves the purpose of benefitting the Tribe—for good reason. It does not.

[REDACTED] *See generally* Ex. 5 at STDC000011-12, Article VII-Corporate Purpose. In fact, Sycuan’s corporate purpose includes [REDACTED]

[REDACTED] *Id.* at STDC000011, Art. VII(A). Of course, the charter also indicates that Sycuan's purpose is to [REDACTED] [REDACTED] *Id.* at STDC000011, Art. VII(B)-(D).

But there is no evidence that Sycuan *actually* serves the purpose of providing employment opportunities to members of the Tribe or otherwise furthers the economic well-being of the Tribe and its members. In fact, [REDACTED] Ex. 2 at 51:7-9, [REDACTED] [REDACTED] Similarly, Sycuan failed to present any evidence of what portion of its revenues or profits is actually distributed for tribal governmental functions, tribal economic development, or other tribal uses. *Compare Breakthrough*, 629 F.3d at 1192-93 (detailing the percentages of revenue from the economic entity directed to tribal governmental functions, tribal economic development, a tribal trust fund, and directly distributed to members of the tribe).

In fact, Sycuan's Rule 30(b)(6) designee admitted [REDACTED] [REDACTED]. Ex. 2 at 65:2-4 [REDACTED]. All of the evidence in the record suggests that [REDACTED]. *Id.* at 62:4-6. Sycuan's Rule 30(b)(6) designee testified [REDACTED] [REDACTED], *id.* at 63:2-4, [REDACTED] [REDACTED] *id.* at 64:12-17. Moreover, Sycuan has not produced or relied on any documentary evidence that it has ever distributed a single dollar to the Tribe.

As a result, this factor weighs strongly against extending tribal immunity to Sycuan.

(3) *The entity's structure, ownership, and management, including the amount of control the tribe has over the entity*

“Evidence that the tribe actively directs or oversees the operation of the entity weighs in favor of immunity; evidence that the tribe is a passive owner, neglects its governance roles, or otherwise exercises little or no control or oversight weighs against immunity.” *Miami Nation*, 2 Cal. 5th at 247; *see also Hunter v. Redhawk Network Sec. LLC*, 2018 WL 4171612, at *4 (D. Or. 2018) (finding the extent to which a tribe exercises control over the actual operations of the corporation relevant to the third factor).

In its Supplemental Brief, Sycuan focuses on the formalities of its corporate structure, but it completely ignores the question of whether the Tribe actually actively directs or oversees Sycuan's operations. That is hardly surprising [REDACTED]

[REDACTED]:

[REDACTED]

[REDACTED]

[REDACTED]

Tr. 51:18-22.

Consistent with that notion, Sycuan's primary spokesperson in this case, Troy Graves, is [REDACTED], Ex. 2 at 52:15-17. Mr. Graves verified all three sets of Sycuan's responses to interrogatories, Exs. 6-8, and served as Sycuan's Rule 30(b)(6) designee for [REDACTED]

[REDACTED]. Ex. 2 Tr. at 15:14-17. Mr. Graves also serves [REDACTED]
[REDACTED], *id.* at 10:21-25, 11:22-12:1, [REDACTED]

[REDACTED]. During his deposition, Mr. Graves confirmed that [REDACTED]
[REDACTED], *id.* at 11:4-6.

[REDACTED], Ex. 2 at 51:7-9, and [REDACTED]
[REDACTED]. *See Breakthrough*, 629 F.3d at 1193
(indicating that the fact that the Chief Financial Officer and General Manager were not tribal
members weighed against immunity). [REDACTED]
[REDACTED]. Ex. 2 at 51:24-52:1. [REDACTED]
[REDACTED]. *Id.* 52:2-17. [REDACTED]
[REDACTED], “[g]iven the manipulability of formal arrangements, it is important to carefully examine
how such arrangements function as a practical matter, lest we expand the application of tribal
immunity beyond its established rationales and indeed beyond common sense.” *Miami Nation*, 2
Cal. 5th at 250 (internal quotations marks omitted).

In the present case, Sycuan produced virtually no information related to its board’s
activities or how much control or oversight it exercises over Sycuan, and its Rule 30(b)(6) designee
and [REDACTED]

[REDACTED], Ex. 2 at 11:4-6.

What little documentary evidence that is available confirms [REDACTED]
[REDACTED]. For example, [REDACTED]
[REDACTED]
[REDACTED], Ex. 9. [REDACTED]
[REDACTED] Ex. 2 at 80:2-24. [REDACTED]
[REDACTED]. *Id.* at 84:8-17 [REDACTED]
[REDACTED]
Id. at 78:5-8, 84:8-85:1.

Moreover, although the [REDACTED]

[REDACTED] Ex. 9, [REDACTED]

[REDACTED], Ex. 2 at 96:25-97:13 [REDACTED]

[REDACTED] *id.* at 99:17-21 [REDACTED]

In sum, this factor confirms that Sycuan does not act as an arm of the tribe and extending tribal immunity is not warranted.

(4) The tribe's intent to share its sovereign immunity

“In some cases, the tribal ordinance or articles of incorporation will express whether the tribe intended the entity to share in its immunity.” *Miami Nation*, 2 Cal. 5th at 246. For example, in *Breakthrough Management Group, Inc. v. Chukchansi Gold Casino & Resort*, the relevant ordinance provided that “the Authority shall be clothed by federal and tribal law with all the privileges and immunities of the Tribe, *including sovereign immunity from suit in any state, federal, or tribal court.*” 629 F.3d at 1193-94 (emphasis added).

In the present case, Sycuan's [REDACTED] indicates that it [REDACTED]

[REDACTED] Ex. 5 at STDC000011,

Article IV(C) (emphasis added), but it [REDACTED]

[REDACTED] *see*

generally, id. On the other hand, [REDACTED]

[REDACTED]

[REDACTED] *id. at* STDC000010, [REDACTED]

[REDACTED]

For the first time, in connection with its Supplemental Memorandum, Sycuan submitted a declaration from Joshua Muse, in which he asserts that the Tribe “has intended to share, and apply its sovereign immunity to [Sycuan] at all times.” Muse Decl. ¶ 7. But his declaration provides no support for this conclusory statement. Nor does it explain how Mr. Muse purports to know the intent of the entire Tribe (or even the entire Tribal General Council) regarding sovereign immunity and is therefore inadmissible. *See* Federal Rule of Evidence 602 (“A witness may testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter.”) He also does not cite any documentary evidence supporting this assertion or any evidence that he is authorized to speak on behalf of the Tribe in this regard. And no other member of the Tribe or its General Counsel corroborates his opinion regarding the intent of the Tribe. Finally, it bears mention that Mr. Muse is hardly a disinterested third party—he is currently the Chairman of Sycuan, Muse Decl. ¶ 1. Considering the foregoing, the conclusory opinion of the Chairman of the party claiming to be an arm of the tribe is of questionable relevance.

Even so, “tribal intent, as expressed in the entities’ articles of incorporation, reveals little about whether the entity *acts* as an arm of the tribe so that its *activities* are properly deemed to be those of the tribe,” and “[t]he tribe’s self-interested and unsupported claim that they intended their sovereign immunity to extend to [commercial entities] cannot, without more, support immunity.” *Miami Nation*, 2 Cal. 5th at 256 (internal citation and quotation omitted). Thus, even if the charter was interpreted as a formal statement of intent to extend immunity to suit to Sycuan, that alone is insufficient to tip the balance in favor of immunity. *Id.*

(5) *The financial relationship between the tribe and the entity*

“The starting point for analyzing the financial relationship between the entity and the tribe is whether a judgment against the entity would reach the tribe’s assets.” *Miami Nation*, 2 Cal. 5th at 247. [REDACTED]

[REDACTED] Ex. 5 at STDC000010, [REDACTED]
[REDACTED] . . . , *id.* at STDC000011, Art. IV(A). Sycuan has never suggested otherwise, and it should be precluded from doing so now because [REDACTED]

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

Ex. 2 at 65:21-66:20. For what it is worth, Sycuan’s counsel did opine that [REDACTED]
[REDACTED] *Id.* at 66:12-13.

For all the foregoing reasons, the starting point for this factor weighs in favor of no sovereign immunity for Sycuan because a judgment against Sycuan would not reach the assets of the Tribe.

Also, “courts consider the extent to which the tribe ‘depends ... on the [entity] for revenue to fund its governmental functions, its support of tribal members, and its search for other economic development opportunities.’” *Miami Nation*, 2 Cal. 5th at 248 (quoting *Breakthrough*, 629 F.3d

at 1195); *see also Williams*, 929 F.3d at 184 (finding the extent to which a tribe “depends . . . on the [entity] for revenue to fund its governmental functions, its support of tribal members, and its search for other economic development opportunities” relevant to fifth arm of the tribe factor).

Sycuan failed to present any evidence that the Tribe relies on revenue from Sycuan or that

[REDACTED]

[REDACTED]

Ex. 2. at 62:4-6; *see also id.* at 62:20-25 [REDACTED].

Thus, it is hardly surprising that Sycuan’s 30(b)(6) designee admitted that [REDACTED]

[REDACTED]. *Id.* at 65:2-4 [REDACTED]

[REDACTED] Similarly, even in its Supplemental Brief, Sycuan appears to be careful not to say that it provides any funding to the Tribe. Instead, it simply says [REDACTED]

[REDACTED] Sycuan Supp. Br. at 9. Glaringly absent from his declaration is a claim that Sycuan [REDACTED]

[REDACTED]

Under these circumstances, this factor strongly weighs against extending tribal immunity to Sycuan.

Conclusion on Arm of the Tribe

As in *People v. Miami Nation*, “[t]he record reveals a nominally close relationship between [the commercial entity and the tribe], [b]ut it contains scant evidence that either tribe actually controls, oversees, or significantly benefits from the underlying business operations of the [commercial entity].” 2 Cal. 5th at 251. But at least in *Miami Nation*, the commercial entities produced evidence that they were created under tribal law and that the tribe expressed a clear intent

to extend its immunity to the commercial entities. *Id.* at 252. In addition, the commercial entities in *Miami Nation* proffered some evidence that a minimum of \$25,000 per month was distributed to the tribe, although they failed to indicate how much revenue was distributed. *Id.* at 253-54. Additionally, there was evidence that the commercial entities employed approximately 20 tribal members. *Id.* at 254. Nevertheless, the *Miami Nation* court held that “the entities are not entitled to tribal immunity on the record before us.” 2 Cal. 5th at 230.

