

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3D SYSTEMS CORPORATION AND 3D SYSTEMS, INC.,

Petitioner,

v.

INTREPID AUTOMATION, INC.,

Patent Owner

IPR2025-01242

U.S. Patent No. 11,338,511

**PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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PATENT OWNER’S EXHIBIT LIST

“IP Ownership Case” means *3D Systems, Inc. v. Wynne et al.*, No. 3:21-cv-01141-AGS-DDL (S.D. Cal.).

“Patent Case” means *Intrepid Automation, Inc. v. 3D Systems Corp.*, No. 3:24-cv-02262-AGS-DDL (S.D. Cal.).

Exhibit	Description
2001	Defendants’ Amended Answer and Intrepid Automation’s Amended Answer and Counterclaim/Third Party Claim [IP Ownership Case, Dkt. 199]
2002	Joint Statement of Undisputed Facts Related to Defendants’ Motion for Summary Judgment [IP Ownership Case, Dkt. 563]
2003	Order Granting in Part Plaintiff’s Summary-Judgment Motion (ECF 484), Denying Kuester’s Summary-Judgment Motion (ECF 489), Granting in Part Defense’s Amended Summary-Judgment Motion (ECF 531), Denying Motions to Strike (ECF 527, 574), and Denying Motions to Exclude Experts (ECF 506, 509, 513, 514, 515) [IP Ownership Case, Dkt. 645]
2004	First Amended Complaint [IP Ownership Case, Dkt. 6]
2005	3D Systems, Inc.’s Notice of Motion and Motion for Entry of Partial Final Judgment and Certification for Appeal Pursuant to Fed. R. Civ. P. 54(b) if Reconsideration is Denied and Motion to Stay Remaining Claims Pending Appeal; Memorandum of Points and Authorities in Support [IP Ownership Case, Dkt. 654]
2006	Report of Clerk and Order of Transfer Pursuant to “Low-Number” Rule [Patent Case, Dkt. 17]
2007	Complaint for Patent Infringement [Patent Case, Dkt. 1]
2008	Order Granting in Part Plaintiff’s Motion for Expedited Discovery [Patent Case, Dkt. 45]

2009	Defendants 3D Systems Corporation and 3D Systems, Inc.'s Motion to Stay Proceedings [Patent Case, Dkt. No. 27]
2010	Joint Submission Regarding 3D Systems Corporation's Motion to Stay Proceedings Pursuant to the Court's April 30, 2025 Order [Patent Case, Dkt. 72]
2011	Defendants 3D Systems Corporation and 3D Systems, Inc.'s Answer to Plaintiff's Complaint for Patent Infringement and Counterclaims [Patent Case, Dkt. 99]
2012	Aug. 21, 2025 Order [Patent Case, Dkt. 100]
2013	Defendants 3D Systems Corporation and 3D Systems, Inc.'s Notice Relating to Inter Partes Review (IPR) Petitions of U.S. Patent Nos. 11,014,301 ('301 Patent) and 11,338,511 ('511 Patent) [Patent Case, Dkt. 95]

I. INTRODUCTION

Pursuant to the Director’s March 26, 2025 Memorandum Regarding Interim Processes for PTAB Workload Management (“March 26, 2025 Memorandum”), Patent Owner Intrepid Automation, Inc. (“Intrepid”) files this Request for Discretionary Denial of the petition in IPR2025-01242, filed by 3D Systems Corporation and 3D Systems, Inc. (collectively, “3DS”), in which 3DS seeks to invalidate U.S. Patent No. 11,338,511 (“the ’511 Patent”). A Notice of Filing Date Accorded was entered on July 18, 2025. Paper 5. As set forth herein, discretionary denial of 3DS’s petition is warranted on several grounds.

II. FACTUAL BACKGROUND AND RELATED LITIGATION

The present petition and its companion, IPR2025-01241¹ (collectively, “the 3DS Petitions”) are the latest salvos launched by Petitioner 3D Systems Corporation and 3D Systems, Inc. (collectively, “3DS”) in its years-long attack on Intrepid and its founders, the latter of whom are former employees of 3DS, in an attempt to obtain ownership of Intrepid’s portfolio of 3D printing multiprojection patents, including the ’301 and ’511 Patents.

