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

Proceeding no.	92086835
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Attachments	PARTIAL MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM PURSUANT TO FE D RULE OF CIVIL PROCEDURE 12b-6.pdf(792375 bytes )

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

Deno Land Inc.,  Petitioner,  v.  Oracle America, Inc.,  Registrant.	Cancellation No.: 92086835  Trademark: JAVASCRIPT  Registration No.: 2416017
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**PARTIAL MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM PURSUANT TO  
FEDERAL RULE OF CIVIL PROCEDURE 12(b)(6)**

Pursuant to Federal Rule of Civil Procedure 12(b)(6) and TBMP § 503, Oracle America, Inc. (“Oracle”), moves to dismiss the Petition for Cancellation in part because the Petition fails to state a claim upon which relief can be granted as to Claim 2, which alleges “Oracle Committed Fraud on the USPTO.” The Petition ignores completely that Oracle submitted two specimens. Moreover, on its face, the Petition fails to allege a claim of fraud as to the renewal in Class 42 because the specimen it touts as “fraudulent” was submitted to support only the renewal in Class 9 and not Class 42.

Pursuant to TBMP § 503.01, this motion tolls the deadline to otherwise answer the Petition,<sup>1</sup> and Oracle requests that the Board reset the answer deadline to at least 30 days after the date of its decision on this motion.

**INTRODUCTION**

Petitioner seeks to cancel Oracle’s longstanding Registration No. 2416017 (the “Registration”) for its JAVASCRIPT mark on the basis of: (1) genericness; (2) fraud; and (3)

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<sup>1</sup> To the extent that an answer is required, Oracle denies all salient allegations set forth in the Petition.

abandonment. *See generally* 1 TTABVue. Oracle expects to prevail as to genericness and abandonment at summary judgment, where the undisputed evidence will show that Oracle uses the JAVASCRIPT mark in connection with a variety of offerings, including its JAVASCRIPT Extension Toolkit as well as developer’s guides and educational resources, and also that relevant consumers do not perceive JAVASCRIPT as a generic term.

For purposes of this motion to dismiss petitioner’s fraud claim, Oracle’s unchallenged specimen showing use of the JAVASCRIPT mark in 2019 in connection with the JAVASCRIPT Extension Toolkit is decisive. That is, notwithstanding Petitioner’s (insufficient) allegations with respect to the node.js website, Petitioner has not challenged and could not plausibly challenge the JAVASCRIPT Extension Toolkit page from Oracle’s own website that Oracle submitted as its primary specimen in Class 9 and as its only specimen in Class 42. Accordingly, Petitioner has failed to plausibly allege that Oracle made any false statement that was material to the renewal of its registration for the JAVASCRIPT registration. The second cause of action must, therefore, be dismissed. Because it is impossible for Petitioner to amend the Petition in a manner that addresses this fundamental pleading failure, leave to amend would be futile, and Oracle respectfully requests that the dismissal be with prejudice.

## **I. BACKGROUND**

Oracle, on its own and through its predecessors-in-interest and licensees, has used the JAVASCRIPT mark since at least as early as 1996 in connection with several offerings, including educational and training services, developer tools, and computer programs. The following facts are of public record in connection with the Registration. On December 26, 2000, the Office granted Oracle Registration No. 2416017, covering “computer programs, namely, utility programs, language processors and interpreters” in Class 9 and “providing computer

