

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DENTAL IMAGING TECHNOLOGIES CORPORATION,

Petitioner,

v.

3SHAPE A/S,

Patent Owner.

Case IPR 2024-00849

Patent No. 10,695,151

**MOTION FOR JOINDER TO
INTER PARTES REVIEW IPR2023-01315**

TABLE OF CONTENTS

	<u>Page</u>
I. STATEMENT OF THE PRECISE RELIEF REQUESTED	1
II. STATEMENT OF MATERIAL FACTS	2
III. STATEMENT OF REASONS FOR RELIEF REQUESTED	3
A. Legal Standard.....	3
B. Petitioner’s Motion For Joinder Is Timely.....	3
C. Every Factor Weighs In Favor Of Joinder.	4
1. Joinder Is Appropriate With The Medit IPR.....	5
2. Petitioner Proposes No New Grounds Of Unpatentability.	5
3. Joinder Will Not Unduly Burden Or Negatively Impact The Medit IPR Trial Schedule.	6
4. Procedures To Simplify Briefing And Discovery.....	8
IV. GENERAL PLASTIC IS GENERALLY INAPPLICABLE AND FAVORS PETITIONER	9
1. Factor 1: “whether the same petitioner previously filed a petition directed to the same claims of the same patent”	11
2. Factors 2, 4, and 5: “whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it,” “the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition,” and “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent”	11
3. Factor 3: “whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition”	12

4. Factors 6 & 7: “the finite resources of the Board” and “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review”	13
V. CONCLUSION.....	13

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Dental Imaging Technologies Corporation (“Petitioner”) respectfully submits this Motion for Joinder (“Motion”), together with a Petition for *Inter Partes* Review of U.S. Patent No. 10,695,151 (“DITC Petition”), filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Medit Corporation v. 3Shape A/S*, IPR2023-01315 (the “Medit IPR”) in view of the Board’s decision to institute trial on March 28, 2024 (Medit IPR, Paper 6). Counsel for Petitioner has conferred with counsel for Medit Corporation (“Medit”), and counsel for Medit does not object to Petitioner joining IPR2023-01315.

Petitioner’s request for joinder is timely under 37 C.F.R. § 42.122(b) as it is submitted no later than one month after the March 28, 2024 institution date of the Medit IPR. The DITC Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Medit IPR. In addition, Petitioner is willing to follow the Medit IPR Scheduling Order.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Medit IPR while efficiently resolving whether claims 1, 2, 4, 5, 9, 10, and 12-17 of the ’151 Patent are valid.

II. STATEMENT OF MATERIAL FACTS

1. The '151 Patent is at issue in an infringement action against DITC in the Northern District of Georgia: Case No. 1:22-cv-01829-WMR (N.D. Ga.). This action was transferred from the Western District of Texas, where it was assigned Case No. 6:21-cv-1110-ADA.

2. The '151 Patent is at issue in other civil actions: *3Shape A/S v. Medit Corporation*, 6:22-cv-00443 (W.D. Tex.).

3. The '151 Patent is the subject of the following Board Proceeding: *Medit Corporation v. 3Shape A/S*, IPR2023-01315.

4. The '151 Patent was formerly at issue in the following Board Proceedings: *Dental Imaging Technologies Corporation v. 3Shape A/S*, IPR2023-00400.

5. On August 18, 2023, Medit filed a petition for *inter partes* review (IPR2023-01315) requesting cancellation of claims 1, 2, 4, 5, 9, 10, and 12-17 of the '151 Patent.

6. On March 28, 2024, the Board instituted the Medit IPR.

7. The DITC Petition and the Medit IPR are substantively identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims, using substantially the same evidence and arguments.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers several factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013); Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 76-78.

B. Petitioner's Motion For Joinder Is Timely.

This Motion for Joinder is timely because it is filed within one month of the March 28, 2024 institution decision of the Medit IPR. 37 C.F.R. § 42.122(b). Further, the one-year bar set forth in 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b) does not apply to the DITC Petition because this Motion for Joinder is filed concurrently with the DITC Petition. 37 C.F.R. § 42.122(b).

C. Every Factor Weighs In Favor Of Joinder.

All four factors considered by the Board weigh in favor of joinder. Specifically, the DITC Petition does not present any new grounds of unpatentability; it is substantively identical to the Medit Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical, and Petitioner will accept an “understudy” role unless and until Medit is terminated from the proceeding. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate here.

