

**UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF LOUISIANA**

ALIGN TECHNOLOGIES, INC.
Plaintiff

v.

O.C. TANNER COMPANY, INC.,
Defendant

CASE NO.:

JUDGE:

MAGISTRATE JUDGE:

SECTION:

Plaintiff Align Technologies, Inc. (“Plaintiff”) hereby brings this complaint for damages and injunctive relief against Defendant O.C. Tanner Company, Inc. (“Defendant”), and respectfully avers the following:

INTRODUCTION

1. This is an action for federal service mark infringement, unfair competition, and false designation of origin under the Trademark Act of 1946, as amended [*The Lanham Act*, 15 U.S.C. § 1051 *et seq.*], as well as common law infringement and deceptive trade practices under Louisiana law, arising from the use, by Defendant, of the name and trademark ALIGN.

2. Plaintiff specializes in providing company goal tracking and communication software under its ALIGN trademark.

3. As a result of its innovation and marketing efforts over the past several years, Plaintiff has positioned itself as a market leader providing its software services to a national and international clientele.

4. Upon information and belief, Defendant is a global company based in Utah that has long focused on developing strategic employee recognition and reward solutions.

5. In 2019, in an effort to seemingly trade off of the goodwill established by Plaintiff, Defendant unveiled its new software under the name “Align,” and promoted the software as a service tool focused on employee management and designed to aid managers into becoming leaders through communication and goal tracking.

6. The goodwill and reputation for quality that Plaintiff has worked so hard to cultivate has been threatened by Defendant’s actions. Defendant has used and continues to use its identical ALIGN word mark to sell competing goods and services to the same market served by Plaintiff. Unless Defendant is enjoined from using the ALIGN mark, such use will continue to cause consumer confusion and will cause irreparable harm to Plaintiff.

7. This action seeks injunctive relief, damages and other appropriate relief arising from Defendant’s ongoing and willful acts of trademark infringement and unfair competition.

JURISDICTION AND VENUE

8. This is an action for trademark infringement and unfair competition in violation of Section 43(a) of the Lanham Act (15 U.S.C. § 1125(a)).

9. This Court has subject matter jurisdiction over this action under 28 U.S.C. §§ 1331 and 1338 because it involves substantial claims arising under the federal Lanham Act.

10. This Court has supplemental jurisdiction over Plaintiff’s state law claims under 28 U.S.C. § 1367.

11. This Court has personal jurisdiction over Defendant. Defendant’s acts of infringement of Plaintiff’s ALIGN mark were committed in the Eastern District of Louisiana, within the jurisdiction of this Court. Defendant is a sophisticated company that markets and sells its products throughout the United States, including Louisiana. Prior to unveiling its product, Defendant retained the Utah based law firm of Kirkton McConkie to apply for a federal trademark

registration of the ALIGN name at the United States Patent and Trademark Office (“USPTO”). According to its website, Kirkton McConkie is “one of the largest Intellectual Property law firms in the Intermountain West” region of the United States. Considering Defendant’s size and sophistication, as well as the law firm it retained to pursue its trademark rights in the “Align” name, Defendant must have known of Plaintiff’s successful business located in this district and the notoriety its ALIGN trademark had achieved both locally and throughout the United States. Despite its prior knowledge, Defendant intentionally marketed and sold its infringing goods and services to customers in this district through its active website as well as other localized outlets, including, its subsidiary sales company registered to do business in Louisiana, O.C. Tanner Recognition Company. Defendant’s contacts and conduct in Louisiana, and in this district, are tantamount to an approximate physical presence in this district such that it is reasonable and foreseeable that Defendant would be hailed into this Court.

12. Venue is proper in this district pursuant to 28 U.S.C. § 1391 as this Court has personal jurisdiction over the Defendant, and upon information and belief, Defendant has and continues to transact business in this district and a substantial part of the events giving rise to the Plaintiff’s claims occurred and are continuing to occur in this district.

THE PARTIES

13. Plaintiff is a corporation, organized under the laws of the State of Delaware, with its principal place of business in New Orleans, Louisiana.

14. Defendant is a corporation, organized under the laws of the State of Utah, with its principle place of business located in Salt Lake City, Utah, and its registered agent located at 1108 E South Union Avenue, Midvale Utah 84047.

STATEMENT OF FACTS

15. Plaintiff, and its predecessor, have been consistently using the ALIGN word mark since 2012 in connection with its services, including its company goal tracking and communication software.

16. Over the past several years, Plaintiff has successfully marketed and sold its software service to thousands of companies, both nationally and internationally.

17. Plaintiff has consistently maintained an active website that contains information about each of its services. Indeed, a Google search using search terms “Align business,” “Align software,” “Align employee,” “Align manager,” or “Align meeting” all return Plaintiff’s website as a top match.

18. Plaintiff has invested substantial time, money, and effort, in the development, enhancement, advertisement, promotion, and marketing of its goods and services under the ALIGN mark. As a result of these efforts, the goodwill built up under Plaintiff’s ALIGN mark, and the consistent, high quality of goods and services rendered thereunder, makes the ALIGN mark a valuable asset to Plaintiff. Members of the public, and relevant consumers, have grown to recognize the ALIGN mark as being associated with Plaintiff’s high caliber services in the field of company goal tracking and communication software.

19. At no time has Plaintiff licensed or otherwise authorized Defendant to use the ALIGN mark, or any confusingly similar mark, in connection with goods or services relating to the software services offered by the Plaintiff.

20. On January 11, 2019, without permission and without Plaintiff’s knowledge, Defendant sought to register the ALIGN mark with the United States Patent and Trademark Office (“USPTO”) in class 042 for services in the field of “providing temporary use of on-line non-

downloadable software for use in the facilitation of productive conversations, namely, software for facilitating productive conversations between managers and employees and featuring templates for creating conversation guides, meeting agendas and recognition history reports.” The application states that Defendant first used the mark on February 1, 2019, more than five years after Plaintiff began using the ALIGN mark in commerce for similar services.

21. Defendant retained the Utah based law firm of Kirkton McConkie to file its trademark application for the ALIGN mark. According to its website, Kirkton McConkie is the largest law firm in Utah and the largest intellectual property law firm in the Intermountain West region of the United States.

22. Considering Plaintiff’s online presence and commercial success in combination with Defendant’s size and sophistication, and the reputable law firm representing its trademark interest, Defendant must have been aware of Plaintiff’s ALIGN mark and the highly regarded services sold under its mark.

23. Defendant has and continues to advertise and promote its competing software services under the ALIGN trademark on its website <https://www.octanner.com/products/leadership.html>.

24. The “Align” designation used by Defendant for its employee management and communication software is identical in appearance, pronunciation, meaning, and commercial impression, to Plaintiff’s ALIGN trademark.

25. The goods and services provided by Plaintiff and Defendant under their respective names and marks, as aforesaid, also are nearly identical; are marketed to the same class of business consumers; and, are advertised and promoted through the same channels of trade.

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