

ESTTA Tracking number: **ESTTA1424600**
Filing date: **03/27/2025**

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

Proceeding no.	92086835
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Attachments	ORACLE_S REPLY IN SUPPORT OF PARTIAL MOTION TO DISMISS.pdf(588027 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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ORACLE’S REPLY IN SUPPORT OF PARTIAL MOTION TO DISMISS

Pursuant to Federal Rule of Civil Procedure 12(b)(6) and TBMP § 503, Oracle America, Inc. (“Oracle”), submits its Reply in Support of its Partial Motion to Dismiss Petitioner, Deno Land Inc.’s (“Petitioner”) fraud claim.

I. INTRODUCTION

Taking together its Petition and Response, Petitioner has not put forth any plausible allegations that would satisfy the heightened pleading standard for fraud. It is clear from Petitioner’s Response that there is no legal or factual basis to allow Petitioner to proceed with its fraud claim or require the parties or the Board to expend any more time on it. Petitioner’s fraud claim should be dismissed without leave to amend.

Oracle’s Motion explained that the Petition fails to plausibly allege fraud because Oracle made no false statement as to the fact that its mark was in use in commerce. And even accepting Petitioner’s allegation that the Node.JS specimen was false, as the Board must in the context of a Rule 12(b)(6) motion, the Primary Specimen prevents Petitioner from plausibly alleging that the allegedly false specimen was material to the Office’s decision to grant the Renewal Application. Nor did Petitioner allege any facts showing that Oracle intended to deceive the Office. The

falsity, materiality, and intentionality elements of a fraud claim have not—and cannot—be plausibly pled. See *La Terra Fina USA, LLC v. Reser's Fine Foods, Inc.*, No. 3:23-cv-02631-JSC, 2024 U.S. Dist. LEXIS 127982, at *7-8 (N.D. Cal. July 19, 2024) (no fraud where two specimens were submitted and only one was disputed).

The only defense Petitioner raises as to the sufficiency of its *original* allegations hinges on a proposed legal standard for materiality that the Board should disregard because Petitioner invented it out of whole cloth—that to be material, a false statement need only be “capable” of influencing the Office’s decision. See 12 TTABVUE 3.¹ This is not the standard. More troubling, Petitioner seeks to buttress its fraud claim with unpled allegations that are neither factual nor plausible but rather rely on a series of wholly implausible speculations that the Board need not consider.

In the process, the Response makes two things clear:

- (1) Petitioner failed to plausibly allege fraud in the original Petition, and
- (2) Petitioner cannot plausibly allege fraud, even if given the opportunity to amend.

There is simply no basis for a fraud claim.

II. ARGUMENT

To survive a motion to dismiss under Rule 12(b)(6), Petitioner must set forth legal standards and factual allegations that give rise to a plausible (not just possible) entitlement to relief. *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555, 127 S. Ct. 1955, 1965, 167 L. Ed. 2d 929, 940 (2007). Fraud must be proven ‘to the hilt’ with clear and convincing evidence. Petitioner relies on Federal Rule of Civil Procedure 8, ignoring the fact that fraud claims are subject to the heightened pleading standard of Rule 9. 12 TTABVUE 1. To support a fraud claim, the

¹ Oracle understands the page count to begin on the first page of the brief and therefore does not include the cover sheet in the page count when citing to the Response.

allegations must state with particularity the circumstances constituting fraud or mistake, and there is no room for speculation, inference, or surmise. Fed. R. Civ. P. 9; *see also Smith Int'l, Inc. v. Olin Corp.*, 209 U.S.P.Q. (BNA) 1033, 1044 (TTAB 1981). Any doubt must be resolved against the charging party. *Smith*, 209 U.S.P.Q. at 1044.

“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)).

A false statement in this context is material when it is “critical to” the Office’s renewal decision. *Bentley Motors Ltd. v. Aucera SA*, 2016 TTAB LEXIS 618, *6-7 (TTAB 2016) [non-precedential]; *see also Kathleen Hiraga v. Sylvester J. Arena*, 90 U.S.P.Q.2d 1102, 1107 (TTAB 2009) [precedential] (same standard as applied to initial application).