¹ The petition in IPR2025-01241, which was accorded a filing date of July 8, 2025, seeks to invalidate U.S. Patent No. 11,014,301 (“the ’301 Patent”). The ’511 Patent is a continuation of the ’301 Patent.

3DS is a publicly traded company that was a market leader in 3D printing, beginning in the 1980s. Ex. 2001 ¶ 104. For decades, 3DS's stereolithographic offerings were traditional, laser-based stereolithography ("SLA") printers. In 2016, 3DS began plans to enter the digital light processing ("DLP") 3D printer market, where instead of using a laser to trace and draw each layer of the object being produced, a DLP projector serially expose thin layers of photopolymer resin to UV light to harden or "cure" each layer, which layers are fused together to form a 3D object. 3DS, however, lacked the technical expertise to deploy a successful DLP system. As such, 3DS's then-CEO (a former Hewlett Packard executive) sought out a team of five multi-disciplinary engineers mostly from Hewlett Packard – Ben Wynne, Christopher Tanner, Robert Mueller, Jamie Etcheson, and Ivan Chousal – who possessed substantial training and experience and the ideal background to develop 3DS's DLP printer system. Ex. 2002 ¶¶ 1-2; Ex. 2001 ¶ 106. 3DS successfully recruited this team of engineers, collectively known as "the Architects," inducing them to leave their positions at Hewlett Packard to join 3DS in the summer of 2016 to design and develop 3DS's "Figure 4" line of DLP printer systems, as well as platform assets for use in it and other 3DS printer systems. Ex. 2002 ¶¶ 1-2; Ex. 2001 ¶ 106.

Despite their accomplishments at 3DS, the Architects were treated poorly at 3DS and resigned from the company in early August 2017. Ex. 2002 ¶ 25; Ex. 2001

¶ 108. In late August or early September 2017, the five Architects formed Intrepid Automation and were thus its founders. Ex. 2001 ¶ 109.

3DS immediately began to monitor patent filings by Intrepid, including obtaining copies of all published Intrepid patent applications and patents as soon as they were publicly available. 3DS's Chief IP counsel obtained a copy of Intrepid's U.S. Pat. Pub. No. 2020/0031051 on January 30, 2020, the same day that the application published. This patent application matured as U.S. Pat. No. 10,780,640. Ex. 2002 ¶ 95. Given that the '301 and '511 Patents that are the subject of the 3DS Petitions are both continuations of the '640 Patent, 3DS has been keenly aware of the subject matter of the '301 and '511 Patents for over five-and-a-half years.

In late January 2021, Evan Kuester, a 3DS employee, visited Intrepid, ostensibly to interview for a position at Intrepid. Ex. 2003 at 13. On January 26, 2021, after signing an NDA, Kuester toured Intrepid's facilities and was shown Intrepid's highly confidential unreleased products, test beds, samples, and technologies. *Id.* at 14; Ex. 2001 ¶ 112. As part of the tour, Kuester viewed a test bed – i.e., a technology demonstration machine – that demonstrated “proof of concept” of a DLP multiprojection print engine with six projectors projecting sub-images that are “stitched together” to form a composite image to be printed. Ex. 2003 at 14; Ex. 2001 ¶ 112. Kuester understood that Intrepid had successfully developed a specific implementation of edge-blending, featuring geometric

correction, irradiance mask filters, and gamma adjustment mask filters referenced in its patents. Moreover, the number of projectors and the structure of the Intrepid test bed made it clear that Intrepid intended to and had the capability to deploy its multiprojection technology in large-format, vat-based printer systems that could be scaled to an extremely large size. Finally, Kuester knew that because the multiprojector system being tested employed DLP instead of SLA technology, the new printer would be much faster than anything 3DS had in the marketplace or even under development at that time. Ex. 2001 ¶ 112.

