

Filed on behalf of Petitioners

By: Todd R. Walters, Esq. (todd.walters@bipc.com)
Roger H. Lee, Esq. (roger.lee@bipc.com)
Andrew R. Cheslock, Esq. (andrew.cheslock@bipc.com)
Mythili M. Markowski, Ph.D. (mythili.markowski@bipc.com)
Buchanan Ingersoll & Rooney PC
1737 King Street, Suite 500
Alexandria, Virginia 22314
Main Telephone (703) 836-6620
Main Facsimile (703) 836-2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3SHAPE A/S and 3SHAPE INC.
Petitioners

v.

MEDIT CORPORATION
Patent Owner

Case No. IPR2024-01266
Patent 9,262,864

**PETITIONERS' RANKING OF PETITIONS AND EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS**

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I. INTRODUCTION

3Shape A/S and 3Shape Inc. (“Petitioners”) have filed two concurrent *inter partes* review Petitions, IPR2024-01265 and IPR2024-01266, each challenging different claims of U.S. Patent No. 9,262,864 (“the ’864 Patent”). Petitioners submit this paper “[t]o aid the Board in determining whether more than one petition is necessary” and identify “a ranking of the petitions in the order in which it wishes the Board to consider the merits.” Consolidated Trial Practice Guide (“CTPG”) (Nov. 2019) at 59-60.

II. RANKING OF PETITIONS

Petitioners request that the Board consider the Petitions in the following order:

Rank	Petition	Grounds and References
1	IPR2024-01265	<u>Ground 1 (Claims 3-7, 9-13):</u> U.S. Patent Pub. No. 2003/0018250 (“Trousset”) (EX1008) in view U.S. Patent Pub. No. 2002/0055082 (“Durbin”) (EX1012) <u>Ground 2 (Claims 3-5, 7, 9, 11, 13):</u> U.S. Pat. Pub. No. 2006/0119622 (“Kariathungal”) (EX1009) in view of Durbin <u>Ground 3 (Claims 6, 12):</u> Kariathungal in view Durbin, and in further view of Trousset
2	IPR2024-01266	<u>Ground 1 (Claims 1, 2, 15-20):</u> U.S. Patent No. 5,417,572 (“Kawai”) (EX1010), in view of U.S. Patent Publication No. 2004/0254476 (“Quadling”) (EX1011), and in further view of U.S. Patent Pub. No. 2002/0055082 (“Durbin”) (EX1012)

III. MATERIAL DIFFERENCES BETWEEN PETITIONS

The Board recognizes that “there may be circumstances in which more than one petition may be necessary” including “when the patent owner has asserted a large number of claims in litigation.” CTPG at 59-60. The ’864 Patent has a total of

twenty (20) claims, six (6) of which are independent. Patent Owner asserted sixteen (16) claims of those twenty (20)¹, including six (6) independent claims and ten (10) dependent claims. The Petitions together challenge eighteen (18) claims, inclusive of the asserted claims. The two petitions challenge different claims, using different prior art combinations. The first petition challenges Claims 3-7 and 9-13, of which 3 and 9 are independent. The second petition challenges Claims 1, 2, and 15-20, of which 1, 2, 15, and 18 are independent. The challenged claims of the second petition include limitations directed to “video” and “a margin of the dentition” not present in the challenged claims of the first petition, explaining the different prior art combinations.

Additionally, the '864 Patent is asserted in a pending lawsuit in which Petitioners are Defendants, *Medit Corporation v. 3Shape A/S*, Civ. Action No. 23-cv-00658 (W.D. Tex.). The litigation is relatively early in its schedule, and Patent Owner has not identified a final list of claims it intends to assert at trial.

IV. THE BOARD SHOULD INSTITUTE TRIAL FOR BOTH PETITIONS

Under the circumstances, Petitioners submit that a ranking of petitions is not necessary given that the petitions challenge different claims with no overlap. Petitioners request that the Board institute trial on both Petitions, however,

¹ Claims 1-6, 9-12, and 15-20.

Petitioners would not oppose the consolidation of the two proceedings upon institution.

Date: August 14, 2024

Respectfully submitted,

/Todd R. Walters/

Todd R. Walters, Esq. (Reg. No. 34,040)

BUCHANAN INGERSOLL & ROONEY PC

1737 King Street, Suite 500

Alexandria, Virginia 22314

Direct Telephone (703) 838-6556

Main Facsimile (703) 836-2021

todd.walters@bipc.com

Counsel for Petitioners

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 14th day of August, 2024, a true and correct copy of the foregoing **PETITIONERS' RANKING OF PETITIONS AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS** is being served by USPS Priority Mail Express on the correspondence address of record as follows:

3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

and a courtesy copy is being served to Patent Owner's litigation counsel as follows:

Douglas F. Stewart
Bracewell LLP
701 5th Avenue, Suite 3420
Seattle, WA 98104
(206) 204-6271
doug.stewart@bracewell.com
Bracewell-IP@bracewell.com

Date: August 14, 2024

/Todd R. Walters/
Todd R. Walters, Esq.
Registration No. 34,040
BUCHANAN INGERSOLL & ROONEY PC
1737 King Street, Suite 500
Alexandria, Virginia 22314
Main Telephone (703) 836-6620
Direct Telephone (703) 838-6556
Main Facsimile (703) 836-2021
todd.walters@bipc.com
Counsel for Petitioners