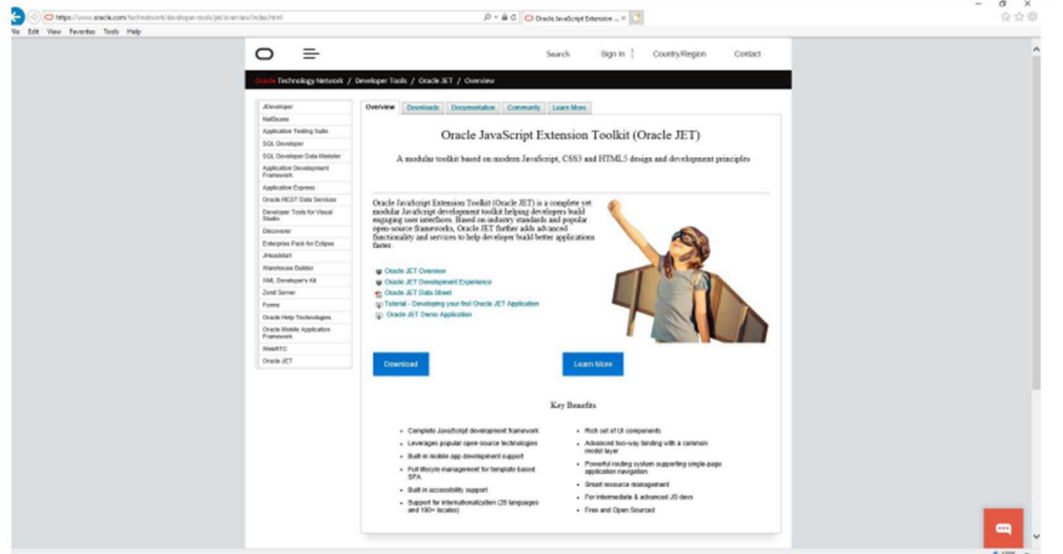
programs, namely, utility programs, language processors and interpreters, that may be downloaded from a global computer network” in Class 42. A Declaration of Continuing Use and Incontestability pursuant to Sections 8 & 15 of the Lanham Act was timely filed and accepted on February 26, 2007, and the Office accepted a Declaration of Continuing Use and Renewal Application on January 10, 2011.

On December 26, 2019, Oracle, through counsel, submitted a Combined Section 8 and 9 Declaration of Use and Application for Renewal (the “Renewal Application”) for the Registration, together with the affirmation that the “owner is submitting one (or more) specimen(s) showing the mark as used in commerce[.]” With its Renewal Application, Oracle submitted two specimens of use. For Class 9, Oracle submitted a specimen showing the JAVASCRIPT mark in use on Oracle’s website in connection with the JAVASCRIPT Extension Toolkit (the “Primary Specimen”) together with a secondary specimen, which consisted of a screenshot of the node.js website (the “Node.js Specimen”).<sup>2</sup> See Dec. 26, 2019 Combined Section 8 & 9 Declaration of Use and Application for Renewal (the “Dec. 26 Combined Section 8 & 9”) pp. 8-9 and below. For Class 42, Oracle submitted only the Primary Specimen.

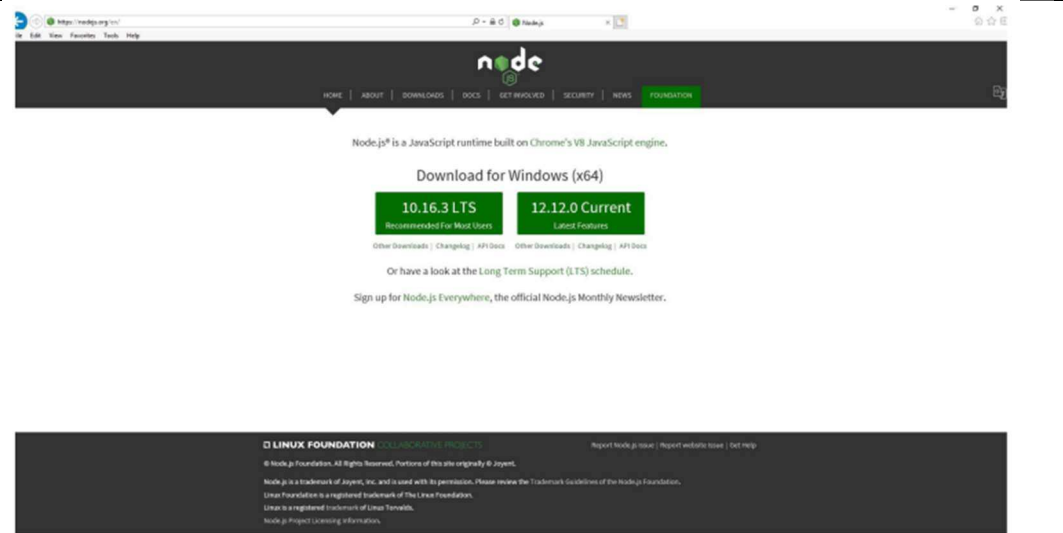
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<sup>2</sup> Oracle does not concede that submission of the Node.js Specimen was improper. However, the Board need not address that question in connection with this Motion.

