

**UNITED STATES DISTRICT
COURT FOR THE NORTHERN
DISTRICT OF GEORGIA**

3SHAPE A/S

Plaintiff,

vs.

CARESTREAM DENTAL, LLC,
DENTAL IMAGING
TECHNOLOGIES CORP., and
DENTAL IMAGING
TECHNOLOGIES CORP. d/b/a DEXIS
Defendants.

Civil Action No: 1:22-cv-
01829-WMR

JURY TRIAL
DEMANDED

**DEFENDANT DENTAL IMAGING TECHNOLOGIES
CORP.’S ANSWER TO PLAINTIFF’S SECOND
AMENDED COMPLAINT, DEFENSES, AND
COUNTERCLAIMS**

Defendants Dental Imaging Technologies Corp. and Dental Imaging Technologies Corp. d/b/a DEXIS (collectively “DITC”), by and through its undersigned attorneys, respectfully submits its Answer and Defenses to 3Shape A/S’s (“3Shape”) Second Amended Complaint, and Counterclaims as follows:

ANSWER TO THE SECOND AMENDED COMPLAINT

THE PARTIES

1. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 1, and therefore denies them.

2. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 2, and therefore denies them.

3. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 3, and therefore denies them.

4. Denied.

5. Denied.

6. Responding to the allegations in paragraph 6, DITC admits that it is a corporation, incorporated in California, with a principal place of business at 450 Commerce Drive, Quakertown, PA 18951. DITC denies all remaining allegations in this paragraph.

7. Responding to the allegations in paragraph 7, DITC admits that it entered into a stock and asset purchase agreement (the “Purchase Agreement”) with Carestream in which DITC agreed to purchase Carestream’s intraoral scanner business. Furthermore, DITC admits that it acquired certain assets of Carestream’s intraoral scanner business. DITC also admits that DITC makes, uses, sells, offers for sale, and/or imports in the United States certain intraoral scanner products previously produced and distributed by Carestream. DITC denies that any of the products that it makes, uses, sells, and/or offers for sale in the United States infringes any patents at issue in this litigation. DITC

denies all remaining allegations in this paragraph.

8. Responding to the allegations in paragraph 8, DITC admits that it does business under the DEXIS brand. DITC further admits that it previously did business as Imaging Sciences International, Inc., Gendex Corp., and Instrumentarium Dental, Inc. DITC denies all remaining allegations in this paragraph.

JURISDICTION AND VENUE

9. Responding to the allegations in paragraph 9, DITC admits that 3Shape's allegations in its Second Amended Complaint purportedly arise under the patent laws of the United States. DITC denies all remaining allegations in this paragraph.

10. Responding to the allegations in paragraph 10, DITC admits that this Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a), but denies that DITC has infringed any of 3Shape's Asserted Patents or rights of 3Shape and further denies that 3Shape is entitled to any form of recovery from DITC. DITC denies all remaining allegations in this paragraph.

11. Responding to the allegations in paragraph 11, DITC denies that Carestream has, directly or indirectly, committed or continues to commit patent infringement giving rise to this action in this District, in Georgia, or

otherwise. Paragraph 11 includes legal conclusions to which no response is required, and on that basis DITC denies them. DITC lacks sufficient knowledge or information to form a belief as to the truth of the remainder of the allegations in paragraph 11, and therefore denies them.

12. Responding to the allegations in paragraph 12, on information and belief, DITC admits that Carestream conducts business in Georgia. Paragraph 12 includes legal conclusions to which no response is required, and on that basis DITC denies them. DITC also denies that Carestream has ever placed or continues to place “infringing products” into the stream of commerce. DITC lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations in paragraph 12, and therefore denies them.

13. Responding to the allegations in paragraph 13, DITC denies that Carestream has ever derived revenue from the sale of “infringing products,” and therefore denies that Carestream has ever knowingly induced, or continues to knowingly induce, any infringement of the Asserted Patents within Georgia. DITC lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations in paragraph 13, and therefore denies them.

14. Responding to the allegations in paragraph 14, DITC denies that

Carestream has ever engaged in “infringing activity.” DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 14, and therefore denies them.

15. Responding to the allegations in paragraph 15, DITC admits that this Court has personal jurisdiction over DITC for the purposes of this specific action. However, DITC denies that it has ever, directly or indirectly, committed acts of infringement in this District and further denies that it has ever made, used, sold, offered to sell, and/or imported infringing products. DITC denies all remaining allegations in this paragraph.

16. Responding to the allegations in paragraph 16, DITC admits that it has conducted business in in this District for the purposes of this specific action. However, DITC denies that it has ever, directly or indirectly, committed acts of infringement in this District and further denies that it has ever made, used, sold, offered to sell, advertised and/or imported infringing products. DITC also denies that it has ever placed or continues to place any infringing products into the stream of commerce, via an established distribution channel, with the knowledge and/or understanding that such products are sold in the United States, including in Georgia and/or this District. DITC denies any remaining allegations in this paragraph.

17. DITC denies the allegations in paragraph 17 in their entirety. Specifically, DITC denies that it has ever derived revenue from the sale of infringing products distributed within Georgia and further denies that DITC has ever knowingly induced, or continues to knowingly induce, any infringement of the Asserted Patents within Georgia.

18. DITC denies the allegations in paragraph 18 in their entirety. Specifically, DITC denies that it has ever participated in infringing activity.

19. Responding to the allegations in paragraph 19, DITC admits that venue in this judicial district is permissible under 28 U.S.C. § 1391 and 28 U.S.C. § 1400(b) for this specific action. DITC denies all remaining allegations in this paragraph.

20. Responding to the allegations in paragraph 20, DITC denies that Carestream has committed acts of infringement. DITC lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations in paragraph 20, and therefore denies them.

21. Responding to the allegations in paragraph 21, DITC admits that it has transacted business and has a regular and established business in this District, thus making venue permissible for this specific action. DITC denies that it has ever committed acts of infringement. DITC denies all remaining

allegations in this paragraph.

22. Responding to the allegations in paragraph 22, DITC admits that it does business as DEXIS (“DEXIS”). DITC further admits that DEXIS has a place of business in this District at 4425 Alexander Drive #100, Alpharetta, Georgia, 30022. DITC denies that DITC or DEXIS has ever participated in any directly or indirectly infringing activity. DITC denies all remaining allegations in this paragraph.

23. Responding to the allegations in paragraph 23, DITC admits that DEXIS sells certain products through third party dealers located in Georgia, including Atlanta Dental Supply Co. located at 1560 Satellite Boulevard, Duluth, Georgia, 30097 and R&F Imaging Systems, Inc. located at 549 Webb Industrial Drive, Marietta, Georgia, 30062. DITC denies that it has participated in any directly or indirectly infringing activity. DITC denies all remaining allegations in paragraph 23.