Here, Sycuan fell far short of the showing that was held to be insufficient in *Miami Nation*. Sycuan was formed [REDACTED]. Sycuan’s 30(b)(6) designee bluntly admitted that [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Under these circumstances, Sycuan fell woefully short of meeting its burden of proving by admissible record evidence that it is entitled to tribal immunity as an arm of the tribe.

III. SYCUAN KNOWINGLY STEPPED INTO THE SHOES OF IP SERVICES AND WAIVED ANY TRIBAL IMMUNITY

A. Tribal Immunity Can be Waived by Conduct in the Absence of an Express Waiver

Finally, even if Sycuan could prove its acquisition of the Registrations was not a sham and it was an arm of the tribe, it still would not be entitled to immunity in this proceeding because Sycuan clearly waived any immunity when it deliberately acquired the Registrations knowing that they were the subject of this proceeding.

Sycuan’s entire argument to the contrary rests on the misguided notion that “a tribal sovereign entity may only waive its immunity by an officially approved express waiver.” Sycuan Supp. Br. at 11. As a corollary to that notion, Sycuan suggests that if a purported waiver of immunity does not expressly contain the words “tribal immunity” or “sovereign immunity,” then it must be rejected as an ineffective implied or implicit waiver. Sycuan Supp. Br. at 10.

These arguments are plainly at odds with longstanding Supreme Court precedent. In *C & L Enterprises, Inc. v. Citizen Band Potawatomi Indian Tribe of Oklahoma*, the Supreme Court held that tribal immunity may be waived in the absence of an express waiver provided the waiver is clear. 532 U.S. 411, 418 (2001) (“to relinquish its immunity, a tribe’s waiver must be ‘clear’”).⁵ The Supreme Court also rejected the notion that “‘to be deemed explicit, [a waiver] must use the words ‘sovereign immunity’ because “[n]o case has ever held that.” *Id.* at 420 (quoting *Sokaogon Gaming Enterprise Corp. v. Tushie–Montgomery Associates, Inc.*, 86 F.3d 656, 661 (7th Cir. 1996)). As a result, the Court held that an arbitration clause waived tribal immunity even though the provision did not reference immunity, let alone contain a statement expressly waiving immunity. 532 U.S. at 420-21.⁶

⁵ In *C&L Enterprises*, the Supreme Court makes clear that its prior statement in *Santa Clara Pueblo v. Martinez*, 436 U.S. 49, 58 (1978), that “waiver of sovereign immunity cannot be implied but must be unequivocally expressed” applied to Congressional attempts to abrogate tribal immunity, *C&L Enterps.*, 532 U.S. at 418, and that a different standard applies to a tribe’s waiver of its own tribal immunity. *Id.* For a tribe to waive its immunity, the only requirement is that the “tribe’s waiver must be clear.” *Id.* Based on that distinction, the Supreme Court found a waiver of tribal immunity without an unequivocal express statement of the tribe’s intent to waive. Therefore, Sycuan’s reliance on *Santa Clara Pueblo*, Sycuan Supp. Br. at 10, is misplaced because this case involves a tribe’s waiver of immunity. Sycuan’s reliance on *American Indian Agricultural Credit Consortium, Inc. v. Standing Rock Sioux Tribe*, 780 F.2d 1374 (8th Cir. 1985), is misplaced for the same reason—in cases involving waiver by a tribe, there is no requirement for an express statement of waiver.

⁶ To the extent Sycuan relies on *American Indian Agriculture Credit Consortium, Inc. v. Standing Rock Sioux Tribe*, 780 F.2d 1374, 1379 (8th Cir. 1985), to argue that tribal immunity can only be waived by an express waiver and cannot be waived by conduct, Sycuan Supp.Br. at 10, that

The Supreme Court’s ruling is consistent with numerous decisions by Courts of Appeal. As the First Circuit recently made clear, “tribal sovereign immunity can be waived through tribal conduct, provided that ‘such actions [are] clear and unequivocal in their import.’” *Aquinnah/Gay Head Cmty. Ass’n, Inc. v. Wampanoag Tribe of Gay Head (Aquinnah)*, 989 F.3d 72, 82 (1st Cir. 2021) (quoting *Narragansett Indian Tribe v. Rhode Island*, 449 F.3d 16, 25 (1st Cir. 2006)). In that case, the First Circuit held that the tribe waived immunity by “failing to address it” in an appeal—not as a result of an express waiver that was officially approved by the tribe’s board.

Similarly, in *Wichita & Affiliated Tribes of Oklahoma v. Hodel*, 788 F.2d 765, 773 (D.C. Cir. 1986), the D.C. Circuit held that a tribe’s conduct waived immunity. “There can be no doubt that the [tribes’] voluntary intervention as party defendants was an express waiver of their right not to be joined in the [] suit.” *Id.* at 773. The Ninth Circuit agrees that intervening in a lawsuit constitutes a waiver. *See United States v. Oregon*, 657 F.2d 1009, 1014 (9th Cir. 1981).

Thus, Sycuan’s claim “a tribal sovereign entity may only waive its immunity by an officially approved express waiver,” Sycuan Supp. at 11, is wrong, and tribal conduct, such as voluntarily taking steps to interject the tribe into litigation as a defendant, waives tribal immunity.

**B. Sycuan’s Decision to Acquire the Registrations [REDACTED]
[REDACTED] Clearly Waives Any Tribal Immunity**

In the present case, Sycuan clearly waived any tribal immunity it had when it acquired the Registrations [REDACTED] and that, as the assignee of the Registrations, it would be stepping into the shoes of IP Services in this proceeding.

Philip Morris filed the Petition to Cancel the Registrations in this proceeding on February 8, 2016, 1 TTABVUE, more than two years before the purported assignment of the Registrations

decision contradicts the Supreme Court’s decision 16 years later in *C&L Enterprises* and is no longer good law.

occurred on March 30, 2018. Ex. 1. [REDACTED]
before it acquired the Registrations on March 30, 2018. In response to an interrogatory, Sycuan
stated:

[REDACTED]

Ex. 8 at 5 (emphasis added); *see also id.* at 6 [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]; *id.* at 10 (same); *id.* at 9 [REDACTED]

[REDACTED]

Sycuan also submitted two declarations [REDACTED]

[REDACTED] x. 10 ¶ 3 [REDACTED]

[REDACTED]

[REDACTED]; Ex. 11 ¶ 3 (stating that [REDACTED])

[REDACTED]

[REDACTED].

Sycuan's attempt to minimize these admissions by asserting that [REDACTED]
[REDACTED] is neither credible nor relevant. As an
initial matter, the mere fact that [REDACTED] and voluntarily injected

itself into them by acquiring the Registrations is clear evidence that Sycuan waived tribal immunity. *See, e.g., Wichita*, 788 F.2d at 773 (holding “the [tribes’] voluntary intervention as party defendants was an express waiver of their right not to be joined in the [] suit”); *Oregon*, 657 F.2d at 1014 (holding tribe’s intervention waived immunity).

Plus, the suggestion that Sycuan simply [REDACTED]
[REDACTED]
see Ex. 2 at 106:9-18, 111:16-112:8, [REDACTED]. According to its privilege log, Sycuan had
[REDACTED]
[REDACTED]. Ex. 12 at 7 (privilege log). But, according
to Sycuan, [REDACTED]
[REDACTED]
[REDACTED]. Ex. 2 at 129:21-25. This
proposition does not pass the straight-face test.

As the Board previously acknowledged, “this litigation is a matter of public record,” 51 TTABVUE at 8-9, and “[t]hose parties who contract to transfer a trademark application or registration generally know if the application or registration is the subject of litigation.” *Id.* at 5. As a result, the Board already concluded that Sycuan “was aware that the assigned [R]egistrations were involved in ongoing litigation.” *Id.* at 8-9.

[REDACTED]
[REDACTED]. Sycuan’s Rule 30(b)(6) designee admitted that there was
[REDACTED]
[REDACTED] Ex. 2 at 115:1-4, and [REDACTED] *id.* at 115:13-16. [REDACTED]
[REDACTED]

██████████ As the Board previously recognized in this case, “[i]t is well settled that as a result of an assignment, the assignee steps into the shoes of the assignor, including any legal burdens or limitations. . . . This principle has been adopted for trademark assignments.” 51 TTABVUE 5. After all, “it is axiomatic that an assignee must accept the consequences of its assignor’s conduct, and, accordingly, in the present case, opposer is bound by the statements *and activity* of its predecessor.” *CBS Inc. v. Man’s Day Publ’g Co., Inc.*, 205 USPQ 470, 477 (TTAB 1980); *see also* 51 TTABVUE 6 (quoting same with approval).

Sycuan assumed the rights and attendant obligations of owning the Registrations by stepping into the shoes of IP Services. By assuming ownership of the Registrations, Sycuan took advantage of the protections of the Lanham Act as a registrant and, therefore, cannot pick and choose which provisions apply to it. *See, e.g., Elem Indian Colony of Pomo Indians of the Sulphur Bank Rancheria v. Ceiba Legal, LLP*, 230 F. Supp. 3d 1146, 1150 (N.D. Cal. 2017) (stating that a tribe “cannot invoke provisions of the Lanham Act to support its claims yet avoid the legal effects of other provisions that do not work in its favor” . . . nor “reclaim immunity just because the case took a turn that was not to its liking”) (citing *In re White*, 139 F.3d 1268, 1272 (9th Cir. 1998)).⁷

⁷ Sycuan relies heavily on *Amerind Risk Management Corp. v. Malaterre*, 633 F.3d 680, (8th Cir. 2011), for the proposition that a successor in interest does not necessarily waive tribal immunity. *See* Sycuan Supp. Br. at 10. That case stands for the unremarkable proposition that when a federally chartered Indian tribe corporation “assumed the rights and obligations of its tribally chartered predecessor,” 633 F.3d at 682, “the general assumption of [the tribally chartered predecessor’s] obligations and liabilities in Amerind’s federal charter does not constitute an express waiver of Amerind’s sovereign immunity, *id.* at 686. While it is hardly surprising that a general assumption of all of another tribal entity’s assets and liabilities does not constitute a waiver of tribal immunity for any claims and potential claims against the predecessor tribe, that sheds little light on the issue raised here. In this case, Sycuan acquired four specific trademark registrations ██████████

██████████ and it nevertheless proceeded to acquire them. As explained below, in circumstances such as these, when a tribe voluntarily interjects itself into a proceeding as a defendant, it waives its tribal immunity with respect to that proceeding.