**Primary Specimen**



**Node.js Specimen**



Petitioner alleges that the Node.js Specimen did not “show any use of the mark by Oracle or on behalf of Oracle” and that Oracle knew its use of the Node.js Specimen to show use in commerce was not valid. 1 TTABVue at ¶¶ 14, 16. According to Petitioner these allegations – if proven – would establish the standard declarations included in Oracle’s Renewal Application (set forth below) were knowingly false:

1. “The owner is submitting one (or more) specimen(s) showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) website where the goods can be downloaded.”
2. “[T]he mark is in use in commerce on or in connection with the goods/services or to indicate membership in the collective membership organization identified above, as evidenced by the attached specimen(s).”
3. “[T]he specimen(s) shows the mark as currently used in commerce on or in connection with the goods/services/collective membership organization.”
4. “To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.”

Dec. 26 Combined Section 8 & 9 pp. 5-7. Petitioner takes this extraordinary position without even addressing the Primary Specimen, which was also submitted to show use of the mark with the Registration's Class 9 goods and was the *only* specimen Oracle submitted for the Class 42 Renewal Application. *Id.* at 10.

## **II. LEGAL ANALYSIS**

Even if taken as true, Petitioner's factual allegations are insufficient to give rise to a plausible entitlement to relief on a fraud claim. Nor would any permissible amendment of this claim resolve these insufficiencies.

### **A. Legal standard**

#### *1. Rule 12(b)(6) Compels Dismissal Where Claims Are Implausible.*

To survive a motion to dismiss pursuant to Rule 12(b)(6), Petitioner must set forth legal standards and factual allegations that give rise to a plausible (not just a possible) entitlement to

relief. *See Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555, 127 S. Ct. 1955, 1965, 167 L. Ed. 2d 929, 940 (2007). The Board must dismiss a petition for cancellation under Rule 12(b)(6) if it fails to state a claim that is “plausible on its face.” TBMP § 503.02 (citing *Twombly*, 550 U.S. at 570, 127 S. Ct. at 1974, 167 L. Ed. 2d at 949); *see also Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 26 U.S.P.Q.2d 1038, 1041 (Fed. Cir. 1993). The primary function of Rule 12(b)(6) “is to allow the court to eliminate actions that are fatally flawed in their legal premise and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity.” *Advanced*, 26 U.S.P.Q.2d at 1041.

When considering a motion to dismiss, the Board must accept the factual allegations pleaded in the complaint as true, but “conclusory allegations of law and unwarranted inferences of fact” are insufficient to support a claim and are not entitled to the assumption of truth.

*Bradley v. Chiron Corp.*, 45 U.S.P.Q.2d 1819, 1822 (Fed. Cir. 1998); *see also La Terra Fina USA, LLC v. Reser's Fine Foods, Inc.*, No. 3:23-cv-02631-JSC, 2024 U.S. Dist. LEXIS 127982, at \*8 (N.D. Cal. July 19, 2024).<sup>3</sup>

Finally, “although it is the general practice of the Board to allow a party an opportunity to correct a defective pleading,” leave to amend the pleading should be refused where, as here, it would be futile or “serve no useful purpose.” *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 U.S.P.Q. (BNA) 151, 155 (TTAB 1983), *aff'd*, 739 F.2d 624 (Fed. Cir. 1984).

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<sup>3</sup> As discussed above, facts as to the number and nature of specimens Oracle submitted in connection with each class of the Registration may be considered by the Board as they are facts of public record that are not subject to reasonable dispute. *Belstone Cap., LLC v. Bellstone Partners, LLC*, No. 2:16-cv-01124-KJM-GGH, 2017 U.S. Dist. LEXIS 46015, at \*6 (E.D. Cal. Mar. 27, 2017) (citing *Intri-Plex Techs., Inc. v. Crest Grp., Inc.*, 499 F.3d 1048, 1052 (9th Cir. 2007), contemplating public records “maintained on the USPTO website”); *see also Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 U.S.P.Q.2d 1251, \*5 (TTAB 2009) [precedential] (facts in the records of the Office that are not subject to proof are properly considered in the context of a motion to dismiss); *see also* TBMP § 503.02 (“In Board proceedings, there are certain facts not subject to proof ... that the Board may consider when a party has filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6).”)