24. Responding to the allegations in paragraph 24, DITC admits that certain former employees of Carestream who reside within this District are now under the employment of DITC in which the employees perform various duties. DITC denies that it has ever participated in any directly or indirectly infringing activity. DITC denies all remaining allegations in paragraph 24.

25. Responding to the allegations in paragraph 25, DITC admits that certain employees are contracted to help sell various products within Georgia and this District for DEXIS. DITC denies all remaining allegations in paragraph 25.

26. Responding to the allegations in paragraph 26, DITC admits that DEXIS contracts with one or more employees in this District whose job title is “Manager.” DITC further admits that paragraph 26 contains a website URL that purportedly links to a job description for “Inside Sales Manager” which states that the Inside Sales organization “has a charter to accelerate...footprint in the dental equipment sales and DTX Software.” DITC denies all remaining allegations in paragraph 26.

27. Responding to the allegations in paragraph 27, DITC admits that it has contracted certain employees who resides in the District to operate as a “Sales Executive – Equipment” for DEXIS. DITC denies all remaining allegations in paragraph 27.

28. Responding to the allegations in paragraph 28, DITC admits that venue is permissible under 28 U.S.C. § 1404(a) for this specific action. DITC denies all remaining allegations in paragraph 28.

29. Responding to the allegations in paragraph 29, DITC admits that

this case was transferred from the Western District of Texas, where this action was originally filed, to the Northern District of Georgia on May 4, 2022. DITC denies all remaining allegations in paragraph 29.

30. Responding to the allegations in paragraph 30, DITC admits that venue is permissible by way of consent for this specific action. DITC denies that it or Carestream is liable for any infringement of 3Shape's asserted patents. DITC denies all remaining allegations of paragraph 30.

3SHAPE'S ASSERTED PATENTS

31. Responding to the allegations in paragraph 31, DITC admits that U.S. Patent No. RE48,211 ("the '211 patent"), on the face of the document, bears an issue date of September 22, 2020 and identifies the following inventors: Henrik Öjelund, David Fischer, and Karl-Josef Hollenbeck. DITC denies all remaining allegations in this paragraph.

32. Responding to the allegations in paragraph 32, DITC admits that Exhibit A purports to be a copy of the '221 patent, which bears the title "System with 3D user interface integration." DITC further admits that Reel/Frame 03124/0837 purports to be an assignment of the '221 patent to 3Shape and that the '221 patent lists 3Shape as an assignee. DITC lacks sufficient knowledge or information to form a belief as to the truth of the

remaining allegations in paragraph 32, and therefore denies them.

33. Responding to the allegations in paragraph 33, DITC admits that U.S. Patent No. 10,695,151 (“the ’151 patent”), on the face of the document, bears an issue date of June 30, 2020 and identifies the following inventors: Bo Esbech, Rune Fisker, Lars Henriksen, and Tais Clausen. DITC denies all remaining allegations in this paragraph.

34. Responding to the allegations in paragraph 32, DITC admits that Exhibit B purports to be a copy of the ’151 patent, which bears the title “Detecting Tooth Shade.” DITC further admits that Reel/Frame 044834/0161 purports to be an assignment of the ’151 patent to 3Shape and that the ’151 patent lists 3Shape as an assignee. DITC lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations in paragraph 34, and therefore denies them.

35. Responding to the allegations in paragraph 35, DITC admits that U.S. Patent No. 11,076,146 (“the ’146 patent”), on the face of the document, bears an issue date of July 27, 2021. DITC admits that Exhibit C purports to be a copy of the ’146 patent, which bears the title “Focus Scanning Apparatus.” DITC further admits that Reel/Frame 055651/0277 purports to be an assignment of the ’146 patent to 3Shape and that the ’146 patent lists 3Shape

as an assignee. DITC lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations in paragraph 35, and therefore denies them.

36. Responding to the allegations in paragraph 36, DITC admits that U.S. Patent No. 11,368,667 (“the ’667 patent”), on the face of the document, bears an issue date of June 21, 2022. DITC admits that Exhibit D purports to be a copy of the ’667 patent, which bears the title “Intraoral Scanning Apparatus.” DITC further admits that Reel/Frame 058193/0461 purports to be an assignment of the ’667 patent to 3Shape and that the ’667 patent lists 3Shape as an assignee. DITC lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations in paragraph 35, and therefore denies them.

BACKGROUND

37. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 37, and therefore denies them.

38. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 38, and therefore denies them.

39. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 39, and therefore denies them.

40. Responding to the allegations in paragraph 40, DITC admits that it designs, develops, manufactures, and markets certain CS Scanners, including the CS 3800, CS 3700, and CS 3600 intraoral scanners, as well as Dexis IS ScanFlow (formerly CS ScanFlow) and CS Model+ software. DITC admits that it distributes certain CS software with certain intraoral scanners. DITC lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations in paragraph 40, and therefore denies them.

41. Responding to the allegations in paragraph 41, DITC denies that its Accused Products infringe 3Shape's asserted patents. DITC admits that it had knowledge of the litigation between 3Shape and Carestream when it acquired Carestream's dental oral scanner business. DITC lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations in paragraph 41, and therefore denies them.

42. Responding to the allegations in paragraph 42, DITC admits that Exhibit D purportedly appears to be an email between Carestream and 3Shape. DITC lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations in paragraph 42, and therefore denies them.

43. Responding to the allegations in paragraph 43, DITC admits that DITC agreed to purchase certain assets of Carestream's intraoral scanner

business via the Purchase Agreement. DITC denies any remaining allegations in this paragraph.

44. Responding to the allegations in paragraph 44, DITC denies any and all allegations of infringement, direct or indirect, related to the Accused Products. DITC admits that it acquired Carestream's intraoral scanner business. DITC denies any remaining allegations in this paragraph.

COUNT I
(Infringement of U.S. Patent No. RE48,211)

45. Responding to the allegations in paragraph 45, DITC incorporates by reference its answers to Paragraphs 1-44 above as if fully set forth herein.

46. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 46, and therefore denies them.

