

ESTTA Tracking number: **ESTTA1102156**

Filing date: **12/16/2020**

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 Technologies Corp.
Granted to Date of previous extension	12/16/2020
Address	2701 ST. CHARLES AVENUE NEW ORLEANS, LA 70130 UNITED STATES
Attorney information	CHRISTOPHER M. WEIMER PIRKEY BARBER PLLC 1801 EAST 6TH STREET SUITE 300 AUSTIN, TX 78702 UNITED STATES Primary Email: cweimer@pirkeybarber.com Secondary Email(s): akuhn@pirkeybarber.com, gyaquinto@pirkeybarber.com, drausa@pirkeybarber.com, tmcentral@pirkeybarber.com 512-322-5200
Docket Number	ALGN002

**Applicant Information**

Application No.	79273525	Publication date	08/18/2020
Opposition Filing Date	12/16/2020	Opposition Period Ends	12/16/2020
International Registration No.	1502095	International Registration Date	06/19/2019
Applicants	Atlassian Pty. Ltd. LEVEL 6, 341 GEORGE STREET SYDNEY NEW SOUTH WALES 2000 AUSTRALIA  Atlassian, Inc. 350 BUSH STREET, FLOOR 13 SAN FRANCISCO, CA 94104 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: downloadable computer software for project management, task and issue tracking, communication and collaboration; downloadable computer software for information technology systems management, task management and project management;

downloadable computer software for analytics regarding project management, task and issue tracking; downloadable computer software using business intelligence for business analytics purposes; downloadable computer software using artificial intelligence for business analytics purposes; downloadable computer software for use on computers and mobile devices for use in task and project management, business management, general work management, project tracking, document management, transmission and receipt of data, images, and files, messaging and conversation based contextual sharing of information, organizing and providing a platform for collaboration, sharing of information and interactive discussions to other users, and uploading, sharing and transferring files; downloadable computer software for use on computers and mobile devices for electronic communications, chats, email and discussions; downloadable computer software for collaboration, and development and release of software; downloadable computer software for facilitating the exchange of information via the Internet featuring collaboration and project and task management tools; downloadable computer software for information technology support services, namely, for trouble shooting of computer software problems, and providing information related to technology project management services; downloadable electronic publications, namely, manuals, brochures, newsletters, technical data sheets and product specification brochures in the fields of computer software, information technology and project management; all of the aforementioned goods intended for the following fields of use: computer software and applications for project and issue tracking, computer software and applications for agile software development, computer software and applications for collaboration, document management, and bug tracking, computer software and applications for information technology support services, namely, for managing help desk services, trouble shooting of computer software problems, technical support services, and providing information related to technology project management services

Class 042. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Developing computer software; computer system analysis; providing online non-downloadable software for information technology systems management, task management and project management; creating of computer programs; design and development of computer software; providing online non-downloadable software for project management, task and issue tracking and communication; platform as a service (PaaS); software as a service (SaaS); software as a service (SaaS) services featuring software for project management, task and issue tracking, and communication; providing online non-downloadable software for analytics regarding project management, task and issue tracking; providing online non-downloadable software using business intelligence for business analytics purposes; providing online non-downloadable software using artificial intelligence for business analytics purposes; providing online non-downloadable software for use in project management, task and issue tracking and communication, business management, general work management, project tracking, document management, transmission and receipt of data and images, messaging and conversation based contextual sharing of information, organizing and providing a platform for collaboration, sharing of information and interactive discussions between users, and uploading and transferring files; providing online non-downloadable software for electronic communications, chats, email and discussions; providing online non-downloadable software for collaboration, development and release of software; providing online non-downloadable software for facilitating the exchange of information via the Internet featuring collaboration tools; providing online non-downloadable software for information technology support services, trouble shooting of computer software problems, technical support in the nature of trouble shooting of computer software problems, and providing information related to technology project management services; computer software design and development; consulting services in the field of design and development of computer software; hosting a website featuring non-downloadable software in the fields of information technology systems management, task management and project management; providing temporary use of a non-downloadable web application for collaboration, project management, document management, and software development; information, consultancy and advisory services in relation to all of the aforesaid; all of the aforementioned services intended for the following fields of use: computer software and applications for project and issue tracking, computer software and applications for agile software development, computer software and applications for collaboration, document management, and bug tracking, computer software and applications for information technology support services, namely, for managing help desk services, trouble shooting of computer software problems, technical support services, and providing information related to technology project management services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Attachments	Notice of Opposition.pdf(119816 bytes )
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Signature	/Christopher M. Weimer/
Name	Christopher M. Weimer
Date	12/16/2020