To slow Intrepid's development, in May 2021, 3DS filed the IP Ownership Case² – a lawsuit against Intrepid and its founders alleging trade secret misappropriation. Among other things, 3DS alleged that Intrepid's patent filings, including the patents that are the subject of the 3DS Petitions, were based on 3DS's trade secret information. Ex. 2004 ¶¶ 50-53.³

3DS's trade secret misappropriation claims against Intrepid were dismissed on summary judgment. Ex. 2003. As the district court found, 3DS had failed to

² The "IP Ownership Case" was initially filed by 3DS in California state court. The case was subsequently removed to federal court (U.S. District Court for the Southern District of California) as *3D Systems, Inc. v. Wynne et al.*, No. 3:21-cv-01141-AGS-DDL (S.D. Cal.).

³ Intrepid asserted its own trade secret misappropriation counterclaims against 3DS and Kuester. Intrepid's counterclaims are still pending with a final pretrial conference scheduled for November 21, 2025.

identify its asserted trade secrets with sufficient particularity and show that they exist:

In short, this scavenger hunt must end. We have now reached the summary-judgment stage—the “‘put up or shut up’ moment in a lawsuit.” A plaintiff alleging trade-secret misappropriation must describe its trade secrets with the requisite particularity. Intrepid did so. 3D Systems did not.

Ex. 2003 at 11 (citations omitted).

Nonetheless, 3DS has sought reconsideration of the summary judgment order dismissing its trade secret claims and, in the alternative, has requested that the district court enter partial judgment and certify dismissal of 3DS’s trade secret misappropriation claims for appeal, so 3DS can immediately continue its assertions of ownership of the ’301 and ’511 Patents before the Ninth Circuit.⁴ See Ex. 2005 at 9.

On November 7, 2024, 3DS announced the impending launch of a new product it calls the PSLA 270, a dual-projector DLP multiprojection printer. Intrepid brought the Patent Case⁵ against 3DS on December 4, 2024, alleging that 3DS’s

⁴ The district court’s summary judgment order dismissed 3DS’s affirmative claims of trade secret misappropriation against Intrepid but denied 3DS’s motion for summary judgment on Intrepid’s counterclaims, which were based on information disclosed to 3DS by Kuester, in breach of the NDA.

⁵ The “Patent Case” is captioned *Intrepid Automation, Inc. v. 3D Systems Corp.*, No. 3:24-cv-02262-AGS-DDL (S.D. Cal.). Both the Patent Case and the IP Ownership Case are assigned to the same district judge and magistrate judge pursuant to the

PSLA 270 printer infringes the '301 and '511 Patents. Ex. 2007. Intrepid also successfully moved for early, expedited discovery to ascertain whether a motion for a preliminary injunction was warranted. Ex. 2008. On January 10, 2025, 3DS moved to stay the Patent Case pending resolution of the IP Ownership case, contending that it was the rightful owner of the '301 and '511 Patents. *See* Ex. 2009 at 13 (“IA is asking that 3DS defend a patent infringement case involving patented technology that *3DS has been claiming for the past three years in the [IP Ownership Case] rightfully belongs to 3DS*”) (emphasis added). In a status report filed in the Patent Case, 3DS reiterated and confirmed that among the remedies it seeks in the IP Ownership case is equitable reassignment of the '301 and '511 Patents. *See* Ex. 2010 at 2-3 (citing myriad cases regarding equitable reassignment). In short, the more than four-year long dispute in the IP Ownership Case was over the *ownership*, not the validity, of the '301 and '511 Patents. *See* Ex. 2009 at 13.

On August 19, 2025, 3DS filed its Answer and Counterclaims in the Patent Case. Ex. 2011. In its Answer, 3DS again reiterated its contention that it has an ownership interest in the '301 and '511 Patents. Ex. 2011 at 18 (“Plaintiff’s claims for relief are barred or limited because it is not the rightful owner of the Asserted Patents and therefore lacks standing, and because *3DS has a license (e.g., shop*

court’s “low number rule” (Local Civil Rule 40.1.e), which calls for the assignment of related cases to the same judge for efficiency purposes. *See* Ex. 2006.

right) to and/or outright ownership of the Asserted Patents.”) (emphasis added).

Indeed, 3DS contends that other 3DS employees rightfully should have been listed as inventors of the '301 and '511 Patents but were omitted. Ex. 2011 at 48 (“Accordingly, the Asserted Patents incorporate inventions, concepts or contributions made by individuals other than those listed as inventors on the patents (the “Omitted Inventors”), including but not limited to Guthrie Cooper. . . . As reflected above, the Omitted Inventors contributed significantly to the conception of one or more claims in the Asserted Patents, such that they should have been named as inventors (joint or otherwise) under 35 U.S.C. § 116.”).

