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. IPR2024-01268
Patent 9,191,648

JOINT MOTION TO TERMINATE PROCEEDING 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, Petitioners 3SHAPE A/S and 3SHAPE INC. ("Petitioners") and Patent Owner MEDIT CORPORATION ("Patent Owner") hereby request that the above-referenced pending *inter partes* review be terminated because the parties have reached an agreement resolving their entire dispute involving the patent at issue in this *inter partes* review, including the co-pending District Court proceedings between the Parties. The Board authorized the filing of this motion in an email to the Parties on January 21, 2025.

Petitioners filed its Petition on August 13, 2024 (Paper 3). Patent Owner has not filed its Preliminary Response.[1] The Board has yet to reach the merits and issue a decision on institution.

Good cause exists to terminate this proceeding because the parties have settled their dispute regarding the involved patent, the Patent Owner has not filed its POPR, and an institution decision has not been entered. Terminating the proceeding now

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[1] On November 21, 2024, Patent Owner informed the Board that the parties entered into a settlement agreement and requested a 60-day extension to file its Patent Owner's Preliminary Response Patent Owner ("POPR"). The Board granted Patent Owner's Request and set the due date for filing the POPR to January 20, 2025.

would thus serve the interest of judicial economy and the mutual interest of the parties.

The Parties filed a Joint Motion to Dismiss with the United States District Court for the Western District of Texas on January 14, 2025 in the co-pending lawsuits, *3Shape A/S v. Medit Corp.,* Case No. 6:22-cv-00443 (W.D. Tex.) and *3Shape A/S v. Medit Corp.,* Case No. 6:23-cv-00658 (W.D. Tex.). 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), Petitioners 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 1020. 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.

Petitioners are concurrently filing a joint request that the Settlement and Release Agreement, Confidential Exhibit 1020, be treated as business confidential information, be kept separate from the file of the involved patent, 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).

The status of the co-pending litigations is provided in the table below.

Case Name	**Case No.**	**Court**	**Case Filing Date**	**Case Status**
Medit Corporation v. 3Shape A/S	6:23-cv-00658	W.D. Tex.	September 8, 2023	Joint Motion to Dismiss filed January 14, 2025.
3Shape A/S v. Medit Corporation	6:22-cv-00443	W.D. Tex.	May 2, 2022	Joint Motion to Dismiss filed January 14, 2025.

Respectfully submitted,

/Todd R. Walters/

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Date: January 27, 2025

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 27th day of January, 2025, a true and correct copy of the foregoing **JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. §317 AND 37 C.F.R. §42.74** and **EXHIBIT 1020** are being served by electronic mail on counsel for Patent Owner:

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