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
U.S. Patent No. 10,695,151

JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Medit Corporation ("Petitioner") and Patent Owner 3Shape A/S ("Patent Owner") hereby jointly request that the above-referenced pending *inter partes* review be terminated. The Board authorized the filing of this motion in an email to the Parties on November 26, 2024.

"There are strong public policy reasons to favor settlement between the parties to a proceeding." Consolidated Trial Practice Guide 86 (Nov. 2019). As such, "[t]he Board expects that a proceeding will terminate after the filing of a settlement agreement." *Id.*; *see also* 35 U.S.C. § 317(a) ("An *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed").

Here, the Parties respectfully submit that termination is appropriate because they have reached an agreement resolving their entire dispute involving the patent at issue in this *inter partes* review, including the copending District Court proceeding between the Parties. The Board has not issued a final written decision or decided the merits of the proceeding. Moreover, the Parties have filed a joint notice of resolution and motion to stay with the United States District Court for the Western District of Texas on November 15, 2024 in the copending lawsuit styled *3Shape A/S v. Medit Corp.,* Case No. 6:22-cv-00443-ADA (W.D. Tex.), and the Court has granted the

stay. The Parties do not anticipate further litigation between them concerning the involved patent. Further, terminating the proceeding now would thus serve the interests of preserving the Board's resources and the mutual interest of the Parties.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner submit concurrently herewith a true and correct copy of the Settlement and Release Agreement governing the resolution of the *inter partes* review and underlying litigation. *See* Confidential Exhibit 1021. There are no other collateral agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

The Parties are concurrently filing a joint request that the Settlement and Release Agreement, Confidential Exhibit 1021, be treated as business confidential information, be kept separate from the file of the involved patents, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 42.74(c).

In further response to the email to the Parties on November 26, 2024, the Parties provide below an update on the status of litigation and proceedings involving the subject patent.

Case Name	Case No.	Court	Case Filing Date	Case Status
Dental Imaging Technologies Corporation d/b/a DEXIS v. 3Shape A/S	IPR2024-00849	PTAB	April 25, 2024	Terminated
Medit Corporation v. 3Shape A/S	IPR2023-01315	PTAB	August 18, 2023	Pending
Dental Imaging Technologies Corporation d/b/a DEXIS v. 3Shape A/S	IPR2023-00400	PTAB	December 21, 2022	Terminated
3Shape A/S v. Carestream Dental LLC	1:22-cv-01829	N.D. Ga.	May 9, 2022	Pending
3Shape A/S v. Medit Corporation	6:22-cv-00443	W.D. Tex.	May 2, 2022	Stayed, Final Settlement Agreement Executed, Joint Motion to Dismiss to be filed in early January after certain obligations under the Agreement are completed.
3Shape A/S v. Carestream Dental LLC	6:21-cv-01110	W.D. Tex.	October 26, 2021	Terminated

3Shape A/S advises that Civ. Action No. 1:22-cv-01829 (N.D. Ga.) is ongoing against Carestream Dental LLC. Carestream Dental LLC was a real party-in-interest

in IPR2023-00400 and IPR2024-00849, both of which have been terminated.

Dated: December 4, 2024

Respectfully submitted,

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