

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3M COMPANY,
Petitioner

v.

BAY MATERIALS, LLC,
Patent Owner

Case No. IPR2023-00243

U.S. Patent No. 10,870,263

Filing Date: December 18, 2019

Issue Date: December 22, 2020

Title: Dual Shell Dental Appliance and Material Constructions

PETITIONER'S NOTICE REGARDING MULTIPLE PETITION

I. INTRODUCTION

Petitioner 3M Company respectfully submits this Paper in support of its present Petition for *Inter Partes* Review of claims 1-4, 7, 11-14, 16, 18, and 31 of U.S. Patent No. 10,870,263 (the “’263 patent”) (“Petition B,” IPR2023-00243). Petitioner filed a Petition for *Inter Partes* Review of claims 1-4, 7, 11-14, 16, 18, and 31 of the ’263 patent on July 19, 2022 (IPR2022-01215) (“Petition A”). Pursuant to the Patent Trial and Appeal Board’s Trial Practice Guide Update released in July 2019, Petitioner provides this separate paper to identify the material differences between its two Petitions and need to file separate petitions regarding the ’263 patent. Petitioner requests that the Board use its discretion to institute both Petitions.

II. MATERIAL DIFFERENCES AND REASONS FOR INSTITUTION

There are material differences between the two Petitions. These differences warrant instituting trial for both of them.

First, the Trial Practice Guide Update recognizes that “more than one petition may be necessary . . . when there is a dispute about priority date” Trial Practice Guide Update (July 2019), 26. In Petition A, Petitioner’s Grounds all hinge on a single dispute about the priority date of the challenged claims of the ’263 patent. The ’263 patent issued from a continuation-in-part application that was filed on December 18, 2019, but claims priority to the earlier filing date of its parent

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applications. In Petition A, Petitioner contends that Patent Owner cannot satisfy its burden of establishing an effective filing date earlier than December 18, 2019. Here, in Petition B, Petitioner is presuming—without conceding—an effective filing date for the challenged claims of the '263 patent as May 31, 2018 (the filing date of the parent PCT application).

Second, Petition A and Petition B rely on wholly different prior art references and grounds, as reflected in Table 1 *infra*. In Petition A, Petitioner relies on intervening prior art to challenge the claims of the '263 patent, while in Petition B, Petitioner relies on references pre-dating May 31, 2017, the date of the earliest filed provisional application. As the Trial Practice Guide Update indicates, one of the situations that can justify multiple petitions is “when there is a dispute about priority date requiring arguments under multiple prior art references.” Trial Practice Guide Update (July 2019), 26. This is precisely such a situation.

Petition	Challenged Claims	Grounds
A (IPR2022-01215)	1-4, 7, 11-14, 16, 18, 31	<u>Ground 1</u> : Claims 11-14, 16, and 18 are anticipated by Yu <u>Ground 2</u> : Claims 1-4, 7, and 31 are anticipated by Yu <u>Ground 3</u> : Claims 1-4, 7, and 31 are anticipated by Stewart '864

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B (IPR2023-00243)	1-4, 7, 11-14, 16, 18, 31	<u>Ground 1</u>: Claim 1 is obvious based on Hinz in view of Durasoft (TPU/PC) Data Sheet, Durasoft (TPU/PETG) Data Sheet, and/or Imprelon S (Copolyester) Data Sheet <u>Ground 2</u>: Claims 2-4 are obvious based on Ground 1 and Sun <u>Ground 3</u>: Claims 7 and 31 are obvious based on Ground 2 in view of Handbook of Thermoplastics <u>Ground 4</u>: Claim 11 is obvious based on Li, Boronkay, and Chen <u>Ground 5</u>: Claims 12-14, 16, and 18 are obvious based on Ground 4 in view of Stewart '552
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Despite the need for two Petitions as demonstrated *supra*, Petitioner has strived to minimize issues for the parties and the Board where possible. For instance, the Petitions rely on testimony from the same expert, Dr. Alan Jeffrey Giacomini.

III. RANKING OF PETITIONS

While both Petitions are meritorious and justified, as explained above, Petitioner requests in accordance with the Trial Practice Guide Update that the Board consider the Petitions in the following order:

1. Petition A (IPR2022-01215)
2. Petition B (IPR2023-00243)

IV. CONCLUSION

For the reasons given above, Petitioner respectfully requests that the Board institute both Petitions.

Dated: December 5, 2022

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Sections 42.6 and 42.105, that a complete copy of the foregoing **Petitioner's Notice of Multiple Petitions**, are being served via Federal Express on the December 5, 2022, the same day as the filing of the above-identified document in the United States Patent and Trademark Office/Patent Trial and Appeal Board, upon the PO by serving the correspondence address of record with the USPTO as follows:

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And, via electronic mail upon counsel of record for the PO in the litigation pending before the U.S. District Court for the District of Delaware entitled *Bay Materials LLC. v. 3M Company*, Case No. 1:21-cv-01610 (D. Del.) as follows:

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DATED: December 5, 2022

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