Sycuan attempts to avoid the consequences of its acquisition of the Registrations and the longstanding precedent holding that a tribe that voluntarily injects itself into litigation waives tribal immunity by analogizing this case to instances in which a rogue representative waives tribal immunity without board approval. *See* Sycuan Supp. Br. at 11-12. [REDACTED]

[REDACTED] Ex. 9,

[REDACTED]. The board resolution provides that [REDACTED]

[REDACTED] *Id.* at 1.⁸

[REDACTED] Under these circumstances, Sycuan waived any tribal immunity it might otherwise have had.

IV. CONCLUSION

For all of these reasons and the reasons set forth in Petitioner’s Response in Opposition to Respondent Sycuan Tribal Development Corporation’s Motion for Summary Judgment Based on Tribal Immunity, the Motion should be denied.

Respectfully submitted,

Dated: May 5, 2025

By: /s/ J. Kevin Fee

J. Kevin Fee
Jane W. Wise

⁸ Because the Sycuan board [REDACTED] *Memphis Biofuels, LCC v. Chikasaw Nation Industries, Inc.*, 585 F.3d 917 (6th Cir. 2009), does not apply here, notwithstanding Sycuan’s argument to the contrary, Sycuan Supp. Br. at 10-12. In *Memphis Biofuels*, the court found no waiver of sovereign immunity because the conduct that potentially waived the tribe’s immunity was done “without board approval, [so the tribe’s] sovereign immunity remains intact.” 585 F.3d at 922.

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500 8th Street, N.W.
Washington, D.C. 20004
Tel. 202-799-4000
Fax 202-799-5000

*Attorneys for Petitioner
Philip Morris USA Inc.*

CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the foregoing Petitioner's Supplemental Response in Opposition to Respondent Sycuan Tribal Development Corporation's Motion for Summary Judgment Based on Tribal Immunity was served on the following via email:

Phillip C. Samouris
Justine Wong
Higgs Fletcher & Mack LLP
401 West A Street, Suite 2500
San Diego, CA 92101-7910
Email: samouris@higgslaw.com, trademarks@higgslaw.com,
wongj@higgslaw.com

this 5th day of May, 2025.

/s/ J. Kevin Fee

Exhibit 1

ASSIGNMENT OF U.S. TRADEMARKS

This ASSIGNMENT OF U.S. TRADEMARKS (the "Assignment") is made as of March 23, 2018 by IP Services International Inc. ("Assignor"), to Sycuan Tribal Development Corporation ("Assignee").

WHEREAS, Assignor owns the marks set forth on Schedule A hereto, which are registered in the United States Patent and Trademark Office (collectively, the "Assigned Marks");

WHEREAS, Assignor has agreed to sell, transfer and convey to Assignee the right, title and interest of Assignor in and to the Assigned Marks; and

WHEREAS, Assignor has agreed to execute and deliver this Assignment for recording with the United States Patent and Trademark Office.

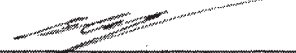
NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignor agrees as follows:

Assignor does hereby transfer, convey, assign and deliver to Assignee all right, title and interest of Assignor in and to the Assigned Marks, the registrations and applications for registrations thereof, and the goodwill of the business connected with the use thereof and symbolized thereby, free and clear of all liens, all rights of priority therein in any country as may now or hereafter be granted to it by law, treaty or other international convention; and all rights, interests, claims and demands recoverable in law or equity that Assignor has or may have in profits and damages for past, present and future infringements of the Assigned Marks, including, without limitation, the right to compromise, sue for and collect such profits and damages; the same to be held and enjoyed by Assignee, its successors and assigns or their legal representatives, as fully and entirely as the same would have been held and enjoyed by Assignor if this Assignment had not been made.

Assignor hereby agrees that Assignor shall execute and deliver to Assignee such additional instruments, documents, conveyances or assurances, and take such other action as shall be necessary or otherwise reasonably requested by Assignee, to confirm and assure the rights and obligations provided for in this Assignment and render effective the consummation of the transactions contemplated hereby, or otherwise to carry out the intent and purposes of this Assignment.

IN WITNESS WHEREOF, Assignor has caused this Assignment to be duly executed as of the date first written above.

IP Services International, Inc.

By: 

Name: Aaron Shoaf

Title: Officer of IP Services International, Inc.

SCHEDULE A

Serial Number	Reg. Number	Word Mark
85243277	4218677	CARPE DIEM
85243276	4261884	CARPE DIEM
85243279	4258288	
85243273	4258287	
85243272	4214752	NYC PREMIUM
85243271	4258286	NEW HAVEN
85243270	4254527	NYC CLASSIC
85243268	4254526	CROSSROADS
76636811	3140971	NYC CLASSIC
76632345	3172861	CROSSROADS
76648143	3137779	NEW HAVEN



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SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
IP Services International, Inc.		03/23/2018	Corporation: PANAMA
RECEIVING PARTY DATA			
Name:	Sycuan Tribal Development Corporation		
Street Address:	2 Kwaaypaay Court		
City:	El Cajon		
State/Country:	CALIFORNIA		
Postal Code:	92019		
Entity Type:	Federally-Recognized Indian Tribe: UNITED STATES		
PROPERTY NUMBERS Total: 11			
Property Type	Number	Word Mark	
Registration Number:	4218677	CARPE DIEM	
Registration Number:	4261884	CARPE DIEM	
Registration Number:	4258288		
Registration Number:	4258287		
Registration Number:	4214752	NYC PREMIUM	
Registration Number:	4258286	NEW HAVEN	
Registration Number:	4254527	NYC CLASSIC	
Registration Number:	4254526	CROSSROADS	
Registration Number:	3140971	NYC CLASSIC	
Registration Number:	3172861	CROSSROADS	
Registration Number:	3137779	NEW HAVEN	
CORRESPONDENCE DATA			
Fax Number:	6123329081		
Phone:	6123325300		
Email:	mmorris@merchantgould.com		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
Correspondent Name:	Heather J. Kliebenstein		
Address Line 1:	P.O. Box 2910		
Address Line 4:	Minneapolis, MINNESOTA 55402		
ATTORNEY DOCKET NUMBER:	17681.0003US01		
NAME OF SUBMITTER:	Heather J. Kliebenstein		
Signature:	/Heather J. Kliebenstein/		
Date:	03/30/2018		
Total Attachments: 2			
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

APRIL 9, 2018

PTAS

HEATHER J. KLIEBENSTEIN
P.O. BOX 2910
MINNEAPOLIS, MN 55402

900444864

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RECORDATION DATE: 03/30/2018

REEL/FRAME: 6304/0284
NUMBER OF PAGES: 4

BRIEF: ASSIGNS THE ENTIRE INTEREST

DOCKET NUMBER: 17681.0003US01

ASSIGNOR:

IP SERVICES INTERNATIONAL, INC.

DOC DATE: 03/23/2018

CITIZENSHIP: PANAMA

ENTITY: CORPORATION

ASSIGNEE:

SYCUAN TRIBAL DEVELOPMENT
CORPORATION

CITIZENSHIP: UNITED STATES

ENTITY: FEDERALLY-RECOGNIZED INDIAN
TRIBE

2 KWAAYPAAY COURT
EL CAJON, CALIFORNIA 92019

SERIAL NUMBER: 76632345

FILING DATE: 02/28/2005

REGISTRATION NUMBER: 3172861

REGISTRATION DATE: 11/21/2006

MARK: CROSSROADS

DRAWING TYPE: AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S) / LETTER(S)
/NUMBER(S)

SERIAL NUMBER: 76636811 FILING DATE: 04/25/2005
REGISTRATION NUMBER: 3140971 REGISTRATION DATE: 09/12/2006
MARK: NYC CLASSIC
DRAWING TYPE: AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S) / LETTER(S)
/NUMBER(S)

SERIAL NUMBER: 76648143 FILING DATE: 10/07/2005
REGISTRATION NUMBER: 3137779 REGISTRATION DATE: 09/05/2006
MARK: NEW HAVEN
DRAWING TYPE: STANDARD CHARACTER MARK

SERIAL NUMBER: 85243268 FILING DATE: 02/15/2011
REGISTRATION NUMBER: 4254526 REGISTRATION DATE: 12/04/2012
MARK: CROSSROADS
DRAWING TYPE: STANDARD CHARACTER MARK

SERIAL NUMBER: 85243270 FILING DATE: 02/15/2011
REGISTRATION NUMBER: 4254527 REGISTRATION DATE: 12/04/2012
MARK: NYC CLASSIC
DRAWING TYPE: STANDARD CHARACTER MARK

SERIAL NUMBER: 85243271 FILING DATE: 02/15/2011
REGISTRATION NUMBER: 4258286 REGISTRATION DATE: 12/11/2012
MARK: NEW HAVEN
DRAWING TYPE: STANDARD CHARACTER MARK

SERIAL NUMBER: 85243272 FILING DATE: 02/15/2011
REGISTRATION NUMBER: 4214752 REGISTRATION DATE: 09/25/2012
MARK: NYC PREMIUM
DRAWING TYPE: STANDARD CHARACTER MARK

SERIAL NUMBER: 85243273 FILING DATE: 02/15/2011
REGISTRATION NUMBER: 4258287 REGISTRATION DATE: 12/11/2012
MARK:
DRAWING TYPE: AN ILLUSTRATION DRAWING WITHOUT ANY WORDS(S) / LETTER(S)
/NUMBER(S)