The Board routinely grants motions for joinder in view of pending litigations involving the same patent and the same parties. *See, e.g., Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00224, Paper 10 at 2-7 (PTAB April 6, 2020) (granting motion for joinder of a copycat petition in view of co-pending lawsuit); *Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 2-13 (PTAB May 30, 2019) (same); *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 2-15 (PTAB Oct. 30, 2018) (same); *Huawei Device Co., Ltd. v. Uniloc Luxembourg S.A.*, IPR2017-02090, Paper 9 at 2-12 (PTAB March 6, 2018) (same); *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-02063, Paper 25 at 4-8 (PTAB Feb. 21, 2018) (same); *General Motors LLC v. Neo Wireless LLC*, IPR2023-00963, Paper 10 at 2-20 (PTAB Dec. 6, 2023) (same); *T-Mobile USA, Inc. v. Dali Wireless, Inc.*, IPR2023-00830, Paper 7 at 2-11 (PTAB Oct. 11, 2023)

(same); *Cooler Master Co., Ltd. v. Asektek Danmark A/S*, IPR2023-00667, Paper 6 at 2-13 (PTAB Aug. 28, 2023) (same).

1. Joinder Is Appropriate With The Medit IPR.

Joinder with the Medit IPR is appropriate because the DITC Petition involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Medit Petition. The DITC Petition is substantively identical to the Medit Petition, containing only minor differences unrelated to the merits of the proposed grounds. There are no changes to the facts, citations, evidence, or arguments presented in the DITC Petition in relation to the grounds of the Medit Petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Medit IPR so that the Board can efficiently resolve all grounds in both the DITC and Medit Petitions in a single proceeding. Moreover, as explained previously, the Medit IPR petition presents compelling unpatentability challenges, resolving the merits of the Medit petition is in the interest of justice, and joinder is appropriate in such circumstances. *Code200 v. Bright Data Ltd.*, IPR2022-00861, Paper 19 at 39.

2. Petitioner Proposes No New Grounds Of Unpatentability.

The DITC Petition does not present any new grounds of unpatentability. The DITC Petition is substantively identical to the Medit Petition. The DITC Petition

presents the unpatentability of the same claims of the same patent in the same way as the Medit Petition. The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted) (emphasis original); *see also STMicroelectronics, Inc. v. Lone Star Silicon Innovations, LLC*, IPR2018-00436, Paper 7 at 5 (PTAB May 4, 2018) (granting joinder and reasoning, “[w]e rely in particular, on Petitioner’s representation that its Petition is ‘substantially identical’...challenges the same claims based on the same prior art and the same grounds of unpatentability....”).

3. Joinder Will Not Unduly Burden Or Negatively Impact The Medit IPR Trial Schedule.

Because the DITC Petition is substantively identical to the Medit Petition, with the same grounds applied to the same claims as instituted by the Board, there are no new issues for Patent Owner to address. Due to the same issues being presented in the Medit Petition, Patent Owner will not be required to present any additional responses or arguments. *LG v. Memory Integrity, LLC*, IPR2015-01353, Paper 11, at 6 (Oct. 5, 2015) (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR].”); *see also id.*, Paper 4 at 5–7.

The Patent Owner Response will also not be negatively impacted because the issues presented in the Medit Petition are identical to the issues presented in the DITC Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Medit Petition. Also, because the DITC Petition relies on the same expert and a substantively identical declaration, only a single deposition is needed for the proposed joined proceeding.¹

Joinder of this proceeding with the Medit IPR would not unduly burden or negatively impact the trial schedule in any meaningful way. Further, even if a small adjustment of the trial schedule were necessary, this is already provided for in the rules and is a routine undertaking by parties in IPR proceedings. See 37 C.F.R. § 42.100(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough of a reason to deny joining the present DITC Petition with the Medit IPR.

¹ Petitioner DITC has engaged Dr. Hassan Foroosh, Ph.D., Medit's expert for the Medit IPR. Petitioner DITC has submitted Dr. Foroosh's declaration from the Medit IPR in unaltered form, except for the exhibit labeling and the removal of discussion of Exhibit 1005, Patent Owner's sealed infringement contentions against Medit, from the table of exhibits and paragraphs 153-154.

