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

| | |
|------------------------|---|
| Proceeding | 91250389 |
| Party | Plaintiff Align Technology, Inc. |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ALIGN TECHNOLOGY, INC.,

Opposer,

v.

WUXI EA MEDICAL INSTRUMENTS
TECHNOLOGIES LIMITED,

Applicant.

Opposition No. 91250389

Serial No. 88150597

Mark: ANGELALIGN & Chinese Characters

Filed: October 10, 2018

Published: April 23, 2019

Serial No.: 88150578

Mark: ANGELALIGN

Filed: October 10, 2018

Published: April 23, 2019

**ALIGN TECHNOLOGY, INC.'S ANSWER TO COUNTERCLAIM AND
AFFIRMATIVE DEFENSES**

Opposer Align Technology, Inc. (“Align Technology”), a corporation opposing the registration of the mark ANGELALIGN shown in Application Serial No. 88150578 and the registration of the mark ANGELALIGN & Chinese Characters shown in Application Serial No. 88150597 for goods and services in International Classes 10, 35, 42, and 44, filed October 10, 2018, for its answer to the Counterclaims of Applicant, Wuxi EA Medical Instruments Technologies Limited (“Applicant”), states and alleges the following:

First Defense

Answering the separately numbered paragraphs of the Counterclaims, Align Technology states and alleges the following

1. Upon information and belief, Align Technology admits the allegations contained in numbered paragraph 1 of the Counterclaims.
2. Align Technology admits the allegations contained in numbered paragraph 2 of the Counterclaims.

3. Align Technology admits that Applicant is shown on U.S. Trademark Application Serial Number 88150597 and 88150578 as the owner of those applications but lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in numbered paragraph 3 of the Counterclaims and therefore denies those allegations.

4. The allegations contained in numbered paragraph 4 of the Counterclaims are admitted.

5. The allegations contained in numbered paragraph 5 of the Counterclaims are admitted.

6. Regarding the allegations contained in numbered paragraph 6 of the Counterclaims, Align Technology admits that it relied upon its family of ALIGN-formative marks, including incontestable registrations for the marks ALIGN and INVISALIGN, in challenging Applicant's ANGELALIGN marks that are the subject of its opposition. The remaining allegations of paragraph 6 are denied.

7. Align Technology is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in numbered paragraph 7 of the Counterclaims and therefore denies those allegations.

8. Align Technology is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in numbered paragraph 8 of the Counterclaims and therefore denies those allegations.

9. Align Technology is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in numbered paragraph 9 of the Counterclaims and therefore denies those allegations.

10. Align Technology denies the allegations contained in numbered paragraph 10 of the Counterclaims as stated and specifically avers that the marks referenced have not “coexisted since at least 2010.”

11. Regarding the allegations contained in numbered paragraph 11 of the Counterclaims, Align Technology admits that it offers, among other products and services, orthodontic appliances to assist in the straightening of teeth under the incontestable INVISALIGN and ALIGN marks and that such marks define and delineate Align Technology’s products in the marketplace. The remaining allegations of paragraph 11 are denied.

12. Align Technology denies the allegations contained in numbered paragraph 12 of the Counterclaims and specifically avers that it offers, among other products and services, orthodontic appliances that assist in the straightening of teeth under the incontestable INVISALIGN and ALIGN marks, and that such marks define and delineate Align Technology’s products in the marketplace.

13. Align Technology denies the allegations contained in numbered paragraph 13 of the Counterclaims and specifically avers that it offers, among other products and services, orthodontic appliances that assist in the straightening of teeth under the incontestable INVISALIGN and ALIGN marks, and that such marks define and delineate Align Technology’s products in the marketplace.

14. Regarding the allegations contained in numbered paragraph 14 of the Counterclaims, Align Technology admits that it has used the term “aligner” when selling orthodontic appliances that assist in the straightening of teeth under the incontestable INVISALIGN and ALIGN marks. The remaining allegations of paragraph 14 are denied.

15. Regarding the allegations contained in numbered paragraph 15 of the Counterclaims, Align Technology admits that Applicant has cited to a Merriam Webster definition of “aligner,” the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document.

16. Regarding the allegations contained in numbered paragraph 16 of the Counterclaims, Align Technology admits that a device referred to as an “aligner” may be used to “align” something but otherwise denies the allegations of paragraph 16, specifically averring that Applicant’s characterizations of what “logic dictates” and what “plain meaning . . . mandates” are opinions of no legal consequence.

