

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

3SHAPE A/S, 3SHAPE TRIOS A/S, and  
3SHAPE, INC.,

Plaintiff,

v.

ALIGN TECHNOLOGY, INC.,

Defendant.

C.A. 1:20-cv-\_\_\_\_\_

**JURY TRIAL DEMANDED**

**COMPLAINT FOR DECLARATORY JUDGMENT OF NON-INFRINGEMENT**

Plaintiffs 3Shape A/S, 3Shape Trios A/S, and 3Shape, Inc. (individually and/or collectively, “3Shape” or “Plaintiff”) by and through their undersigned counsel, file this Complaint for Declaratory Judgment (“Complaint”) against Defendant Align Technology, Inc. (“Defendant” or “Align”). 3Shape seeks declaratory relief pursuant to 28 U.S.C. §§ 2201 and 2202, declaring that 3Shape does not infringe U.S. Patent Nos. 9,101,433 (the “433 patent”), 10,728,519 (the “519 patent”), 10,750,151 (the “151 patent”), 10,750,152 (the “152 patent”), 10,791,934 (the “934 patent”), 10,791,936 (the “936 patent”), and 10,709,527 (the “527 patent”) (collectively the “Patents-in-Suit” or “Texas Patents”).

**PARTIES**

1. Plaintiff 3Shape A/S is a Danish corporation with a principal place of business at Holmens Kanal 7, 1060 Copenhagen K, Denmark.
2. Plaintiff 3Shape Trios A/S is a Danish corporation with a principal place of business at Holmens Kanal 7, 1060 Copenhagen K, Denmark.
3. Plaintiff 3Shape Inc. is a Delaware corporation with a principal place of business at 10 Independence Boulevard, Suite 150, Warren, New Jersey 07059.

4. On information and belief, Defendant Align Technology Inc. (“Align”) is a United States corporation organized and existing under the laws of Delaware with a principal place of business at 2820 Orchard Parkway, San Jose, California 95134.

### **JURISDICTION AND VENUE**

5. This lawsuit is an action for declaratory judgment of non-infringement under the Patent Laws of the United States, 35 U.S.C. § 1 et seq. and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202.

6. This Court has subject matter jurisdiction over this action pursuant to 28 U.S. C. §§ 1331, 1338, 2201, and 2202.

7. This Court has personal jurisdiction over Defendant because Defendant has purposely availed itself of the privilege of conducting activities within this State and judicial District. For example, Defendant is incorporated in the state of Delaware and has availed itself of the use of this District’s courts in asserting its own patent rights on multiple, recent occasions.

8. On information and belief, Defendant regularly conducts business in Delaware, and purposefully avails itself of the privileges of conducting business in Delaware. In particular, Defendant is incorporated in Delaware. Further, on information and belief, Defendant, directly and/or through its agents and/or intermediaries, makes, uses, imports, offers for sale, sells, and/or advertises its products and affiliated services in Delaware.

9. Defendant has also purposely availed itself of the court of this District, having brought at least seven different patent infringement actions against Plaintiffs in the District of Delaware – C.A. Nos. 17-cv-1646, 17-cv-1647, 17-cv-1648, 17-cv-1649, 18-cv-1949, 18-cv-1950, and 19-cv-2098. The use of the courts of this jurisdiction is sufficient to give rise to jurisdiction over Defendant.

10. Venue for these claims is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b) and (c) and 1400(b) because Defendant is a resident of the state of Delaware through its incorporation under the laws of this state.

### **BACKGROUND**

11. 3Shape is a pioneer developer of dental equipment and software for use by dental professionals and laboratories.

12. As one example, Plaintiff 3Shape A/S designs, develops, manufactures, and sells 3Shape's portfolio of lab scanners as well as 3Shape's Dental System CAD/CAM software.

13. As another example, 3Shape Trios A/S designs, develops, manufactures, and sells the Trios family of intraoral scanners – the first color wireless intraoral full mouth scanners in the industry – and related software products. The Trios system can be used for scanning, designing, and ordering of clear aligners and a number of other orthodontic treatments or dental products.

