

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

PETITIONER'S REPLY TO MOTION FOR JOINDER

Dental Imaging Technologies Corporation (“Petitioner”) respectfully submits this Reply to its Motion for Joinder (Paper 3, “Mot.”), in response to Patent Owner’s Opposition to Petitioner’s Motion (Paper 7, “Opp.”). As outlined in the Motion, the *General Plastic* factors weigh in favor of institution, not denial.

A. *General Plastic* Factor 1

The first factor addresses previous IPR petitions. Petitioner does not dispute that it previously sought *inter partes* review of the ’151 Patent. In this proceeding, however, Petitioner will assume an *understudy* role—a fact PO does not address. As a result, this factor weighs only slightly against institution.

B. *General Plastic* Factor 2

The second factor addresses knowledge of the prior art references in the joinder petition. In its invalidity contentions, Petitioner identified *fifty* prior art patents and printed publications for the ’151 patent. Ex. 1018 at 14-16. The Korten, Pye, and Lehmann II references included in Medit’s IPR are not listed. PO has a three-prong response: PO argues (1) the publication of the Korten reference is listed on the face of the ’151 patent; (2) Pye has the same disclosures as Graham in Petitioner’s first IPR; and (3) the Medit art would have come up in a robust search.

First, Petitioner does not dispute it was aware of other references by Korten. Indeed, Petitioner’s invalidity contentions include other Korten references for the ’151 Patent. Ex. 1018 at 12. Nor does Petitioner dispute the ’151 patent cites the

publication of Korten. However, neither Petitioner’s invalidity contentions nor the ’151 patent cite the *same* Kortens reference used in Medit’s IPR, which is an issued U.S. patent. Ex. 1001; Ex. 1018. Notably, the Korten publication highlighted by PO was not cited by the Examiner during prosecution. Ex. 1001 at 2.

Second, Petitioner acknowledges that the Graham reference included in its first IPR is the publication of the Pye reference in Medit’s IPR. Petitioner was unaware of the relationship between the references due to the way the inventors’ names are presented on the two references. *Compare* Ex. 1012 *with* Ex. 2003. Petitioner submits, however, that this should not change the weighting of this factor, because Petitioner was unaware of other references.

Third, PO argues that Petitioner *should have* found the Lehmann II reference. In so doing, PO tacitly acknowledges that Lehmann II is not cited in the ’151 patent or in Petitioner’s contentions. PO’s argument—that a “skilled searcher” would have found Lehmann II—is a strawman. PO crafts its own search, which turns up “114 listed utility patent documents.” Opp. at 6. PO’s strawman search is exceptionally broad and is based on the patent’s *title* (“detecting tooth shade”) rather than its *contents* or its *claims*. Petitioner’s search, in contrast, focused on the claims and uncovered 50 patents and printed publications. Ex. 1018 at 14-16. Petitioner employed “skilled searchers” to find these results and did not uncover Lehmann II.

Ultimately, there is no dispute that Petitioner was not aware of Lehmann II.

This is critical to the weighting off this factor, as Lehmann II is one of the references used in Grounds 2-3 in combination with Korten and Babayoff. Petitioner therefore neither “knew of the prior art” in the Medit petition nor “should have been aware of it” and factor 2 weighs in favor of institution.

C. General Plastic Factor 3

The third factor addresses whether Petitioner has previously received a POPR or institution decision and, as with factor 1, Petitioner does not dispute it has. However, because Petitioner is assuming an understudy role, this factor should carry little weight. Moreover, there can be no dispute that the majority of the prior art raised in Medit’s IPR is different than in Petitioner’s first IPR petition. Indeed, PO does not dispute that *Korten*—Medit’s primary reference for all grounds, included as anticipatory art in Ground 1—*was not included in Petitioner’s first IPR*. Thus, the Board’s decision in Petitioner’s first IPR does not bear on Medit’s IPR or the instant Petition, which rely on different art. Indeed, the ID and POPR in Petitioner’s first IPR were attached as exhibits to Medit’s IPR, and it was instituted regardless.

D. General Plastic Factor 4

The fourth factor addresses the length of time after learning of the prior art references before the petition was filed. Here, PO’s argument is the same as for factor 2—the baseless allegation that Petitioner *was* aware of the Medit prior art references and waited to file its joinder petition to get a “second bite” at the ’151

patent. To the contrary, the reality is the Medit IPR was instituted and Petitioner filed its copycat Petition within one month of institution, as required by rule. 37 C.F.R. § 42.122(b). Again, Petitioner will assume an understudy role to Medit, and if Medit succeeds in invalidating the '151 patent, the '151 patent will be invalid regardless. Petitioner's joinder petition is fully above board—Petitioner is not gaming the system, as PO suggests, but instead is merely taking advantage of the statutory joinder process to act as an understudy to Medit.

E. General Plastic Factor 5

The fifth factor addresses the time elapsed between filing multiple petitions. PO accuses Petitioner of “neglect[ing] to inform the Board” of the Carestream Dental case, but Petitioner *did identify Carestream as an RPI*. Pet. at 64-65. There is no dispute that Petitioner filed its joinder petition after its bar date; however, there can be no dispute that the 1-year bar does not preclude joinder petitions. TPG at 76-77. The governing joinder statute allows the Director to join “any person who properly files a petition under section 311,” and there is no dispute Petitioner has done so here. 35 U.S.C. § 315(c). Nor is there any prejudice to PO, as the Medit IPR will proceed irrespective of Petitioner's joinder petition.

F. General Plastic Factor 6

The sixth factor addresses the finite resources of the Board. PO claims this proceeding “taxes the finite resources of the Board” because PO “has additional

arguments to present.” Opp. at 12. But it is well-settled 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).

With respect to Petitioner’s email to the Board, no such email is required to perfect Petitioner’s Motion. Instead, as the TPG makes clear, the “purpose of the conference call is for the panel to timely manage the proceedings. TPG at 76. In any event, there is no dispute that Petitioner *did* send the required email arranging a conference call, but that no call has been scheduled. The scheduling of an optional conference call does not weigh for or against institution.

G. General Plastic Factor 7

The seventh factor relates to whether the joinder petition would affect the requirement for the Board to issue a FWD within one year. PO’s Opposition does not address this factor. *See, generally*, Opp. Regardless, this factor favors institution. There is no reason why Petitioner 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.

CERTIFICATE OF SERVICE

I hereby certify that on June 13, 2024, I caused a true and correct copy of the foregoing Reply to be served via overnight courier upon the following counsel of record for Patent Owner as follows:

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Dated: June 13, 2024

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