17. Align Technology denies the allegations contained in numbered paragraph 17 of the Counterclaims and specifically avers that the mark ALIGN as used by Align Technology in connection with its goods and services is neither descriptive nor generic and that Align Technology has been using the incontestable ALIGN mark in commerce since 1999. Further, Align Technology notes that claims of descriptiveness are not cognizable defenses against incontestable marks.

18. Align Technology denies the allegations contained in numbered paragraph 18 of the Counterclaims and specifically avers that it devised, among other inventions, the orthodontic appliances that assist in the straightening of teeth that it sells under the incontestable INVISALIGN and ALIGN marks.

19. Regarding the allegations contained in numbered paragraph 19 of the Counterclaims, Align Technology admits that it is not the exclusive user of the term “aligner. Align Technology further answers that it offers, among other products and services, orthodontic

appliances that assist in the straightening of teeth under the incontestable INVISALIGN and ALIGN marks. The remaining allegations of paragraph 19 are denied.

20. Align Technology denies the allegations contained in numbered paragraph 20 of the Counterclaims and specifically avers that Align Technology has invested heavily in the branding of its orthodontic devices under the incontestable INVISALIGN and ALIGN marks and that such marks have achieved widespread recognition and secondary meaning in the marketplace.

Answering Count 1

21. Regarding the allegations contained in numbered paragraph 21 of the Counterclaims, Align Technology realleges and incorporates by reference its responses to each and every allegation contained in paragraphs 1-21 as if fully restated herein.

22. Regarding the allegations contained in numbered paragraph 22 of the Counterclaims, Align Technology admits that it is the owner of U.S. Trademark Registration No. 3,259,957 (“the ‘957 Registration”) for the incontestable mark ALIGN for use in connection with “Dental apparatus, namely plastic orthodontic appliances” in International Class 10.

23. Regarding the allegations contained in numbered paragraph 23 of the Counterclaims, Align Technology admits that the ‘957 Registration is among those asserted in its Notice of Opposition. The remaining allegations of paragraph 23 are denied.

24. Regarding the allegations contained in numbered paragraph 24 of the Counterclaims, Align Technology admits that among its uses of the incontestable ALIGN mark, the mark is used in connection with the sale of its orthodontic devices that assist in the straightening of teeth.

25. Align Technology denies the allegations contained in numbered paragraph 25 of the Counterclaims and specifically avers that Applicant has no reason whatsoever to infringe upon the incontestable ALIGN mark.

26. Align Technology denies the allegations contained in numbered paragraph 26 of the Counterclaims and specifically avers that the incontestable ALIGN mark has achieved widespread recognition and secondary meaning in the marketplace in connection with, among other products and services, orthodontic appliances offered by Align Technology.

27. The allegations of numbered paragraph 27 of the Counterclaims are denied.

Answering Count II

28. Regarding the allegations contained in numbered paragraph 28 of the Counterclaims, Align Technology realleges and incorporates by reference its responses to each and every allegation contained in paragraphs 1-27 as if fully restated herein.

29. Regarding the allegations contained in numbered paragraph 29 of the Counterclaims, Align Technology admits that it is the owner of U.S. Trademark Registration No. 3,259,957 (“the ‘957 Registration”), for the incontestable mark ALIGN for use in connection with “Dental apparatus, namely plastic orthodontic appliances” in International Class 10.

30. Regarding the allegations contained in numbered paragraph 30 of the Counterclaims, Align Technology admits that the ‘957 Registration is among those asserted in its Notice of Opposition. The remaining allegations of paragraph 30 are denied.

31. Regarding the allegations contained in numbered paragraph 31 of the Counterclaims, Align Technology admits that as originally filed, the ‘957 Registration originally included an application for Class 44 for “[o]rthodontic services; orthodontic training and support services.” Align Technology denies all remaining allegations of paragraph 31 and specifically

avers that the content of Align Technology's trademark prosecution file for the incontestable ALIGN mark speaks for itself.

32. Regarding the allegations contained in numbered paragraph 32 of the Counterclaims, Align Technology admits that it divided the application for what became the '957 Registration. The remaining allegations of paragraph 32 are denied. Align Technology specifically avers that the trademark prosecution history for the incontestable ALIGN mark speaks for itself and shows no deception.

