

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
WACO DIVISION**

ALIGN TECHNOLOGY, INC.,

Plaintiff and Counterclaim  
Defendant,

v.

3SHAPE A/S and 3SHAPE TRIOS A/S

Defendants and  
Counterclaimants.

C.A. No. 6:20-cv-00979-ADA

**JURY TRIAL DEMANDED**

**PUBLIC VERSION**

**ALIGN TECHNOLOGY, INC.'S PARTIAL ANSWER AND AFFIRMATIVE DEFENSES  
TO CERTAIN SECOND AMENDED COUNTERCLAIMS AND  
COUNTERCLAIMS-IN-REPLY**

Plaintiff Align Technology, Inc. (“Align”), by and through its counsel of record, demands trial by jury on all counterclaims so triable, and hereby answers and provides affirmative defenses to certain amended “contingent” counterclaims filed by Defendants 3Shape A/S and 3Shape Trios A/S (collectively, “3Shape”) on January 7, 2022. (Dkt. No. 179, Defendants 3Shape Trios A/S and 3Shape A/S’s Second Amended Contingent Answer, Affirmative Defenses, and Counterclaims (“Second Amended Counterclaims” or “Counterclaims”).)

By 3Shape’s own admission, its January 7, 2022 filing was merely “contingent” and therefore has no force or effect. As a result, no response is required at this time. However, out of an abundance of caution, Align is filing both this partial Answer along with motions to dismiss several of 3Shape’s Amended Contingent Counterclaims. This partial Answer relates only to those certain counterclaims that are not covered by Align’s motions to dismiss. Align reserves the right to amend this partial Answer once the Court has ruled on the pending motions to dismiss.

In addition to this Partial Answer, Align also hereby files Counterclaims-in-Reply, pursuant to Rules 7 and 13 of the Federal Rules of Civil Procedure. *See Med. Components, Inc. v. Osiris Med., Inc.*, EP-15-CV-305-PRM, 2016 WL 7638155, at \*3 (W.D. Tex. July 12, 2016) (“A counterclaim-in-reply is a permissible pleading when it is a compulsory reply to a permissive counterclaim.”) (citation and quotation marks omitted).

### **ANSWER TO COUNTERCLAIMS**

Any allegations of the Counterclaims not specifically admitted are denied.

#### **PARTIES**

1. Counterclaim-Plaintiff 3Shape A/S (“3Shape A/S”) is a Danish corporation with a principal place of business at Holmens Kanal 7, 1060 Copenhagen K, Denmark.

**ANSWER:** Align admits on information and belief that 3Shape A/S is a Danish corporation with a principal place of business at Holmens Kanal 7, 1060 Copenhagen K, Denmark.

2. Counterclaim-Plaintiff 3Shape Trios A/S (“3Shape Trios A/S”) is a Danish corporation with a principal place of business at Holmens Kanal 7, 1060 Copenhagen K, Denmark.

**ANSWER:** Align admits on information and belief that 3Shape Trios A/S is a Danish corporation with a principal place of business at Holmens Kanal 7, 1060 Copenhagen K, Denmark.

3. 3Shape A/S is the owner by assignment of the entire right, title and interest in and to U.S. Patent No. 10,905,333 (the “333 patent”) entitled, “3D intraoral scanner measuring fluorescence,” a copy of which is attached hereto as Exhibit 4.

**ANSWER:** Align admits that U.S. Patent No. 10,905,333 is entitled “3D intraoral scanner measuring fluorescence” and that a copy is attached as Exhibit 4 to 3Shape’s Amended Contingent Counterclaims. Align denies the remainder of the allegations in this paragraph.

4. 3Shape A/S is the owner by assignment of the entire right, title and interest in and to U.S. Patent No. 10,383,711 (the “711 patent”) entitled, “Focus scanning apparatus recording color,” a copy of which is attached hereto as Exhibit 5.

**ANSWER:** Align admits that U.S. Patent No. 10,383,711 is entitled “Focus Scanning Apparatus Recording Color” and that a copy is attached as Exhibit 5 to 3Shape’s Amended Contingent Counterclaims. Align denies the remainder of the allegations in this paragraph.

5. 3Shape A/S is the owner by assignment of the entire right, title and interest in and to U.S. Patent No. 10,097,815 (the “815 patent”) entitled, “Focus scanning apparatus,” a copy of which is attached hereto as Exhibit 6.