47. DITC denies the allegations in paragraph 47 in their entirety.

48. DITC denies the allegations in paragraph 48 in their entirety.

49. DITC denies the allegations in paragraph 49 in their entirety.

50. DITC denies the allegations in paragraph 50 in their entirety.

51. DITC denies the allegations in paragraph 51 in their entirety.

52. Responding to the allegations in paragraph 52, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should

be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

53. Responding to the allegations in paragraph 53, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

54. Responding to the allegations in paragraph 54, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further

denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

55. Responding to the allegations in paragraph 55, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

56. Responding to the allegations in paragraph 56, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

57. Responding to the allegations in paragraph 57, DITC responds

that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

58. DITC denies the allegations in paragraph 58 in their entirety.

59. Responding to the allegations in paragraph 59, DITC admits that it had knowledge of the '221 patent on the date DITC was served with a copy of the Complaint and Exhibits. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

60. DITC denies the allegations in paragraph 60 in their entirety.

61. DITC denies the allegations in paragraph 61 in their entirety.

62. DITC denies the allegations in paragraph 62 in their entirety.

63. DITC denies the allegations in paragraph 63 in their entirety.

64. DITC denies the allegations in paragraph 64 in their entirety.

65. DITC denies the allegations in paragraph 65 in their entirety.

66. DITC denies the allegations in paragraph 66 in their entirety.

67. DITC denies the allegations in paragraph 67 in their entirety.

68. DITC denies the allegations in paragraph 68 in their entirety.

69. DITC denies the allegations in paragraph 69 in their entirety.

COUNT II
(Infringement of U.S. Patent No. 10,695,151)

70. Responding to the allegations in paragraph 70, DITC incorporates by reference its answers to Paragraphs 1-69 above as if fully set forth herein.

71. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 71, and therefore denies them.

72. DITC denies the allegations in paragraph 72 in their entirety.

73. DITC denies the allegations in paragraph 73 in their entirety.

74. DITC denies the allegations in paragraph 74 in their entirety.

75. DITC denies the allegations in paragraph 75 in their entirety.

76. DITC denies the allegations in paragraph 76 in their entirety.

77. Responding to the allegations in paragraph 77, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

78. Responding to the allegations in paragraph 78, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

79. Responding to the allegations in paragraph 79, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

80. Responding to the allegations in paragraph 80, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

81. DITC denies the allegations in paragraph 81 in their entirety.

82. Responding to the allegations in paragraph 82, DITC admits that it had knowledge of the '151 patent on the date DITC was served with a copy of the Complaint and Exhibits. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

83. DITC denies the allegations in paragraph 83 in their entirety.

84. DITC denies the allegations in paragraph 84 in their entirety.

85. DITC denies the allegations in paragraph 85 in their entirety.

86. DITC denies the allegations in paragraph 86 in their entirety.

87. DITC denies the allegations in paragraph 87 in their entirety.

88. DITC denies the allegations in paragraph 88 in their entirety.

89. DITC denies the allegations in paragraph 89 in their entirety.

90. DITC denies the allegations in paragraph 90 in their entirety.

91. DITC denies the allegations in paragraph 91 in their entirety.

92. DITC denies the allegations in paragraph 92 in their entirety.

COUNT III
(Infringement of U.S. Patent No. 11,076,146)

93. Responding to the allegations in paragraph 93, DITC incorporates by reference its answers to Paragraphs 1-92 above as if fully set forth herein.

94. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 94, and therefore denies them.

95. DITC denies the allegations in paragraph 95 in their entirety.

96. DITC denies the allegations in paragraph 96 in their entirety.

97. DITC denies the allegations in paragraph 97 in their entirety.

98. DITC denies the allegations in paragraph 98 in their entirety.

99. DITC denies the allegations in paragraph 99 in their entirety.

100. Responding to the allegations in paragraph 100, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the

snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

101. Responding to the allegations in paragraph 101, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

102. Responding to the allegations in paragraph 102, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

103. Responding to the allegations in paragraph 103, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

104. DITC denies the allegations in paragraph 104 in their entirety.

105. Responding to the allegations in paragraph 105, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

106. Responding to the allegations in paragraph 106, DITC responds

that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

107. Responding to the allegations in paragraph 107, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

108. Responding to the allegations in paragraph 108, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the

snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

109. Responding to the allegations in paragraph 109, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

110. Responding to the allegations in paragraph 110, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

111. Responding to the allegations in paragraph 111, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

112. DITC denies the allegations in paragraph 112 in their entirety.

113. Responding to the allegations in paragraph 113, DITC admits that it had knowledge of the '146 patent on the date DITC was served with a copy of the Complaint and Exhibits. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

114. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 114, and therefore denies them.

115. DITC denies the allegations in paragraph 115 in their entirety.

116. DITC denies the allegations in paragraph 116 in their entirety.

117. DITC denies the allegations in paragraph 117 in their entirety.

118. DITC denies the allegations in paragraph 118 in their entirety.

119. DITC denies the allegations in paragraph 119 in their entirety.

120. DITC denies the allegations in paragraph 120 in their entirety.

121. Responding to the allegations in paragraph 121, DITC denies participating in any infringing activity related to 3Shape's Asserted Patents. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 121, and therefore denies them.

122. DITC denies the allegations in paragraph 122 in their entirety.

123. DITC denies the allegations in paragraph 123 in their entirety.

124. DITC denies the allegations in paragraph 124 in their entirety.

COUNT IV
(Infringement of U.S. Patent No. 11,368,667)

125. Responding to the allegations in paragraph 125, DITC incorporates by reference its answers to Paragraphs 1-124 above as if fully set forth herein.

126. DITC lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 126, and therefore denies them.

127. DITC denies the allegations in paragraph 127 in their entirety.

128. DITC denies the allegations in paragraph 128 in their entirety.

129. DITC denies the allegations in paragraph 129 in their entirety.

130. DITC denies the allegations in paragraph 130 in their entirety.

131. Responding to the allegations in paragraph 131, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

132. Responding to the allegations in paragraph 132, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

133. Responding to the allegations in paragraph 133, DITC responds

that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

134. Responding to the allegations in paragraph 134, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

135. Responding to the allegations in paragraph 135, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the

snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

136. Responding to the allegations in paragraph 136, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

137. DITC denies the allegations in paragraph 137 in their entirety.

138. Responding to the allegations in paragraph 138, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further

denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

139. Responding to the allegations in paragraph 139, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

140. Responding to the allegations in paragraph 140, DITC responds that the guides, manuals, demonstrations, and/or product documentation cited by 3Shape in its Second Amended Complaint speak for themselves and should be understood in light of the entire context of the information and not in the snippets that 3Shape have identified in this Second Amended Complaint.

DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products.

DITC denies any remaining allegations in this paragraph.

141. DITC denies the allegations in paragraph 141 in their entirety.

142. Responding to the allegations in paragraph 82, DITC admits that it had knowledge of the '667 patent on the date DITC was served with a copy of the Complaint and Exhibits. DITC denies any and all allegations of infringement of any kind and further denies any and all alleged liabilities associated with the Accused Products. DITC denies any remaining allegations in this paragraph.

