

ESTTA Tracking number: **ESTTA189167**

Filing date: **01/28/2008**

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                                  | Align Technology, Inc.   |
| Granted to Date of previous extension | 01/27/2008   |
| Address                               | 881 Martin Avenue<br>Santa Clara, CA 95050<br>UNITED STATES  |
| Attorney information                  | John L. Slafsky and Hollis Beth Hire<br>Wilson Sonsini Goodrich & Rosati<br>650 Page Mill Rd.<br>Palo Alto, CA 94304<br>UNITED STATES<br>trademarks@wsgr.com, hhire@wsgr.com |

### Applicant Information

|                        |  |                        |            |
|------------------------|--|------------------------|------------|
| Application No         | 78885830   | Publication date       | 07/31/2007 |
| Opposition Filing Date | 01/28/2008   | Opposition Period Ends | 01/27/2008 |
| Applicant              | Cronauer, Edward<br>3010 Sorrel Court<br>Weston, FL 33331<br>UNITED STATES |                        |            |

### Goods/Services Affected by Opposition

|   |
|---|
| Class 010.<br>All goods and services in the class are opposed, namely: orthodontic appliances |
|---|

### Grounds for Opposition

|                                      |                            |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

### Marks Cited by Opposer as Basis for Opposition

|                       |                                   |                       |            |
|-----------------------|-----------------------------------|-----------------------|------------|
| U.S. Registration No. | 3216998                           | Application Date      | 04/01/2005 |
| Registration Date     | 03/13/2007                        | Foreign Priority Date | NONE       |
| Word Mark             | THE CLEAR WAY TO STRAIGHTEN TEETH |                       |            |
| Design Mark           |                                   |                       |            |
| Description of Mark   | NONE                              |                       |            |

|                |  |
|----------------|--|
| Goods/Services | Class 010. First use: First Use: 2002/08/31 First Use In Commerce: 2002/08/31<br>Dental apparatus, namely plastic orthodontic appliances<br>Class 044. First use: First Use: 2002/08/31 First Use In Commerce: 2002/08/31<br>Orthodontic and dental services |
|----------------|--|

|                      |   |                       |            |
|----------------------|---|-----------------------|------------|
| U.S. Application No. | 77226385  | Application Date      | 07/10/2007 |
| Registration Date    | NONE  | Foreign Priority Date | NONE       |
| Word Mark            | THE CLEAR ALTERNATIVE TO BRACES   |                       |            |
| Design Mark          |   |                       |            |
| Description of Mark  | NONE  |                       |            |
| Goods/Services       | Class 010. First use:<br>dental apparatus, namely, orthodontic appliance<br>Class 044. First use:<br>orthodontic and dentistry services |                       |            |

|             |   |
|-------------|---|
| Attachments | 78600466#TMSN.jpeg ( 1 page )( bytes )<br>77226385#TMSN.jpeg ( 1 page )( bytes )<br>THE CLEAR CHOICE opp.pdf ( 6 pages )(199433 bytes ) |
|-------------|---|

### 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 | /Hollis Beth Hire/                   |
| Name      | John L. Slafsky and Hollis Beth Hire |
| Date      | 01/28/2008                           |

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

|                        |   |                             |
|------------------------|---|-----------------------------|
| ALIGN TECHNOLOGY, INC. | ) | Opposition No.              |
| Opposer,               | ) |                             |
|                        | ) |                             |
| v.                     | ) |                             |
|                        | ) |                             |
| EDWARD CRONAUER,       | ) | <u>NOTICE OF OPPOSITION</u> |
| Applicant.             | ) |                             |

Re: Mark: THE CLEAR CHOICE IN TARGETED ALIGNMENT  
Serial No.: 78/885830  
Filed: May 17, 2006  
Published: July 31, 2007

Align Technology, Inc. (“Opposer”), a corporation organized and existing under the laws of the State of Delaware, located at 881 Martin Avenue, Santa Clara, California 95050, believes that it will be damaged by the registration of the mark shown in application Serial No. 78/885830 (the “Application”), and it hereby opposes the Application.

As grounds for the opposition, Opposer alleges that:

1. Opposer is the well-known, leading provider of transparent, removable orthodontic products for use in straightening teeth. Hundreds of thousands of people have chosen Opposer’s aligners as their preferred treatment for teeth straightening, and tens of thousands of doctors worldwide have made Opposer’s products a part of their practice.
2. Opposer has continuously used the trademarks THE CLEAR WAY TO STRAIGHTEN TEETH and THE CLEAR ALTERNATIVE TO BRACES in connection with dental apparatuses, plastic orthodontic appliances, and related goods and services since at least as early as 2002 and 2003, respectively.

3. Opposer has continuously used the trademarks ALIGN and INVISALIGN in connection with dental apparatuses, plastic orthodontic appliances, and related goods and services since at least as early as 1999.