2. *Fraud Must Be Pled with Particularity and Proven To the Hilt.*

“Fraud in the procurement or maintenance of a trademark registration occurs when a party knowingly makes a false, material representation of fact in connection with an application to register or a post-registration document with the intent of obtaining or maintaining a registration right to which it is otherwise not entitled.” *Thrive Nat. Care Inc. v. Nature's Sunshine Prods.*, 2023 TTAB LEXIS 294, \*6-7 (TTAB 2023) [precedential] (citing *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 U.S.P.Q.2d 1419, 1432 (TTAB 2014) and *ShutEmDown Sports, Inc. v. Lacy*, 102 U.S.P.Q.2d 1036, 1044 (TTAB 2012)). *See also* Fed. R. Civ. P. 9 (“In alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake.”).

The party alleging fraud in the procurement or maintenance of a registration bears the heavy burden of proving fraud with clear and convincing evidence. *In re Bose Corp.*, 580 F.3d 1240, 1243, 91 U.S.P.Q.2d 1938, 1939-40 (Fed. Cir. 2009). Indeed, “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Smith Int'l, Inc. v. Olin Corp.*, 209 U.S.P.Q. (BNA) 1033, 1044 (TTAB 1981).

Where, as here, Registrant “provided the USPTO with [two specimens]” at least one of which shows use of the mark in commerce, Petitioner cannot plausibly allege that the inclusion of a second, purportedly defective specimen, was material. *Belstone Cap., LLC*, 2017 U.S. Dist. LEXIS 46015, at \*13. *See also La Terra Fina USA, LLC*, 2024 U.S. Dist. LEXIS 127982, at \*7-8 (finding no fraud where “at least one of the two specimens depicted the mark as used in commerce.”); *Bentley Motors Ltd. v. Aucera SA*, 2016 TTAB LEXIS 618, \*6-7 (TTAB 2016)



[non-precedential] (holding materiality exists where “the false statement is critical to” the Office’s registration decision). Moreover, disagreement with the Office’s decision to renew a registration based on a certain specimen “does not make out a claim of fraud.” *Belstone Cap., LLC*, 2017 U.S. Dist. LEXIS 46015, at \*12.

Intent to deceive is another “indispensable element of the analysis in a fraud claim.” *Daimlerchrysler Corp. v. Am. Motors Corp.*, 94 U.S.P.Q.2D (BNA) 1086, 1089 (TTAB 2010) (citing *In re Bose Corp.*, 580 F.3d at 1245, 91 U.S.P.Q.2d at 1941). “Because direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence. But this indirect and circumstantial evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement.” *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 2013 TTAB LEXIS 347, \*62 (TTAB 2013) [precedential] (quoting *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1366, 88 U.S.P.Q.2d 1001 (Fed. Cir. 2008), *rev’d in part on other grounds*, 655 F.3d 1364 (Fed. Cir. 2011)), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014). “Absent the requisite intent to mislead the PTO, even a material misrepresentation would not qualify as fraud under the Lanham Act warranting cancellation.” *In re Bose Corp.*, 580 F.3d at 1243, 91 U.S.P.Q.2d at 1940 (citing *King Auto., Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 1011 n.4, 212 U.S.P.Q. 801 (CCPA 1981)).

**B. Submission of the Primary Specimen Renders the Falsity Allegation Implausible.**

Petitioner does not allege any manner of false statement with respect to the Primary Specimen, which shows the JAVASCRIPT mark in use on the Oracle website, located at oracle.com. In connection with the Class 42 renewal, Oracle submitted *only* the Primary Specimen. As such, Petitioner fails to plausibly allege any false statements with respect to the

Renewal Application in Class 42, and there is no question that the fraud claim must be dismissed as to this class. *See, e.g., G&W Labs., Inc. v. G W Pharma Ltd.*, 89 U.S.P.Q.2D (BNA) 1571, 1574 (TTAB 2009) [precedential] (“[E]ach class of goods or services in a multiple class registration must be considered separately when reviewing the issue of fraud, and judgment on the ground of fraud as to one class does not in itself require cancellation of all classes in a registration.”).

