

JOSH A. KREVITT (SBN 208552)
jkrevitt@gibsondunn.com
ANDREW ROBB (SBN 291438)
arobb@gibsondunn.com
GIBSON, DUNN & CRUTCHER LLP
310 University Avenue
Palo Alto, CA 94301
Telephone: 650.849.5300
Facsimile: 650.849.5333

CHARLOTTE JACOBSEN (*pro hac vice*)
cjacobsen@gibsondunn.com
GIBSON, DUNN & CRUTCHER LLP
200 Park Avenue
New York, NY 10166-0193
Telephone: 212.351.3961
Facsimile: 212.716.0781

JAYSEN S. CHUNG (SBN 280708)
jschung@gibsondunn.com
GIBSON, DUNN & CRUTCHER LLP
One Embarcadero Center, Suite 2600
San Francisco, CA 94111-3715
Telephone: 415.393.8200
Facsimile: 415.393.8306

Attorneys for Plaintiff
DENTAL MONITORING SAS

Renée E. Rothauge (SBA 271239)
RRothauge@perkinscoie.com
PERKINS COIE LLP
505 Howard Street, Suite 1000
San Francisco, CA 94105
T: (415) 344-7000 / F: (415) 344-7050

Hari Santhanam (*pro hac vice*)
HSanthanam@perkinscoie.com
PERKINS COIE LLP
110 North Wacker Drive, Suite 3400
Chicago, IL 60606
T: (312) 324-8400 / F: (312) 324-9400

John Gray (*pro hac vice*)
JHGray@perkinscoie.com
PERKINS COIE LLP
2525 E. Camelback Road, Suite 500
Phoenix, AZ 85016-4227
T: (602) 351-8000 / F: (602) 648-7000

Sarah Fowler (SBA 264838)
SFowler@perkinscoie.com
PERKINS COIE LLP
3150 Porter Drive
Palo Alto, CA 94304
T: (650) 838-4300 / F: (650) 838-4350

Attorneys for Defendant
ALIGN TECHNOLOGY, INC.

**UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION**

Dental Monitoring SAS,
Plaintiff/Counterclaim
Defendant,

v.

Align Technology, Inc.,
Defendant/Counterclaim
Plaintiff.

CASE NO. 3:22-cv-07335-WHA

**JOINT STIPULATION TO ENTRY OF
FINAL JUDGMENT CONCERNING
CLAIMS 1 AND 14 OF U.S. PATENT NO.
11,049,248 AND CLAIMS 1, 7, AND 12
OF U.S. PATENT NO. 10,755,409**

ALIGN - EXHIBIT 1050

Align Technology, Inc. v. Dental Monitoring SAS - IPR2024-00052

1 Pursuant to Federal Rule of Civil Procedure 58, Plaintiff Dental Monitoring SAS (“Dental
2 Monitoring”) and Defendant Align Technology, Inc. (“Align”) (collectively, “the parties”), by and
3 through their respective undersigned counsel of record, and subject to the approval of the Court,
4 hereby stipulate and agree to entry of final judgment as follows:

5 WHEREAS, Dental Monitoring has asserted that Align infringes claims 1, 2, 4, 7, 13, and 14
6 of U.S. Patent No. 11,049,248 (“’248 patent”) and claims 1, 7, 12, 14, and 15 of U.S. Patent Nos.
7 10,755,409 (“’409 patent”);

8 WHEREAS, pursuant to the Court’s Patent Showdown Scheduling Order (Dkt. 56), Dental
9 Monitoring selected claim 14 of the ’248 patent (which depends from independent claim 1) as its
10 “Showdown Claim” and Align selected claim 12 of the ’409 patent (which depends from independent
11 claim 1) as its “Showdown Claim,” and the parties conducted fact and expert discovery and briefed
12 summary judgment motions on certain issues relating to those two Showdown Claims;

13 WHEREAS, after hearing argument on the parties’ summary judgment motions (Dkt. 130),
14 the Court entered a Showdown Order holding that both Showdown Claims and their corresponding
15 independent claims are not patent-eligible under 35 U.S.C. § 101 (Dkt. 151 at 15);

16 WHEREAS, after the Court’s Showdown Order, only dependent claims 2, 4, 7, and 13 of the
17 ’248 patent and dependent claims 7, 14, and 15 of the ’409 patent remain unadjudicated and still
18 asserted in this case;

19 WHEREAS, although Dental Monitoring respectfully disagrees with the Court’s Showdown
20 Order, and further respectfully disagrees that the Showdown Claims are representative of the
21 remaining unadjudicated and still-asserted claims of the ’248 and ’409 patents, so that the Court may
22 enter an appealable final judgment, (1) Dental Monitoring agrees to voluntarily withdraw its
23 allegations of infringement by Align of claims 2, 4, 7, and 13 of the ’248 patent and claims 14 and 15
24 of the ’409 patent, and dismisses those particular claims of the two patents from the above-captioned
25 matter without prejudice, except that Dental Monitoring may reassert those claims against Align only
26 in this case in the event that the U.S. Court of Appeals for the Federal Circuit reverses or vacates the
27 judgment entered by this Court and remands for further proceedings; and (2) the parties agree that
28 claim 7 of the ’409 patent is not patent-eligible under the Court’s reasoning in the Showdown Order