14. Trios has been named the best intraoral scanner by the industry for five years in a row. Trios was also named the most accurate intraoral scanner in an independent American Dental Association study.

15. Trios has numerous operational advantages for dental professionals as well. The most important is that Trios is an open system scanner, integrated with many different providers of restorative products and orthodontic treatments. Dental professionals can send scans directly from Trios to any provider that accepts STL files, the open industry standard file format. Trios's open system provides patients and dental professionals freedom of choice and access to an open market for dental and orthodontic treatments.

16. On or about December 31, 2015, Align and 3Shape Trios A/S entered into a contract ("the Scanner Agreement") to promote interoperability between 3Shape's Trios and

Trios 3 intraoral scanners and related software and technology and Align's Invisalign clear aligner workflows.

17. Align purported to terminate the Scanner Agreement in December 2017.

18. Align purported to close the interoperability between Trios and Invisalign for new cases in the U.S. only in January of 2018. *See* Press Release: Align Technology to Discontinue Acceptance of Digital Scan Submissions From Trios Scanners in the United States, [aligntech.com](http://investor.aligntech.com/static-files/c58144fd-bf1f-404a-91ff-32416d39af83) (Dec. 20, 2017) *available at* <http://investor.aligntech.com/static-files/c58144fd-bf1f-404a-91ff-32416d39af83>.

19. Trios and Trios 3 users outside the U.S. can still send scans to Invisalign to this day.

#### **DELAWARE ACTIONS**

20. On November 14, 2017, Defendant filed four Actions against Plaintiffs in this District: C.A. No. 17-cv-01646 (the "1646 Action"); C.A. No. 17-cv-01647 (the "1647 Action"); 17-cv-01648 (the "1648 Action"); C.A. No. 17-cv-01649 (the "1649 Action") ("the Initial District Court Cases").

21. Also on November 14, 2017, Defendant filed two Investigations before the International Trade Commission ("ITC"): *Certain Intraoral Scanners and Related Hardware and Software*, Inv. No. 337-TA-1090 (U.S.I.T.C.) (the "1090 Investigation"); *Certain Color Intraoral Scanners and Related Hardware and Software*, Inv. No. 337-TA-1091 (the "1091 Investigation") against Plaintiffs.

22. On or about December 10, 2018, Defendant agreed that it would not challenge jurisdiction or venue in this District in the then pending patent infringement actions between Plaintiff and Defendant. (Ex. A).

23. On that same day, December 10, 2018, Defendant filed a third ITC Investigation: *Certain Dental and Orthodontic Scanners and Software*, Inv. No. 337-TA-1144 (U.S.I.T.C.) (the “1144 Investigation”) against Plaintiffs.

24. On December 11, Defendant filed two additional actions against Plaintiffs in this District: C.A. No. 18-cv-01949 (the “1949 Action”) and C.A. 18-cv-01950 (the “1950 Action”).

25. In the 1646 Action and the 1144 Investigation, Align accused 3Shape of infringing, *inter alia*, U.S. Patent No. 9,299,192 (the “’192 patent” or “First Selective Rescanning Patent”).

26. In the 1646 Action, Align asserted that “[o]n information and belief, 3Shape has been and is now directly and indirectly infringing, literally and/or under the doctrine of equivalents, the ’192 patent by making, using, selling, and/or offering for sale in the United States, and/or importing into the United States products covered by one or more of the claims of the ’192 patent, including the Trios and Trios 3, as well as the related Dental System software products.” (1646 Action, D.I. 1.) 3Shape counterclaimed for a declaratory judgment that it does not infringe the ’192 Patent. (1646 Action, D.I. 214.)

27. In the 1144 Investigation, Align asserted that 3Shape “directly infringe[s] [claims 1-32 of the ’192 patent] at least through their sale for importation, importation and/or sale after importation into the United States of the Accused Products, including 3Shape’s Trios 3 intraoral digital impression system, which operates using Trios Module software running on computer hardware, 3Shape’s Trios intraoral digital impression system, which operates in conjunction with Dental System software running on computer hardware; and 3Shape’s Lab Scanners, which operate in conjunction with Dental System software running on computer hardware.”

28. The ’192 Patent is still asserted in the 1646 Action.

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