Leave to amend a 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); *see also* TBMP § 503.03 (“[W]here justice does not require that leave to amend be given, the Board, in its discretion, may refuse to allow an opportunity . . . for amendment.”); *Dragon Bleu (SARL) v. VENM, LLC*, 112 U.S.P.Q.2D (BNA) 1925, 1929 n.10 (TTAB 2014) [precedential] (dismissing the fraud claim without leave to amend because the Board could “perceive no theory by which the recited facts could be plausibly alleged to constitute fraud.”).

A. There is no Support for Petitioner’s Proposed Materiality Standard, and the Petition Fails to Sufficiently Allege Fraud.

In Petitioner’s attempt to defend the sufficiency of its original allegations, the Response urges the Board to ignore the established “critical to” materiality standard in favor of two standards that are unsupported by authority and contradicted by case law.

First, Petitioner claims that “[t]he crucial question is whether the fraudulent representation was *capable of influencing* the USPTO’s decision to grant or renew the registration.” 12 TTABVUE 3-4 (emphasis added). Petitioner cites no legal support for this standard, and with good reason—it is entirely fabricated. Further, such an expansive definition would render superfluous the materiality element of a fraud claim, as it is difficult to imagine any aspect of a renewal application that would not qualify as *capable* of influencing the Office.

Second, Petitioner takes the extraordinarily circular position that the “act of passing off a fraudulent specimen as a genuine use is inherently material” because it “directly impacts” the Office’s decision on renewability. 12 TTABVUE 5. This purported materiality standard puts the cart before the horse. To find a specimen fraudulent, there must *first* be a materiality finding—not the other way around. *Thrive Nat. Care Inc.*, 2023 TTAB LEXIS, at *6-7 (“Fraud ... occurs when a party knowingly makes a false, material representation of fact ... with the intent of obtaining or maintaining a registration right to which it is otherwise not entitled.”). Petitioner’s circular standard arguing that any alleged misstatement in a filing is “inherently material” would eviscerate the materiality standard altogether.²

The Board should ignore Petitioner’s unsupported proposed standards for materiality. Under settled Board precedent with respect to materiality, because Oracle submitted the Primary

² Indeed, in other contexts the Board similarly acknowledges that certain misstatements are not fraudulent where the misstatement was not material to the Office’s decision – such as a claimed date of first use. *Kathleen Hiraga*, 90 U.S.P.Q.2d at 1107.

Specimen which was not alleged to have been false and which was accepted as sufficient by the Office, the Node.JS Specimen was not material as a matter of law.

B. Leave to Amend Should be Denied because the New Allegations are Equally Insufficient to Support a Fraud Claim.

Because it focuses on new allegations and theories, the Response acts as a roadmap of what Petitioner would allege were it permitted to amend its fraud claim. Petitioner asserts two new and interrelated theories:

(1) the Primary Specimen was legally insufficient because it showed only generic use of the JAVASCRIPT mark, and

(2) the Examiner “must have” concluded the Primary Specimen was legally insufficient and therefore relied more heavily on the Node.JS Specimen in granting the renewal.

12 TTABVUE 3-4.

Just like the original Petition, these new allegations fail to sufficiently allege a claim of fraud. Legal sufficiency of specimens cannot be the basis of a fraud claim and “conclusory allegations of law and unwarranted inferences’ cannot defeat an otherwise proper motion to dismiss.” *See 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) (quoting *Schmier v. U.S. Court of Appeals for Ninth Circuit*, 279 F.3d 817, 820 (9th Cir. 2002)). If anything, the Response just underscores that Petitioner’s only cognizable (albeit meritless) theories in this proceeding are whether the JAVASCRIPT mark is generic and/or has been abandoned. The fraud claim is merely frivolous window dressing.