Turning to the Class 9 renewal, the Petition alleges fault only with the Node.js Specimen and ignores the concomitantly submitted Primary Specimen. As a result, the Petition cannot be read to allege falsity of Oracle’s representation that “[t]he owner is submitting *one (or more)* specimen(s) showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) website where the goods can be downloaded” (emphasis added) or any other representation contained in the Renewal Application. And in light of the dual specimens submitted, no amount of discovery could reveal evidence to support a claim of falsity.

A nearly identical issue was considered in *La Terra Fina*, in which Reser sought cancellation of La Terra Fina’s registration, claiming fraud because one of two specimens submitted was allegedly digitally created and did not depict the mark used in commerce. 2024 U.S. Dist. LEXIS 127982, at \*4-5. Reser alleged that La Terra Fina’s statements to the Office that its specimens evidenced the mark in use in commerce were materially and intentionally false. *Id.* The Court granted La Terra Fina’s motion to dismiss the fraud claim because La Terra Fina’s representation to the Office was that *at least one* of the specimens depicted the mark in use in commerce, and Reser had disputed only one of the two specimens. *Id.* at \*7-8.

The same outcome is warranted here. Even taking Petitioner’s allegations regarding the Node.js Specimen as true, based on the public TSDR record, there can be no dispute that, for

both classes covered in the Registration, Oracle submitted “one (or more)” specimens showing use of the mark in commerce. *See id.* at \*8; *see also Belstone Cap., LLC*, 2017 U.S. Dist. LEXIS 46015, at \*12 (“Even given that defendants provided the USPTO with two specimens that appear different, plaintiff cannot plausibly allege fraud when defendants provided the USPTO with both.”). Petitioner therefore has not and cannot plausibly allege the falsity element of a fraud claim as to either Class 9 or Class 42, and the fraud claim should therefore be dismissed.

**C. Submission of the Primary Specimen Likewise Renders the Materiality Allegation Implausible.**

The Petition fails to plausibly allege that Oracle made a false statement to the Office, as outlined above. To the extent the Petition alleges that submission of the Node.js Specimen, in and of itself, constitutes a false statement, it fails to plausibly allege that this submission was material to the Office’s decision to grant the Renewal Application. Thus, even if the Node.js Specimen constitutes a false statement to the USPTO (which Oracle does not concede), Petitioner has not alleged any facts supporting the contention that such a false statement was material since a second specimen was also filed. Petitioner does not, and cannot plausibly, allege that the Examiner relied solely on the Node.js Specimen in making the renewal determination.<sup>4</sup> Again, with respect to Class 42, there can be no plausible allegation of materiality because Oracle submitted only the Primary Specimen to show use of the mark in connection with Class 42, and Petitioner has raised no issue with this specimen. *G&W Labs., Inc.*, 89 U.S.P.Q.2D at 1574.

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<sup>4</sup> If Petitioner argues that it should be allowed to amend the Petition to allege that the Examiner did rely on the Node.js Specimen, the Board should deny such a request. The Board cannot accept unsupported allegations. *La Terra Fina USA*, 2024 U.S. Dist. LEXIS 127982, at \*8 (the court “cannot accept conclusory and unsupported allegations” such as “the assumption the PTO in fact relied on the First Specimen as opposed to the Second when granting La Terra Fina's trademark application”). There is not, nor can there be, any support for allegations of the Office’s sole reliance on the Node.js Specimen.

With respect to Class 9 software, Petitioner fails to and cannot plausibly allege that the Office, in granting the Renewal Application, relied exclusively on the Node.js Specimen and ignored the Primary Specimen. Absent a plausible allegation that the Office relied exclusively on the supposedly improper specimen, a showing of materiality is impossible. For example, in *La Terra Fina*, the Court held that Reser’s materiality theory required an assumption that the Office relied only on the disputed specimen, but there were no facts alleged to support that assumption. 2024 U.S. Dist. LEXIS 127982, at \*7-8.