33. Regarding the allegations contained in numbered paragraph 33 of the Counterclaims, Align Technology admits that among its uses of the incontestable ALIGN mark, the mark is used in connection with the sale of its orthodontic devices that assist in the straightening of teeth .

34. The allegations contained in numbered paragraph 34 of the Counterclaims are denied.

35. The allegations contained in numbered paragraph 35 of the Counterclaims are denied.

36. Regarding the allegations contained in numbered paragraph 36 of the Counterclaims, Align Technology admits that it has used the term "aligner" when offering orthodontic appliances that assist in the straightening of teeth under the incontestable ALIGN mark and otherwise denies the allegations of paragraph 36.

37. The allegations contained in numbered paragraph 37 of the Counterclaims are denied.

38. The allegations contained in numbered paragraph 38 of the Counterclaims are denied.

39. The allegations contained in numbered paragraph 39 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

40. The allegations contained in numbered paragraph 40 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

41. The allegations contained in numbered paragraph 41 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

42. The allegations contained in numbered paragraph 42 of the Counterclaims are denied.

43. Regarding the allegations contained in numbered paragraph 43 of the Counterclaims, Align Technology admits that the Trademark Office issued an Office Action dated September 2, 2004, in connection with the application that matured into the '957 Registration, the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document and further denies all remaining allegations in paragraph 43.

44. Regarding the allegations contained in numbered paragraph 44 of the Counterclaims, Align Technology admits that Applicant has quoted from a portion of Align Technology's response to an Office Action for the incontestable ALIGN mark, the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document and further denies all remaining allegations in paragraph 44.

45. The allegations contained in numbered paragraph 45 of the Counterclaims are denied.

46. The allegations contained in numbered paragraph 46 of the Counterclaims are denied.

47. The allegations contained in numbered paragraph 47 of the Counterclaims are denied.

48. The allegations contained in numbered paragraph 48 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

49. The allegations contained in numbered paragraph 49 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

50. The allegations contained in numbered paragraph 50 of the Counterclaims are denied.

51. Regarding the allegations contained in numbered paragraph 51 of the Counterclaims, Align Technology admits that it asserted a claim of acquired distinctiveness during the prosecution of the application that resulted in the '957 Registration. Align Technology further avers that the content of the trademark prosecution file for the incontestable ALIGN mark speaks for itself, and Align Technology denies any characterization that is inconsistent with the document and denies all remaining allegations in paragraph 51.

52. Align Technology denies the allegations contained in numbered paragraph 52 of the Counterclaims and specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

53. Align Technology denies the allegations contained in numbered paragraph 53 of the Counterclaims and specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

54. Align Technology denies the allegations contained in numbered paragraph 54 of the Counterclaims and specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

55. Align Technology denies the allegations contained in numbered paragraph 55 of the Counterclaims and specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

56. Align Technology admits that in numbered paragraph 56 of the Counterclaims, Applicant has cited to Align Technology's trademark prosecution file for the incontestable ALIGN mark, the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document and further denies the remaining allegations in paragraph 56.

57. Align Technology admits that in numbered paragraph 57 of the Counterclaims, Applicant has cited to Align Technology's trademark prosecution file for the incontestable ALIGN mark, the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document and further denies the remaining allegations in paragraph 57.

58. The allegations contained in numbered paragraph 58 of the Counterclaims are denied.

59. Align Technology admits that in numbered paragraph 59 of the Counterclaims, Applicant has cited to Align Technology's trademark prosecution file for the incontestable

ALIGN mark, the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document and further denies the remaining allegations in paragraph 59.

60. The allegations contained in numbered paragraph 60 of the Counterclaims are denied. Align Technology specifically avers that it has sold products bearing the ALIGN mark.

61. The allegations contained in numbered paragraph 61 of the Counterclaims are denied.

62. Align Technology admits that in numbered paragraph 62 of the Counterclaims, Applicant has cited to statements in the Align Technology trademark prosecution file for the incontestable ALIGN mark, the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document and further denies the remaining allegations in paragraph 62.

63. Align Technology admits that in numbered paragraph 63 of the Counterclaims, Applicant has cited to statements in the Align Technology trademark prosecution file for the incontestable ALIGN mark, the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document and further denies the remaining allegations in paragraph 63.

64. The allegations contained in numbered paragraph 64 of the Counterclaims are denied.

65. Align Technology admits that in numbered paragraph 65 of the Counterclaims, Applicant has cited to statements in the Align Technology trademark prosecution file for the incontestable ALIGN mark, the content of which speaks for itself. Align Technology denies any

characterization that is inconsistent with the document and further denies the remaining allegations in Paragraph 65.