1 with respect to claims 1 and 12 of the '409 patent and the "creation" and "training" limitations of
2 claim 14 of the '248 patent (*see, e.g.*, Dkt. 151 at 8–9, 12–13);

3 WHEREAS, for the reasons stated in the Court's Showdown Order and in the preceding
4 paragraph of this joint stipulation, Align seeks entry of final judgment of patent ineligibility as to
5 claims 1 and 14 of the '248 patent and claims 1, 7, and 12 of the '409 patent, pursuant to its Fifth and
6 Sixth Defenses and Fourth and Fifth Counterclaims for invalidity of the '248 and '409 patents (Dkt.
7 54 at 11-13, 53-54), to bring this case to a close and to that end agrees to dismiss each of its other
8 counterclaims without prejudice;

9 NOW, THEREFORE, the parties hereby jointly stipulate and agree, subject to the approval of
10 the Court, the following:

- 11 1. Under the Court's Showdown Order, and for the reasons stated in this joint stipulation,
12 Align is entitled to judgment of patent ineligibility as to claims 1 and 14 of the '248 patent
13 and claims 1, 7, and 12 of the '409 patent, pursuant to Align's Fifth and Sixth Defenses
14 and Fourth and Fifth Counterclaims for invalidity of the '248 and '409 patents;
- 15 2. For the reasons stated in this joint stipulation, Dental Monitoring voluntarily withdraws its
16 allegations of infringement by Align of claims 2, 4, 7, and 13 of the '248 patent and claims
17 14 and 15 of the '409 patent, and dismisses those particular claims of the two patents from
18 the above-captioned matter without prejudice, except that Dental Monitoring may reassert
19 those claims against Align only in this case in the event that the U.S. Court of Appeals for
20 the Federal Circuit reverses or vacates the judgment entered by this Court and remands for
21 further proceedings;
- 22 3. Align's other counterclaims against Dental Monitoring shall be dismissed without
23 prejudice; and
- 24 4. Each party shall bear its own costs of suit in this matter.

25 WHEREFORE, the parties respectfully request that the Court enter Final Judgment on the
26 terms in the attached Proposed Order.
27
28

1 **IT IS SO STIPULATED.**

2 Dated: July 26, 2024

 Respectfully submitted,

3
4 /s/ Charlotte Jacobsen

5 JOSH A. KREVITT (SBN 208552)

6 jkrevitt@gibsondunn.com

7 ANDREW ROBB (SBN 291438)

8 arobb@gibsondunn.com

9 **GIBSON, DUNN & CRUTCHER LLP**

10 310 University Avenue

11 Palo Alto, CA 94301

12 Telephone: 650.849.5300

13 Facsimile: 650.849.5333

14 CHARLOTTE JACOBSEN (*pro hac vice*)

15 cjacobsen@gibsondunn.com

16 **GIBSON, DUNN & CRUTCHER LLP**

17 200 Park Avenue

18 New York, NY 10166-0193

19 Telephone: 212.351.3961

20 Facsimile: 212.716.0781

21 JAYSEN S. CHUNG (SBN 280708)

22 jschung@gibsondunn.com

23 WILLIAM FELDMAN (SBN 339008)

24 wfeldman@gibsondunn.com

25 **GIBSON, DUNN & CRUTCHER LLP**

26 One Embarcadero Center, Suite 2600

27 San Francisco, CA 94111-3715

28 Telephone: 415.393.8200

 Facsimile: 415.393.8306

 Y. AUDREY YANG (*pro hac vice*)

 ayang@gibsondunn.com

GIBSON, DUNN & CRUTCHER LLP

 2001 Ross Avenue

 Dallas, TX 75201 Telephone: 214.698.3215

 Facsimile: 214.571.2915

 NOAHLANI LITWINSELLA (SBN 349942)

 nlitwinsella@gibsondunn.com

GIBSON, DUNN & CRUTCHER LLP

 1801 California St., Suite 4200

 Denver, CO 80202 Telephone: 303.298.5715

 Facsimile: 303.313.2885

 Attorneys for Plaintiff

 DENTAL MONITORING SAS

/s/ Hari Santhanam

 Renée E. Rothauge (SBA 271239)

 RRothauge@perkinscoie.com

PERKINS COIE LLP

 505 Howard Street, Suite 1000

 San Francisco, CA 94105

 T: (415) 344-7000 / F: (415) 344-7050

 Hari Santhanam (*pro hac vice*)

 HSanthanam@perkinscoie.com

PERKINS COIE LLP

 110 North Wacker Drive, Suite 3400

 Chicago, IL 60606

 T: (312) 324-8400 / F: (312) 324-9400

 John Gray (*pro hac vice*)

