

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

ALIGN TECHNOLOGY, INC.,

Plaintiff,

v.

CLEARCORRECT OPERATING, LLC,
CLEARCORRECT HOLDINGS, INC.,
INSTITUT STRAUMANN AG, &
STRAUMANN USA, LLC

Defendants.

Civil Action No. 6:24-cv-00187-ADA-DTG

JURY TRIAL DEMANDED

CLEARCORRECT OPERATING, LLC,
CLEARCORRECT HOLDINGS, INC.,
& STRAUMANN USA, LLC,

Counterclaim-Plaintiffs,

v.

ALIGN TECHNOLOGY, INC.,

Counterclaim-Defendant.

**DEFENDANTS' AND COUNTERCLAIM-PLAINTIFFS' PRIOR ART NARROWING
DISCLOSURE**

Pursuant to the Scheduling Order (Dkt. 188) and discussions between the parties, Defendants and Counterclaim-Plaintiffs ClearCorrect Holdings, Inc., ClearCorrect Operating, LLC, and Straumann USA, LLC and Defendant Institut Straumann AG (collectively, “ClearCorrect”) narrow prior art references as set forth below.

On July 18, 2025 Plaintiff and Counterclaim-Defendant Align Technology, Inc. (“Align”) narrowed its asserted patent claims as follows:

Patent No.	Previously Asserted Claims	Claims Dropped on July 18, 2025	Currently Asserted Claims
10,973,613	1, 3, 4, 6-10, 12-15, 17, 18, 20, 22	None	1, 3, 4, 6-10, 12-15, 17, 18, 20, 22
11,154,384	1, 2, 4, 6-8, 10-12, 14, 16-18, 20-22, 24, 26-28, 30	None	1, 2, 4, 6-8, 10-12, 14, 16-18, 20-22, 24, 26-28, 30
11,648,090	1-3, 5, 9-10	None	1-3, 5, 9-10
11,648,091	1, 4-7, 9-11, 13, 17-19, 21, 25, 26	None	1, 4-7, 9-11, 13, 17-19, 21, 25, 26
8,038,444	1-42	7-10, 13, 17-18, 21-24, 27, 35-38, 41	1-6, 11-12, 14-16, 19-20, 25-26, 28-34, 39-40, 42
10,456,217	1-20	1-20	None
10,524,879	1-24	1-24	None
11,369,456	1-19	1-19	None
10,791,936	1, 4-17, 20 ¹	None	1, 4-17, 20

See July 18, 2025 Email from Potter. ClearCorrect agreed to narrow its prior art references to 100 by August 4, 2025. ClearCorrect hereby narrows its prior art references as set forth below. To be clear, ClearCorrect’s prior art narrowing applies only to prior art references used as anticipatory and/or as part of an obviousness combination (or single-reference obviousness theory) under § 102 and/or § 103, including at least under Align’s apparent infringement theory. ClearCorrect’s

¹ Claims 2, 3, 18, 19 were dropped previously. See July 1, 2025 Email from A. Potter.

narrowing does not apply to prior art references used only to show the state of the art, or under § 101 and/or § 112. Further, for product and system art identified below, ClearCorrect reserves the right to rely on documents, testimony, and other evidence describing the properties and/or features of those products. Because ClearCorrect has listed below only 98 references (fewer than the 100 agreed to), ClearCorrect reserves the right to add up to 2 additional references before its deadline for submitting final invalidity contentions.

1. Zendura FLX product (Bay Materials)
2. SmartTrack / Bayer #34 product (Align)
3. SmartTrack / Bayer #54 product (Align)
4. Essix ACE product (Dentsply / Raintree Essix)
5. Durasoft (TPU/PC) product (Scheu Dental GmbH)
6. US Patent Application Publication No. 2011/0020761 (Kalili)
7. WO Publication No. 2010043419 (Hinz) (IPR2022-01214, Exhibit No. 1015 (certified translation to English))
8. US Patent Application Publication No. 2015/0374464 (Stewart-464)
9. US Patent Application Publication No. 2005/0100853 (Tadros)
10. US Patent No. 6,077,075 (Bedard)
11. US Patent Application Publication No. 2009/0246724 (Chen)
12. WO Publication No. 2006/096558 (Wen)
13. US Patent Application Publication No. 2006/0078841 (DeSimone)
14. US Patent Application Publication No. 2005/0082703 (Wrosz)
15. WO Publication No. 2013/171124 (Pudleiner)
16. US Patent No. 10,549,511 (Stewart-511)
17. US Patent No. 9,655,691 (Li)