**ANSWER:** Align admits that U.S. Patent No. 10,097,815 is entitled “Focus Scanning Apparatus” and that a copy is attached as Exhibit 6 to 3Shape’s Amended Contingent Counterclaims. Align denies the remainder of the allegations in this paragraph.

6. 3Shape A/S is the owner by assignment of the entire right, title and interest in and to U.S. Patent No. RE48,221 (the “221 patent”) entitled, “System with 3D user interface integration,” a copy of which is attached hereto as Exhibit 7.

**ANSWER:** Align admits that U.S. Patent No. RE48,221 is entitled “System with 3D User Interface Integration” and that a copy is attached as Exhibit 7 to 3Shape’s Amended Contingent Counterclaims. Align denies the remainder of the allegations in this paragraph.

7. 3Shape markets and sells industry-leading Trios intraoral scanners, including, in the United States, Trios 3 and Trios 4 (collectively with their predecessors, Trios and Trios Color, “Trios”).

**ANSWER:** Align admits on information and belief that 3Shape has marketed and sold intraoral scanners under the brand name TRIOS® in the United States. Align denies the remaining allegations of this paragraph.

8. The Trios scanners incorporate embodiments of the claimed technologies in the '711, '815, '221, and '333 patents (collectively, the "Asserted Counterclaim Patents").

**ANSWER:** Denied.

9. On information and belief, Align is a Delaware corporation with its principal place of business in San Jose, California.

**ANSWER:** Align admits that it is a United States corporation organized and existing under the laws of Delaware and located in Tempe, Arizona. Align denies the remaining allegations of this paragraph.

10. On information and belief, Align makes, uses, sells and offers for sale in the United States and/or imports into the United States, the iTero Element, Element 2, Element Flex, Element 5D, Element 5D Plus, Element 5D Plus Lite, and Element Foundation (collectively, the "iTero Element" or "iTero Element Scanners," all of which comprise at least a handheld intraoral 3D scanner/wand and a base unit including a PC.

**ANSWER:** Align admits it uses, sells and offers for sale in the United States and/or imports into the United States products called the "iTero Element," "iTero Element 2," "iTero Element Flex," "iTero Element 5D," "iTero Element 5D Plus," "iTero Element 5D Plus Lite," and "iTero Element Foundation." Align denies the remainder of the allegations in this paragraph.

11. 3Shape's Trios and Align's iTero Element scanners compete against each other in, at least, the market for scanners for orthodontic treatment.

**ANSWER:** Align admits that it is a competitor of 3Shape's in the field of intraoral scanners. Align denies the remainder of the allegations in this paragraph.

## JURISDICTION AND VENUE

12. 3Shape's contingent counterclaims arise under the Patent Laws of the United States, 35 U.S.C. § 1 *et seq.*, the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, the Lanham Act, 15 U.S.C. § 1125, and state laws.

**ANSWER:** This paragraph contains legal conclusions to which no response is required. To the extent any response is required, Align admits that 3Shape purports to bring its contingent counterclaims under the patent laws of the United States, pursuant to Title 35 of the United States Code. To the extent there are any remaining allegations in this paragraph not addressed by the foregoing, Align denies them.

13. This Court has original jurisdiction over the subject matter of 3Shape's federal question counterclaims pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338, 2201, and 2202.

**ANSWER:** This paragraph contains legal conclusions to which no response is required. To the extent any response is required, Align admits that this Court has subject matter jurisdiction over actions properly arising under 28 U.S.C. §§ 1331 and 1338(a), as well as 15 U.S.C. § 1121. To the extent there are any remaining allegations in this paragraph, Align denies them.

14. This Court has diversity jurisdiction over 3Shape's federal and state law counterclaims under 28 U.S.C. § 1332(a) because Align is a citizen of a U.S. state(s) and 3Shape is a citizen of a foreign state, and the amount in controversy exceeds \$75,000.

**ANSWER:** This paragraph contains legal conclusions to which no response is required. To the extent any response is required, Align admits that this Court has subject matter jurisdiction over actions properly arising under 28 U.S.C. § 1332(a). To the extent there are any remaining allegations in this paragraph, Align denies them.

15. This Court has supplemental jurisdiction over 3Shape's counterclaims of business disparagement, unjust enrichment, tortious interference with prospective business relations, tortious

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.