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

Proceeding no.	92086835
Party	Plaintiff Deno Land Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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Deno Land Inc.,

Petitioner,

v.

Oracle America, Inc.,

Registrant,

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Cancellation No.: 92086835

Mark: JAVASCRIPT

Registration No.: 2416017

**PETITIONER’S OPPOSITION TO PARTIAL MOTION TO DISMISS**

Deno Land Inc. (“Petitioner”) hereby submits its opposition to Oracle America, Inc.’s (“Registrant’s”) Partial Motion to Dismiss for failure to state a claim under Federal Rule of Civil Procedure 12(b)(6) due to an insufficient pleading of Petitioner’s fraud claim (“Motion to Dismiss”).

On November 22<sup>nd</sup>, 2024, Petitioner filed a Petition to Cancel (the “Cancellation”) against Registrant’s JAVASCRIPT trademark registration, Registration Number 2416017 (“Registrant’s Registration”) on three grounds: (1) abandonment of the mark; (2) the mark has become generic; and (3) fraud upon the USPTO for knowingly misleading the USPTO regarding its specimen filed in connection with its Section 8 and 9 maintenance filing submitted on December 26, 2019. *See generally* 1 TTABVUE.

On February 3, 2025, Registrant, through its counsel, submitted the Motion to Dismiss at issue. 7 TTABVUE. Petitioner asks that Registrant’s Motion to Dismiss be denied.

**Legal Standard of Review for Motion to Dismiss**

Rule 8 of the Federal Rules of Civil Procedure (“FRCP”) requires that pleadings setting forth claims for relief must include only “a short and plain statement of the claim showing the pleader is entitled to relief.” Fed. R. Civ. P. 8(a). To withstand a Motion to Dismiss based on Fed. R. Civ. P.

12(b)(6), the complaint need only allege such facts that would, if proved, establish that the Petitioner is entitled to the relief sought. Specifically, in this Motion to Dismiss, Petitioner need only establish that the Petitioner has an entitlement to a statutory cause of action to bring the proceeding (formerly referred to as “standing”) *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998). A complaint must only “state a claim to relief that is plausible on its face” to survive a Motion to Dismiss. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007). *See also Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (plausibility standard applies to all federal civil claims); *Doyle v. Al Johnson’s Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) (*citing Ashcroft v. Iqbal* for the standard to determine whether a claim has been properly pleaded).

The motion to dismiss under FRCP 12(b)(6) may be granted only if, after accepting all well-pleaded allegations in the Cancellation as true and drawing all reasonable inferences in favor of Petitioner, the Board finds that Petitioner has failed to set forth fair notice of its claims and the grounds upon which it rests. *Bell Atlantic Corp. v. Twombly*, 550 U.S. at 570. In this case, the Cancellation will survive a motion to dismiss if it states plausible grounds for Petitioner’s entitlement to the relief sought. *Id.* at 55 5-557. The Cancellation must merely contain sufficient factual allegations “to raise a right to relief above the speculative level.” *Id.* at 555-556.

Accordingly, upon consideration of the pending motion to dismiss, the issue before the Board is not whether Petitioner “will ultimately prevail but whether the claimant is entitled to offer evidence in support of the claims.” *McDowell v. N Shore-Long Island Jewish Health Sys., Inc.*, 839 F. Supp. 2d 562, 565 (E.D.N.Y.2012) (*citing Todd v. Exxon Corp.*, 275 F.3d 191, 198 (2d Cir.2001)). Whether Petitioner “can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment after the parties have had an opportunity to submit evidence in support of their respective positions.” *Cent. Mfg. Co. v. Outdoor Innovations, L.L.C.*, Proc. No. 110,966, 2003 WL 1905441 (T.T.A.B. April 17, 2003) (*citing Caron*

*Corp. v. Helena Rubinstein, Inc.*, 193 USPQ 113 (TTAB 1976)). For this reason, a motion to dismiss for failure to state a claim “is viewed with disfavor and is rarely granted.” *Phonometrics, Inc. v. Hospitality Franchise Sys.*, 203 F.3d 790, 794 (Fed. Cir. 2000). Petitioner has sufficiently pleaded its fraud claim in its Cancellation against Registrant’s Registration. Therefore, the Motion to Dismiss should be denied.

### **Petitioner has Pled its Fraud Claim with Sufficient Particularity**

Fraud before the USPTO occurs when an applicant or registrant “knowingly makes false, material representations of fact in connection with [its] application” with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009). For the purposes of this Motion to Dismiss, Petitioner’s facts, as pled in its Cancellation, must be accepted as true, and Petitioner should be afforded the opportunity to provide evidence in support of its claim that Registrant knowingly misled the USPTO to secure its Registration.