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

In Re Serial No. 79/273,525	§	
Filed: June 19, 2019	§	
Mark: <b>JIRA ALIGN</b>	§	
Published: August 18, 2020	§	
 	§	
Align Technologies Corp.,	§	
	§	Opposition No. _____
Opposer,	§	
	§	
v.	§	
	§	
Atlassian, Inc. and Atlassian Pty. Ltd.,	§	
	§	
Applicants.	§	

**NOTICE OF OPPOSITION**

Align Technologies Corp. (“Opposer”), a corporation organized and existing under the laws of the State of Delaware, having its principal place of business in New Orleans, Louisiana, believes that it will be damaged by registration of the mark identified above, and hereby opposes same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, Opposer asserts that:

1. Opposer specializes in providing company goal tracking and communication software. Opposer, directly and through its predecessor-in-interest, has continuously used the trade name and mark ALIGN (the “ALIGN Mark”) in commerce in connection with its business, products, and services since at least as early as 2012, including specifically in connection with its company goal tracking and communication software. As a result of its innovation and marketing efforts over the past several years, Opposer has positioned itself as a market leader in providing its software services, all of which it has done under its ALIGN Mark.
2. Opposer’s use of the ALIGN Mark has been continuous and extensive, and the mark has never been abandoned.

3. Opposer has invested substantial time, money, and effort, in the development, enhancement, advertisement, promotion, and marketing of its goods and services offered under its ALIGN mark. As a result of these efforts and of the consistent, high quality of its goods and services rendered thereunder, Opposer has built up considerable goodwill in its ALIGN Mark, which has become a valuable asset to Opposer. Members of the public and relevant consumers have grown to recognize the ALIGN Mark as being associated with Opposer's high-caliber goods and services in the field of company goal tracking, project management, and communication software (i.e., "Opposer's Goods and Services").

4. Opposer's ALIGN Mark is inherently distinctive, serving to identify and indicate the source of Opposer's Goods and Services to the consuming public, and to distinguish Opposer's Goods and Services from those of others.

5. Additionally, as a result of Opposer's extensive use and promotion of its ALIGN Mark, it has become widely recognized by consumers. Opposer has invested significant effort and resources in advertising and promoting its ALIGN Mark and the goods and services provided under it, with the result that the purchasing public has come to know, rely on, and recognize Opposer's Goods and Services by the ALIGN Mark. As a consequence, Opposer has established significant goodwill in its ALIGN Mark.

6. Atlassian, Inc. ("Applicant") is a Delaware corporation with an address of 350 Bush Street, Floor 13, San Francisco, California 94104.

7. Atlassian Pty. Ltd. ("Applicant") is an Australian proprietary limited company with an address of Level 6, 341 George Street, Sydney New South Wales 2000 Australia.

8. Applicants filed U.S. Serial No. 79/273,525 (the "Application") pursuant to Section 66(a) of the Trademark Act on June 19, 2019 for the mark JIRA ALIGN ("Applicants' Mark"). The

Application covers “downloadable computer software for project management, task and issue tracking, communication and collaboration; downloadable computer software for information technology systems management, task management and project management; downloadable computer software for analytics regarding project management, task and issue tracking; downloadable computer software using business intelligence for business analytics purposes; downloadable computer software using artificial intelligence for business analytics purposes; downloadable computer software for use on computers and mobile devices for use in task and project management, business management, general work management, project tracking, document management, transmission and receipt of data, images, and files, messaging and conversation based contextual sharing of information, organizing and providing a platform for collaboration, sharing of information and interactive discussions to other users, and uploading, sharing and transferring files; downloadable computer software for use on computers and mobile devices for electronic communications, chats, email and discussions; downloadable computer software for collaboration, and development and release of software; downloadable computer software for facilitating the exchange of information via the Internet featuring collaboration and project and task management tools; downloadable computer software for information technology support services, namely, for trouble shooting of computer software problems, and providing information related to technology project management services; downloadable electronic publications, namely, manuals, brochures, newsletters, technical data sheets and product specification brochures in the fields of computer software, information technology and project management; all of the aforementioned goods intended for the following fields of use: computer software and applications for project and issue tracking, computer software and applications for agile software development, computer software and applications for collaboration, document