66. The allegations contained in numbered paragraph 66 of the Counterclaims are denied.

67. The allegations contained in numbered paragraph 67 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

68. The allegations contained in numbered paragraph 68 of the Counterclaims are denied.

69. The allegations contained in numbered paragraph 69 of the Counterclaims are denied.

70. The allegations contained in numbered paragraph 70 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

71. The allegations contained in numbered paragraph 71 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

72. The allegations contained in numbered paragraph 72 of the Counterclaims are denied.

73. Align Technology admits that in numbered paragraph 73 of the Counterclaims, Applicant has cited to statements contained in the Align Technology trademark prosecution file for the incontestable ALIGN mark, the content of which speaks for itself. Align Technology

denies any characterization that is inconsistent with the document and further denies the remaining allegations in paragraph 73.

74. The allegations contained in numbered paragraph 74 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

75. The allegations contained in numbered paragraph 75 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

76. Regarding the allegations contained in numbered paragraph 76 of the Counterclaims, Align Technology admits that Applicant purports to cite to the trademark prosecution history for obtaining the incontestable ALIGN mark. Align Technology denies any characterization that is inconsistent with the documents, specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception, and further denies the remaining allegations in paragraph 76.

77. Regarding the allegations contained in numbered paragraph 77 of the Counterclaims, Align Technology admits that Applicant purports to cite to the trademark prosecution history for obtaining the incontestable ALIGN mark. Align Technology denies any characterization that is inconsistent with the documents, specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception, and further denies the remaining allegations in paragraph 77. Align Technology further states that the ALIGN mark has been prominently featured on product boxes since at least 2002 as reflected in the pictures below.





78. Regarding the allegations contained in numbered paragraph 78 of the Counterclaims, Align Technology admits that Applicant purports to cite to the trademark prosecution history for obtaining the incontestable ALIGN mark. Align Technology denies any characterization that is inconsistent with the documents, specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception, and further denies the remaining allegations in paragraph 78.

79. Regarding the allegations contained in numbered paragraph 79 of the Counterclaims, Align Technology admits that Applicant purports to cite to the trademark prosecution history for obtaining the incontestable ALIGN mark. Align Technology denies any characterization that is inconsistent with the documents, specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception, and further denies the remaining allegations in paragraph 79.

80. The allegations contained in numbered paragraph 80 of the Counterclaims are denied.

81. The allegations contained in numbered paragraph 81 of the Counterclaims are denied.

82. The allegations contained in numbered paragraph 82 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

83. The allegations contained in numbered paragraph 83 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

84. The allegations contained in numbered paragraph 84 of the Counterclaims are denied.

Answering Count III

85. Regarding the allegations contained in numbered paragraph 85 of the Counterclaims, Align Technology realleges and incorporates by reference its responses to each and every allegation contained in paragraphs 1-84 as if fully restated herein.

86. The allegations contained in numbered paragraph 86 of the Counterclaims are denied. Align Technology specifically avers that it continues to use the ALIGN mark as permitted under the '957 Registration.

87. The allegations contained in numbered paragraph 87 of the Counterclaims are denied. Align Technology specifically avers that it has made use of the ALIGN designation as a mark on its goods continuously since 1999.

88. The allegations contained in numbered paragraph 88 of the Counterclaims are denied. Align Technology specifically avers that it intends to continue use of the ALIGN designation as a mark for its goods.

Answering Count IV

89. Regarding the allegations contained in numbered paragraph 89 of the Counterclaims, Align Technology realleges and incorporates by reference its responses to each and every allegation contained in paragraphs 1-84 as if fully restated herein.

90. Regarding the allegations contained in numbered paragraph 90 of the Counterclaims, Align Technology admits that it is the owner of U.S. Trademark Registration No. 3,181,043 (“the ‘043 Registration”) for the incontestable mark ALIGN for use in connection with “Training in the use of orthodontic appliances” in International Class 41 and “Orthodontic Services” in International Class 44.

91. Regarding the allegations contained in numbered paragraph 91 of the Counterclaims, Align Technology admits that it relied upon its family of ALIGN-formative marks, including incontestable registrations for the marks ALIGN and INVISALIGN, in challenging Applicant’s ANGELALIGN marks that are the subject of its opposition. The remaining allegations of paragraph 91 are denied.

