

ESTTA Tracking number: **ESTTA665207**

Filing date: **04/06/2015**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	The Node Firm, LLC
Granted to Date of previous extension	04/05/2015
Address	c/o Kramer Levin Naftalis & Frankel LLP 1177 Avenue of the Americas New York, NY 10036 UNITED STATES
Party who filed Extension of time to oppose	Node Source LLC
Relationship to party who filed Extension of time to oppose	Node Source, LLC, now NodeSource, Inc., is in privity with The Node Firm, LLC for purposes of TBMP Â§ 206.02.

Correspondence information	The Node Firm, LLC c/o Kramer Levin Naftalis & Frankel LLP 1177 Avenue of the Americas New York, NY 10036 UNITED STATES kltrademark@kramerlevin.com Phone:212-715-9205
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**Applicant Information**

Application No	86174797	Publication date	10/07/2014
Opposition Filing Date	04/06/2015	Opposition Period Ends	04/05/2015
Applicant	YLD Limited 32-38 Scrutton St. STE# 5 London,, EC2A4RQ UNITED KINGDOM		

**Goods/Services Affected by Opposition**

Class 042. First Use: 2011/11/28 First Use In Commerce: 2011/11/28 All goods and services in the class are opposed, namely: Computer programming; Computer programming consultancy; Computer software consulting; Computer software development and computer programming development for others; Creating of computer programs
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Void Ab Initio; Abandonment

### Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	THE NODE FIRM		
Goods/Services	Computer programming; computer programming consultancy; computer software consulting; computer software development and computer programming development for others; creating of computer programs		

Related Proceedings	YLD Limited v. The Node Firm, LLC et al, Case No. 1:15-cv-00855-JPO (S.D.N.Y. Feb. 5, 2015)
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Attachments	Notice of Opposition.pdf(1877769 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Erica D. Klein/
Name	The Node Firm, LLC
Date	04/06/2015



Source, LLC, now NodeSource, Inc., a corporation duly formed and existing under the laws of the State of Delaware, is in privity with The Node Firm for purposes of TBMP § 206.02.

The grounds for opposition are set forth below.

## **I. BACKGROUND**

### **A. Opposer.**

1. Opposer is the owner of common law rights in the name and mark THE NODE FIRM (“Opposer’s Mark”), which such name and mark has been used by or on behalf of Opposer since at least as early as November 28, 2011 in connection with services including computer programming; computer programming consultancy; computer software consulting; computer software development and computer programming development for others; and creating of computer programs (“Opposer’s Services”).

2. Through Opposer’s long term use of Opposer’s Mark in connection with Opposer’s Services, Opposer’s Mark has acquired secondary meaning as a source of Opposer’s Services.

3. Through Opposer’s long term use of Opposer’s Mark in connection with Opposer’s Services, Opposer’s Mark has acquired significant value and goodwill.

4. Through Opposer’s long term use of Opposer’s Mark in connection with Opposer’s Services, Opposer’s Mark is closely associated with Opposer, its owners and employees, and work performed by them or on their behalf.

### **B. Applicant.**

5. The Offending Application seeks registration of the Offending Mark for use in connection with Computer programming; Computer programming consultancy; Computer software consulting; Computer software development and computer programming development for others; Creating of computer programs in International Class 42 (the “Offending Services”).

6. The Offending Application was filed on January 24, 2014 (the “Filing Date”) based on Section 1(a) of the Trademark Act.

7. The Offending Application alleges November 28, 2011 as the date that the Offending Mark was first used by Applicant in connection with the Offending Services, and as the date that the Offending Mark was first used in commerce by Applicant in the United States in connection with the Offending Services.

## **II. GROUNDS FOR OPPOSITION**

### **A. The Offending Application is Void *Ab Initio* Because Applicant Had No Use of the Offending Mark in Connection with the Offending Services Prior to the Filing Date.**

8. Upon information and belief, the Offending Mark was not created by Applicant or any predecessor thereof.

9. Upon information and belief, Applicant is a foreign corporation that operates under the laws of the United Kingdom.

10. Upon information and belief, the LinkedIn profile for Applicant, a true and correct copy of which is attached as Exhibit A hereto, indicates that Applicant was formed in 2013.

11. Upon information and belief, since its formation, Applicant has not used the Offending Mark in connection with the Offending Services.

12. Upon information, Applicant, for its own behalf, has never used the Offending Mark in connection with any of the Offending Services.

13. Because Applicant was not rendering the Offending Services at the time it filed its use-based application for the Offending Mark, the Offending Application is void *ab initio*.

**B. The Offending Application is Void *Ab Initio* Because the Services Applicant Relied Upon to Support the Offending Application Were Performed for the Benefit of Opposer.**

14. Opposer repeats and realleges the allegations stated in Paragraphs 1- 13 hereof and incorporates the same by reference as though fully restated herein.

