

**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN INTRAORAL SCANNERS
AND RELATED HARDWARE AND
SOFTWARE**

Investigation No. 337-TA-1090

**NOTICE OF COMMISSION DETERMINATION TO VACATE THE FINAL
INITIAL DETERMINATION FINDING NO VIOLATION OF SECTION 337 AND
TO TERMINATE THE INVESTIGATION IN ITS ENTIRETY**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to vacate the presiding administrative law judge's ("ALJ") final initial determination ("ID") issued on April 26, 2019, finding no violation of section 337 in the above-referenced investigation, and to terminate the investigation in its entirety.

FOR FURTHER INFORMATION CONTACT: Cathy Chen, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street SW, Washington, DC 20436, telephone (202) 205-2392. Copies of non-confidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street SW, Washington, DC 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <https://www.usitc.gov>. The public record for this investigation may be viewed on the Commission's electronic docket (EDIS) at <https://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on December 19, 2017, based on a complaint filed on behalf of Align Technology, Inc. ("Align") of San Jose, California. 82 FR 60215 (Dec. 19, 2017). The complaint alleges violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. 1337 ("section 337"), in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain intraoral scanners and related hardware and software by reason of infringement of one or more claims of U.S. Patent Nos.: 9,615,901 ("the '901 patent"); 8,638,448 ("the '448 patent"); 8,638,447 ("the '447 patent"); 6,845,175 ("the '175 patent"); and

6,334,853 (“the ’853 patent”). *Id.* The complaint further alleges that a domestic industry exists. The Commission’s notice of investigation named as respondents 3Shape A/S of Copenhagen K, Denmark and 3Shape, Inc., of Warren, New Jersey. The notice of investigation was amended to add 3Shape Trios A/S of Copenhagen K, Denmark as a respondent. 83 FR 13782 (Mar. 30, 2018). The Office of Unfair Import Investigations is not participating in the investigation. The investigation was terminated as to the ’853 and ’175 patents and certain claims of the ’447, ’448, and ’901 patents based on the withdrawal of Align’s allegations. *See* ID at 1-2.

On April 26, 2019, the ALJ issued the final ID, finding no violation of section 337 with respect to the ’901, ’448, and ’447 patents. That same day, the ALJ issued her Recommended Determination on Remedy and Bonding. On May 13, 2019, Align filed a petition for review of the final ID, and Respondents filed a joint contingent petition for review of the final ID. The parties filed responses to the petitions on May 21, 2019.

On July 19, 2019, the Commission determined to review the final ID in its entirety.

Having considered the record of the investigation, including the parties’ submissions to the Commission, the Commission decides as follows. The Commission “can issue only an exclusion order barring future importation or a cease and desist order barring future conduct,” neither of which can issue as to an expired patent. *Texas Instruments Inc. v. U.S. Int’l Trade Comm’n*, 851 F.2d 342, 344 (Fed. Cir. 1988).

The ’448 and ’447 patents expired on August 5, 2019, which terminated the Commission’s jurisdiction as to these patents and rendered the Commission’s investigation with respect to these patents moot. *See id.*; 19 U.S.C. 1337(a)(1)(B)(i).

The ’901 patent will expire on August 30, 2019, four days after the target date for completion of the investigation. Given the imminent expiration of the ’901 patent, the ID’s finding of no violation with respect to the ’901 patent based on multiple grounds, and the schedule for Commission review established by the Commission’s Rules of Practice and Procedure, the Commission finds that Align cannot obtain effective relief as to the ’901 patent prior to its expiration. Even if the Commission were to reverse the ID in this investigation and find a violation with respect to the ’901 patent, the Commission finds that it cannot grant relief as to the ’901 patent before the patent expires given its long-standing procedures for determining the appropriate remedy and bonding, and for considering the public interest. Moreover, any exclusion order with respect to the ’901 patent would likely not protect complainant from any injury until after the patent expires given that the ALJ recommended that no bond be imposed during the 60-day Presidential review period.

The Commission has therefore determined on review to vacate the final ID as moot, including the ID’s finding of no violation of section 337 with respect to the asserted patents. The investigation is terminated in its entirety.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), and in part 210 of the Commission's Rules of Practice and Procedure (19 CFR 210).

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton', with a stylized flourish at the end.

Lisa R. Barton
Secretary to the Commission

Issued: August 20, 2019