

3. Upon information and belief, defendant Dentsply Sirona Inc. is a corporation organized and existing under the laws of the State of Delaware, having a place of business located at 30 30 47th Avenue, Suite 500, Long Island City, New York.

4. Upon information and belief, defendant Dentsply GAC International is a company affiliated with Dentsply Sirona and has a principal place of business at 355 Knickerbocker Avenue, Bohemia, NY 11716.

JURISDICTION AND VENUE

5. This action arises under Title 35 of the United States Code. Jurisdiction of this Court is based on 28 U.S.C. §§ 1331 and 1338(a), as this action arises under the patent laws of the United States.

6. This Court also has personal jurisdiction over defendant Dentsply GAC International by virtue of Dentsply GAC International's specific and continuous contacts in this district and the State of New York. Specifically, on information and belief, Dentsply GAC International maintains a continuous and voluntary presence in this district and the state of New York by virtue of its permanent office located at 355 Knickerbocker Avenue, Bohemia, NY 11716.

7. This Court has personal jurisdiction over defendant Dentsply Sirona Inc. by virtue of Dentsply Sirona Inc.'s specific and continuous contacts in this district and the State of New York. Specifically, on information and belief, Dentsply Sirona Inc. is registered to do business in the State of New York, has a registered agent for service of process in the State of New York, sells its products throughout the State of New York and owns and operates a place of business in the State of New York and in this judicial district.

8. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391(b), 1391(c), and 1400(b), because one or both Defendants have committed acts of infringement and/or induced acts of infringement in this judicial district.

ALLEGATIONS COMMON TO ALL CAUSES OF ACTION

9. Plaintiff is engaged in the business of conceiving of, developing, designing, patenting and licensing innovative new devices, systems and methods in the field of orthodontics, including orthodontic brackets. Plaintiff's principal is Dr. John Voudouris, who is an orthodontist and individual resident of Toronto, Ontario.

10. Dr. Voudouris is a practicing orthodontist and a clinical research scientist. He is currently a member of the Discipline of Orthodontics Division of Biological Sciences as Visiting Scholar, and teaches Craniofacial Growth and Development combined with Biomechanics at the Orthodontic Graduate Department, New York University, College of Dentistry and the University of Toronto. Dr. Voudouris is the listed inventor on twelve issued U.S. Patents directed to self-ligating orthodontic brackets, including U.S. Patent Nos. 5,630,715 (the "'715 patent") and 8,636,507 (the "'507 patent").

11. The Defendants are well aware of Dr. Voudouris and OrthoArm through previous dealings. In or about December 1997, OrthoArm and Dentsply GAC entered into a written license agreement (the "License Agreement"), pursuant to which OrthoArm licensed to GAC, worldwide, the right to manufacture, have manufactured, use, market, and sell a self-ligating orthodontic bracket, including the right to grant sublicenses under the trademark "In-Ovation," patented by way of the '715 Patent.

12. During negotiations for the Licensing Agreement, Dr. Voudouris conceived and suggested to Dentsply GAC the use of the trademark “In-Ovation,” which Defendants ultimately adopted. Defendants never compensated Dr. Voudouris for this contribution.

13. Upon information and belief, each of the Defendants has been involved in at least one of manufacturing, using, offering for sale, selling, and/or importing certain orthodontic brackets, specifically including but not limited to the brackets sold under the trade designation “In-Ovation Mini” (the “Infringing Products”) in or into one or more states in the United States, including the State of New York and this Judicial District.

14. On information and belief, each of the Defendants has continuous and systematic business activities in the State of New York, including within this Judicial District, and is involved in this Judicial District with at least one of designing, developing, conducting research and development, using, offering for sale, selling, and/or importing the Infringing Products.

AS AND FOR A FIRST CAUSE OF ACTION
(Infringement of U.S. Patent No. 8,636,507 Under 35 U.S.C. § 271)

15. Plaintiff incorporates by reference each and every allegation contained in paragraphs 1 through 14 above.

16. Plaintiff is now the owner by assignment of the entire right, title, and interest in and to United States Patent No. 8,636,507, entitled “Self-Ligating Orthodontic Bracket,” including the right to sue for infringement and receive damages for such infringement. The ‘507 patent was duly and legally issued on January 28, 2014 and is now in full force and effect and has been since its issuance. A copy of the ‘507 Patent is attached hereto as Exhibit A.

17. Plaintiff has the full right to bring any and all actions for infringement of the ‘507 Patent and to receive any and all monetary awards and obtain injunctive relief therefor.

18. On information and belief, each of the Defendants is infringing and has infringed, either directly and/or by inducing infringement, at least one claim of the ‘507 Patent in violation of 35 U.S.C. § 271, by making, using, offering for sale, selling, and/or importing the Infringing Products, in or into the United States and by inducing others to do so.

19. A representative claim of the ‘507 Patent and a chart showing how a representative product of the Infringing Products infringes the ‘507 Patent is provided below.