92. Regarding the allegations contained in numbered paragraph 92 of the Counterclaims, Align Technology admits that among the uses of the incontestable ALIGN mark is its use in connection with the sale of orthodontic devices that assist in the straightening of teeth and the services related to such orthodontic devices. The remaining allegations of paragraph 92 are denied.

93. The allegations contained in numbered paragraph 93 of the Counterclaims are denied. Align Technology specifically avers that Applicant has no reason whatsoever to infringe upon the incontestable ALIGN mark.

94. The allegations contained in numbered paragraph 94 of the Counterclaims are denied. Align Technology specifically avers that the incontestable ALIGN mark has achieved widespread recognition and secondary meaning in the marketplace in connection with, among other goods and services, the services related to the orthodontic appliances sold by Align Technology.

95. The allegations contained in numbered paragraph 95 of the Counterclaims are denied.

Answering Count V

96. Regarding the allegations contained in numbered paragraph 96 of the Counterclaims, Align Technology realleges and incorporates by reference its responses to each and every allegation contained in paragraphs 1-95 as if fully restated herein.

97. Regarding the allegations contained in numbered paragraph 97 of the Counterclaims, Align Technology admits that it is the owner of U.S. Trademark Registration No. 3,181,043 (“the ‘043 Registration”) for the incontestable mark ALIGN for use in connection with “Training in the use of orthodontic appliances” in International Class 41 and “Orthodontic Services” in International Class 44.

98. Regarding the allegations contained in numbered paragraph 98 of the Counterclaims, Align Technology admits that it relied upon its family of ALIGN-formative marks, including incontestable registrations for the marks ALIGN and INVISALIGN, in challenging Applicant’s ANGELALIGN marks that are the subject of its opposition. The remaining allegations of paragraph 98 are denied.

99. The allegations contained in numbered paragraph 99 of the Counterclaims are denied.

100. Align Technology denies the allegations contained in numbered paragraph 100 of the Counterclaims and specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception. Further, Align Technology notes that at the time the application was divided, the Trademark Office had dropped its descriptiveness position with respect to Classes 41 and 44.

101. The allegations contained in numbered paragraph 101 of the Counterclaims are denied.

102. The allegations contained in numbered paragraph 102 of the Counterclaims are denied.

103. Regarding the allegations of numbered paragraph 103 of the Counterclaims, Align Technology admits that it has used the term "aligner" when selling orthodontic appliances that assist in the straightening of teeth—and services related to such orthodontic appliances—under the incontestable ALIGN mark. Align Technology denies the remaining allegations of paragraph 103.

104. The allegations contained in numbered paragraph 104 of the Counterclaims are denied.

105. The allegations contained in numbered paragraph 105 of the Counterclaims are denied.

106. The allegations contained in numbered paragraph 106 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

107. The allegations contained in numbered paragraph 107 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

108. The allegations contained in numbered paragraph 108 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

109. The allegations contained in numbered paragraph 109 of the Counterclaims are denied.

110. Regarding the allegations contained in numbered paragraph 110 of the Counterclaims, Align Technology admits that the Trademark Office issued an Office Action dated September 2, 2004, in connection with the application that matured into the '043 Registration, the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document and further denies the remaining allegations in paragraph 110.

111. Regarding the allegations contained in numbered paragraph 111 of the Counterclaims, Align Technology admits that in Paragraph 111, Applicant has quoted from a portion of the Align Technology trademark prosecution file for the incontestable ALIGN mark, the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document and further denies the remaining allegations in paragraph 111.

112. The allegations contained in numbered paragraph 112 of the Counterclaims are denied.

113. The allegations contained in numbered paragraph 113 of the Counterclaims are denied.

114. The allegations contained in numbered paragraph 114 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

115. The allegations contained in numbered paragraph 115 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

116. The allegations contained in numbered paragraph 116 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

117. The allegations contained in numbered paragraph 117 of the Counterclaims are denied.

118. Regarding the allegations contained in numbered paragraph 118 of the Counterclaims, Align Technology admits that Applicant has quoted from statements contained in the Align Technology trademark prosecution file for the incontestable ALIGN mark, the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document and further denies the remaining allegations in paragraph 118.