SERIAL NUMBER: 85243276 FILING DATE: 02/15/2011
REGISTRATION NUMBER: 4261884 REGISTRATION DATE: 12/18/2012
MARK: CARPE DIEM
DRAWING TYPE: AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S) / LETTER(S)
/NUMBER(S)

SERIAL NUMBER: 85243277 FILING DATE: 02/15/2011
REGISTRATION NUMBER: 4218677 REGISTRATION DATE: 10/02/2012
MARK: CARPE DIEM
DRAWING TYPE: AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S) / LETTER(S)
/NUMBER(S)

SERIAL NUMBER: 85243279 FILING DATE: 02/15/2011
REGISTRATION NUMBER: 4258288 REGISTRATION DATE: 12/11/2012
MARK:
DRAWING TYPE: AN ILLUSTRATION DRAWING WITHOUT ANY WORDS(S) / LETTER(S)
/NUMBER(S)

ASSIGNMENT RECORDATION BRANCH
PUBLIC RECORDS DIVISION

IPS000081

Exhibit 2
Filed Under Seal

Exhibit 3
Filed Under Seal

Exhibit 4
Filed Under Seal

Exhibit 5
Filed Under Seal

Exhibit 6
Redacted Public Version

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

In the matter of Trademark
Registration No. 3172861
Mark: CROSSROADS & Design
Filed: February 28, 2005
Registered: November 21, 2006

In the matter of Trademark
Registration No. 3140971
Mark: NYC CLASSIC & Design
Filed: April 25, 2005
Registered: September 12, 2006

In the matter of Trademark
Registration No. 4218677
Mark: CARPE DIEM & Design
Filed: February 15, 2011
Registered: October 2, 2012

In the matter of Trademark
Registration No. 4261884
Mark: CARPE DIEM & Design
Filed: February 15, 2011
Registered: December 18, 2012

PHILIP MORRIS USA INC.,

Petitioner,

v.

IP SERVICES INTERNATIONAL, INC.
and SYCUAN TRIBAL DEVELOPMENT
CORPORATION,

Respondents.

Cancellation No.: 92063134

**—CONFIDENTIAL—
SUBJECT TO PROTECTIVE ORDER**

**SYCUAN TRIBAL DEVELOPMENT
CORPORATION’S ANSWERS AND
OBJECTIONS TO PETITIONER’S
INTERROGATORIES PURSUANT TO
BOARD ORDER**

Specially appearing Respondent, Sycuan Tribal Development Corporation (“Sycuan” or
“STDC”), a tribal corporation chartered under section 17 of the Indian Reorganization Act

(25 U.S.C.A. § 5124 [formerly cited as 25 USCA § 477]), and approved by the Bureau of Indian Affairs as a legal entity wholly owned by the Sycuan Band of the Kumeyaay Nation (the “Sycuan Band”), a federally recognized Indian Tribe, hereby responds to Petitioner Philip Morris USA Inc.’s Interrogatories to Respondent Sycuan Tribal Development Corporation Pursuant to Board Order. STDC’s responses are made without waiving or intending to waive STDC’s immunity from suit in this case, as set forth in its Motion for Summary Judgment Based on Tribal Immunity dated November 16, 2018 (52, 53 TTABVUE), or any objection as to relevancy, privilege, or admissibility of any information in this or any other action on any ground. STDC provides these responses and objections for the limited purpose of responding to the limited, jurisdictional discovery allowed by the Board in this case in the Order dated January 30, 2021 (66 TTABVUE).

ANSWERS AND OBJECTIONS

Objections to Petitioner’s “Instructions and Definitions of Terms” and general objections

STDC objects to Petitioner’s “Instructions and Definitions of Terms” and interrogatories to the extent that Petitioner purports to impose obligations on STDC greater than or different from those under the Board’s order in this case, dated January 30, 2021 (66 TTABVUE), which *solely* permits limited, jurisdictional discovery.

STDC objects to Petitioner’s use of the terms “describe in detail all facts and circumstances relating to,” and “any relationship” in its interrogatories on the ground that these terms are overly broad and may call for information that is not within the scope of the allowed, limited jurisdictional discovery.

STDC also objects to Petitioner’s instructions in Paragraph O about claims of privilege. While none of Petitioner’s interrogatories require STDC to make any such claims, Petitioner’s

instructions are objectionable because they purport to require additional and different burdens on STDC not within the scope of the allowed jurisdictional discovery and beyond the federal rules.

STDC also objects to Petitioner's instructions regarding supplementing answers and responses, which purport to require STDC to provide Petitioner with "any additional information relating in any way to these interrogatories and to events occurring or documents existing prior to the filing of the Cancellation herein which Sycuan acquires or which becomes known to Sycuan up to and including the close of the rebuttal testimony period" and "within a reasonable time after such information is acquired or becomes known." Petitioner's instructions are objectionable because they purport to require additional and different burdens on STDC not within the scope of the allowed, limited jurisdictional discovery and beyond the federal rules.

OBJECTIONS AND ANSWERS TO INTERROGATORIES

Below, STDC repeats each of Petitioner's interrogatories and provides STDC's specific objections and answer to each. STDC's above objections shall be considered fully incorporated into each specific objection and answer below.

Interrogatory No. 1

Describe in detail all facts and circumstances relating to Sycuan's process to seek status as "a federally chartered Section 17 corporation approved by the Bureau of Indian Affairs as a legal entity wholly owned by the Tribe," as stated in Troy Graves' Declaration in support of Sycuan's Motion for Summary Judgment Based on Tribal Immunity (54 & 55 TTABVUE 58 (¶ 9)).

Objections and Answer to Interrogatory No. 1

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

██████████

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 2

Describe in detail all facts and circumstances where Sycuan has had any tribal immunity waived.

Objections and Answer to Interrogatory No. 2

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 3

Describe in detail all facts and circumstances relating to when Sycuan first became aware of this Cancellation Proceeding involving the Disputed Marks.

Objections and Answer to Interrogatory No. 3

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[illegible]

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 4

Describe in detail all facts and circumstances relating to Sycuan's decision to enter into the Purported Assignment Agreement.

Objections and Answer to Interrogatory No. 4

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

A series of 20 horizontal black bars of varying lengths, representing a list of redacted items. The bars are arranged in a single column, with some bars being significantly longer than others, suggesting a list of items with different lengths or weights.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Describe in detail all facts and circumstances relating to discussions between Sycuan and IP Services about this Cancellation Proceeding involving the Disputed Marks which occurred prior to entering into the Purported Assignment Agreement.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 6

Describe in detail all facts and circumstances relating to the reason the Purported Assignment Agreement was signed by IP Services only.

Objections and Answer to Interrogatory No. 6

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 7

Describe in detail all facts and circumstances relating to the stated “right, title and interest” received by Sycuan in and to each of the Disputed Marks under the Purported Assignment Agreement.

Objections and Answer to Interrogatory No. 7

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 8

Describe in detail all facts and circumstances relating to the stated “good and valuable consideration” referenced in the Purported Assignment Agreement.

Objections and Answer to Interrogatory No. 8

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

A series of 20 horizontal black bars of varying lengths, representing a redacted list or data set. The bars are arranged in a single column, with some bars being significantly longer than others, suggesting a list of items with different values or categories.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 9

Describe in detail all facts and circumstances relating to the reason Sycuan entered into the Purported Assignment Agreement.

Objections and Answer to Interrogatory No. 9

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 10

Describe in detail all facts and circumstances relating to any relationship between the persons at Sycuan on the one hand and IP Services on the other hand who were involved in discussions which culminated in the Purported Assignment Agreement.

Objections and Answer to Interrogatory No. 10

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[illegible]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Dated: March 22, 2021

Respectfully submitted,

/Phillip C. Samouris/ _____

Phillip C. Samouris

James Cekola
Higgs Fletcher & Mack LLP
401 West "A" Street, Suite 2500
San Diego, CA 92101-7910
Telephone: (619) 236-1551
Facsimile: (619) 696-1410
Email: trademarks@higgslaw.com,
samouris@higgslaw.com
cekolaj@higgslaw.com

ATTORNEYS FOR RESPONDENT SYCUAN
TRIBAL DEVELOPMENT CORPORATION

VERIFICATION

I, Troy Graves, Treasurer for Respondent Sycuan Tribal Development Corporation of 2 Kwaaypaay Court, El Cajon, California 92019, hereby declare that the answers provided in the foregoing SYCUAN TRIBAL DEVELOPMENT CORPORATION'S ANSWERS AND OBJECTIONS TO PETITIONER'S INTERROGATORIES PURSUANT TO BOARD ORDER dated March 22, 2021, are true and correct to the best of my knowledge, information, and belief of the information available to Respondent Sycuan Tribal Development Corporation, executed under penalty of perjury on this 22nd day of March, 2021, at El Cajon (city), California.

By:



Troy Graves, Treasurer

Sycuan Tribal Development Corporation

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing SYCUAN TRIBAL DEVELOPMENT CORPORATION'S ANSWERS AND OBJECTIONS TO PETITIONER'S INTERROGATORIES PURSUANT TO BOARD ORDER in Cancellation No. 92063134 was served on March 22, 2021 via email to:

Ann K Ford
John M Nading
DLA Piper LLP (US)
500 8th St NW
Washington, DC 20004
ann.ford@dlapiper.com, john.nading@dlapiper.com, dc trademarks@dlapiper.com

as Petitioner Philip Morris USA Inc.'s counsel

and

Heather Kliebenstein
Rachel Zimmerman Scobie
Eric R. Chad
Merchant & Gould P.C.
80 South Eighth St. Suite 3200
Minneapolis, Minnesota 55402
hkliebenstein@merchantgould.com, rscobie@merchantgould.com, echad@merchantgould.com,
dockmpls@merchantgould.com

as Respondent IP Services International, Inc.'s counsel

Dated: March 22, 2021

By:



Diane Trus

Exhibit 7
Redacted Public Version

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

In the matter of Trademark
Registration No. 3172861
Mark: CROSSROADS & Design
Filed: February 28, 2005
Registered: November 21, 2006

In the matter of Trademark
Registration No. 3140971
Mark: NYC CLASSIC & Design
Filed: April 25, 2005
Registered: September 12, 2006

In the matter of Trademark
Registration No. 4218677
Mark: CARPE DIEM & Design
Filed: February 15, 2011
Registered: October 2, 2012

In the matter of Trademark
Registration No. 4261884
Mark: CARPE DIEM & Design
Filed: February 15, 2011
Registered: December 18, 2012

PHILIP MORRIS USA INC.,

Petitioner,

v.