143. DITC denies the allegations in paragraph 143 in their entirety.

144. DITC denies the allegations in paragraph 144 in their entirety.

145. DITC denies the allegations in paragraph 145 in their entirety.

146. DITC denies the allegations in paragraph 146 in their entirety.

147. DITC denies the allegations in paragraph 147 in their entirety.

148. DITC denies the allegations in paragraph 148 in their entirety.

149. DITC denies the allegations in paragraph 149 in their entirety.

150. DITC denies the allegations in paragraph 150 in their entirety.

151. DITC denies the allegations in paragraph 151 in their entirety.

RESPONSE TO 3SHAPE'S PRAYER FOR RELIEF

To the extent that a response to 3Shape's Prayer for Relief is appropriate, DITC denies that 3Shape is intitled to any requested relief.

AFFIRMATIVE DEFENSES

Pursuant to FRCP Rule 8(b) and (c), DITC alleges and asserts the following defenses in response to the allegations in 3Shape's Second Amended Complaint. DITC reserves the right to rely on any other defense that may become available or known throughout the course of discovery in this case, and reserves the right to amend this Answer to assert any such defense. Assertion of a defense is not a concession that DITC has the burden of proving the matter asserted.

FIRST DEFENSE **(Noninfringement)**

1. 3Shape's claims are barred, in whole or in part, because DITC does not infringe and has not infringed, directly or indirectly, literally or under the doctrine of equivalents, any valid and enforceable claim of the Patents-in-Suit as required by 35 U.S.C. § 271.

SECOND DEFENSE **(Invalidity)**

2. Each asserted claim of the Patents-in-Suit is invalid for failure to comply with one or more of the requirements of Title 35, United States Code, including, without limitation, 35 U.S.C. §§ 101, 102, 103, 112, and/or 116, the non-statutory doctrine of double patenting, incorrect inventorship, and the rules, regulations, and laws pertaining thereto.

THIRD DEFENSE
(Limitation on Damages)

3. 3Shape's claims for damages are statutorily limited by 35 U.S.C. § 286.

FOURTH DEFENSE
(No Enhanced Damages)

4. In the event DITC was found to infringe any valid, enforceable claim of 3Shape's Asserted Patents, 3Shape is precluded from recovering increased or enhanced damages under 35 U.S.C. § 284.

FIFTH DEFENSE
(No Willfulness)

5. In the event DITC was found to infringe any valid, enforceable claim of 3Shape's Asserted Patents, such infringement was not willful.

SIXTH DEFENSE
(No Attorneys' Fees)

6. 3Shape is precluded from recovering its reasonable attorneys' fees and/or costs under 35 U.S.C. § 285.

SEVENTH DEFENSE
(No Costs)

7. 3Shape is precluded from recovering costs associated with this action under 35 U.S.C. § 288.

EIGHTH DEFENSE
(No Injunctive Relief)

8. 3Shape is not entitled to any injunctive relief under any theory because of, but not limited to, the following reasons: (1) any alleged injury to 3Shape is not immediate or irreparable; (2) in the unlikely event 3Shape prevails, 3Shape has an adequate remedy at law; and/or (3) public policy concerns weigh against any injunctive relief.

NINTH DEFENSE
(Waiver, Estoppel, Unclean Hands)

9. 3Shape's attempted enforcement of 3Shape's Asserted Patents against DITC is barred by one or more of the equitable doctrines of waiver, estoppel, and unclean hands.

TENTH DEFENSE
(Prosecution History Estoppel)

10. 3Shape is estopped from construing any valid claim of 3Shape's Asserted Patents to cover or include, either literally or by application of the doctrine of equivalents, any product or service made, used, sold, offered for sale or imported by DITC because of admissions and statements made to the United States Patent and Trademark Office ("PTO") during prosecution of the applications leading to the issuance of 3Shape's Asserted Patents.

ELEVENTH DEFENSE
(Patent Misuse)

11. 3Shape's Asserted Patents are unenforceable due to misuse

TWELFTH DEFENSE
(Failure to Mark)

12. To the extent that 3Shape or any predecessors-in-interest to 3Shape's Asserted Patents and any and all licensees of 3Shape's Asserted Patents failed to properly mark any of their relevant products as required by 35 U.S.C. § 287 or otherwise give proper notice that DITC's actions allegedly infringed the Patents-in-Suit, DITC is not liable to 3Shape for the acts alleged to have been performed before receiving actual notice that it was allegedly infringing the Asserted Patents.

THIRTEENTH DEFENSE
(Failure to State a Claim)

13. 3Shape's Complaint fails to state a claim upon which relief can be granted.

FOURTEENTH DEFENSE
(Lack of Standing)

14. 3Shape lacks standing to assert infringement of 3Shape's Asserted Patents because it did not have sufficient rights in those patents at the time the suit was filed.

FIFTEENTH DEFENSE
(Ensnarement)

15. 3Shape have alleged infringement under the doctrine of equivalents. However, 3Shape have not provided detailed pleadings or claim charts properly alleging infringement under the doctrine of equivalents.

16. Ensnarement bars a patentee from asserting a scope of equivalency that would encompass, or “ensnare,” the prior art.

17. If pursued, 3Shape’s claims of infringement under the doctrine of equivalents are barred due to ensnarement because the alleged equivalents would encompass or “ensnare” the prior art as identified in Defendant’s Invalidity Contentions.

COUNTERCLAIMS

In accordance with Rule 13 of the Federal Rules of Civil procedure, Counterclaim Plaintiff Dental Imaging Technologies Corp. (“Counterclaim-Plaintiff” or “DITC”), by and through its undersigned attorneys, alleges as follows:

THE PARTIES

1. Counterclaim-Plaintiff DITC is incorporated in California, with a principal place of business at 450 Commerce Drive, Quakertown, PA 18951. DITC does business as DEXIS.

2. Counterclaim-Defendant 3Shape A/S purports to be a Danish corporation with a principal place of business at Holmens Kanal 7, 1060 Copenhagen K, Denmark.

JURISDICTION AND VENUE

3. DITC's Counterclaims arise under the Declaratory Judgment Act, 28 U.S.C. §§ 2201, *et seq.* and the patent laws of the United States, 35 U.S.C. §§ 1 *et seq.* The Court has subject matter jurisdiction over the claims set forth herein pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202.

4. An actual case or controversy exists between DITC and 3Shape regarding whether DITC has infringed or is infringing, directly or indirectly, one or more valid and enforceable claims of 3Shape's Asserted Patents. DITC denies those allegations. Further, an actual case or controversy exists under the patent laws of the United States because 3Shape infringes and has infringed DITC's U.S. Patent Nos. 11,234,798 (the "'798 patent") and 10,076,391 (the "'391 patent") (collectively, "DITC's Asserted Patents").