1. Alleged Legal Insufficiency of the Primary Specimen Cannot Support a Fraud Claim.

Petitioner argues—but did not allege—that in the Primary Specimen, the JAVASCRIPT mark “was not emphasized or used as a trademark” and that the mark “is merely a generic

element of the product name, not a source identifier[.]” 12 TTABVUE 3-4. However, because the Office accepted the Primary Specimen as showing use of the JAVASCRIPT trademark, Petitioner cannot, as a matter of law, make out a fraud claim by arguing the Office should have decided otherwise. *See Belstone Cap., LLC*, 2017 U.S. Dist. LEXIS 46015, at *12 (disagreements with respect to the Office’s decision to renew a registration do “not make out a claim of fraud.”) If anything, this attempt to bootstrap the fraud claim only exemplifies that Petitioner’s claims do not sound in fraud but rather drive at whether the JAVASCRIPT mark is generic (which the evidence will show it is not) or has been abandoned (which the evidence will show it has not).

2. “Speculation, Inference or Surmise” Cannot Support a Fraud Claim or Defeat a Motion to Dismiss.

To escape established precedent dismissing fraud in an analogous two-specimen case, Petitioner invites the Board down a path of speculation as to the Office’s thought process. This exercise only serves to confirm that there is no plausible basis for a fraud claim, and amendment would be futile. Petitioner: (1) argues that the Primary Specimen was insufficient because it shows generic use of the JAVASCRIPT mark; (2) speculates that the Office must have concluded the Primary Specimen was insufficient; (3) infers that the Office ignored or heavily discounted the Primary Specimen (even in Class 42, where it was the *only* specimen submitted); and (4) speculates that the Office “possibly relied” primarily on the Node.JS Specimen. 12 TTABVUE 3-4. Only after this chain of supposition and surmise does Petitioner reach the conclusion that, therefore, the Node.JS Specimen was material to the Office’s decision to grant the Renewal Application. *Id.* at 4.

Petitioner’s own verbiage highlights the purely speculative nature of these allegations—*e.g.*, “the USPTO specialist considered, and *possibly* relied upon, the Node.JS Specimen”

because “had the USPTO scrutinized these specimens independently, it is *highly improbable* that the registration would have been granted” and the Node.JS Specimen “was *likely* crucial in persuading the USPTO to grant the renewal.” *Id.* (emphasis added).

Not only are Petitioner’s speculative inferences utterly implausible, this imagined sequence of events is contrary to USPTO examining procedure. The Post Registration Division does not review Combined Section 8 & 9 Affidavits of Use and Applications for Renewal for genericness issues. *See* TMEP § 1604.15 (2024) (“The propriety of the original registration is not re-examined in connection with the affidavit or declaration under §8”); TMEP § 1606.02 (2024) (discussing the requirements for a complete renewal under Section 9). Petitioner thus cannot plausibly allege that the Office discounted the Primary Specimen and relied only on the Node.JS Specimen in accepting the Renewal Application in Class 9. Further, as stated in TMEP § 1604.12, to the extent a *single* specimen supports use in more than one class, the Post Registration staff would make a Note to the File, indicating which classes are *supported* by the specimen. No such Note was made with respect to the Node.JS Specimen, so Petitioner cannot plausibly allege that the Office relied on the Node.JS Specimen in Class 42.

To the contrary, it follows both established USPTO procedure and common sense that the Office reviewed and relied upon the *only* specimen submitted for Class 42 (the Primary Specimen) to grant the renewal application in that Class, and having found that specimen to be sufficient, also relied upon it—at least in part—to renew in Class 9 (where it was one of two specimens submitted). *See La Terra Fina*, 2024 U.S. Dist. LEXIS 127982, at *7-8 (where no facts were alleged to support the assumption that Office relied only on the disputed specimen to the exclusion of the other specimen provided). Indeed, to the extent the Office performed a genericness review (which is inconsistent with post-registration procedure), the Office’s approval

of the Renewal Application, with no Note to the File or refusal, is evidence that the Office *did not* consider JAVASCRIPT to be generic. *See, e.g., Bell Atl. Corp. v. Twombly*, 550 U.S. 544 at 566-67, 127 S. Ct. at 1971, 167 L. Ed. 2d at 947 (holding when two inferences are equally plausible, and one inference does not support liability, the plaintiff fails to state a claim).

Absent a plausible allegation that the Office relied exclusively on the supposedly improper Node.JS Specimen (or that it was otherwise “critical” to the Office’s decision), a showing of materiality is impossible. Petitioner’s Response confirms there are no plausible allegations to support an assumption that the Node.JS Specimen was critical to the Office’s approval of the Renewal Application.