IP SERVICES INTERNATIONAL, INC.
and SYCUAN TRIBAL DEVELOPMENT
CORPORATION,

Respondents.

Cancellation No.: 92063134

**—CONFIDENTIAL—
SUBJECT TO PROTECTIVE ORDER**

**SYCUAN TRIBAL DEVELOPMENT
CORPORATION'S FIRST
SUPPLEMENTAL ANSWERS AND
OBJECTIONS TO PETITIONER'S
INTERROGATORIES PURSUANT TO
BOARD ORDER (NOS. 1, 3, 4, 5 and 9)**

Specially appearing Respondent, Sycuan Tribal Development Corporation ("Sycuan" or
"STDC"), a tribal corporation chartered under section 17 of the Indian Reorganization Act

(25 U.S.C.A. § 5124 [formerly cited as 25 USCA § 477]), and approved by the Bureau of Indian Affairs as a legal entity wholly owned by the Sycuan Band of the Kumeyaay Nation (the “Sycuan Band”), a federally recognized Indian Tribe, hereby makes its First Supplemental Answers and Objections to Petitioner Philip Morris USA Inc.’s Interrogatories to Respondent Sycuan Tribal Development Corporation Pursuant to Board Order. STDC’s First Supplemental Answers and Objections are made without waiving or intending to waive STDC’s immunity from suit in this case, as set forth in its Motion for Summary Judgment Based on Tribal Immunity dated November 16, 2018 (52, 53 TTABVUE), or any objection as to relevancy, privilege, or admissibility of any information in this or any other action on any ground. STDC provides these First Supplemental Answers and Objections to nos. 1, 3, 4, 5 and 9 for the limited purpose of responding to the limited, jurisdictional discovery allowed by the Board in this case in the Order dated January 30, 2021 (66 TTABVUE) and in accordance with the further order of the Board dated September 30, 2021 (74 TTABVUE).

FIRST SUPPLEMENTAL ANSWERS AND OBJECTIONS TO INTERROGATORIES

Interrogatory No. 1

Describe in detail all facts and circumstances relating to Sycuan’s process to seek status as “a federally chartered Section 17 corporation approved by the Bureau of Indian Affairs as a legal entity wholly owned by the Tribe,” as stated in Troy Graves’ Declaration in support of Sycuan’s Motion for Summary Judgment Based on Tribal Immunity (54 & 55 TTABVUE 58 (¶ 9)).

Objections and Answer to Interrogatory No. 1 (Initial Response)

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

A horizontal bar chart consisting of 15 solid black bars. The bars are arranged vertically, with their lengths varying significantly. The second bar from the top is the longest, extending nearly across the entire width of the image. The top and bottom bars are the shortest, appearing as small horizontal dashes. The bars are evenly spaced, creating a rhythmic pattern of varying horizontal lengths.

[REDACTED]
[REDACTED]
[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

First Supplemental Objections and Answer to Interrogatory No. 1

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 3

Describe in detail all facts and circumstances relating to when Sycuan first became aware of this Cancellation Proceeding involving the Disputed Marks.

Objections and Answer to Interrogatory No. 3 (Initial Response)

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[illegible]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

First Supplemental Objections and Answer to Interrogatory No. 3

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 4

Describe in detail all facts and circumstances relating to Sycuan's decision to enter into the Purported Assignment Agreement.

Objections and Answer to Interrogatory No. 4 (Initial Response)

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

First Supplemental Objections and Answer to Interrogatory No. 4

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[illegible]

Describe in detail all facts and circumstances relating to discussions between Sycuan and IP Services about this Cancellation Proceeding involving the Disputed Marks which occurred prior to entering into the Purported Assignment Agreement.

Objections and Answer to Interrogatory No. 5 (Initial Response)

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[illegible]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

First Supplemental Objections and Answer to Interrogatory No. 5

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 9

Describe in detail all facts and circumstances relating to the reason Sycuan entered into the Purported Assignment Agreement.

A series of 20 horizontal black bars of varying lengths, representing a list of redacted text. The bars are arranged in a single column, with some bars being longer than others, suggesting a list of items of different lengths. The bars are solid black and have no text or other markings on them.

immunity.

[illegible]

[illegible]

A series of horizontal black bars of varying lengths, representing redacted text. The bars are arranged in a list-like fashion, with some bars being longer than others, suggesting different levels of redaction or different types of information being withheld. The bars are solid black and have sharp edges.

[illegible]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Dated: October 20, 2021

Respectfully submitted,

/Phillip C. Samouris/

Phillip C. Samouris

James Cekola
Higgs Fletcher & Mack LLP
401 West "A" Street, Suite 2500
San Diego, CA 92101-7910
Telephone: (619) 236-1551
Facsimile: (619) 696-1410
Email: trademarks@higgslaw.com,
samouris@higgslaw.com
cekolaj@higgslaw.com

ATTORNEYS FOR RESPONDENT SYCUAN
TRIBAL DEVELOPMENT CORPORATION

VERIFICATION

I, Troy Graves, Treasurer for Respondent Sycuan Tribal Development Corporation of 2 Kwaaypaay Court, El Cajon, California 92019, hereby declare that the answers provided in the foregoing SYCUAN TRIBAL DEVELOPMENT CORPORATION'S FIRST SUPPLEMENTAL ANSWERS AND OBJECTIONS TO PETITIONER'S INTERROGATORIES PURSUANT TO BOARD ORDER, are true and correct to the best of my knowledge, information, and belief of the information available to Respondent Sycuan Tribal Development Corporation, executed under penalty of perjury on this 20 day of October, 2021, at El Cajon (city), California.

By:



Troy Graves, Treasurer
Sycuan Tribal Development Corporation

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing SYCUAN TRIBAL DEVELOPMENT CORPORATION'S FIRST SUPPLEMENTAL ANSWERS AND OBJECTIONS TO PETITIONER'S INTERROGATORIES PURSUANT TO BOARD ORDER (NOS. 1, 3, 4, 5 and 9) in Cancellation No. 92063134 was served on October 20, 2021 via email to:

Ann K Ford
DLA Piper LLP (US)
500 8th St NW
Washington, DC 20004
ann.ford@dlapiper.com, thomas.zutic@dlapiper.com, john.nading@dlapiper.com,
ashley.joyce@dlapiper.com, dctrademarks@dlapiper.com

as Petitioner Philip Morris USA Inc.'s counsel

and

Heather Kliebenstein
Merchant & Gould P.C.
80 South Eighth St. Suite 3200
Minneapolis, Minnesota 55402
akrueger@merchantgould.com, dockmpls@merchantgould.com,
hkliebenstein@merchantgould.com

as Respondent IP Services International, Inc.'s counsel

Dated: October 20, 2021

By:

/James Cekola/
James Cekola, attorney for Respondent
Sycuan Tribal Development Corporation

Exhibit 8
Redacted Public Version

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

In the matter of Trademark
Registration No. 3172861
Mark: CROSSROADS & Design
Filed: February 28, 2005
Registered: November 21, 2006

In the matter of Trademark
Registration No. 3140971
Mark: NYC CLASSIC & Design
Filed: April 25, 2005
Registered: September 12, 2006

In the matter of Trademark
Registration No. 4218677
Mark: CARPE DIEM & Design
Filed: February 15, 2011
Registered: October 2, 2012

In the matter of Trademark
Registration No. 4261884
Mark: CARPE DIEM & Design
Filed: February 15, 2011
Registered: December 18, 2012

PHILIP MORRIS USA INC.,

Petitioner,

v.

IP SERVICES INTERNATIONAL, INC.
and SYCUAN TRIBAL DEVELOPMENT
CORPORATION,

Respondents.

Cancellation No.: 92063134

**—CONFIDENTIAL—
SUBJECT TO PROTECTIVE ORDER**

**SYCUAN TRIBAL DEVELOPMENT
CORPORATION'S SECOND
SUPPLEMENTAL ANSWERS AND
OBJECTIONS TO PETITIONER'S
INTERROGATORIES PURSUANT TO
BOARD ORDER (NOS. 3 and 5)**

Specially appearing Respondent, Sycuan Tribal Development Corporation ("Sycuan" or
"STDC"), a tribal corporation chartered under section 17 of the Indian Reorganization Act

(25 U.S.C.A. § 5124 [formerly cited as 25 USCA § 477]), and approved by the Bureau of Indian Affairs as a legal entity wholly owned by the Sycuan Band of the Kumeyaay Nation (the “Sycuan Band”), a federally recognized Indian Tribe, hereby makes its Second Supplemental Answers and Objections to Petitioner Philip Morris USA Inc.’s Interrogatories to Respondent Sycuan Tribal Development Corporation Pursuant to Board Order. STDC’s Second Supplemental Answers and Objections are made without waiving or intending to waive STDC’s immunity from suit in this case, as set forth in its Motion for Summary Judgment Based on Tribal Immunity dated November 16, 2018 (52, 53 TTABVUE), or any objection as to relevancy, privilege, or admissibility of any information in this or any other action on any ground. STDC provides these Second Supplemental Answers and Objections to nos. 3 and 5 for the limited purpose of responding to the limited, jurisdictional discovery allowed by the Board in this case in the Order dated January 30, 2021 (66 TTABVUE) and in accordance with the further order of the Board dated September 30, 2021 (74 TTABVUE), and pursuant to the parties’ meet and confer efforts.

SECOND SUPPLEMENTAL ANSWERS AND OBJECTIONS TO INTERROGATORIES

Interrogatory No. 3

Describe in detail all facts and circumstances relating to when Sycuan first became aware of this Cancellation Proceeding involving the Disputed Marks.