15. Upon information and belief, Mr. Nuno Job (“Job”) is a founder of Applicant.

16. Upon information and belief, prior to founding Applicant, Job offered services including computer programming; computer programming consultancy; computer software consulting; computer software development and computer programming development for others; and creating of computer programs as part of a collaboration with persons including founders of Opposer.

17. All computer programming; computer programming consultancy; computer software consulting; computer software development and computer programming development for others; and creating of computer programs performed by Job under the Offending Mark were performed on behalf of Opposer or a predecessor thereof.

18. Because the Offending Services performed by Job under the Offending Mark were performed on behalf of Opposer or a predecessor thereof, Job had no rights in the Offending Mark as a result of his performance of any Offending Services.

19. Job’s performance of the Offending Services under the Offending Mark do not inure to the benefit of Applicant.

20. Job’s performance of the Offending Services under the Offending Mark are an insufficient basis for Applicant to support the Offending Application.

21. The Offending Application is void *ab initio* because any Offending Services rendered by Job under the Offending Mark did not inure to the benefit of Applicant or a predecessor thereof (and instead inured to the benefit of Opposer or a predecessor thereof), and

thus the Offending Services had not been performed on behalf of Applicant or a predecessor thereof at the time Applicant filed its use-based application for the Offending Mark.

**C. The Offending Application is Void Because Applicant Committed Fraud on the PTO.**

22. Opposer repeats and realleges the allegations stated in Paragraphs 1-21 hereof and incorporates the same by reference as though fully restated herein.

23. Upon information and belief, Applicant knew at the time that it executed and filed the Offending Application that Applicant was not rendering the Offending Services at the time it filed its use-based application for the Offending Mark.

24. Upon information and belief, Applicant knew at the time that it executed and filed the Offending Application that any Offending Services performed by Job did not inure to the benefit of Applicant or any predecessor thereof.

25. Upon information and belief, Applicant knew at the time that it executed and filed the Offending Application that any Offending Services performed by Job were performed for the benefit of Opposer or a predecessor thereof.

26. Upon information and belief, Applicant knew at the time that it executed and filed the Offending Application that the Offending Mark was not in use in commerce by or on behalf of Applicant in connection with the Offending Services.

27. Upon information and belief, Applicant knew at the time it executed and filed the Offending Application that the specimens submitted in support of the Offending Application, true and correct copies of which are attached hereto as Exhibit B (the "Specimens"), were not actually in use in commerce by or on behalf of Applicant.

28. Upon information and belief, Applicant knew at the time it executed and filed the Offending Application that the Specimens did not show use in commerce by or on behalf of Applicant in the rendering or advertising of the Offending Services.

29. Upon information and belief, by filing the Offending Application, representing that the Offending Mark was in use in commerce by Applicant in the United States in connection with the Offending Services, Applicant knowingly made a false, material representation with the intent to deceive the United States Patent and Trademark Office (“PTO”).

30. Upon information and belief, as a result of the aforementioned acts of Applicant, the PTO relied on Applicant’s false statement that the Offending Mark was in use in commerce by Applicant in the United States in connection with the Offending Services, and thereby approved the Offending Application for publication.

31. Upon information and belief, Applicant’s fraud in the execution and filing of the Offending Application requires that the Offending Application be deemed void and that this opposition be sustained.

**D. The Offending Mark is Descriptive, and Applicant Has Not Established the Requisite Secondary Meaning to Support Registration.**

32. Opposer repeats and realleges the allegations stated in Paragraphs 1-31 hereof and incorporates the same by reference as though fully restated herein.

33. The Offending Mark is comprised of the term THE NODE FIRM.

34. The word NODE describes Node.js, which is an open source, cross-platform runtime environment for server-side and networking applications.

35. The word FIRM describes a type of business organization.

36. The Offending Mark is merely descriptive under §2(e)(1) of the Trademark Act, as it describes a characteristic and purpose of the Offending Services recited in the Offending Application, namely, a business organization that performs computer programming; computer programming consultancy; computer software consulting; computer software development and computer programming development for others; and creating of computer programs, in the Node.js programming language.

37. To be registerable on the Principal Register, the Offending Mark must have acquired distinctiveness.

38. Because Applicant has not established acquired distinctiveness of the Offending Mark, and for the reasons stated above could not establish acquired distinctiveness of the Offending Mark, Applicant is not entitled to registration of the Offending Mark covered by the Offending Application.

**E. The Offending Mark Has Been Abandoned by Applicant.**

39. Opposer repeats and realleges the allegations stated in Paragraphs 1-38 hereof and incorporates the same by reference as though fully restated herein.

40. Opposer alleges in the alternative that, if Applicant, or any predecessor thereof, has at any time used the Offending Mark in connection with the Offending Services on Applicant's behalf: (a) the Offending Mark has not been used in connection with the Offending Services by or on behalf of Applicant or any predecessor thereof for several years; and (b) Applicant has an intent not to resume use of the Offending Mark in connection with the Offending Services.