119. Regarding the allegations contained in numbered paragraph 119 of the Counterclaims, Align Technology admits that Applicant has quoted from statements contained in the Align Technology trademark prosecution file for the incontestable ALIGN mark, the content of which speaks for itself. Align Technology denies any characterization that is inconsistent with the document and further denies the remaining allegations in paragraph 119.

120. Regarding the allegations contained in numbered paragraph 120 of the Counterclaims, Align Technology admits that the highlighted statement in Paragraph 119 referred to in Paragraph 120 is factual.

121. The allegations contained in numbered paragraph 121 of the Counterclaims are denied.

122. The allegations contained in numbered paragraph 122 of the Counterclaims are denied. Align Technology specifically avers that it has made widespread and exclusive use of the incontestable ALIGN mark in sales of orthodontic appliances that assist in the straightening of teeth and services related to such orthodontic appliances.

123. The allegations contained in numbered paragraph 123 of the Counterclaims are denied.

124. The allegations contained in numbered paragraph 124 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

125. The allegations contained in numbered paragraph 125 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

126. The allegations contained in numbered paragraph 126 of the Counterclaims are denied. Align Technology specifically avers that Align Technology's trademark prosecution history in obtaining the incontestable ALIGN mark speaks for itself and shows no deception.

127. The allegations contained in numbered paragraph 127 of the Counterclaims are denied.

Answering Count VI

128. Regarding the allegations contained in numbered paragraph 128 of the Counterclaims, Align Technology realleges and incorporates by reference its responses to each and every allegation contained in paragraphs 1-127 as if fully restated herein.

129. The allegations contained in numbered paragraph 129 of the Counterclaims are denied. Align Technology specifically avers that it continues to use the ALIGN mark as permitted under the '043 Registration.

130. The allegations contained in numbered paragraph 130 of the Counterclaims are denied. Align Technology specifically avers that it has made use of the ALIGN designation as a mark on its goods continuously since 1999.

131. The allegations contained in numbered paragraph 131 of the Counterclaims are denied. Align Technology specifically avers that it intends to continue use of the ALIGN designation as a mark for its goods.

Align Technology denies all allegations of the Counterclaim not expressly admitted above.

AFFIRMATIVE DEFENSES

First Affirmative Defense

Applicant fails to state a claim upon which relief may be granted.

Second Affirmative Defense

Applicant's contentions in the Counterclaim are or may be barred by estoppel.

Third Affirmative Defense

Applicant's contentions in the Counterclaim are or may be barred by waiver and/or acquiescence.

Fourth Affirmative Defense

Applicant's contentions in the Counterclaim are or may be barred by Applicant's own unclean hands.

Fifth Affirmative Defense

Applicant's contentions in the Counterclaim are or may be barred by waiver and/or acquiescence.

Sixth Affirmative Defense

Applicant's Counterclaim fails because Align Technology has maintained continuous use of the ALIGN mark since 1999.

Seventh Affirmative Defense

Applicant's Counterclaim fails because the ALIGN mark has achieved secondary meaning.

Eighth Affirmative Defense

Applicant's Counterclaim fails because the ALIGN mark is incontestable, defeating claims of descriptiveness or genericness.

Ninth Affirmative Defense

Applicant's Counterclaim fails because it does not plead fraud with particularity.

WHEREFORE, Align Technology, Inc., Registrant of the incontestable U.S. Trademark Registrations No. 3,259,957 and No. 3,181,043 for the mark ALIGN, respectfully requests that the petition for cancellation of the marks be denied and that the petition be dismissed with prejudice.

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| December 1, 2019 | |
| | <p>Respectfully submitted,</p> <p>SHEPPARD, MULLIN, RICHTER & HAMPTON LLP</p> <p>By: <i>/s/ Steven P. Hollman</i> _____ Steven P. Hollman</p> <p>2099 Pennsylvania Avenue, NW, Suite 100 Washington, DC 20006-6801 Telephone: (202) 747-1941 E-mail: shollman@sheppardmullin.com</p> <p>Harold J. Milstein Chelseaa Bush SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 379 Lytton Avenue Palo Alto, CA 94301 Telephone: (650) 815-2600 hmilstein@sheppardmullin.com cbush@sehppardmullin.com</p> <p>Attorneys for Opposer Align Technology, Inc.</p> |

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of ALIGN TECHNOLOGY, INC.'S ANSWER TO COUNTERCLAIM AND AFFIRMATIVE DEFENSES, was served on December 1, 2019, via email to the following counsel of record:

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