

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDIT CORPORATION,

Petitioner,

v.

3SHAPE A/S,

Patent Owner.

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Case No.: IPR2023-01315  
U.S. Patent No. 10,695,151

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**PETITIONER'S MOTION TO STRIKE PORTIONS  
OF PATENT OWNER'S SUR-REPLY**

As authorized by the Board’s Order (Paper 20), Petitioner Medit Corporation hereby moves to strike portions of Patent Owner’s Sur-Reply (Paper 16) as advancing new arguments that are outside the scope of a proper sur-reply. Specifically, Petitioner respectfully requests that the Board strike Section II.B. of the Sur-Reply because it is directed to arguments regarding the Lehmann II reference that Patent Owner had the opportunity to raise in its Response, but failed to raise.

## **I. LEGAL STANDARD**

The Board’s rules are unequivocal: “A sur-reply may only respond to arguments raised in the corresponding reply.” 37 C.F.R. § 42.23. If a brief raises new issues or otherwise exceeds the proper scope of a sur-reply, a party may file a motion to strike. *See Consolidated Trial Practice Guide (CTPG)* at 80. While the Board may wait to address new issues when weighing the evidence, the remedy of striking portions of a sur-reply may be appropriate in some circumstances. *Id.* at 80–81. One such circumstance, present here, occurs “where a reply clearly relies on a new theory not included in prior briefing, and where addressing this new theory during oral hearing would prejudice the opposing party, striking the portion of the brief containing that theory may be appropriate.” *Id.* at 81.

## **II. PROCEDURAL HISTORY**

The Petition in this case raised five grounds of unpatentability, two of which were obviousness combinations involving the Lehmann II reference, Exhibit 1011.

Ground 2 of the Petition challenged claims 1, 2, 4, 5, 9, and 12–16 over Korten (Ex. 1009) and Lehmann II, while Ground 3 challenged claims 10, 16, and 17 over Korten, Lehmann II, and Babayoff (Ex. 1013).

In response to the Petition, Patent Owner filed a Preliminary Response (Paper 5). Despite purporting to oppose Grounds 2 and 3 by analyzing Lehmann II (*id.* at 19–29), Patent Owner instead cited throughout to a different reference, Lehmann I (Ex. 1010). Indeed, a search of the Preliminary Response reveals only one citation to Exhibit 1011, and that appears to be a typo.<sup>1</sup> Lehmann II was not raised or discussed by Patent Owner in any way. This was not an inadvertent omission, but an affirmative citation to, and analysis of, the entirely wrong reference.

Patent Owner’s opposition to Grounds 2 and 3 in its Response is nearly verbatim<sup>2</sup> to what appeared in the Preliminary Response. Paper 10, 25–37. Importantly, Patent Owner did not revise its argument to correctly analyze Lehmann II, the reference that is the basis of Grounds 2 and 3. Instead, the twelve pages devoted to those grounds only discuss Exhibit 1010, Lehmann I. A search of the entirety of the Patent Owner Response reveals ***no*** citations to Exhibit 1011.

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<sup>1</sup> Given the context of the citation, Patent Owner likely meant to cite to Exhibit 1008, the Decision Denying Institution in IPR2023-00400. Paper 5, 39.

<sup>2</sup> The primary difference between the two documents is that the Response adds citations to the Declaration of Patent Owner’s expert. As discussed below, however, the Declaration also cites to Lehmann I throughout and does not analyze Lehmann II.

Petitioner noted the Patent Owner’s lack of analysis of Grounds 2 and 3 in its Reply. Paper 13, 12–13. The Reply explained that Lehmann I and Lehmann II are not related beyond sharing a first-named inventor and provided a comparison illustrating the extent of differences in their disclosures. *Id.* at 12; Ex. 1020.

After receiving Petitioner’s Reply identifying this fatal error in its analysis, Patent Owner did not seek relief from the Board or raise this issue with Petitioner. Instead, despite the Board’s admonition in the Scheduling Order<sup>3</sup> regarding the waiver of new arguments, Patent Owner attempted to overcome this determinative oversight via its Sur-Reply, backfilling the analysis of Lehmann II that was missing from the Response. Paper 16, 16–21. This attempt at self-help not only violates the Board’s rules, but will prejudice Petitioner if allowed to remain in the record.