4. Procedures To Simplify Briefing And Discovery

The Medit Petition and the DITC Petition present substantively identical grounds of rejection, including the same prior art combinations against the same claims. Additionally, Petitioner explicitly agrees to take an “understudy” role, as described by the Board:

“(a) all filings by [Petitioner] in the joined proceeding [will] be consolidated with [the filings of the petitioner in the Medit IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Medit IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Medit IPR], or introduce any argument or discovery not already introduced by [the petitioner in the Medit IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Medit IPR] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Medit IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Medit IPR].”

See IPR2014-00550, Paper 38 at 5 (Apr. 10, 2015).

Petitioner DITC will assume the primary role only if Medit ceases to participate in the Medit IPR. Counsel for DITC has conferred with counsel for Medit, and Medit does not object to Petitioner DITC joining IPR2023-01315 in an

“understudy” role. By Petitioner accepting an “understudy” role, Patent Owner and Petitioner DITC can comply with the current trial schedule and avoid any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that may result due to joinder. See, e.g., *Garmin Int’l, Inc. v. Philips North Am. LLC*, IPR2020-00910, Paper 8 at 45, 47-50 (PTAB Nov. 19, 2020) (granting joinder where petitioners agreed to accept an “understudy” role); *STMicroelectronics*, IPR2018-00436, Paper 7 at 5 (similar).

IV. GENERAL PLASTIC IS GENERALLY INAPPLICABLE AND FAVORS PETITIONER

In *General Plastic*, the Board sets forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the Board. In the current motion, DITC merely seeks to join Medit’s proceeding in an understudy rule and does not present any new grounds. The PTAB has previously found that such circumstances “effectively neutralize[]” a *General Plastic* analysis. See *Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21, 2018) (instituting a joinder copycat petition where petitioner agreed to assume a passive understudy role, and noting such circumstances “effectively neutraliz[es] the *General Plastic* factors”); see also *Celltrion, Inc. v. Genetech, Inc.*, IPR2019-01019, Paper 11 at 10 (PTAB Oct. 30, 2018) (noting the joinder motion “effectively obviates any concerns of serial harassment and unnecessary expenditures of

resources”) and *Code200*, Vidal Remand (Paper 18) (finding roadmapping and other *General Plastic* concerns generally inapplicable or of limited relevance when a motion for joinder presents a copycat petition).

On balance, the *General Plastic* factors counsel against discretionary denial, *i.e.*, in favor of instituting the present IPR and joining it with the Medit IPR. *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i).

Petitioner acknowledges the Board’s precedential decision in *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (precedential) (“Uniloc”) governs the application of the *General Plastic* factors to joinder petitions. *Uniloc*, however, is distinguishable because, unlikely in *Uniloc*, the *General Plastic* factors favor institution here. In particular, with respect to *General Plastic* factors 2, 4, and 5, DITC represents that at the time of filing of DITC’s first petition (IPR2023-00400), counsel for DITC in any of the actions involving 3Shape had not identified or considered three of the five prior art references on which the Medit IPR was instituted, despite extensive prior art searching. Ex. 1018 (invalidity contentions). The references are also not cited on the face of the ’151 patent. Ex. 1001. DITC promptly filed the present Petition and accompanying Motion for Joinder upon institution of the Medit IPR, in accordance with § 315(c). Moreover, factors 6 and 7, which relate to Board efficiency and resources, favor instituting the

pending petition and granting the motion for joinder. Thus, on balance, the *General Plastic* factors weigh in favor of instituting the pending petition and granting the motion for joinder.

1. Factor 1: “whether the same petitioner previously filed a petition directed to the same claims of the same patent”

DITC previously filed a Petition seeking *inter partes* review of the '151 Patent, for which institution was denied. However, this factor only slightly weighs against institution and joinder in the present proceeding because DITC seeks to assume an understudy role and counsel for DITC was not aware of three of the five prior art references that formed the basis of the grounds on which the Medit IPR was instituted.