Registrant argues that Petitioner’s claims should be dismissed because, even if the “Node.js” specimen was fraudulent, other specimens were filed, rendering the fraudulent specimen immaterial. 7 TTABVue. This argument misconstrues the nature of the fraud in the trademark registration. The existence of other specimens does not negate the materiality of a fraudulent submission and the sworn statements and declarations made in conjunction with them. The crucial question is whether the fraudulent representation was capable of influencing the USPTO’s decision to grant or renew the registration.

In this case, Petitioner alleges that Registrant knowingly submitted specimens that did not reflect bona fide use of the mark in commerce as a source identifier. As pled, the word “JAVASCRIPT” was not emphasized or used as a trademark in that specimen, and Registrant was aware of this deficiency. By submitting this knowingly deficient specimen and swearing to its

accuracy, Registrant made a material misrepresentation to the USPTO. This misrepresentation was capable of influencing the USPTO's decision to renew the registration, as it was presented as evidence of legitimate use of the mark in commerce. The intent to deceive, coupled with the submission of a false specimen capable of influencing the USPTO's decision, constitutes fraud, irrespective of the presence of other specimens.

Moreover, Registrant's reliance on the other submitted specimens as a shield against the fraud allegation is misplaced. A detailed examination of these specimens, as presented in the Petition to Cancel, reveals their inadequacy in demonstrating trademark use for JAVASCRIPT. These specimens consist of duplicative representations of a product identified as "ORACLE JAVASCRIPT EXTENSION TOOLKIT." In these depictions, "JAVASCRIPT" is merely a generic element of the product name, not a source identifier, which by itself would not have been acceptable proof of use. Instead, the USPTO specialist considered, and possibly relied upon, the Node.JS Specimen. This falls far short of the requirement that a trademark specimen must show the mark being used in a trademark capacity to identify and distinguish the source of goods or services. *See In re Quantum Foods, Inc.*, 94 USPQ2d 1375, 1378 (TTAB 2010) (holding that use of a trademark on a website specimen was acceptable when the mark appeared alone above product images in a relatively large and distinctively colored font); *In re Osterberg*, 83 USPQ2d 1220, 1223 (TTAB 2007) (finding that text buried in the middle of text describing the goods insufficient to show use of a trademark).

The fact that Registrant submitted the same insufficient specimen twice further underscores the weakness of its submission. Had the USPTO scrutinized these specimens independently, it is highly improbable that the registration would have been granted or renewed based on them alone. This reinforces the materiality of the fraudulent Node.JS specimen, as it was likely crucial in persuading the USPTO to grant the renewal. In essence, the fraudulent specimen served as a smokescreen, masking the lack of genuine trademark use in the other specimens.

While Registrant relies upon *La Terra Fina USA, LLC* to show that a single submission of a specimen as sufficient to overcome a fraud claim, Registrant has not sufficiently provided context that Petitioner in *La Terra Fina* was *unsure* and making conclusory allegations as to the legitimacy or falsity of the allegedly fraudulent specimen. *La Terra Fina USA, LLC v. Reser's Fine Foods, Inc.*, No. 3:23-CV-02631-JSC, 2024 WL 3471196, at \*2 (N.D. Cal. July 19, 2024). In the instant case, Registrant does not put forth any argument that the Node.js Specimen is an acceptable specimen, and Petitioner believes the submission of the Nose.js Specimen was done with the intent to falsely bolster a maintenance filing and influence the USPTO's decision to maintain Registrant's Registration.

The integrity of the trademark registration system relies on the veracity of all information presented to the USPTO. Permitting registrants to submit a mix of valid and fraudulent specimens to evade scrutiny undermines this integrity and creates a dangerous precedent. The core issue remains: Registrant knowingly submitted a false specimen as evidence of use, and this act goes directly to the materiality of the misrepresentation. The act of passing off a fraudulent specimen as genuine use is inherently material because it directly impacts the USPTO's assessment of whether the mark is in use and thus eligible for registration or renewal.

Petitioner believes it will be harmed by Registrant's continued ownership and use of the fraudulently obtained Registration. The fraudulent act and its potential to influence the USPTO's decision, establishes materiality. Therefore, Petitioner has sufficiently and properly pled fraud upon the USPTO. The materiality of the fraudulent specimen is not negated by the presence of other specimens. Registrant's motion to dismiss should be denied.

### **In the alternative, Petitioner Seeks Leave to Amend its Complaint**

If the Board deems Petitioner's fraud claim insufficient to state a claim upon which relief can be granted, Petitioner seeks leave to amend its complaint to address such deficiencies.

**WHEREFORE**, Petitioner asks that this Motion to Dismiss be denied and grant such other relief as the Board deems appropriate.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'EJP', is positioned below the text 'Respectfully submitted,'.

Dated: March 7, 2025

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing OPPOSITION TO MOTION TO DISMISS is being served by electronic mail on Registrant as shown in the correspondence record in the Office, as follows:

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'E Perrott', is written over a horizontal line.

Dated: March 7, 2025

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