management, and bug tracking, computer software and applications for information technology support services, namely, for managing help desk services, trouble shooting of computer software problems, technical support services, and providing information related to technology project management services” in Class 9 and “Developing computer software; computer system analysis; providing online non-downloadable software for information technology systems management, task management and project management; creating of computer programs; design and development of computer software; providing online non-downloadable software for project management, task and issue tracking and communication; platform as a service (PaaS); software as a service (SaaS); software as a service (SaaS) services featuring software for project management, task and issue tracking, and communication; providing online non-downloadable software for analytics regarding project management, task and issue tracking; providing online non-downloadable software using business intelligence for business analytics purposes; providing online non-downloadable software using artificial intelligence for business analytics purposes; providing online non-downloadable software for use in project management, task and issue tracking and communication, business management, general work management, project tracking, document management, transmission and receipt of data and images, messaging and conversation based contextual sharing of information, organizing and providing a platform for collaboration, sharing of information and interactive discussions between users, and uploading and transferring files; providing online non-downloadable software for electronic communications, chats, email and discussions; providing online non-downloadable software for collaboration, development and release of software; providing online non-downloadable software for facilitating the exchange of information via the Internet featuring collaboration tools; providing online non-downloadable software for information technology support services, trouble shooting of computer software

problems, technical support in the nature of trouble shooting of computer software problems, and providing information related to technology project management services; computer software design and development; consulting services in the field of design and development of computer software; hosting a website featuring non-downloadable software in the fields of information technology systems management, task management and project management; providing temporary use of a non-downloadable web application for collaboration, project management, document management, and software development; information, consultancy and advisory services in relation to all of the aforesaid; all of the aforementioned services intended for the following fields of use: computer software and applications for project and issue tracking, computer software and applications for agile software development, computer software and applications for collaboration, document management, and bug tracking, computer software and applications for information technology support services, namely, for managing help desk services, trouble shooting of computer software problems, technical support services, and providing information related to technology project management services” in Class 42 (“Applicants’ Goods and Services”).

9. Opposer has priority based on its use in commerce of its ALIGN Mark in the United States, prior to Applicants’ filing of the Application or any date on which Applicant can rely for establishing rights in the mark that is the subject of the Application.

10. Opposer has not given Applicants permission or approval to use or register Applicants’ Mark, which wholly incorporates Opposer’s ALIGN Mark.

11. Applicants’ Goods and Services are identical, or highly similar and closely related, to the goods and services for which Opposer has long used its ALIGN Mark in commerce, and for which Opposer has built up considerable goodwill associated with its ALIGN Mark. In particular, Applicants’ Goods and Services as recited in the Application seek registration of Applicants’ Mark



in connection with goods and services that overlap with Opposer's Goods and Services.

12. As explained above, Opposer's Mark has been used extensively in connection with Opposer's Goods and Services, namely computer software for project management, task, goal and issue tracking, communication and collaboration, and related services.

13. Applicants' Goods and Services recited in its Application are not restricted and will travel in the same or similar channels of trade as Opposer's Goods and Services. Applicants' Goods and Services are likely to be purchased by the same or similar types of consumers who purchase or use Opposer's Goods and Services, and to compete with Opposer's Goods and Services offered under its ALIGN Mark.

14. Applicants' Mark so resembles Opposer's ALIGN Mark and trade name as to be likely, when used on or in connection with Applicants' Goods and Services, to cause confusion or mistake, or to deceive. Purchasers and prospective purchasers are likely to believe that Applicants' Goods and Services are sponsored, endorsed, or approved by Opposer, or are in some way affiliated, connected, or associated with Opposer or its goods and services. Registration should therefore be refused under 15 U.S.C. § 1052(d).

15. Additionally, registration of Applicants' Mark would damage Opposer because it would confer upon Applicants statutory presumptions to which they are not entitled in view of Opposer's prior use of and common law rights in its ALIGN Mark.

WHEREFORE, Opposer prays that U.S. Serial No. 79/273,525 be rejected, and that registration of the mark therein be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey

Barber PLLC, Account No. 50-3924/ALGN002/CMW, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: December 16, 2020

*/Christopher M. Weimer/*

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