**F. Any Use of the Offending Mark on Applicant's Behalf Falsely Suggests a Connection with Opposer.**

41. Opposer repeats and realleges the allegations stated in Paragraphs 1-40 hereof, as applicable, and incorporates the same by reference as though fully restated herein.

42. Through Opposer's use of THE NODE FIRM to identify Opposer's Services, such mark has acquired significant value and goodwill as a source of Opposer's Services, and is closely associated with Opposer, its owners and employees, and work performed by them or on their behalf.

43. Opposer alleges in the alternative that, if Applicant, or any predecessor thereof, has at any time used the Offending Mark in connection with the Offending Services on

Applicant's behalf, such use falsely suggests a connection with Opposer, and therefore violates the rights of Opposer under Section 2(a) of the Trademark Act.

**G. Any Use of the Offending Mark on Applicant's Behalf is Likely to Cause Confusion with Opposer's Mark.**

44. Opposer repeats and realleges the allegations stated in Paragraphs 1-43 hereof, as applicable, and incorporates the same by reference as though fully restated herein.

45. Opposer alleges in the alternative that, if Applicant, or any predecessor thereof, has at any time used the Offending Mark in connection with the Offending Services on Applicant's behalf, such use is likely to cause confusion with Opposer's Mark and therefore violates the rights of Opposer under Section 2(d) of the Trademark Act.

WHEREFORE, Opposer requests that this opposition be sustained and that Application Serial No. 86/174,797 for the mark THE NODE FIRM be refused registration.

This Notice is being filed electronically with the Board, and is being served on Applicant, through its attorney of record, at Applicant's correspondence address of record with the PTO. Proof of Service is attached hereto.

Respectfully submitted,

Dated: New York, NY  
April 6, 2015

KRAMER LEVIN NAFTALIS & FRANKEL LLP  
Attorneys for Opposer The Node Firm, LLC



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CERTIFICATE OF SERVICE

I hereby certify that on April 6, 2015, I caused one true and correct copy of the foregoing Notice of Opposition against U.S. Application No. 86/174,797 for THE NODE FIRM, and accompanying Exhibits, to be served by first class mail upon YLD Limited, by causing a true and correct copy thereof to be deposited in the United States mail, postage prepaid, addressed to Applicant's attorney of record, at the correspondence address of record with the PTO as follows:

Sarah M. Matz  
Adelman Matz P.C.  
1173A Second Avenue, Suite 153  
New York, NY 10065



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Erica D. Klein

Opposition filed against  
Application No. 86/174,797  
The Node Firm, LLC v. YLD Limited  
Exhibit A Filed by The Node Firm, LLC

## **EXHIBIT A**

[What is LinkedIn?](#) [Join Today](#) [Sign In](#)



**YLD**

Home

From concept to product we build high performance, stable node.js products. Responsible for some of the largest Node.js solutions in production today. We are based in London. Created by Nuno Job and Pedro Teixeira, engineers responsible for the Nodejitsu Cloud.

**Specialties**

Node.js, Consulting, Docker, Training

**Website**

<http://yld.io>

**Industry**

Computer Software

**Type**

Privately Held

**Headquarters**

32-38 Scrutton St, Suite 5 London, EC2A 4RQ United Kingdom

**Company Size**

1-10 employees

**Founded**

2013

60 followers

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**YLD employees**

**14** Employees on LinkedIn

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Opposition filed against  
Application No. 86/174,797  
The Node Firm, LLC v. YLD Limited  
Exhibit B Filed by The Node Firm, LLC

## **EXHIBIT B**



the  
**NODE FIRM**

projects are developed around



**Sebastian Tiedtke**

 **sourishkrout**



Products  
Pricing  
Technology  
Partners  
Company

Home About Us Open DevOps Get Started

Get Started Today **FREE TRIAL**

## The Node Firm and Joyent Offer Node.js Training

August 28, 2013 - by **The Node Firm**

SHARE

This post originally appeared on [The Node Firm blog](#).

Since its inception, The Node Firm has been the go-to choice for corporate Node.js training. We've excited to begin offering open enrollment training too. We are launching our public trainings at the home of Node.js at Joyent in San Francisco. Custom tailored training doesn't fit all budgets and some teams are just so lean that flying in experts doesn't make sense. We hope you come join us for these inaugural sessions.

### Increased Demand for Professional Training

Node.js has become the number one choice for creating scalable, efficient, real-time services. This has led to an increasing need to train developers in Node.js from startups to government to Fortune 100 corporations. Companies like IBM, Oracle, Microsoft, Google and others have been relying on Node.js in the production stack since 2010. Node has now become the default choice for new development, enabling rapid development with robust scalability and unparalleled ease of use for developers.

“The simple truth is Node has revolutionized the way we create websites. Developers just don't know how to write in Node.” - [Michael Martinez, AWS Product Operations](#)

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