Objections and Answer to Interrogatory No. 3 (Initial Response)

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]
 [REDACTED]
 [REDACTED]
 [REDACTED]

10626656.1

A series of 20 horizontal black bars of varying lengths, representing a redacted list or document. The bars are stacked vertically, with some having significant gaps before them, suggesting a list structure where certain items are indented or separated. The lengths vary from approximately 10% to 100% of the container width.

[REDACTED]

[REDACTED]

First Supplemental Objections and Answer to Interrogatory No. 3

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Second Supplemental Objections and Answer to Interrogatory No. 3

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Interrogatory No. 5

Describe in detail all facts and circumstances relating to discussions between Sycuan and IP Services about this Cancellation Proceeding involving the Disputed Marks which occurred prior to entering into the Purported Assignment Agreement.

Objections and Answer to Interrogatory No. 5 (Initial Response)

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]
 [REDACTED]
 [REDACTED]
 [REDACTED]

10626656.1

[REDACTED]

[REDACTED].

First Supplemental Objections and Answer to Interrogatory No. 5

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Second Supplemental Objections and Answer to Interrogatory No. 5

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Dated: November 8, 2021

Respectfully submitted,

/Phillip C. Samouris/

Phillip C. Samouris
Higgs Fletcher & Mack LLP
401 West "A" Street, Suite 2500
San Diego, CA 92101-7910
Telephone: (619) 236-1551
Facsimile: (619) 696-1410
Email: trademarks@higgslaw.com,
samouris@higgslaw.com

ATTORNEYS FOR RESPONDENT SYCUAN
TRIBAL DEVELOPMENT CORPORATION

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing SYCUAN TRIBAL DEVELOPMENT CORPORATION'S SECOND SUPPLEMENTAL ANSWERS AND OBJECTIONS TO PETITIONER'S INTERROGATORIES PURSUANT TO BOARD ORDER (NOS. 3 and 5) in Cancellation No. 92063134 was served on November 8, 2021 via email to:

Ann K Ford
DLA Piper LLP (US)
500 8th St NW
Washington, DC 20004
ann.ford@dlapiper.com, thomas.zutic@dlapiper.com, john.nading@dlapiper.com,
ashley.joyce@dlapiper.com, dctrademarks@dlapiper.com

as Petitioner Philip Morris USA Inc.'s counsel

and

Heather Kliebenstein
Merchant & Gould P.C.
80 South Eighth St. Suite 3200
Minneapolis, Minnesota 55402
akrueger@merchantgould.com, dockmpls@merchantgould.com,
hkliebenstein@merchantgould.com

as Respondent IP Services International, Inc.'s counsel

Dated: November 8, 2021

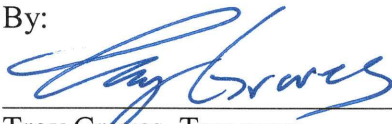
By: /Philip C. Samouris/
Philip C. Samouris

CONFIDENTIAL — SUBJECT TO PROTECTIVE ORDER

VERIFICATION

I, Troy Graves, Treasurer for Respondent Sycuan Tribal Development Corporation of 2 Kwaaypaay Court, El Cajon, California 92019, hereby declare that the answers provided in the foregoing SYCUAN TRIBAL DEVELOPMENT CORPORATION'S SECOND SUPPLEMENTAL ANSWERS AND OBJECTIONS TO PETITIONER'S INTERROGATORIES PURSUANT TO BOARD ORDER, are true and correct to the best of my knowledge, information, and belief of the information available to Respondent Sycuan Tribal Development Corporation, executed under penalty of perjury on this 9th day of November, 2021, at El Cajon (city), California.

By:



Troy Graves, Treasurer

Sycuan Tribal Development Corporation

Exhibit 9
Filed Under Seal

Exhibit 10

Filed Under Seal

Exhibit 11

Filed Under Seal

Exhibit 12

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

In the matter of Trademark
Registration No. 3172861
Mark: CROSSROADS & Design
Filed: February 28, 2005
Registered: November 21, 2006

In the matter of Trademark
Registration No. 3140971
Mark: NYC CLASSIC & Design
Filed: April 25, 2005
Registered: September 12, 2006

In the matter of Trademark
Registration No. 4218677
Mark: CARPE DIEM & Design
Filed: February 15, 2011
Registered: October 2, 2012

In the matter of Trademark
Registration No. 4261884
Mark: CARPE DIEM & Design
Filed: February 15, 2011
Registered: December 18, 2012

PHILIP MORRIS USA INC.,

Petitioner,

v.

IP SERVICES INTERNATIONAL, INC.
and SYCUAN TRIBAL DEVELOPMENT
CORPORATION,

Respondents.

Cancellation No.: 92063134

**SYCUAN TRIBAL DEVELOPMENT
CORPORATION'S FIRST
SUPPLEMENTAL RESPONSES AND
OBJECTIONS TO PETITIONER'S
REQUESTS FOR PRODUCTION OF
DOCUMENTS AND THINGS
PURSUANT TO BOARD ORDER
(NOS. 1-2, 4-6, and 10)**

Specially appearing Respondent, Sycuan Tribal Development Corporation ("Sycuan" or
"STDC"), a tribal corporation chartered under section 17 of the Indian Reorganization Act (25

U.S.C.A. § 5124 [formerly cited as 25 USCA § 477]), and approved by the Bureau of Indian Affairs as a legal entity wholly owned by the Sycuan Band of the Kumeyaay Nation (the “Sycuan Band”), a federally recognized Indian Tribe, hereby provides its First Supplemental Responses and Objections to Petitioner Philip Morris USA Inc.’s Requests for Production of Documents and Things to Respondent Sycuan Tribal Development Corporation Pursuant to Board Order. STDC’s First Supplemental Responses and Objection are made without waiving or intending to waive STDC’s immunity from suit in this case, as set forth in its Motion for Summary Judgment Based on Tribal Immunity dated November 16, 2018 (52, 53 TTABVUE), or any objection as to relevancy, privilege, or admissibility of any information in this or any other action on any ground. STDC provides these First Supplemental Responses and Objections for the limited purpose of responding to the limited, jurisdictional discovery allowed by the Board in this case in the Order dated January 30, 2021 (66 TTABVUE) and in accordance with the further order of the Board dated September 30, 2021 (74 TTABVUE).

FIRST SUPPLEMENTAL RESPONSES AND OBJECTIONS

Request No. 1

Produce all documents related to Sycuan’s process to seek status as “a federally chartered Section 17 corporation approved by the Bureau of Indian Affairs as a legal entity wholly owned by the Tribe,” as stated in Troy Graves’ Declaration in support of Sycuan’s Motion for Summary Judgment Based on Tribal Immunity (54 & 55 TTABVUE 58, ¶ 9).

Objections and Response to Request No. 1 (Initial Response)

STDC objects to this request to the extent that it goes beyond the scope of the allowed discovery. The Board has allowed Petitioner “limited, jurisdictional discovery” in the form of “written discovery requests directed **solely** to the issues of whether Sycuan TDC is an entity that may claim tribal sovereign immunity and, if so, whether there has been a waiver of any such immunity in this case.” 66 TTABVUE 4 (emphasis in original).

Under well-established federal law, the factors that courts apply to determine whether an entity is an “arm-of-the-tribe” that may claim tribal sovereign immunity include: (1) the method of the entity’s creation; (2) its purpose; (3) its structure, ownership, and management; (4) the tribe’s intent to share its sovereign immunity; and (5) the financial relationship between the tribe and the entity. *See White v. Univ. of Cal.*, 765 F.3d 1010, 1026 (9th Cir. 2014) (citing *Breakthrough Management Group, Inc. v. Chukchansi Gold Casino & Resort*, 629 F.3d 1173 (10th Cir. 2010)); *see also Amerind Risk Management Corp. v. Malaterre*, 633 F.3d 680, 685 (8th Cir. 2011) (recognizing that “[s]everal courts have recently recognized that § 477 corporations [i.e., tribal corporations chartered under section 17 of the Indian Reorganization Act (25 U.S.C. § 5124 [formerly cited as 25 U.S.C. § 477]),] are entitled to tribal sovereign immunity” and citing *Memphis Biofuels, LLC v. Chickasaw Nation Indus., Inc.*, 585 F.3d 917, 920–21 (6th Cir.2009); *Bales v. Chickasaw Nation Indus.*, 606 F. Supp. 2d 1299, 1304 (D.N.M. 2009); and *Sanchez v. Santa Ana Golf Club, Inc.*, 136 N.M. 682, 104 P.3d 548, 551 (2004)). Therefore, only information relevant to those factors are within the scope of the allowed discovery with respect to the issue of whether STDC is an entity that may claim tribal sovereign immunity.

Subject to the stated objections, and properly limiting the request to the method of STDC’s creation as a federally chartered Section 17 corporation, STDC is producing the discovery sought by this request with this response.

First Supplemental Objections and Response to Request No. 1

STDC repeats its prior objections to this Request to the extent not overruled by the order of the Board dated September 30, 2021 (74 TTABVUE) and further objects that the request may

seek information protected by the attorney-client and/or the attorney work product privileges.

Without waiving those objections, STDC provides the following First Supplemental response:

After a reasonably diligent review of its records and internal inquiry, STDC has confirmed that its initial production is complete.

Request No. 2

Produce all documents relied upon by Sycuan to substantiate its “arm-of-the-tribe” assertion, as stated in Sycuan’s Motion for Summary Judgment Based on Tribal Immunity (54 TTABVUE 5 n.2).

Objections and Response to Request No. 2 (Initial Response)

Subject to the stated objections, STDC is producing the discovery sought by this request with this response.

First Supplemental Objections and Response to Request No. 2

STDC previously produced discovery sought by this request and is producing additional responsive discovery with this first supplemental response.

Request No. 4

Produce all documents in relation to Sycuan’s knowledge of the Cancellation Proceeding before the execution of the Purported Assignment Agreement.

