

Filed on behalf of Patent Owner

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIT CORPORATION
Petitioner

v.

3SHAPE A/S
Patent Owner

Case No. IPR2023-01315
Patent 10,695,151

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

TABLE OF CONTENTS

	<u>Page</u>
I. LEGAL STANDARD	1
II. PROCEDURAL HISTORY	2
III. ARGUMENT.....	4
IV. CONCLUSION.....	5

APPENDIX A – LIST OF EXHIBITS

CERTIFICATE OF SERVICE

As authorized by the Board's Order dated November 5, 2024 (Paper 20), Patent Owner ("PO") submits this opposition to Petitioner's Motion to Strike Portions of Patent Owner's Sur-Reply ("Motion"). PO specifically requests that the Motion be denied.

I. LEGAL STANDARD

The "Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply." *See* Consolidated Trial Practice Guide (CTPG) at 80. As such, "striking the entirety or a portion of a party's brief is an exceptional remedy that the Board expects will be granted rarely." *Id.* Parties are not barred from elaborating on their arguments on issues previously raised. *Chamberlain Grp. Inc. v. One World Techs. Inc.*, 944 F.3d 919, 925 (Fed. Cir. 2019). Moreover, "there is a strong public policy for making all information filed in an administrative proceeding available to the public." *Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00010, Paper 59 at 40 (PTAB Feb. 24, 2014). When Petitioner challenges PO's argument and evidence, without acknowledging that any portions constitute proper reply, such lack of specificity is fatal to a motion to strike. *Neuroderm Ltd. v. Abbvie Inc.*, PGR2022-00040, Paper 77 at 47 (PTAB Oct. 31, 2023).

II. PROCEDURAL HISTORY

Ground 2 of the Petition challenged Claims 1, 2, 4, 5, 9, and 12–16 over Korten (EX1009) and Lehmann II (EX1011). Petitioner relied solely on Lehmann II for the disclosure of claim limitations [1b] (“Lehman II discloses this limitation”) and claim limitation [1c] (Lehman II discloses this limitation”). Pet., 30

PO filed a Patent Owner Response (“POR”). PO made numerous arguments explaining how Lehman II does not disclose claim elements [claim 1b] and [claim1c]. For example, PO argued that “Petitioner fails to explain how Lehmann II determines a tooth shade value for at least one point on the tooth based on the texture data of the corresponding point of a 3D digital representation.” POR, 26. PO argued that, like Korten, “Lehmann II makes no reference to determining a tooth shade value based on the texture (comprising at least one of color or surface roughness) data of the corresponding point of a digital 3D representation.” *Id.* at 27. PO argued “Lehmann II makes no reference to a digital 3D representation containing shape and texture data at all.” *Id.* PO argued that “Lehmann II does not disclose obtaining a certainty score or accuracy value of the tooth shade based on data on the texture of a digital 3D representation continuing shape and texture data.” *Id.* at 28. PO argued that “Lehmann II makes no reference to a digital 3D representation at all.” *Id.* at 29.

Petitioner filed a Reply (“PR”). Petitioner argued that the “only portion of Lehmann II being incorporated into Korten involves the process for determining the

‘best fit’ tooth shade value.” PR, 14. However, this new argument is inconsistent to what was originally presented in the Petition. Again, the Petition states, under headings B.1.c. and B.1.d, that Lehmann II discloses the entirety of limitations 1[b] and 1[c], *i.e.*, Petitioner did not originally argue that Korten taught any aspect of limitations 1[b] or 1[c]. Pet., 30. Petitioner’s original arguments did not address Petitioner’s new assertion that Lehmann II does not disclose elements of claim limitations 1[b] or 1[c]. Instead of addressing PO’s substantive arguments, Petitioner states that “Patent Owner and its expert analyzed the wrong [Lehmann] reference.” PR, 12.

In response to Petitioner’s Reply, PO filed a Sur-Reply (“POSR”). In the POSR, PO explained that Petitioner raised a new argument that the “only portion of Lehmann II being incorporated into Korten involves the process for determining the ‘best fit’ tooth shade value.” POSR, 15. PO acknowledges that its citations to Lehmann I (EX1010) in place of Lehmann II (EX1011) were inadvertent citation errors but, as discussed above, did address the correct underlying Lehmann II reference and explained the failures of the reference in disclosing the features of claim limitations [1b] and [1c]. *Id.* at 16. PO had argued that it was apparent that the underlying arguments are the same regardless of whether PO cited to Lehmann I or Lehmann II. POSR, 16-17. PO further responded to Petitioner’s reliance on “best fit” arguments presented in the PR and in Dr. Foroosh’s declaration. POSR,

17-20.

III. ARGUMENT

Petitioner's Motion should be denied for at least four reasons.

First, Petitioner has not demonstrated that PO has attempted to rely on any new evidence or new theory that was not already in the record. Instead, Petitioner asserts that PO provides cites to the wrong Lehmann reference. However, there is no prejudice because Petitioner recognized that the citation errors were "clear when considering that [PO] cites column and line numbers in discussing 'Lehmann II,' but Lehmann II is a published U.S. patent application, and any citations would be to paragraph numbers." PR, 12. The citation to Lehmann I was in connection with PO's statement that "Lehmann II discloses the use of a digital camera connected to a tooth shade analyzer subsystem." POR, 27. Petitioner also cannot deny that the relevant text from Lehmann I (of the use of a digital camera) is also found in Lehmann II. It is apparent that the underlying arguments are the same regardless of whether PO cited to Lehmann I or Lehmann II. Petitioner is requesting an extraordinary remedy for what is, at best, a simple inconvenience.

Two, Petitioner had every opportunity to respond to the failures of Lehmann II to disclose claim limitations 1[b] and 1[c] but chose not to address those deficiencies in its PR. Petitioner can further argue at oral argument how the Petition purportedly explains where Lehmann II discloses claim elements 1[b] and 1[c].

Instead, Petitioner seeks to side-step the issue on citation errors as a “gotcha.” This Motion is a red herring designed to take attention away from the fact that Petitioner’s arguments still do not address the fact that Lehmann II does not disclose limitations 1[b] or 1[c].

Three, Petitioner seeks to strike the entirety of the argument related to Ground 2 based on citation errors without any recognition of the properly presented arguments. Under the facts of this case, Petitioner challenges all of PO’s argument and evidence addressing Ground 2 in the POSR without acknowledging that any portions constitute proper reply. Simple fairness dictates denial.

Four, Petitioner does not address the fact that it newly raised that the “only portion of Lehmann II being incorporated into Korten involves the process for determining the ‘best fit’ tooth shade value.” PR, 14. Petitioner also provided new arguments as to why the combination of 2D color with a 3D image is purportedly irrelevant to the combination of Korten and Lehmann II. PR, 16-18. These new arguments should be ignored. However, regardless of whether the arguments are ignored, PO should have the ability to respond to any new argument presented by Petitioner in its PR.

IV. CONCLUSION

For the foregoing reasons, Petitioner’s Motion to Strike Portions of Patent Owner’s Sur-Reply should be denied.

Respectfully submitted,

Date: November 19, 2024

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APPENDIX A - LIST OF EXHIBITS

Exhibit No.	Description
1009	U.S. Patent No. 10,028,810 (“Korten”)
1010	U.S. Patent No. 6,206,691 (“Lehmann I”)
1011	U.S. Publication No. 2011/0188086 (“Lehmann II”)

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSITION TO PETITIONER'S MOTION TO STRIKE PORTIONS OF PATENT OWNER'S SUR-REPLY** is being served on counsel for Petitioner by electronic mail this 19th day of November, 2024 as follows:

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