 JHGray@perkinscoie.com

PERKINS COIE LLP

 2525 E. Camelback Road, Suite 500

 Phoenix, AZ 85016-4227

 T: (602) 351-8000 / F: (602) 648-7000

 Sarah Fowler (SBA 264838)

 SFowler@perkinscoie.com

 Moeka Takagi (SBA 33326)

 MTakagi@perkinscoie.com

PERKINS COIE LLP

 3150 Porter Drive

 Palo Alto, CA 94304

 T: (650) 838-4300 / F: (650) 838-4350

 Jon Carter (*pro hac vice*)

 JCarter@perkinscoie.com

PERKINS COIE LLP

 1155 Avenue of the Americas

 New York, NY 10036

 T: (212) 262-6900 / F: (202) 977-1649

 Maria Stubbings (*pro hac vice*)

 MStubbings@perkinscoie.com

PERKINS COIE LLP

 700 13th Street, NW, Suite 800

 Washington, DC 20005

 T: (202) 654-6200 / F: (202) 654-6211

 Kaitlin Dryden (*pro hac vice*)

 KDryden@perkinscoie.com

PERKINS COIE LLP

 33 East Main Street, Suite 201

 Madison, WI 53703

T: (608) 663-7460 / F: (608) 663-7499

Attorneys for Defendant
ALIGN TECHNOLOGY, INC.

1 **ATTESTATION**

2 Pursuant to Civil Local Rule 5-1(h)(3), I hereby attest that all signatories to this document
3 concur in its filing.

4 /s/ Charlotte Jacobsen
5 Charlotte Jacobsen
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1 **~~PROPOSED~~ ORDER**

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3 **FINAL JUDGMENT**

4 The Court's Showdown Order held that four of the asserted claims are not patent-eligible
5 under 35 U.S.C. § 101: dependent claim 14 and its corresponding independent claim 1 of U.S. Patent
6 No. 11,049,248 ("248 patent") and dependent claim 12 and its corresponding independent claim 1 of
7 U.S. Patent No. 10,755,409 ("409 patent"). Dkt. 151 at 15. Plaintiff Dental Monitoring SAS
8 ("Dental Monitoring") and Defendant Align Technology, Inc. ("Align") have stipulated that:

- 9 1. Dental Monitoring voluntarily withdraws its allegations of infringement by Align of
10 claims 2, 4, 7, and 13 of the '248 patent and claims 14 and 15 of the '409 patent, and
11 dismisses those particular claims of the two patents from the above-captioned matter
12 without prejudice, except that Dental Monitoring may reassert those claims against Align
13 only in this case in the event that the U.S. Court of Appeals for the Federal Circuit reverses
14 or vacates the judgment entered by this Court and remands for further proceedings;
- 15 2. Under the Court's reasoning in the Showdown Order with respect to claims 1 and 12 of
16 the '409 patent and the "creation" and "training" limitations of claim 14 of the '248 patent,
17 claim 7 of the '409 patent is not patent-eligible under 35 U.S.C. § 101;
- 18 3. Under the Court's reasoning in the Showdown Order, Align is entitled to judgment that
19 claims 1 and 14 of the '248 patent and claims 1, 7, and 12 of the '409 patent are not patent-
20 eligible under 35 U.S.C. § 101, pursuant to Align's Fifth and Sixth Defenses and Fourth
21 and Fifth Counterclaims for invalidity of the '409 and '248 patents (Dkt. 54 at 11-13, 53-
22 54);
- 23 4. Align's other counterclaims against Dental Monitoring shall be dismissed without
24 prejudice; and
- 25 5. Each party shall bear its own costs of suit in this matter.

26 Accordingly, pursuant to Federal Rule of Civil Procedure 58, the Court enters Judgment as
27 follows:

28 Claims 1 and 14 of the '248 patent and claims 1, 7, and 12 of the '409 patent are not patent-

1 eligible under 35 U.S.C. § 101, pursuant to Align's Fifth and Sixth Defenses and Fourth and Fifth
2 Counterclaims for invalidity of the '409 and '248 patents;

3 Dental Monitoring shall take nothing from Align with respect to claims 1 and 14 of the '248
4 patent and claims 1, 7, and 12 of the '409 patent;

5 Dental Monitoring's allegations of infringement by Align of claims 2, 4, 7, and 13 of the '248
6 patent and claims 14 and 15 of the '409 patent are dismissed without prejudice, except that Dental
7 Monitoring may reassert those claims against Align only in this case in the event that the U.S. Court
8 of Appeals for the Federal Circuit reverses or vacates the judgment entered by this Court and remands
9 for further proceedings;

10 Align's other counterclaims are dismissed without prejudice; and

11 Each party shall bear its own costs of suit in this matter.

12
13 **IT IS SO ORDERED.**

14 Dated: August 8, 2024



THE HONORABLE WILLIAM H. ALSUP
UNITED STATES DISTRICT JUDGE