Objections and Response to Request No. 4 (Initial Response)

STDC objects to this request on the grounds that it seeks information beyond the scope of the allowed discovery. The Board has allowed Petitioner only “limited, jurisdictional discovery” in the form of “written discovery requests directed **solely** to the issues of whether Sycuan TDC is an entity that may claim tribal sovereign immunity and, if so, whether there has been a waiver of any such immunity in this case.” 66 TTABVUE 4 (emphasis in original).

Under well-established federal law, the factors that courts apply to determine whether an entity is an “arm-of-the-tribe” that may claim tribal sovereign immunity include: (1) the method

of the entity’s creation; (2) its purpose; (3) its structure, ownership, and management; (4) the tribe’s intent to share its sovereign immunity; and (5) the financial relationship between the tribe and the entity. *See White v. Univ. of Cal.*, 765 F.3d 1010, 1026 (9th Cir. 2014) (citing *Breakthrough Management Group, Inc. v. Chukchansi Gold Casino & Resort*, 629 F.3d 1173 (10th Cir. 2010)); *see also Amerind Risk Management Corp. v. Malaterre*, 633 F.3d 680, 685 (8th Cir. 2011) (recognizing that “[s]everal courts have recently recognized that § 477 corporations [i.e., tribal corporations chartered under section 17 of the Indian Reorganization Act (25 U.S.C. § 5124 [formerly cited as 25 U.S.C. § 477]),] are entitled to tribal sovereign immunity” and citing *Memphis Biofuels, LLC v. Chickasaw Nation Indus., Inc.*, 585 F.3d 917, 920–21 (6th Cir.2009); *Bales v. Chickasaw Nation Indus.*, 606 F. Supp. 2d 1299, 1304 (D.N.M. 2009); and *Sanchez v. Santa Ana Golf Club, Inc.*, 136 N.M. 682, 104 P.3d 548, 551 (2004)). Therefore, only information relevant to those factors are within the scope of the allowed discovery with respect to the issue of whether STDC is an entity that may claim tribal sovereign immunity.

This request does not seek information related to the factors to be considered under the law to determine whether an entity is an “arm-of-the-tribe” that may claim tribal sovereign immunity.

This request also does not seek information related to whether STDC has waived its immunity in this case. Under well-established federal law, a waiver of tribal sovereign immunity must be clear and unequivocally expressed by Congress or the immune party, here STDC. *Oklahoma Tax Comm’n v. Citizen Band Potawatomi Tribe of Okla.*, 498 U.S. 505, 509 (1991) (“*Potawatomi*”); *N. Arapaho Tribe v. Harnsberger*, 697 F.3d 1272, 1281 (10th Cir. 2012). STDC’s approved Federal Charter limits how it may waive tribal immunity. Under the approved

Federal Charter, only STDC's Corporate Board, and no other corporate officer, employee or agent, is authorized to waive sovereign immunity. Waivers must be considered by the Corporate Board on a transaction by transaction basis. In order to waive STDC's sovereign immunity, the Corporate Board must take official action on each proposed waiver and by resolution set the conditions, terms, and limits of the Corporation's waiver of immunity for that transaction.

Waiver cannot be implied through STDC's knowledge of this proceeding as a matter of law. *See Amerind*, 633 F.3d at 686-88 (8th Cir. 2011) (immunity not waived by tribal entity assuming predecessor's non-immune obligations and liabilities: "A sovereign entity does not automatically waive its sovereign immunity through the mere act of succeeding a corporation that is either not entitled to sovereign immunity or that has waived such immunity. In other words, a predecessor corporation's amenability to a pending suit is irrelevant unless the sovereign successor's immunity has been expressly and unequivocally waived" (citations omitted)); *see also, e.g., Potawatomi*, 498 U.S. at 509 (filing lawsuit did not waive immunity with respect to compulsory counterclaims); *Contour Spa v. Seminole Tribe of Fla.*, 692 F.3d 1220, 1206-08 (11th Cir. 2012) (removal of case to federal court did not waive tribal immunity); *Memphis Biofuels*, 585 F.3d at 919 (upholding immunity of tribal corporation despite corporation's express waiver of immunity because corporate charter required approval of waiver by board of directors, which was absent); *Navajo Nation*, Civ. No. 12-195 LH/LAM, 2014 U.S. Dist. LEXIS 187452, at *23-4 (D.N.M. Sept. 19, 2014) (filing infringement lawsuit did not waive tribe's immunity from counterclaim for cancellation of trademark registration).

Accordingly, this request is not within the scope of the allowed discovery. STDC therefore objects to this request in full.

First Supplemental Objections and Response to Request No. 4

STDC objects to this Request to the extent that it requests documents subject to the attorney-client privilege, work product protection, or any other applicable privilege or protection from discovery as described in the privilege log, below. STDC repeats its prior objections to this Request to the extent not overruled by the order of the Board dated September 30, 2021 (74 TTABVUE) and provides this First Supplemental response:

STDC is withholding the following document on the basis of privilege:

Privilege Log No.	Document Date	To:	From:	Document's General Subject Matter	Privilege / Protection Claimed
1	Jan. 29, 2018	Michelle Carr (In-House counsel for Sycuan); Troy Graves (STDC Board Treasurer); Cody Martinez (Sycuan Chairman); and Henry Murphy (Sycuan Vice Chairman)	Bob Whitener (STDC advisor)	E-mail requesting legal advice relating to potential purchase agreement for cigarette brands and litigation involving cigarette brands	Attorney-Client Privilege

STDC responds that no further documents exist that are responsive to this request.

Request No. 5

Produce all documents in relation to Sycuan's knowledge of the Cancellation Proceeding after the execution of the Purported Assignment Agreement.

Objections and Response to Request No. 5 (Initial Response)

STDC objects to this request on the grounds that it seeks information beyond the scope of the allowed discovery. The Board has allowed Petitioner only "limited, jurisdictional discovery" in the form of "written discovery requests directed **solely** to the issues of whether Sycuan TDC is an entity that may claim tribal sovereign immunity and, if so, whether there has been a waiver of any such immunity in this case." 66 TTABVUE 4 (emphasis in original).

Under well-established federal law, the factors that courts apply to determine whether an entity is an "arm-of-the-tribe" that may claim tribal sovereign immunity include: (1) the method

of the entity’s creation; (2) its purpose; (3) its structure, ownership, and management; (4) the tribe’s intent to share its sovereign immunity; and (5) the financial relationship between the tribe and the entity. *See White v. Univ. of Cal.*, 765 F.3d 1010, 1026 (9th Cir. 2014) (citing *Breakthrough Management Group, Inc. v. Chukchansi Gold Casino & Resort*, 629 F.3d 1173 (10th Cir. 2010)); *see also Amerind Risk Management Corp. v. Malaterre*, 633 F.3d 680, 685 (8th Cir. 2011) (recognizing that “[s]everal courts have recently recognized that § 477 corporations [i.e., tribal corporations chartered under section 17 of the Indian Reorganization Act (25 U.S.C. § 5124 [formerly cited as 25 U.S.C. § 477]),] are entitled to tribal sovereign immunity” and citing *Memphis Biofuels, LLC v. Chickasaw Nation Indus., Inc.*, 585 F.3d 917, 920–21 (6th Cir.2009); *Bales v. Chickasaw Nation Indus.*, 606 F. Supp. 2d 1299, 1304 (D.N.M. 2009); and *Sanchez v. Santa Ana Golf Club, Inc.*, 136 N.M. 682, 104 P.3d 548, 551 (2004)). Therefore, only information relevant to those factors are within the scope of the allowed discovery with respect to the issue of whether STDC is an entity that may claim tribal sovereign immunity.

This request does not seek information related to the factors to be considered under the law to determine whether an entity is an “arm-of-the-tribe” that may claim tribal sovereign immunity.

This request also does not seek information related to whether STDC has waived its immunity in this case. Under well-established federal law, a waiver of tribal sovereign immunity must be clear and unequivocally expressed by Congress or the immune party, here STDC. *Oklahoma Tax Comm’n v. Citizen Band Potawatomi Tribe of Okla.*, 498 U.S. 505, 509 (1991) (“*Potawatomi*”); *N. Arapaho Tribe v. Harnsberger*, 697 F.3d 1272, 1281 (10th Cir. 2012). STDC’s approved Federal Charter limits how it may waive tribal immunity. Under the approved

Federal Charter, only STDC's Corporate Board, and no other corporate officer, employee or agent, is authorized to waive sovereign immunity. Waivers must be considered by the Corporate Board on a transaction by transaction basis. In order to waive STDC's sovereign immunity, the Corporate Board must take official action on each proposed waiver and by resolution set the conditions, terms, and limits of the Corporation's waiver of immunity for that transaction.

Waiver cannot be implied through STDC's knowledge of this proceeding as a matter of law. *See Amerind*, 633 F.3d at 686-88 (8th Cir. 2011) (immunity not waived by tribal entity assuming predecessor's non-immune obligations and liabilities: "A sovereign entity does not automatically waive its sovereign immunity through the mere act of succeeding a corporation that is either not entitled to sovereign immunity or that has waived such immunity. In other words, a predecessor corporation's amenability to a pending suit is irrelevant unless the sovereign successor's immunity has been expressly and unequivocally waived" (citations omitted)); *see also, e.g., Potawatomi*, 498 U.S. at 509 (filing lawsuit did not waive immunity with respect to compulsory counterclaims); *Contour Spa v. Seminole Tribe of Fla.*, 692 F.3d 1220, 1206-08 (11th Cir. 2012) (removal of case to federal court did not waive tribal immunity); *Memphis Biofuels*, 585 F.3d at 919 (upholding immunity of tribal corporation despite corporation's express waiver of immunity because corporate charter required approval of waiver by board of directors, which was absent); *Navajo Nation*, Civ. No. 12-195 LH/LAM, 2014 U.S. Dist. LEXIS 187452, at *23-4 (D.N.M. Sept. 19, 2014) (filing infringement lawsuit did not waive tribe's immunity from counterclaim for cancellation of trademark registration).

Accordingly, this request is not within the scope of the allowed discovery. STDC therefore objects to this request in full.

