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Paper: 25
Entered: February 12, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3SHAPE A/S and 3SHAPE INC.,
Petitioner,

v.

ALIGN TECHNOLOGY, INC.,
Patent Owner.

Case IPR2019-00154, Patent 8,363,228 B2
Case IPR2019-00157, Patent 8,363,228 B2[1]

Before BRIAN J. MCNAMARA, NEIL T. POWELL, and ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

JUDGMENT
Granting Request for Adverse Judgment After Institution of Trial
37 C.F.R. § 42.73(b)

[1] This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties may not use this style caption for any subsequent papers without prior Board authorization.

On June 5, 2019, in IPR2019-00154, we instituted trial on claims 1–26 of U.S. Patent No. 8,363,228 B2 (Ex. 1001, "the 228 patent"), and in IPR2019-00157, we instituted trial on claims 1–7 and 26 of the '228 patent. IPR2019-00154, Paper 9; IPR2019-00157, Paper 9. On February 7, 2020, Align Technology, Inc. ("Patent Owner") filed Patent Owner's Unopposed Motion for Adverse Judgment in each proceeding. IPR2019-00154, Paper 23; IPR2019-00157, Paper 26.

Patent Owner states that it filed U.S. Reissue Application No. 16/784,493, which cancelled claims 1–26 of the '228 patent. IPR2019-00154, Paper 23.

In IPR2019-00154, Patent Owner requests that the Board acknowledge the cancellation of claims 1–26 and enter adverse judgment under 37 C.F.R. § 42.73(b). *Id.* Patent Owner further requests that, because claims 1–26 are the only claims at issue in IPR2019-00154, we terminate the *inter partes* review. *Id.*

In IPR2019-00157, Patent Owner requests that the Board acknowledge the cancellation of claims 1–7 and 26 and enter adverse judgment under 37 C.F.R. § 42.73(b). IPR2019-00157, Paper 26. Patent Owner further requests that, because claims 1–7 and 26 are the only claims at issue in IPR2019-00157, we terminate the *inter partes* review. *Id.*

A party may request entry for adverse judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Actions construed to be a request for adverse judgment include cancellation of patent claims, such that a party has no remaining claim in the trial. *Id*. § 42.73(b)(2).

Patent Owner's request for cancellation of claims 1–26 of the '228 patent leaves no claim remaining for trial in either IPR2019-00154 or

IPR2019-00157. Accordingly, entry of judgment adverse to Patent Owner pursuant to 37 C.F.R. § 42.73(b) is appropriate.

Accordingly, it is

ORDERED that Patent Owner's request for adverse judgment is *granted*;

FURTHER ORDERED that claims 1–26 of U.S. Patent No. 8,363,228 B2 are *cancelled*;

FURTHER ORDERED that, in IPR2019-00154, judgment is entered adverse to Patent Owner with respect to claims 1–26 of U.S. Patent No. 8,363,228 B2;

FURTHER ORDERED that, in IPR2019-00157, judgment is entered adverse to Patent Owner with respect to claims 1–7 and 26 of U.S. Patent No. 8,363,228 B2;

FURTHER ORDERED that these *inter partes* reviews are terminated.

IPR2019-00154, Patent 8,363,228 B2
IPR2019-00157, Patent 8,363,228 B2

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