18. WO Publication No. 2007/110071 (including certified translation to English) (Paulus)
19. US Patent No. 9,022,903 (Rafih)
20. Texin 990R Data Sheet
21. Texin RxT50D Data Sheet
22. Texin 970U Data Sheet
23. Desmopan 9365D Data Sheet
24. Desmopan DP 9365D Data Sheet
25. Durasoft pd (TPU/PET-G) Data Sheet
26. Durasoft (TPU/PC) Data Sheet
27. Imprelon S pd Data Sheet
28. Hytrel 8238 Data Sheet
29. Pellethane 2363-90AE Data Sheet
30. Eastar 6763 Data Sheet
31. Tritan EX401 Data Sheet
32. Tritan MP100 Data Sheet
33. Public Awareness Drives Market for Safer Alternatives (Bailin, Paul S., et al.)
34. Dishwasher Safe: New Clear Copolyester Is Tougher, More Heat-Resistant, and Processes Easier, Too (Porter, David S., et al.)
35. Helping You Shape What's Next In Rigid Medical Packaging (Eastman Chemical)
36. U.S. Patent No. 7,987,099 (Kuo)
37. U.S. Patent Application Publication No. 2002/0010568 (Rubbert-568)
38. U.S. Patent No. 6,471,511 (Chishti-511)
39. U.S. Patent Application Publication No. 2004/0137400 (Chishti-400)
40. U.S. Patent No. 6,729,876 (Chishti-876)

41. WO Publication No. 2000/019929A1 (Chishti-929)
42. The Invisalign System (Tuncay)
43. Align TREAT system
44. Align ClinCheck
45. OraMetrix SureSmile system
46. U.S. Patent Application Publication No. 2002/0150859 (Imgrund)
47. WO Publication No. 01/80761 (Rubbert-761)
48. U.S. Patent No. 6,250,918 (Sachdeva)
49. Group Distal Movement of Teeth Using Microscrew Implant Anchorage (Park)
50. The Amalgamated Technique, a Mechanically and Biologically Efficient Method for Controlled Tooth Movement (DeAngelis)
51. Light Arch Wire Technique (Begg)
52. The Orthodontic Treatment of Impacted Teeth (Becker)
53. Nonextraction treatment of upper canine-premolar transposition in an adult patient (Kuroda)
54. U.S. Patent Application Publication No. 2002/0072027 (Chishti-027)
55. U.S. Patent Application Publication No. 2003/0096210 (Rubbert-210)
56. U.S. Patent Application Publication No. 2002/0006217 (Rubbert-417)
57. WO Publication No. 03/094102 (Rubbert-102)
58. OrthoCAD system
59. OrthoCAD Virtual Set-Up Quick Overview Version 2.4 (dated March 2004) [WBM page of April 4, 2004] Video,
https://web.archive.org/web/20040404191456/http://orthocad.com/services/setup_presentation.htm#expand
60. OrthoCAD 2.3 Help Manual (dated Jan. 13, 2004) [WBM page of April 19, 2004],
<https://web.archive.org/web/20040419173450/http://orthocad.com:80/download/OrthoCAD%202.3%20Help%20Manual.pdf>

61. Release Notes for OrthoCAD Version 2.7 (dated Dec. 11, 2005) [WBM page of March 11, 2006],
<https://web.archive.org/web/20060311173619/http://www.orthocad.com/download/OrthoCAD%202.7%20R.%20Notes.pdf>
62. iTero scanner system
63. Jacobson, Taking the Headache Out of Impressions, *Dentistry Today*, (Sept. 2007), 74-76
64. Henkel G., A Comparison of Fixed Prostheses Generated from Conventional vs Digitally Scanned Dental Impressions, *Compend Contin Educ Dent.*, 28(8):422-431 (Aug. 2007)
65. iTero Scanning Demo, SmileyDental (Dec. 15, 2008),
<https://www.youtube.com/watch?v=2wAxAXN4uPs&list=FLtVa6v5nq58YbWhbfzF214w&index=3>
66. Lava COS scanner system
67. 3M ESPE Lava Chairside Oral Scanner User Guide 2.0, (June 10, 2009)
68. 3M ESPE Lava Chairside Oral Scanner User Guide 3.0, 3M ESPE, (Dec. 9, 2010)
69. CEREC scanner system
70. CEREC 3D Operator's Manual Software Version 3.6X (Mar. 2009)
71. CEREC – New Products 2009: Seeing CAD/CAM in a new light, Sirona (Dec. 23, 2008)
72. OraScanner scanner system
73. SureSmile Clinical Reference Manual, Release 5.2 (2006)
74. James Mah, DDS, MSc, DMSc, Rohit Sachdeva, BDS, MSc, Computer-assisted orthodontic treatment: The SureSmile process, *Am. J. Orthod. Dentofacial Orthop.*, Vol. 120, No. 1, (July 2001), 85-87
75. Sachdeva, SureSmile Technology in a Patient-Centered Orthodontic Practice, *JCO*, Vol. 35, No. 4 (Apr. 2001), 245-53
76. E4D scanner system
77. E4D Dentist Elements of Success Manual (2009)
78. E4D Dentist User Manual, Version 10560400.G (2009)