5. The Court has personal jurisdiction over 3Shape at least because 3Shape consented to the jurisdiction of this Court by filing the Complaint and consented to the transfer of this action from the U.S. District Court for the Western District of Texas to this Court.

6. Based solely on the filing of this action, venue is proper in this Judicial District under at least 28 U.S.C. §§ 1391(b)-(c) and 1400(b).

7. This Court further has personal jurisdiction over 3Shape because it has, directly and/or through its agents and/or intermediaries, committed acts and continues to commit acts of patent infringement within Georgia giving rise to this action and has established minimum contacts with Georgia such that the exercise of jurisdiction would not offend traditional notions of fair play and substantial justice. 3Shape, directly and indirectly at least through agents and intermediaries, has committed acts of infringement in this District by, among other things, making, using, selling, offering to sell, and importing the TRIOS 3, TRIOS 4, and TRIOS 5 intraoral scanners and associated software made available to 3Shape's customers for storage in memory on those customers' computer hardware components (collectively, the "Accused 3Shape Products").

8. On information and belief, 3Shape regularly conducts business in Georgia, including in this District, and purposefully avails itself of the privileges of

conducting business in Georgia and this District. In particular, on information and belief, 3Shape and/or its agents and/or intermediaries, made, used, imported, offered for sale, sold and/or advertised their products and affiliated services in Georgia and this District, including but not limited to the 3Shape Products, sufficient to give rise to jurisdiction.

9. On information and belief, 3Shape has placed and continued to place, infringing products into the stream of commerce, via an established distribution channel, with the knowledge and/or understanding that such products are sold in the United States, including in Georgia and specifically including in this District.

10. On information and belief, 3Shape derived substantial revenue from the sale of infringing products distributed within Georgia and/or expected or should have reasonably expected its actions to have consequences in Georgia. In addition, on information and belief, 3Shape knowingly induced, and continued to knowingly induce, infringement of DITC's Asserted Patents within Georgia by offering for sale, selling, and/or contracting with others to market infringing products with the intent to facilitate infringing use of the products by others within Georgia and by creating and/or disseminating product information and other materials providing instruction for infringing use.

11. 3Shape's infringing activity has led to foreseeable harm and injury to DITC.

BACKGROUND

12. On October 26, 2021, 3Shape filed its original Complaint in the U.S. District Court for the Western District of Texas in *3Shape A/S v. Carestream Dental LLC*, Case No. 6-21-cv-01110 (W.D. Tex.). The parties jointly filed a motion to transfer that case to this District on May 4, 2022. Case No. 6-21-cv-01110, Dkt. 34. The court granted the motion on May 6, 2022. Case No. 6-21-cv-01110, Dkt. 35.

13. After this case was transferred from the Western District of Texas to this Court, on June 17, 2022, 3Shape filed its First Amended Complaint. Dkt. 82. On June 28, 2022, 3Shape filed its Second Amended alleging infringement by DITC of 3Shape's Asserted Patents. Dkt. 86.

14. On August 29, 2022, DITC filed its partial Motion to Dismiss under Fed. R. Civ. P. 12(b)(6) which states that the '151 Patent is invalid under 35 U.S.C. § 101 for being directed to patent-ineligible subject matter. Dkt. 114. DITC's motion is currently pending before this Court.

15. An actual and justiciable controversy has thus arisen between 3Shape and DITC concerning the alleged infringement, validity, and enforceability of 3Shape's Asserted Patents, and 3Shape's infringement of DITC's Asserted Patents.

3SHAPE'S ASSERTED PATENTS

16. In its Second Amended Complaint, 3Shape alleges that DITC has directly infringed and continues to directly and indirectly infringe, literally and/or under the doctrine of equivalents, at least claim 1 of the '221, '146, and '667 patents and at least claim 14 of the '151 patent by making, using, selling, offering for sale in the United States and/or importing into the United States the Accused Products. DITC denies all of 3Shape's claims of infringement, and contends that it has not and does not infringe the '221, '151, '146, and '667 patents, directly or indirectly, and further contends that the '221, '151, '146, and '667 patents are invalid and unenforceable.

PRIOR ART TO 3SHAPE'S ASSERTED PATENTS

17. On November 7, 2022 DITC served its First Supplemental Preliminary Invalidity Contentions (the "Invalidity Contentions") regarding the claims identified by 3Shape in its Preliminary Infringement Contentions. DITC's Invalidity Contentions pertain to the following claims of 3Shape's Asserted Patents:

Asserted Patent	Asserted Claims
RE48,221	1-3, 5, 9-11, 19-28, 30, 31, 33, and 34
11,076,146	1-6, 8-13, 15, 20-27, and 29
10,695,151	1-3, 6, 7, and 9-17
11,368,667	1-3, 5-8, 12-20, 22, 26-29

18. DITC’s Invalidity Contentions included detailed positions regarding (1) where in the prior art references each element of 3Shape’s Asserted Claims may be found; (2) an identification of any limitations that are indefinite or lack written description under § 112; (3) an identification of the claims that are directed to ineligible subject matter under § 101; and (4) an explanation as to why the asserted claims of the ’221 patent are unenforceable under the doctrine of inequitable conduct.

19. In addition to the charts identifying prior art references to 3Shape’s Asserted Patents respectively, DITC’s Invalidity Contentions also identified prior art apparatuses/systems (“System Prior Art”) that are prior art under pre-AIA 35 U.S.C. § 102(a), (b), and/or (g) and/or AIA 35 U.S.C. § 102(a)(1).

20. As disclosed in DITC’s Invalidity Contentions, the claimed inventions in 3Shape’s Asserted Patents are invalid in view of the extensive prior art, 35

U.S.C. § 101, 35 U.S.C. § 112, the doctrine of inequitable conduct, and the prosecution history of 3Shape's Asserted Patents.

FIRST COUNTERCLAIM
(Declaratory Judgment of Invalidity of U.S. Pat. No. RE48,221)

21. DITC realleges and incorporates by reference the allegations in the Counterclaim Paragraphs 1-20 as if fully set forth herein.

22. 3Shape has asserted that DITC infringes the '221 patent.

23. Based on the filing of this action, an actual controversy has arisen and presently exists between DITC and 3Shape as to the validity of the '221 patent within the meaning of 28 U.S.C. §§ 2201 and 2202.

24. The asserted claims of the '221 patent are invalid and/or unenforceable for failure to comply with the requirements and/or conditions for patentability of one or more of 35 U.S.C. §§ 101, 102, 103, and 112.

25. To resolve the legal and factual questions raised by 3Shape and to afford relief from the uncertainty and controversy from which 3Shape's accusations have precipitated, DITC is entitled to a declaratory judgment that the '221 patent is invalid.

26. A judicial declaration concerning these matters is necessary and appropriate so that DITC can ascertain its rights regarding the '221 patent.