First Supplemental Objections and Response to Request No. 5

STDC objects to this Request to the extent that it requests documents subject to the attorney-client privilege, work product protection, or any other applicable privilege or protection from discovery as described in the privilege log, below. STDC repeats its prior objections to this Request to the extent not overruled by the order of the Board dated September 30, 2021 (74 TTABVUE) and provides this First Supplemental response:

STDC is withholding the following documents on the basis of privilege:

Privilege Log No.	Document Date	To:	From:	Document's General Subject Matter	Privilege / Protection Claimed
2	July 12, 2018	Oliver Duggal; Mark Radoff (Sycuan General Counsel); Denise Turner Walsh (Rincon Band of Luiseño Indians Attorney General); George Forman (Soboba Band of Luiseno Indians Outside Counsel); Jay B. Shapiro (Soboba Band of Luiseno Indians Outside Counsel); Scott Wheat (Rincon Band of Luiseño Indians Outside Counsel); Troy Graves (STDC Board Treasurer); Glenn Quiroga (STDC EVP)	Bob Whitener (STDC advisor)	E-mail requesting and referring to legal advice relating to purchase and sale agreement for cigarette brands and litigation involving cigarette brands	Attorney-Client Privilege; Joint Defense & Common Interest Privilege

Privilege Log No.	Document Date	To:	From:	Document's General Subject Matter	Privilege / Protection Claimed
3	September 14, 2018	Jay B. Shapiro (Soboba Band of Luiseno Indians Outside Counsel); Scott Wheat (Rincon Band of Luiseño Indians Outside Counsel); Scott Wheat (Rincon Band of Luiseño Indians Outside Counsel Legal Assistant) Denise Turner Walsh (Rincon Band of Luiseño Indians Attorney General); Mark Radoff (Sycuan General Counsel); George Forman (Soboba Band of Luiseno Indians Outside Counsel); Catherine Locher (Sycuan General Counsel Legal Assistant); Glenn Quiroga (STDC EVP); Cody Martinez (Sycuan Chairman); Troy Graves (STDC Board Treasurer);	Bob Whitener (STDC advisor)	E-mail requesting and referring to legal advice relating to purchase and sale agreement for cigarette brands and litigation involving cigarette brands	Attorney-Client Privilege; Joint Defense & Common Interest Privilege
4	Numerous after 9/25/2018	To/From Sycuan General Counsel (Mark Radoff)	To/From Outside Counsel in this proceeding (Higgs, Fletcher & Mark LLP)	Defense in this proceeding	Attorney-Client Privilege

STDC responds that no further documents exist that are responsive to this request.

Request No. 6

Produce all documents which reflect any communications between Sycuan and IP Services in connection with the assignment of the Disputed Marks from IP Services to Sycuan.

Objections and Response to Request No. 6 (Initial Response)

STDC objects to this request on the grounds that it seeks information beyond the scope of the allowed discovery. The Board has allowed Petitioner only “limited, jurisdictional discovery” in the form of “written discovery requests directed **solely** to the issues of whether Sycuan TDC is

an entity that may claim tribal sovereign immunity and, if so, whether there has been a waiver of any such immunity in this case.” 66 TTABVue 4 (emphasis in original).

Under well-established federal law, the factors that courts apply to determine whether an entity is an “arm-of-the-tribe” that may claim tribal sovereign immunity include: (1) the method of the entity’s creation; (2) its purpose; (3) its structure, ownership, and management; (4) the tribe’s intent to share its sovereign immunity; and (5) the financial relationship between the tribe and the entity. *See White v. Univ. of Cal.*, 765 F.3d 1010, 1026 (9th Cir. 2014) (citing *Breakthrough Management Group, Inc. v. Chukchansi Gold Casino & Resort*, 629 F.3d 1173 (10th Cir. 2010)); *see also Amerind Risk Management Corp. v. Malaterre*, 633 F.3d 680, 685 (8th Cir. 2011) (recognizing that “[s]everal courts have recently recognized that § 477 corporations [i.e., tribal corporations chartered under section 17 of the Indian Reorganization Act (25 U.S.C. § 5124 [formerly cited as 25 U.S.C. § 477]),] are entitled to tribal sovereign immunity” and citing *Memphis Biofuels, LLC v. Chickasaw Nation Indus., Inc.*, 585 F.3d 917, 920–21 (6th Cir.2009); *Bales v. Chickasaw Nation Indus.*, 606 F. Supp. 2d 1299, 1304 (D.N.M. 2009); and *Sanchez v. Santa Ana Golf Club, Inc.*, 136 N.M. 682, 104 P.3d 548, 551 (2004)). Therefore, only information relevant to those factors are within the scope of the allowed discovery with respect to the issue of whether STDC is an entity that may claim tribal sovereign immunity.

This request does not seek information related to the factors to be considered under the law to determine whether an entity is an “arm-of-the-tribe” that may claim tribal sovereign immunity.

This request also does not seek information related to whether STDC has waived its immunity in this case. Under well-established federal law, a waiver of tribal sovereign immunity

must be clear and unequivocally expressed by Congress or the immune party, here STDC.

Oklahoma Tax Comm'n v. Citizen Band Potawatomi Tribe of Okla., 498 U.S. 505, 509 (1991)

(“*Potawatomi*”); *N. Arapaho Tribe v. Harnsberger*, 697 F.3d 1272, 1281 (10th Cir. 2012).

STDC’s approved Federal Charter limits how it may waive tribal immunity. Under the approved Federal Charter, only STDC’s Corporate Board, and no other corporate officer, employee or agent, is authorized to waive sovereign immunity. Waivers must be considered by the Corporate Board on a transaction by transaction basis. In order to waive STDC’s sovereign immunity, the Corporate Board must take official action on each proposed waiver and by resolution set the conditions, terms, and limits of the Corporation’s waiver of immunity for that transaction.

Waiver cannot be implied through STDC’s knowledge of this proceeding as a matter of law. *See Amerind*, 633 F.3d at 686-88 (8th Cir. 2011) (immunity not waived by tribal entity assuming predecessor’s non-immune obligations and liabilities: “A sovereign entity does not automatically waive its sovereign immunity through the mere act of succeeding a corporation that is either not entitled to sovereign immunity or that has waived such immunity. In other words, a predecessor corporation’s amenability to a pending suit is irrelevant unless the sovereign successor’s immunity has been expressly and unequivocally waived” (citations omitted)); *see also, e.g., Potawatomi*, 498 U.S. at 509 (filing lawsuit did not waive immunity with respect to compulsory counterclaims); *Contour Spa v. Seminole Tribe of Fla.*, 692 F.3d 1220, 1206-08 (11th Cir. 2012) (removal of case to federal court did not waive tribal immunity); *Memphis Biofuels*, 585 F.3d at 919 (upholding immunity of tribal corporation despite corporation’s express waiver of immunity because corporate charter required approval of waiver by board of directors, which was absent); *Navajo Nation*, Civ. No. 12-195 LH/LAM, 2014 U.S.

Dist. LEXIS 187452, at *23-4 (D.N.M. Sept. 19, 2014) (filing infringement lawsuit did not waive tribe's immunity from counterclaim for cancellation of trademark registration).

Accordingly, this request is not within the scope of the allowed discovery. STDC therefore objects to this request in full.

First Supplemental Objections and Response to Request No. 6

STDC repeats its prior objections to this Request to the extent not overruled by the order of the Board dated September 30, 2021 (74 TTABVUE) and provides the following response limited to “documents which reflect communications between Sycuan TDC and IP Services International, Inc., related to Sycuan TDC’s knowledge of this cancellation proceeding, in connection with the assignment of the Disputed Marks from IP Services International, Inc. to Sycuan TDC” pursuant to the order of the Board dated September 30, 2021 (74 TTABVUE):

STDC is withholding the following document on the basis of privilege:

Privilege Log No.	Document Date	To:	From:	Document’s General Subject Matter	Privilege / Protection Claimed
2	July 12, 2018	Oliver Duggal; Mark Radoff (Sycuan General Counsel); Denise Turner Walsh (Rincon Band of Luiseño Indians Attorney General); George Forman (Soboba Band of Luiseno Indians Outside Counsel); Jay B. Shapiro (Soboba Band of Luiseno Indians Outside Counsel); Scott Wheat (Rincon Band of Luiseño Indians); Troy Graves (STDC Board Treasurer; Glenn Quiroga (STDC EVP)	Bob Whitener (STDC advisor)	E-mail requesting and referring to legal advice relating to purchase and sale agreement for cigarette brands and litigation involving cigarette brands	Attorney-Client Privilege; Joint Defense & Common Interest Privilege

STDC responds that no further documents exist that are responsive to this request.

Request No. 10

Produce all documents reflecting a waiver of tribal immunity in connection with this Cancellation Proceeding.

Objections and Response to Request No. 10 (Initial Response)

Subject to the stated objections, STDC responds that the discovery sought by this request does not exist. Although not required to do so by this request, in the spirit of cooperation and in a good faith effort to avoid discovery disputes with Petitioner, STDC states that it has not waived its immunity in this case and/or issued any waivers of immunity to any party in this case at any time.

First Supplemental Objections and Response to Request No. 10

STDC repeats its prior objections to this Request to the extent not overruled by the order of the Board dated September 30, 2021 (74 TTABVUE) and provides this First Supplemental response:

STDC responds that the discovery sought by this request does not exist.

Dated: October 20, 2021

Respectfully submitted,

/Phillip C. Samouris/

Phillip C. Samouris

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ATTORNEYS FOR RESPONDENT SYCUAN
TRIBAL DEVELOPMENT CORPORATION

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing SYCUAN TRIBAL DEVELOPMENT CORPORATION'S FIRST SUPPLEMENTAL RESPONSES AND OBJECTIONS TO PETITIONER'S REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS PURSUANT TO BOARD ORDER (NOS. 1-2, 4-6, and 10) in Cancellation No. 92063134 was served on October 20, 2021 via email to:

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as Respondent IP Services International, Inc.'s counsel

Dated: October 20, 2021

By:

/James Cekola/
James Cekola, attorney for Respondent
Sycuan Tribal Development Corporation