

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DENTAL IMAGING TECHNOLOGIES CORPORATION,
Petitioner,

v.

3SHAPE A/S,
Patent Owner

U.S. Patent No RE48,221 to Öjelund *et al.*

Issue Date: September 22, 2020

Title: SYSTEM WITH 3D USER INTERFACE INTEGRATION

IPR Case No.: 2023-00388

**JOINT MOTION TO TERMINATE
INTER PARTES REVIEW OF U.S. PATENT RE48,221
UNDER 37 C.F.R. § 42.72**

Pursuant to 37 C.F.R. § 42.72, Petitioner and Patent Owner jointly move to terminate the *Inter Partes* Review of U.S. Patent No. RE48,221 (“Joint Motion to Terminate”).

Petitioner and Patent Owner have entered into a written, confidential binding settlement agreement fully resolving this matter with respect to the '221 patent, including both this proceeding and Patent Owner's assertion of the '221 patent in the related district court litigation, No. 1:22-cv-01829-WMR (N.D. Ga.). A copy of the agreement is submitted herewith as Ex. 1045.

Concurrently, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties are filing Joint Motion to Keep Confidential and Separate (“Motion to Keep Confidential”) the confidential agreement.

The undersigned represent that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding.

The undersigned further represent that Ex. 1045 is a true and accurate copy of the confidential agreement between the parties resolving the present proceeding.

On April 13, 2023, the parties informed the Board of the settlement via e-mail and requested authorization to file the Motion to Terminate and Motion to Keep Confidential. In an email dated April 17, 2023, the Board authorized the filing of this Joint Motion to Terminate and the Motion to Keep Confidential.

The Board has not yet rendered an institution decision in this proceeding.

There are no other pending USPTO proceedings regarding the '221 patent.

In view of the foregoing, Petitioner and Patent Owner respectfully request termination of the *Inter Partes* Review of U.S. Patent No. RE48,221.

Dated: April 20, 2023

Respectfully submitted,

/s/ John T. McKee

John T. McKee

Reg. No. 65,926

Lead Counsel for Petitioner

/s/ Todd R. Walters

Todd R. Walters

Reg. No. 34,040

Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a copy of the foregoing JOINT MOTION TO TERMINATE was served electronically via e-mail on April 20, 2023 to the following:

/s/ John T. McKee

John T. McKee

Reg. No. 65,926

Lead Counsel for Petitioner