SECOND COUNTERCLAIM
(Declaratory Judgment of Non-Infringement of U.S. Pat. No. RE48,221)

27. DITC realleges and incorporates by reference the allegations in the Counterclaim Paragraphs 1-26 as if fully set forth herein.

28. 3Shape has asserted that DITC infringes the '221 patent.

29. Based on the filing of this action, an actual controversy has arisen and presently exists between the parties as to whether DITC infringes the '221 patent within the meaning of 28 U.S.C. §§ 2201 and 2202.

30. Neither DITC nor its customers directly infringe the asserted claims of the '221 patent at least because the Carestream Products do not practice every element of any valid, enforceable claim of the '221 patent.

31. DITC has not and does not indirectly infringe the '221 patent. DITC does not induce infringement of the '221 patent at least because there is no direct infringement of the '221 patent.

32. In addition, DITC has not and does not induce infringement of the '221 patent at least because DITC lacked any intent to cause the acts alleged by 3Shape and did not know and should not have known that the acts alleged by 3Shape would induce infringement.

33. DITC does not contributorily infringe the '221 patent at least because DITC did not know that any Carestream Product was especially made or adapted for use in a manner that would infringe the '221 patent.

34. DITC further does not contributorily infringe the '221 patent at least because the Accused Products have substantial non-infringing uses.

THIRD COUNTERCLAIM
(Declaratory Judgment of Invalidity of U.S. Pat. No. 11,076,146)

35. DITC realleges and incorporates by reference the allegations in the Counterclaim Paragraphs 1-34 as if fully set forth herein.

36. 3Shape has asserted that DITC infringes the '146 patent.

37. Based on the filing of this action, an actual controversy has arisen and presently exists between DITC and 3Shape as to the validity of the '146 patent within the meaning of 28 U.S.C. §§ 2201 and 2202.

38. The asserted claims of the '146 patent are invalid and/or unenforceable for failure to comply with the requirements and/or conditions for patentability of one or more of 35 U.S.C. §§ 101, 102, 103, and 112.

39. To resolve the legal and factual questions raised by 3Shape and to afford relief from the uncertainty and controversy from which 3Shape's accusations have precipitated, DITC is entitled to a declaratory judgment that the '146 patent is invalid.

40. A judicial declaration concerning these matters is necessary and appropriate so that DITC can ascertain its rights regarding the '146 patent.

FOURTH COUNTERCLAIM
(Declaratory Judgment of Non-Infringement of U.S. Pat. No. 11,076,146)

41. DITC realleges and incorporates by reference the allegations in the Counterclaim Paragraphs 1-40 as if fully set forth herein.

42. 3Shape has asserted that DITC infringes the '146 patent.

43. Based on the filing of this action, an actual controversy has arisen and presently exists between the parties as to whether DITC infringes the '146 patent within the meaning of 28 U.S.C. §§ 2201 and 2202.

44. Neither DITC nor its customers directly infringe the asserted claims of the '146 patent at least because the Carestream Products do not practice every element of any valid, enforceable claim of the '146 patent.

45. DITC has not and does not indirectly infringe the '146 patent. DITC does not induce infringement of the '146 patent at least because there is no direct infringement of the '146 patent.

46. In addition, DITC has not and does not induce infringement of the '146 patent at least because DITC lacked any intent to cause the acts alleged by 3Shape and did not know and should not have known that the acts alleged by 3Shape would induce infringement.

47. DITC does not contributorily infringe the '146 patent at least because DITC did not know that any Carestream Product was especially made or adapted for use in a manner that would infringe the '146 patent.

48. DITC further does not contributorily infringe the '146 patent at least because the Accused Products have substantial non-infringing uses.

FIFTH COUNTERCLAIM
(Declaratory Judgment of Invalidity of U.S. Pat. No. 10,695,151)

49. DITC realleges and incorporates by reference the allegations in the Counterclaim Paragraphs 1-48 as if fully set forth herein.

50. 3Shape has asserted that DITC infringes the '151 patent.

51. Based on the filing of this action, an actual controversy has arisen and presently exists between DITC and 3Shape as to the validity of the '151 patent within the meaning of 28 U.S.C. §§ 2201 and 2202.

52. The asserted claims of the '151 patent are invalid and/or unenforceable for failure to comply with the requirements and/or conditions for patentability of one or more of 35 U.S.C. §§ 101, 102, 103, and 112.

53. To resolve the legal and factual questions raised by 3Shape and to afford relief from the uncertainty and controversy from which 3Shape's accusations have precipitated, DITC is entitled to a declaratory judgment that the '151 patent is invalid.

54. A judicial declaration concerning these matters is necessary and appropriate so that DITC can ascertain its rights regarding the '151 patent.

SIXTH COUNTERCLAIM
(Declaratory Judgment of Non-Infringement of U.S. Pat. No. 10,695,151)

55. DITC realleges and incorporates by reference the allegations in the Counterclaim Paragraphs 1-54 as if fully set forth herein.

56. 3Shape has asserted that DITC infringes the '151 patent.

57. Based on the filing of this action, an actual controversy has arisen and presently exists between the parties as to whether DITC infringes the '151 patent within the meaning of 28 U.S.C. §§ 2201 and 2202.

58. Neither DITC nor its customers directly infringe the asserted claims of the '151 patent at least because the Carestream Products do not practice every element of any valid, enforceable claim of the '151 patent.

59. DITC has not and does not indirectly infringe the '151 patent. DITC does not induce infringement of the '151 patent at least because there is no direct infringement of the '151 patent.

60. In addition, DITC has not and does not induce infringement of the '151 patent at least because DITC lacked any intent to cause the acts alleged by

3Shape and did not know and should not have known that the acts alleged by 3Shape would induce infringement.

61. DITC does not contributorily infringe the '151 patent at least because DITC did not know that any Carestream Product was especially made or adapted for use in a manner that would infringe the '151 patent.

62. DITC further does not contributorily infringe the '151 patent at least because the Accused Products have substantial non-infringing uses.

SEVENTH COUNTERCLAIM
(Declaratory Judgment of Invalidity of U.S. Pat. No. 11,368,667)

63. DITC realleges and incorporates by reference the allegations in the Counterclaim Paragraphs 1-62 as if fully set forth herein.

64. 3Shape has asserted that DITC infringes the '667 patent.

65. Based on the filing of this action, an actual controversy has arisen and presently exists between DITC and 3Shape as to the validity of the '667 patent within the meaning of 28 U.S.C. §§ 2201 and 2202.

66. The asserted claims of the '667 patent are invalid and/or unenforceable for failure to comply with the requirements and/or conditions for patentability of one or more of 35 U.S.C. §§ 101, 102, 103, and 112.