### **III. ARGUMENT**

This case presents the Board with exactly the type of exceptional circumstances that justify granting a motion to strike. Specifically, because the Patent Owner Response opposed Grounds 2 and 3 only by analyzing the contents of Lehmann I, its arguments against Grounds 2 and 3 in the Sur-Reply based on Lehmann II are—by definition—a “new theory” as to why those grounds are allegedly insufficient. The CTPG expressly provides that this sort of clear-new-theory situation is sufficient to justify striking the new theories from an offending

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<sup>3</sup> “Any arguments not raised in the response may be deemed waived.” Paper 7, 9.

brief. CTPG at 81.

In its improper Sur-Reply, Patent Owner attempts to minimize the fact that it analyzed the wrong reference and will likely do so again in response to this Motion. Paper 16 at 16–17. But this is not a simple situation of “citation error,” as the Patent Owner would have the Board believe. If Patent Owner had analyzed the disclosure of Lehmann II, but inadvertently cited to “Ex. 1010,” that would be an example of a simple citation error and Petitioner would have had no need to raise it with the Board.

Patent Owner’s failures here are of an entirely different class, however, because *the disclosures relied upon by Patent Owner are from Lehmann I*. They differ in significant respects from the disclosures of Lehmann II, a reference that was published over a decade after Lehmann I. For example, Patent Owner quotes “Lehmann II” as disclosing that the “camera captures digital color images of the tooth, which are processed to form pseudo-pixels corresponding to areas of the tooth surface, and then compared to images of tooth shades relating to reference shade guides.” Paper 16, 27. *This statement is only in Lehmann I; it does not appear in Lehmann II*. Indeed, Lehmann II contains no discussion of “pseudo-pixels” at all.

This error also infects the analysis performed by Patent Owner’s expert Dr. Saber. Again, Dr. Saber’s failure to cite to Lehmann II<sup>4</sup> is not a mere “citation error,”

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<sup>4</sup> As with the Response, a search of the body of Dr. Saber’s Declaration turns up zero citations to “Ex. 1011” (Lehmann II).

but a fundamental failure to analyze a reference on which the Board instituted trial. For instance, one of the core allegations made by Dr. Saber is that a person of ordinary skill in the art would not have combined Korten with Lehmann II because “Lehmann II discloses the use of images, not points as disclosed in Korten.” Ex. 2008 ¶ 90. Even if this were true of Lehmann I, it is certainly not true of Lehmann II, which discloses images captured at the pixel level (i.e., points). *See, e.g.*, Ex. 1011 ¶ [0066]. It is abundantly clear Dr. Saber analyzed the wrong reference.

In the remainder of its improper Sur-Reply section, Patent Owner attempts to provide the analysis of Lehmann II that was missing from its Response. Paper 16 at 18–21. These arguments are plainly prejudicial to Petitioner. If this analysis had been presented in the Response as required, Petitioner would have had the opportunity to respond, and more importantly, to have its expert, Dr. Foroosh, provide testimony in response. If these portions of the Sur-Reply are allowed to remain in the record, Petitioner will have no such opportunity. The ability to address these new arguments at oral hearing is not a sufficient substitute for the opportunity to present evidence in response. The only sufficient remedy is striking this belated analysis from the record.

#### **IV. RELIEF REQUESTED**

For the foregoing reasons, Petitioner respectfully requests the Board grant this Motion to Strike, and strike Section II.B. of Patent Owner’s Sur-Reply (Paper 16).

Respectfully Submitted,

Dated: November 12, 2024

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**CERTIFICATE OF SERVICE**

I hereby certify that on November 12, 2024, I caused a true and correct copy of the foregoing PETITIONER'S MOTION TO STRIKE PORTIONS OF PATENT OWNER'S SUR-REPLY to be served electronically via e-mail upon the following counsel.

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