

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
Counterclaim Plaintiffs.

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

JURY TRIAL DEMANDED

**PLAINTIFF AND COUNTERCLAIM DEFENDANT ALIGN TECHNOLOGY, INC.'S
STIPULATION REGARDING IPR2022-00144 and IPR2022-00145**

On November 9, 2021, Plaintiff and Counterclaim Defendant Align Technology, Inc. (“Align”) filed two petitions with the Patent Trial and Appeal Board requesting *inter partes* review of U.S. Patent No. RE48,221 (“the ’221 patent”)—petition numbers IPR2022-00144 and IPR2022-00145. The petitions referred to the following prior art references:

- U.S. Patent Publ. No. 2006/0020204 (“Serra”)
- U.S. Patent Publ. No. 2007/0171220 (“Kriveshko”)
- U.S. Patent Publ. No. 2005/0212756 (“Marvit”)
- U.S. Patent Publ. No. 2005/0237581 (“Knighton”)
- U.S. Patent Publ. No. 2009/0298017 (“Boerjes”)
- U.S. Patent Publ. No. 2009/0087050 (“Gandyra”)
- U.S. Patent Publ. No. 2005/0020910 (“Quadling”)

The petitions asserted the following grounds of invalidity:

Align EX1048

| IPR Petition No. | Ground | Claims | Grounds of Unpatentability |
|------------------|--------|-------------------------------------|--|
| IPR2022-00144 | 1 | [1, 19] ¹ , 20–34, 37–44 | Obvious under 35 U.S.C. §103 in view of Serra |
| | 2 | [1, 19], 20–44 | Obvious under 35 U.S.C. §103 in view of Serra, Kriveshko, and Marvit |
| | 3 | [1, 19], 20–44 | Obvious under 35 U.S.C. §103 in view of Knighton and Marvit |
| IPR2022-00145 | 1 | [1, 19] 20–44 | Obvious under 35 U.S.C. §103 in view of Boerjes and Marvit |
| | 2 | [1, 19] 20–44 | Obvious under 35 U.S.C. §103 in view of Boerjes, Gandyra, and Marvit |
| | 3 | [1, 19] 20–27, 33–44 | Obvious under 35 U.S.C. §103 in view of Quadling and Marvit |

Align hereby stipulates that if the Patent Trial and Appeal Board institutes *inter partes* review in IPR2022-00144 and/or IPR2022-00145, then Align will not pursue in this case the specific grounds identified above in connection with the referenced claim(s) of the '221 patent as originally issued in the instituted *inter partes* review petition or on any other ground for the '221 patent that could reasonably have been raised in the instituted *inter partes* review for that patent using the same or substantially similar references; however, this stipulation does not extend to any of the above-identified grounds that are not instituted by the PTAB.

This stipulation is not intended and should not be construed to limit Align's ability to assert invalidity of the asserted claims of the '221 patent in this case on any other ground regardless of whether *inter partes* review is instituted.

¹ RE'221 patent claims 20–28, 30, 31, and 40–42 depend from claim 1, which was canceled in IPR2018-00197. Claims 29, 32, and 43 depend from claim 19, which was canceled in IPR2018-00197. Claims 1 and 19 are not *directly* challenged since they are canceled, but features of claims 1 and 19 are addressed in substance as the challenged claims incorporate their features.

Dated: December 16, 2021

By: */s/ Faye Paul Teller*

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on all counsel of record via the Court's ECF system.

/s/ Faye Paul Teller

Faye Paul Teller