

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN DIGITAL MODELS, DIGITAL
DATA, AND TREATMENT PLANS FOR USE
IN MAKING INCREMENTAL DENTAL
POSITIONING ADJUSTMENT APPLIANCES,
THE APPLIANCES MADE THEREFROM,
AND METHODS OF MAKING THE SAME**

Investigation No. 337-TA-833

**RESCISSION OF CEASE AND DESIST ORDERS;
TERMINATION OF INVESTIGATION**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to rescind the cease and desist orders issued in this investigation and to terminate the investigation with a finding of no violation of Section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337 (“Section 337”).

FOR FURTHER INFORMATION CONTACT: Sidney A. Rosenzweig, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-2532. 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, S.W., Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server (<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: This investigation was instituted on April 5, 2012, based upon a complaint filed on behalf of Align Technology, Inc., of San Jose, California (“Align”), on March 1, 2012, as corrected on March 22, 2012. *77 Fed. Reg.* 20648 (April 5, 2012). The complaint alleged violations of Section 337 in the sale for importation, importation, or sale within the United States after importation of certain digital models, digital data, and

treatment plans for use in making incremental dental positioning adjustment appliances, the appliances made therefrom, and methods of making the same by reason of infringement of certain claims of U.S. Patent No. 6,217,325 (“the ’325 patent”); U.S. Patent No. 6,471,511 (“the ’511 patent”); U.S. Patent No. 6,626,666 (“the ’666 patent”); U.S. Patent No. 6,705,863 (“the ’863 patent”); U.S. Patent No. 6,722,880 (“the ’880 patent”); U.S. Patent No. 7,134,874 (“the ’874 patent”); and U.S. Patent No. 8,070,487 (the ’487 patent”). The notice of institution named as respondents ClearCorrect Pakistan (Private), Ltd. of Lahore, Pakistan (“CCPK”) and ClearCorrect Operating, LLC of Houston, Texas (“CCUS”) (collectively, “the Respondents”). A Commission investigative attorney (“IA”) participated in the investigation.

On May 6, 2013, the presiding administrative law judge (“ALJ”) issued his final initial determination (“ID”), finding a violation of Section 337 with respect to the ’325 patent, the ’880 patent, the ’487 patent, the ’511 patent, the ’863 patent, and the ’874 patent. He found no violation as to the ’666 patent. The ALJ recommended the issuance of cease and desist orders directed to the Respondents.

After receiving briefing from the parties and the public, on April 3, 2014, the Commission issued notice of its determination to affirm-in-part, modify-in-part, and reverse-in-part the final ID and to find a violation of Section 337. 79 *Fed. Reg.* 19640-41 (Apr. 9, 2014). The Commission found a violation of Section 337 with respect to (i) claims 1 and 4-8 of the ’863 patent; (ii) claims 1, 3, 7, and 9 of the ’666 patent; (iii) claims 1, 3, and 5 of the ’487 patent; (iv) claims 21, 30, 31 and 32 of the ’325 patent; and (v) claim 1 of the ’880 patent. On the same day, the Commission issued an opinion, with a dissenting opinion from Commissioner Johanson, and also issued cease and desist orders directed to CCUS and CCPK. The Commission terminated the investigation.

On May 2, 2014, the Respondents filed a motion to stay the cease and desist orders pending appeal. On May 14, 2014, Complainant Align and the IA filed responses in opposition. On June 2, 2014, the Commission issued a notice and order granting the motion.

ClearCorrect and Align each took appeals of the Commission’s determination to the U.S. Court of Appeals for the Federal Circuit. In ClearCorrect’s appeal, the Federal Circuit reversed the Commission’s decision that the electronic transmission of the digital models could constitute an imported “article” within the meaning of 19 U.S.C. § 1337, and remanded the case to the Commission. *ClearCorrect Operating, LLC v. ITC*, 810 F.3d 1283 (Fed. Cir. 2015), *reh’g en banc denied*, 819 F.3d 1334 (2016). No petition for *certiorari* was filed with the Supreme Court.

In Align’s appeal, the Federal Circuit vacated and remanded the case to the Commission “for further proceedings in light of” the *ClearCorrect* decision. *Align Tech., Inc. v. ITC*, 622 F. App’x 910 (Fed. Cir. 2015).

In view of the foregoing final decisions of the Federal Circuit, the Commission has determined to rescind the cease and desist orders issued in this investigation. The investigation is terminated with a finding of no violation of section 337.

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 C.F.R. Part 210).

By order of the Commission.

A handwritten signature in black ink, appearing to read "Lisa R. Barton". The signature is stylized and cursive.

Lisa R. Barton
Secretary to the Commission

Issued: September 23, 2016