79. Dental Wings 5 Series scanner system
80. Dental Wings 3 Series scanner system
81. Dental Wings iSeries scanner system
82. Dental Wings Software Version 2.1 User Guide
83. Dental Wings Software Version 2.5 User Guide
84. WO Publication No. 2007/084727 (Boerjes)
85. U.S. Patent No. 7,474,932 (Geng)
86. U.S. Patent Application Publication No. 2007/0236494 (Kriveshko-494)
87. U.S. Patent Application Publication No. 2002/0006217 (Rubbert-217)
88. U.S. Patent Application Publication No. 2009/0316966 (Marshall)
89. U.S. Patent No. 6,227,850 (Chishti-850)
90. U.S. Patent Application Publication No. 2005/0283065 (Babayoff-065)
91. U.S. Patent Application Publication No. 2007/0172112 (Paley)
92. U.S. Patent Application Publication No. 2004/0155975 (Hart)
93. U.S. Patent Application Publication No. 2006/0115793 (Kopelman-793)
94. Contemporary Fixed Prosthodontics (Rosentiel)
95. WO Publication No. 2003094102 (Rubbert-102)
96. WO Publication No. 2000008415 (Babayoff-415)
97. U.S. Patent Application Publication No. 2003/0232302 (Babayoff-302)
98. WO Publication No. 2007/062658 (Fisker-658)

/s/ Marissa A. Lalli

Melissa R. Smith
Texas Bar No. 24001351
melissa@gillamsmithlaw.com
GILLAM AND SMITH, LLP
303 South Washington Avenue
Marshall, TX 75670
(903)934-8450
Fax: (903)934-9257

James Travis Underwood
Texas Bar No. 24102587
travis@gillamsmithlaw.com
GILLAM AND SMITH, LLP
102 N. College, Suite 800
Tyler, TX 75702
(903) 934-8450
Fax: (903)934-9257

Joseph J. Mueller
Vinita Ferrera
Mark A. Ford
Marissa A. Lalli
Harry D. Hanson
Holly A. Ovington
Tyler L. Shearer
WILMER CUTLER PICKERING
HALE AND DORR LLP
60 State Street
Boston, MA 02109
(617) 526-6000
joseph.mueller@wilmerhale.com
vinita.ferrera@wilmerhale.com
mark.ford@wilmerhale.com
marissa.lalli@wilmerhale.com
harry.hanson@wilmerhale.com
holly.ovington@wilmerhale.com
tyler.shearer@wilmerhale.com

Omar A. Khan
WILMER CUTLER PICKERING
HALE AND DORR LLP
250 Greenwich Street
New York, NY 10007
(212) 230-8800
omar.khan@wilmerhale.com

Todd C. Zubler
R. Gregory Israelsen
Gerard A. Salvatore
WILMER CUTLER PICKERING
HALE AND DORR LLP
2100 Pennsylvania Avenue, NW
Washington, DC 20037
(202) 663-6000
todd.zubler@wilmerhale.com
greg.israelsen@wilmerhale.com
jerry.salvatore@wilmerhale.com

Hannah Santasawatkul
Texas State Bar No. 24107617
WILMER CUTLER PICKERING
HALE AND DORR LLP
1225 17th Street, Suite 2600
Denver, Colorado 80202
(720) 274-3135
hannah.santasawatkul@wilmerhale.com

*Attorneys for Defendants and
Counterclaim-Plaintiffs
ClearCorrect Operating, LLC
ClearCorrect Holdings, Inc., Straumann
USA LLC*

*Attorneys for Defendant
Institut Straumann AG*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of this document has been served on all counsel of record via electronic mail on August 4, 2025.

/s/ Marissa A. Lalli