The same is true here. Petitioner does not allege, and cannot plausibly allege, facts sufficient to enable the Board to conclude that the Office relied solely on the Node.js Specimen in its review of the Renewal Application. And, with respect to Class 42, there can be no dispute that the Office reviewed and relied *only* on the Primary Specimen in connection with the Renewal Application, since that is the *only* specimen that was provided in connection with that class. Petitioner therefore fails to plead facts sufficient to support the materiality element of a fraud claim with respect to both Classes 9 and 42. For this independent reason, the fraud claim must be dismissed.

**D. The Petition Alleges No Deceptive Intent.**

Finally, in addition to the Petition’s failure to adequately allege either falsity or materiality, the Petition is bereft of any allegation or even a hint of an allegation that Oracle intended to deceive the Office, which is an “indispensable element of the analysis in a fraud claim.” *Daimlerchrysler Corp.*, 94 U.S.P.Q.2D (BNA) at 1089. Even if Petitioner is allowed to amend to add this requisite allegation, Petitioner cannot plausibly allege that Oracle intended to deceive the Office.

The Primary Specimen—about which Petitioner raises no complaint—was submitted in connection with both Class 9 goods and Class 42 services in the Renewal Application. And for Class 42, Oracle submitted *only* the Primary Specimen. Even taking Petitioner’s allegations as true that the Node.js Specimen did not show use of the mark in commerce by or on behalf of Oracle, there can be no plausible allegation that Oracle intended to mislead the Office into believing that it was using the mark when it was not. Indeed, for purposes of this motion, the Primary Specimen submitted simultaneously with the Node.js Specimen conclusively shows the JAVASCRIPT mark in use on Oracle’s company website. *See, e.g., La Terra Fina*, 2024 U.S. Dist. LEXIS 127982, at \*8 (finding no plausible facts alleged to support an assumption that La Terra Fina intended to induce the Office to rely only on the allegedly fraudulent specimen).

Oracle’s submission of the Primary Specimen completely vitiates any asserted inference that Oracle intended to deceive the Office. That is, the Primary Specimen fully supports all four of the standard declarations in Oracle’s Renewal. Thus, not only has Petitioner failed to allege intent to deceive, the unchallenged Primary Specimen establishes that Petitioner could not plausibly allege such intent. This compels dismissal of the fraud claim without leave to amend. *See, e.g., Bell Atl. Corp. v. Twombly*, 550 U.S. 544 at 567, 127 S. Ct. at 197-72, 167 L. Ed. 2d at 947-48.

### **III. CONCLUSION**

Petitioner has failed to allege facts sufficient to meet the heightened fraud pleading standards, nor can it. There is no allegation that the Primary Specimen submitted in connection with the Class 42 renewal was legally flawed, much less fraudulent. So, there can be no question that Claim 2 for fraud must be dismissed with respect to the Registration’s Class 42 offerings. With respect to Class 9 software, Oracle’s submission of two specimens obviates any claim of

falsity; moreover, there is no allegation that the Office, in approving the Renewal Application *relied solely* on the Node.js Specimen to the exclusion of the Primary Specimen; and finally, the Petition fails to allege, even obliquely, an intent to deceive.

Therefore, Oracle respectfully requests that Petitioner's fraud claim (Claim 2) be dismissed with prejudice in its entirety without leave to amend. *See NSM Res. Corp. v. Microsoft Corp.*, 113 U.S.P.Q.2D (BNA) 1029, 1035 (TTAB 2014) [precedential] (refusing to grant leave to amend a petition for cancellation and dismissing the claim with prejudice because it would be futile, in part "[g]iven the record of this proceeding."). Oracle further requests that its deadline to answer the remaining claims be reset to at least thirty days from the date of the Board's order on this motion.

February 3, 2025

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**CERTIFICATE OF SERVICE**

I hereby certify that on February 3, 2025 I served a copy of the above PARTIAL MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM PURSUANT TO FEDERAL RULE OF CIVIL PROCEDURE 12(b)(6) by email, to the following:

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