67. To resolve the legal and factual questions raised by 3Shape and to afford relief from the uncertainty and controversy from which 3Shape's

accusations have precipitated, DITC is entitled to a declaratory judgment that the '667 patent is invalid.

68. A judicial declaration concerning these matters is necessary and appropriate so that DITC can ascertain its rights regarding the '667 patent.

EIGHTH COUNTERCLAIM
(Declaratory Judgment of Non-Infringement of U.S. Pat. No. 11,368,667)

69. DITC realleges and incorporates by reference the allegations in the Counterclaim Paragraphs 1-68 as if fully set forth herein.

70. 3Shape has asserted that DITC infringes the '667 patent.

71. Based on the filing of this action, an actual controversy has arisen and presently exists between the parties as to whether DITC infringes the '667 patent within the meaning of 28 U.S.C. §§ 2201 and 2202.

72. Neither DITC nor its customers directly infringe the asserted claims of the '667 patent at least because the Carestream Products do not practice every element of any valid, enforceable claim of the '667 patent.

73. DITC has not and does not indirectly infringe the '667 patent. DITC does not induce infringement of the '667 patent at least because there is no direct infringement of the '667 patent.

74. In addition, DITC has not and does not induce infringement of the '667 patent at least because DITC lacked any intent to cause the acts alleged by 3Shape and did not know and should not have known that the acts alleged by 3Shape would induce infringement.

75. DITC does not contributorily infringe the '667 patent at least because DITC did not know that any Carestream Product was especially made or adapted for use in a manner that would infringe the '667 patent.

76. DITC further does not contributorily infringe the '667 patent at least because the Accused Products have substantial non-infringing uses.

NINTH COUNTERCLAIM
(Infringement of U.S. Patent No. 11,234,798)

77. DITC realleges and incorporates by reference the allegations in the Counterclaim Paragraphs 1-76 as if fully set forth herein.

78. U.S. Patent No. 11,234,798 (the "'798 patent"), entitled "Scanning Sequence for an Intra-Oral Imaging System," was duly and lawfully issued by the USPTO on February 1, 2022. The '798 patent is a continuation of U.S. Patent No. 10,098,713 and claims priority to U.S. Provisional Application No. 61/784,535, which was filed on March 14, 2013. Robert F. Dillon, Craig A. Andreiko, Andrew F. Vesper, Neil H. K. Judell, and Timothy I. Fillion are the named inventors.

DITC is the current owner by assignment of all right, title, and interest in the '798

patent and is entitled to sue for past and future infringement thereof. A true and correct copy of the '798 patent is attached hereto as Exhibit A.

79. On information and belief, 3Shape has directly infringed, continues to infringe, and/or, at least as of the date of filing of this Counterclaim, induces or contributes to the infringement by other of one or more claims of the '798 patent by making, using, selling, offering for sale, and/or importing into the United States, without authority or license, for example, the Accused 3Shape Products in violation of 35 U.S.C. §§ 271(a), (b), and (c). The 3Shape Accused Products are non-limiting examples identified based on publicly available information, and DITC reserves the right to identify additional infringing activities, products, and services on the basis of information obtained, for example, during discovery.

80. 3Shape received actual notice of the '798 patent through at least the filing of this Counterclaim.

81. On information and belief, 3Shape has been and is now directly and indirectly infringing, literally and/or under the doctrine of equivalents, at least claim 1 of the '798 patent.

82. By way of illustration only, a claim chart setting forth exemplary evidence how the TRIOS System meets each element of at least one claim of the '798 patent in violation of 35 U.S.C. § 271(a) is attached as Exhibit C. The

description in the claim chart is based on publicly available information and a reasonable investigation of the structure and operation of the 3Shape Accused Products, and evidences 3Shape's direct and indirect infringement at least by 3Shape's use and/or testing of the 3Shape Accused Products and encouragement of others to use the 3Shape Accused Products in an infringing manner. DITC reserves the right to modify this description, including, for example, on the basis of information about the 3Shape Accused Products that it obtains during discovery.

83. On information and belief, at least as of the filing of this Counterclaim and based on the information set forth herein, 3Shape also actively, knowingly, and intentionally induces infringement of one or more claims of the '798 patent under 35 U.S.C. § 271(b) by actively encouraging others to import, make, use, sell, and/or offer to sell in the United States, the 3Shape Accused Products. 3Shape instructs its customers how to use the 3Shape Accused Products in a way that infringes one or more claims of the '798 patent. For example, on information and belief, 3Shape maintains and operates a YouTube page at the URL <https://www.youtube.com/@3shape>, which includes videos instructing and encouraging its agents, customers and others to operate the Accused 3Shape Products to infringe one or more claims of the '798 patent. Additional evidence

showing how 3Shape instructs and encourages others to infringe one or more claims of the '798 patent can be found in Exhibit C.

84. On information and belief, at least as of the filing of this Counterclaim and based on the information set forth herein, 3Shape further contributes to the infringement of one or more claims of the '798 patent under 35 U.S.C. § 271(c) by offering to sell, selling, and/or importing into the United States a component of the Accused 3Shape Products, or a material or apparatus for use in practicing a process claimed in the '798 patent, that constitutes a material part of the inventions, knowing the same to be especially made or especially adapted for use in an infringement of the '798 patent, and is not a staple article or commodity of commerce suitable for substantial non-infringing use.

85. DITC has complied with the requirements of 35 U.S.C. § 287(a) at least by the previous assignee of the '798 patent,Ormco Corp., providing notice that its products are protected by the '798 patent on its virtual marking website, <https://ormco.com/download/ormco-patents>, and by giving actual notice to 3Shape as of the filing of this Counterclaim.

86. 3Shape's infringement has damaged and continues to damage DITC in an amount yet to be determined, of at least a reasonable royalty and/or the lost profits that DITC would have made but for 3Shape's acts of infringement.

3Shape's acts have caused, and unless restrained and enjoined, will continue to cause, irreparable injury and damage to DITC.

TENTH COUNTERCLAIM
(Infringement of U.S. Patent No. 10,076,391)

87. DITC realleges and incorporates by reference the allegations in the Counterclaim Paragraphs 1-86 as if fully set forth herein.

88. U.S. Patent No. 10,076,391 (the "'391 patent"), entitled "Method and System for Bite Registration," was duly and lawfully issued by the USPTO on September 18, 2018. The '391 patent claims priority to PCT No. PCT/CN2013/072420, which was filed on March 13, 2013. Yannick Glinec, Qinran Chen, and Mo Yufeng are the named inventors. DITC is the current owner by assignment of all right, title, and interest in the '391 patent and is entitled to sue for past and future infringement thereof. A true and correct copy of the '391 patent is attached hereto as Exhibit B.