2. Factors 2, 4, and 5: “whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it,” “the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition,” and “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent”

Factors 2, 4, and 5 weigh in favor of instituting the present IPR and joining it with the Medit IPR. In the DITC Petition, counsel for DITC represents that, at the time of filing of the first petition, the counsel for DITC in any proceeding against 3Shape was not aware of three of the five prior art references on which the Medit IPR was instituted. DITC filed its first petition on December 21, 2022. Attached as

Exhibit 1018 are DITC's invalidity contentions dated November 7, 2022. Those confirm that, although DITC was aware of Babayoff and Lehmann I, it was not aware of Korten (U.S. Patent No. 10,028,810), Pye (U.S. Patent No. 7,341,450), or Lehmann II (U.S. Publ. No. 2011/0188086). Moreover, none of Korten, Pye, or Lehmann II are cited on the face of the '151 patent. Ex. 1001. DITC then promptly filed the present Petition and accompanying Motion for Joinder upon institution of the Medit IPR, in accordance with § 315(c).

3. Factor 3: “whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition”

This factor does not weigh against joinder. As discussed above, the DITC Petition is substantively identical to the Medit Petition. DITC seeks to take on an understudy role as to Medit's invalidity positions, and has not raised additional arguments that would have benefited from the Patent Owner's preliminary response or the Board's decision with respect to the first petition. Petitioner acknowledges that Patent Owner filed a preliminary response and that the Board issued an institution decision in IPR2023-00400, filed by Petitioner. Indeed, these papers are included as exhibits to the Medit Petition. However, given that different art is raised in the Medit Petition than in IPR2023-00400, the POPR and ID filed in connection with IPR2023-00400 do not provide Petitioner with any benefit here.

4. Factors 6 & 7: “the finite resources of the Board” and “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review”

Factors 6 and 7, which relate to Board resources and efficiency, weigh in favor of instituting the pending petition and granting the motion for joinder. The Board has recognized numerous times since *Uniloc* that “Board resources are not a concern [where a new party joins a pending petition] because this panel has the capacity to see the [Medit] IPR to its conclusion regardless of the constitution of the petitioner.” *See Google v. Express Mobile*, IPR2022-00791, Paper 15 at 12 (PTAB Oct. 7, 2022); *Advanced Micro Devices Inc. v. Monterey Research LLC*, IPR 2021-00776, Paper 13 at 17-18 (PTAB Oct. 13, 2021). Moreover, there is no reason why DITC joining the Medit IPR as an understudy would affect the Board’s ability to timely issue a final written decision. *See Express Mobile* at 13; *Advanced Micro* at 18. No changes in the schedule will be necessary, and the limited participation, if any, of DITC will not impact the timeline of the ongoing proceeding.

V. CONCLUSION

For the foregoing reasons, DITC respectfully requests the Board grant DITC’s Petition and Motion for Joinder with the Medit IPR.

CERTIFICATE OF SERVICE

I hereby certify that on April 25, 2024, I caused a true and correct copy of the foregoing Motion for Joinder and associated exhibits to be served via overnight courier upon the following counsel of record for Patent Owner per 37 CFR §§ 42.105(a) and 42.205(a).

Patent Office Counsel of Record	Litigation Counsel of Record
William C. Rowland Buchanan, Ingersoll & Rooney PC 1737 King Street, Suite 500 Alexandria, VA 22314-2727	Kimberly E. Coghill TROUTMAN PEPPER HAMILTON SANDERS LLP 401 9th Street, N.W., Suite 1000 Washington, DC 20004 Tel: 202.220.1246

I further certify that I served courtesy copies of the foregoing documents via electronic mail on April 25, 2024, upon Patent Owner's counsel of record as follows:

Patent Office Counsel of Record	Litigation Counsel of Record
William C. Rowland Buchanan, Ingersoll & Rooney PC 1737 King Street, Suite 500 Alexandria, VA 22314-2727	Kimberly E. Coghill TROUTMAN PEPPER HAMILTON SANDERS LLP 401 9th Street, N.W., Suite 1000 Washington, DC 20004 Tel: 202.220.1246

Courtesy copies of the same documents were served electronically by email at the following addresses:

Ana Spone: ana.spone@troutman.com

Bryan J. Cannon: bryan.cannon@troutman.com

Frank Liu: frank.liu@troutman.com

Gregory Len: gregory.len@troutman.com

Kimberly E. Coghill: kimberly.coghill@troutman.com

William D. Belanger: william.belanger@troutman.com

Puja Patel Lea: puja.lea@troutman.com

Dated: April 25, 2024

/s/ John T. McKee

John T. McKee

Quinn Emanuel Urquhart & Sullivan LLP