3. *Petitioner Cannot Distinguish La Terra Fina, Where Fraud Was Dismissed in an Analogous Two-Specimen Case.*

Petitioner’s attempt to distinguish *La Terra Fina* is misleading and wrong. Petitioner wrongly suggests that in *La Terra Fina*, conclusory allegations as to falsity of the challenged specimen were necessary to the dismissal of the fraud claim. 12 TTABVUE 5. This is false. The court held Reser failed to state a fraud claim for “at least two reasons.” *La Terra Fina USA*, 2024 U.S. Dist. LEXIS 127982, at *5. The first reason speaks to conclusory allegations about falsity of the challenged specimen—namely, the court held that Reser’s allegations were not plausible and “when two inferences are equally plausible, and one inference does not support liability, the plaintiff does not state a claim.” *Id.* (citing *Twombly*, 550 U.S. 557).

The second independent reason the court dismissed the fraud claim, however, is applicable here irrespective of the falsity of the challenged specimen. Namely, the court held that *La Terra Fina* provided two specimens and Reser had not alleged that the second specimen was false. As such, *La Terra Fina*’s representation that its mark was in use in commerce was not false. The court therefore found that Reser had not sufficiently alleged that *La Terra Fina* made

any false statement to the Office, *even if* the challenged specimen was false. *Id.* at *8. Similarly, the court found materiality had not been sufficiently alleged, rejecting Reser’s speculative assumptions that “La Terra Fina intended to induce the PTO to rely on the First Specimen” and that “the PTO in fact relied on the First Specimen as opposed to the Second Specimen” because there were “no facts alleged to support these inferences” and the court “cannot accept conclusory and unsupported allegations such as these.” *Id.*

In other words, and as is proper in the context of a Rule 12(b)(6) motion³, the court presumed true the allegations as to falsity of the challenged specimen and *still* found no fraud because of the existence of the other specimen. This is the exact same fact pattern presented to the Board here. To the extent conclusory allegations are relevant to the analysis, there can be no question that Petitioner’s new allegations—asking the Board to speculate that the Office broke from various accepted post registration review rules and norms—are at least as speculative, implausible, and conclusory as the allegations at issue in *La Terra Fina*.

La Terra Fina is exactly analogous to the facts at issue here—there are allegations that one of two specimens submitted in connection with the Renewal Application did not show use of the mark by or on behalf of Oracle. Even when taking that allegation as true, as the Board must in the context of the Motion, fraud is not sufficiently pled because there are “no facts alleged to support” Petitioner’s new allegations regarding the Office’s reliance on the Node.JS Specimen over the Primary Specimen, and the Board should not accept Petitioner’s “conclusory and unsupported allegations.” *See, La Terra Fina USA*, 2024 U.S. Dist. LEXIS 127982, at *8.

³ Oracle appropriately confined the Motion’s arguments to the insufficient nature of the fraud claim as pled in accordance with the Rule 12(b)(6) standard. The sufficiency of the Node.JS Specimen is not germane to the Motion. 7 TTABVUE 3 n.2.

III. CONCLUSION

As of the filing of this Reply, Petitioner has not put forth a single, plausible allegation that would satisfy the heightened fraud pleading standard. Petitioner's Response reveals that any amended fraud claim would necessarily rely not on facts but on pure speculation, such that there is no plausible basis for a fraud claim, and amendment would be futile. The Board and the Parties should not be required to spend time and resources litigating a claim that has not been, and cannot be, sufficiently or plausibly alleged.

Because the Petition fails to sufficiently allege fraud, and because the speculative and unsupported nature of the Response clearly demonstrates that an amended Petition would be futile, Oracle respectfully requests that the Board dismiss the fatally flawed fraud claim without leave to amend. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 1160, 26 U.S.P.Q.2d (BNA) 1038, 1041 (Fed. Cir. 1993); *Pure Gold, Inc.*, 221 U.S.P.Q. (BNA) at 155.

March 27, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on March 27, 2025 I served a copy of the above ORACLE'S REPLY
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