89. On information and belief, 3Shape has directly infringed, continues to infringe, and/or, at least as of the date of filing of this Counterclaim, induces or contributes to the infringement by other of one or more claims of the '391 patent by making, using, selling, offering for sale, and/or importing into the United States, without authority or license, for example, the Accused 3Shape Products in violation of 35 U.S.C. §§ 271(a), (b), and (c). The Accused 3Shape Products are

non-limiting examples identified based on publicly available information, and DITC reserves the right to identify additional infringing activities, products, and services on the basis of information obtained, for example, during discovery.

90. 3Shape received actual notice of the '391 patent through at least the filing of this Counterclaim.

91. On information and belief, 3Shape has been and is now directly and indirectly infringing, literally and/or under the doctrine of equivalents, at least claim 1 of the '391 patent.

92. By way of illustration only, a claim chart setting forth exemplary evidence how the TRIOS System meets each element of at least one claim of the '391 patent in violation of 35 U.S.C. § 271(a) is attached as Exhibit D. The description in the claim chart is based on publicly available information and a reasonable investigation of the structure and operation of the Accused 3Shape Products, and evidences 3Shape's direct and indirect infringement at least by 3Shape's use and/or testing of the Accused 3Shape Products and encouragement of others to use the Accused 3Shape Products in an infringing manner. DITC reserves the right to modify this description, including, for example, on the basis of information about the Accused 3Shape Products that it obtains during discovery.

93. On information and belief, at least as of the filing of this Counterclaim and based on the information set forth herein, 3Shape also actively, knowingly, and intentionally induces infringement of one or more claims of the '391 patent under 35 U.S.C. § 271(b) by actively encouraging others to import, make, use, sell, and/or offer to sell in the United States, the Accused 3Shape Products. 3Shape instructs its customers how to use the Accused 3Shape Products in a way that infringes one or more claims of the '391 patent. For example, on information and belief, 3Shape maintains and operates a YouTube page at the URL <https://www.youtube.com/@3shape>, which includes videos instructing and encouraging its agents, customers and others to operate the Accused 3Shape Products to infringe one or more claims of the '391 patent. Additional evidence showing how 3Shape instructs and encourages others to infringe one or more claims of the '391 patent can be found in Exhibit D.

94. On information and belief, at least as of the filing of this Counterclaim and based on the information set forth herein, 3Shape further contributes to the infringement of one or more claims of the '391 patent under 35 U.S.C. § 271(c) by offering to sell, selling, and/or importing into the United States a component of the Accused 3Shape Products, or a material or apparatus for use in practicing a process claimed in the '391 patent, that constitutes a material part of the inventions,

knowing the same to be especially made or especially adapted for use in an infringement of the '391 patent, and is not a staple article or commodity of commerce suitable for substantial non-infringing use.

95. 3Shape's infringement has damaged and continues to damage DITC in an amount yet to be determined, of at least a reasonable royalty and/or the lost profits that DITC would have made but for 3Shape's acts of infringement. 3Shape's acts have caused, and unless restrained and enjoined, will continue to cause, irreparable injury and damage to DITC.

DEMAND FOR JURY TRIAL

Defendant DITC hereby demands a trial by jury on all issues so triable arising from the Second Amended Complaint, the Affirmative Defenses, and/or DITC's Counterclaims.

PRAYER FOR RELIEF

WHEREFORE, DITC requests that:

- A. The Court dismiss with prejudice any and all claims of 3Shape's Complaint;
- B. the Court enter judgment that 3Shape is not entitled to any relief whatsoever, whether in law or equity or otherwise, from its suit against DITC;

- C. the Court enter judgment that the claims of 3Shape's Asserted Patents are invalid and/or unenforceable;
- D. the Court enter judgment that DITC does not infringe and has not infringed any valid claim of 3Shape's Asserted Patents and that 3Shape take nothing by its Complaint;
- E. the Court enter judgment that DITC's Asserted Patents are valid and enforceable;
- F. the Court enter judgment that 3Shape infringes and has infringed DITC's Asserted Patents both directly and indirectly by way of induced or contributory infringement;
- G. the Court permanently enjoin 3Shape and its officers, directors, agents, affiliates, employees, divisions, branches, subsidiaries, parents, and all others in active concert therewith from directly or indirectly infringing the DITC Asserted Patents;
- H. the Court order 3Shape to pay DITC its damages, costs, expenses, and pre-judgment and post-judgment interest for 3Shape's infringement of the DITC Asserted Patents, as provided under 35 U.S.C. § 284;

- I. the Court declare this case to be exceptional and award DITC its costs, expenses, and reasonable attorneys' fees incurred in defending this action under 35 U.S.C. § 285; and
- J. the Court grant to DITC such other and further relief as it deems just and proper.

Dated: February 16, 2023

Respectfully submitted,

/s/ Robin McGrath

Robin Lynn McGrath

Yunzhi Lin

Quinn Emanuel Urquhart & Sullivan, LLP

1050 Crown Pointe Parkway

Suite 500

Atlanta, Georgia 30338-7702

Tel.:(404) 482-3502

Richard W. Erwine

Quinn Emanuel Urquhart & Sullivan, LLP

51 Madison Avenue, 22nd Floor

New York, New York 10010

Tel.:(212) 849-7000

Scott Alex Lasher (*pro hac vice*)

Jared W. Newton (*pro hac vice*)

Quinn Emanuel Urquhart & Sullivan, LLP

1300 I Street, NW, Suite 900

Washington, D.C. 20005

Tel.: (202) 538-8000

Patrick D. Curran (*pro hac vice*)

Quinn Emanuel Urquhart & Sullivan, LLP
111 Huntington Ave, Suite 520
Boston, MA 02199
Tel.: (617) 712-7100

Dave Nelson (*pro hac vice*)
Quinn Emanuel Urquhart & Sullivan, LLP
191 N. Wacker Dr., Ste 2700
Chicago, IL 60606
Tel.: (312) 705-7400

Kevin (Gyushik) Jang (*pro hac vice*)
Quinn Emanuel Urquhart & Sullivan LLP
50 California Street, 22nd Floor
San Francisco, CA 94111

*Attorneys for Dental Imaging
Technologies Corp. and Dental Imaging
Technologies Corp. d/b/a DEXIS*

CERTIFICATE OF COMPLIANCE

Pursuant to LR 7.1(D), I hereby certify that the foregoing has been prepared in Times New Roman 14 point, as approved by the Court in LR 5.1(C).

Dated: February 16, 2023

/s/ Robin McGrath
Robin Lynn McGrath

CERTIFICATE OF SERVICE

I hereby certify that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document on February 16, 2023.

Dated: February 16, 2023

/s/ Robin McGrath
Robin Lynn McGrath