4. Opposer is the owner of the following trademark registrations and applications:

a. Registration No. 3,216,998 for THE CLEAR WAY TO STRAIGHTEN TEETH in connection with “dental apparatus, namely plastic orthodontic appliances,” and “orthodontic and dental services,” registered March 3, 2007.

b. Application No. 77/226385 for THE CLEAR ALTERNATIVE TO BRACES in connection with “dental apparatus, namely plastic orthodontic appliances,” and “orthodontic and dental services,” filed July 13, 2007 and allowed January 1, 2008.

c. Registration No. 3,259,957 for ALIGN in connection with “dental apparatus, namely plastic orthodontic appliances,” registered July 10, 2007;

d. Registration No. 3,181,043 for ALIGN in connection with “orthodontic services” and “training in the use of orthodontic appliances,” registered December 5, 2006.

e. Reg. No. 2409473 for INVISALIGN in connection with “dental apparatus, namely plastic orthodontic appliances,” registered November 28, 2000;

f. Reg. No. 3060471 for INVISALIGN in connection with “computer software, namely digital imaging software used to depict tooth movement and proposed treatment plan; computer software used to provide, track and modify proposed courses of orthodontic treatment and patient data and information related thereto,” registered February 21, 2006;

g. Registration No. 3,191,195 for INVISALIGN in connection with “training in the use of orthodontic appliances,” and “orthodontic and dentistry services,” registered January 2, 2007;

h. Application No. 77/278,128 for INVISALIGN in connection with “custom manufacture of orthodontic appliances, dental laboratory services,” filed September 12, 2007 with a first use date of August 31, 1999 and first use in commerce date of September 2, 1999. The application is scheduled for publication on February 12, 2008.

i. Application No. 77/309,811 for INVISALIGN TEEN in connection with “products for use in the dental field and services in the dental field; software,” filed October 22, 2007.

5. Through Opposer’s continued and exclusive use, and as a result of the substantial popularity and publicity of Opposer’s product, Opposer’s trademarks ALIGN, INVISALIGN, THE CLEAR WAY TO STRAIGHTEN TEETH, and THE CLEAR ALTERNATIVE TO BRACES have achieved secondary meaning in the mind of the consumer.

6. Opposer is informed and believes, and therefore alleges that on May 17, 2006, Applicant Edward Cronauer (“Applicant”) filed the Application, an Intent-to-Use application in the United States Patent and Trademark Office for THE CLEAR CHOICE IN TARGETED ALIGNMENT as a trademark in International Class 10. The identification of services in the Application as published is “orthodontic appliances.”

7. The Application was published for opposition on July 31, 2007. Opposer has obtained all necessary extensions of time to oppose this Application.

8. Opposer is informed and believes, and therefore alleges, that Applicant did not use the mark in the Application in or before 2003.

9. The goods for which Applicant seeks to register THE CLEAR CHOICE IN TARGETED ALIGNMENT are identical or closely related to Opposer's goods and services, as reflected in Opposer's registrations and applications, and as Opposer has used them since at least as early as 1999.

10. Applicant's mark so resembles Opposer's trademarks as to be likely, when used in connection with the goods of Applicant, to cause confusion or to cause mistake, or to deceive as to the source, sponsorship, or affiliation of Applicant's and Opposer's respective products, services, and commercial activities.

11. If Applicant is permitted to register THE CLEAR CHOICE IN TARGETED ALIGNMENT for the goods described in the application, confusion in the trade and in the public is likely to result. Confusion caused by Applicant will damage Opposer and injure its reputation in the trade and with the public. That confusion will also injure the public, in that consumers, upon seeing Applicant's mark used in connection with Applicant's goods, are likely to believe that Applicant's goods are somehow associated with or approved by Opposer.

WHEREFORE, Opposer prays that Application Serial No. 78/885830 be rejected, that no registration be issued to Applicant, and that this opposition be sustained in favor of Opposer.

Opposer authorizes payment of the required filing fee of \$300.00 from its counsel's USPTO Deposit Account. Please charge the fee to Deposit Account No. 23-2415 ATTN: 22773.900.

Please address all U.S.P.T.O. communications regarding this Notice of Opposition to:

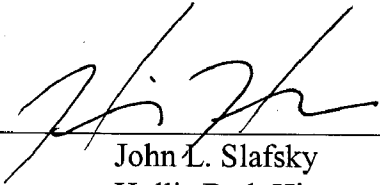
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650 Page Mill Road  
Palo Alto, California 94304-1050

Tel: (650) 493-9300  
Fax: (650) 493-6811  
trademarks@wsgr.com

Date: January 28, 2008

Respectfully Submitted,

WILSON SONSINI GOODRICH & ROSATI  
Professional Corporation

By:   
John L. Slafsky  
Hollis Beth Hire  
Attorneys for Opposer  
Align Technology, Inc.

**CERTIFICATE OF SERVICE BY MAIL**

I, Launa Hovland, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

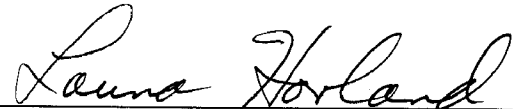
On this date, I served **NOTICE OF OPPOSITION** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Edward Cronauer  
3010 Sorrel Court  
Weston, FL 33331

Joseph R. Englander  
Christopher & Weisberg, P.A.  
200 E. Las Olas Blvd. Ste 2040  
Fort Lauderdale, FL 33301-2240

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed at Palo Alto, California on January 28, 2008.



Launa Hovland