U.S. Patent No. 8,636,507	Dentsply In-Ovation Mini
1. A self-ligating orthodontic bracket comprising:	The In-Ovation Mini is a self-ligating orthodontic bracket.
a body having an archwire slot defined at least partially by an occlusal side surface and a lingual surface, wherein a mesio-gingival reference plane is tangent to a lingual-most point of the lingual surface,	The In-Ovation Mini includes a body having an archwire slot defined at least partially by an occlusal side surface and a lingual surface, wherein a mesio-gingival reference plane is tangent to a lingual-most point of the lingual surface.
the body further having an occlusal-gingival opening, wherein the reference plane intersects the opening; and	The body of the In-Ovation Mini has an occlusal-gingival opening. The reference plane that is tangent to a lingual-most point of the lingual surface of the archwire slot intersects this opening.
a locking shutter coupled to the body and movable between a closed position where access to the archwire slot is inhibited and an open position where access to the archwire slot is permitted,	The In-Ovation Mini includes a locking shutter coupled to the body and movable between a closed position where access to the archwire slot is inhibited and an open position where access to the archwire slot is permitted.
wherein the locking shutter includes a lingual end located in the opening at a closed lingual location when the locking shutter is in the closed position, and	The locking shutter of the In-Ovation Mini includes a lingual end located in the opening at a closed lingual location when the locking shutter is in the closed position.
wherein the lingual end is located at an open lingual location when the locking shutter is in the open position,	The lingual end of the locking shutter is located at an open lingual location when the locking shutter is in the open position.
wherein the locking shutter further includes a labial end located at a closed labial location when the locking shutter is in the closed position and at an open labial	The locking shutter of the In-Ovation Mini includes a labial end located at a closed labial location when the locking shutter is in the closed position and at an open labial location when the locking shutter is in the open position, wherein the side surface is closer to the open

location when the locking shutter is in the open position, wherein the side surface is closer to the open labial location than to the closed labial location, and	labial location than to the closed labial location
wherein a first occlusal-gingival distance from the closed lingual location to the open lingual location is from 70% to 90% a second occlusal-gingival distance from the closed labial location to the side surface.	The first occlusal-gingival distance from the closed lingual location to the open lingual location of the In-Ovation Mini is from 70% to 90% a second occlusal-gingival distance from the closed labial location to the side surface In-Ovation Mini.

20. On information and belief, Defendants' activities have been with knowledge of the '507 Patent and Plaintiff's patent rights therein. In addition, and in the alternative, Defendants have been aware of the '507 patent and Plaintiff's allegations of infringement since at least the filing of the original complaint on September 29, 2016. On information and belief, each of Defendants had actual knowledge and/or notice of the '507 Patent prior to the filing of the original complaint. Defendants had actual knowledge that they were engaging in infringing activities. Defendants, therefore, specifically intended to engage in infringing actions.

21. Despite Defendants' awareness of the '507 patent and Plaintiff's rights therein, and in the alternative Plaintiff's allegations of infringement, Defendants have knowingly and actively induced others to infringe the '507 patent. In particular, in marketing and selling the Infringing Products, Defendants have provided and continue to provide to their customers, distributors and end users promotional materials for the Infringing Products, and instructions regarding installation and use of the Infringing Products. *See, e.g.*, Exhibit B¹ and Exhibit C². By communicating and providing to its customers, distributors and/or end users these

¹ https://www.dentsply.com/content/dam/dentsply/pim/manufacture/Orthodontics/Brackets/Self_Ligating/In_Ovation_mini/In_Ovation_mini/120-191-03-r1-InOv-Mini-LR-7wqgvas-en-1505.pdf

² https://www.dentsply.com/content/dam/dentsply/pim/manufacture/Orthodontics/Brackets/Self_Ligating/In_Ovation_mini/In_Ovation_mini/120-191-03-r1-InOv-Mini-LR-7wqgvas-en-1505.pdf

promotional materials and instructional information regarding installation and use of the Infringing Products, Defendants have promoted and demonstrated how to use the Infringing Products in an infringing manner, thereby inducing direct infringement by its customers, distributors and/or end users (e.g., orthodontists and patients undergoing orthodontic procedures) of at least one of the claims of the '507 patent. Defendants, therefore, have specifically intended to actively induce others to infringe at least one claim of the '507 patent.

22. Plaintiff has been damaged as a result of Defendants' acts of patent infringement in an amount to be determined at trial, and will suffer imminent and irreparable injury unless this Court enjoins Defendants from further acts of infringement.

23. On information and belief, Defendants' activities have been with knowledge of the '507 Patent and Plaintiff's patent rights therein, and such acts of infringement have been carried out deliberately and willfully, without the consent of Plaintiff and with full knowledge of the '507 Patent, entitling Plaintiff to treble damages under 35 U.S.C. § 284.

24. This is an exceptional case entitling Plaintiff to an award of attorneys' fee under 35 U.S.C. § 285.

WHEREFORE, Plaintiff OrthoArm, Inc. respectfully requests that this Court enter judgment in Plaintiff's favor on each and every claim for relief set forth above and award it relief including, but not limited to, the following:

1. That Defendants have been and are infringing, and are actively inducing infringement of the '507 Patent;

2. That Defendants and their officers, agents, and employees and all others in concert or participation with them be preliminarily and permanently enjoined from further acts of infringement of the '507 Patent under 35 U.S.C. § 283;

3. That Plaintiff be awarded damages adequate to compensate it for Defendants' direct and indirect infringement of the '507 Patent in an amount to be determined at trial, together with interest and costs under 35 U.S.C. § 284;

4. That Plaintiff be awarded treble the damages it has incurred by reason of Defendants' acts of deliberate and willful infringement of the '507 Patent under 35 U.S.C. § 284;

5. That Defendants be required to pay Plaintiff's reasonable attorneys' fees in connection with this action as provided in 35 U.S.C. § 285;

6. That Defendants be directed to file with this Court and serve on Plaintiffs within thirty (30) days after service of an injunction, a report in writing, under oath, setting forth in detail the manner and form in which Defendants have complied with this injunction ordered by this Court;

7. That Defendants be required to pay all of Plaintiff's costs and expenses, including expert witness fees; and

8. That Plaintiff has such other, further and different relief as this Court deems just and proper.

DEMAND FOR JURY

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Plaintiff hereby demands a trial by jury as to all issues properly so tried.

DATED: December 14, 2016
New York, New York

Respectfully submitted,

FOX ROTHSCHILD LLP

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