Moreover, in arguing in its Answer and Counterclaims that the '301 and '511 Patents are invalid under 35 U.S.C. § 102/103, 3DS avers that system prior art that is not presented in the 3DS Petitions, including an “Autodesk Ember 3D Printer system,” constitutes invalidating prior art. Ex. 2011 at 61. Although 3DS has filed a *Sotera* stipulation, that stipulation is limited to just the invalidity arguments that were raised or could have reasonably been raised in the petitions (and therefore does not encompass any system prior art). Notably, the Autodesk Ember system art cited in 3DS’s Answer and Counterclaim is the commercial embodiment of the Greene reference cited by 3DS in the 3DS Petitions. See Ex. 1006 at [0056].

3DS has moved to stay the Patent Case pending a determination of IPR2025-01241 and -01242. The court has set a hearing date of November 5, 2025 for 3DS's motion to stay pending IPR. Ex. 2012.

III. THE DIRECTOR SHOULD EXERCISE DISCRETION AND DENY INSTITUTION OF *INTER PARTES* REVIEW

A. Fairness Dictates that 3DS Should Not Be Permitted to Challenge the '301 Patent Through *Inter Partes* Review

The Director's determination to exercise discretion to deny institution is based on a holistic assessment of all the evidence and arguments presented. Here, the circumstances clearly favor discretionary denial. 3DS and Intrepid have been embroiled in litigation, initiated by 3DS, for over four years over the ownership of the '301 and '511 Patents. Even after filing the petitions in IPR2025-01241 and IPR2025-01242, 3DS persists in arguing that 3DS is the rightful owner of the '301 and '511 Patents and that other 3DS employees are joint inventors. Ex. 2011 at 18, 48.

In *Tessell, Inc. v. Nutanix, Inc.*, IPR2025-00322, Paper 14 (Director June 12, 2025), two named inventors of the challenged patent left the employ of the Patent Owner, Nutanix, and founded Petitioner Tessell. Tessell later hired away two more named inventors from Nutanix and then challenged the patent. In exercising discretion to deny the IPR petition, the Director stated, "[T]he Office may consider unfair dealings as a factor when determining whether to exercise discretion to deny

institution under 35 U.S.C. § 314(a). It is not an appropriate use of Office resources where the inventors applied for and were issued a patent, but, as is the case here, now advocate for its unpatentability.” *Id.* at 2.

The present situation presents a similar question – namely, whether it is an appropriate use of Office resources for the Petitioner, who has consistently contended in litigation it initiated and has pursued for over four years that it is the rightful owner of the ’301 and ’511 Patents, to argue in proceedings before the Board that those same patents that it claims to own are unpatentable. Because these – and myriad other issues – have been before the district court over the last four-plus years, Intrepid contends that justice is best served by allowing the United States District Court for the Southern District of California to continue to adjudicate these matters, as it has done since May 2021.

While the Patent Case, technically the parallel litigation, is still at an early stage, the IP Ownership Case is at an advanced stage. The Court Clerk has already found that the IP Ownership Case and the Patent Case both involve the same patents, and that assignment of the Patent Case to the same judges as the IP Ownership case would further judicial economy. Ex. 2006. The Director may consider the effect of an IPR on related litigation. *See SIG Sauer Inc. v. Lone Star Future Weapons, Inc.*, IPR2025-00410, Paper 13 at 2 (Director June 26, 2025) (Director noting that while parallel litigation technically did not exist, “the parties are engaged in *related*

litigation, and there is a persuasive argument that the filing of the Petition may be inappropriate here.”) (emphasis added).

There are myriad procedural permutations the IP Ownership Case can take. But regardless, the issue of ownership of the ’301 and ’511 Patents will be litigated and likely determined before a jury and/or appellate court during the pendency of this proceeding (if instituted). Discovery in the IP Ownership Case is complete. If 3DS’s motion for reconsideration is granted, the IP Ownership Case will likely be before a jury in the Southern District of California by Summer 2026. If 3DS’s motion for entry of partial judgment and for certification of appeal is granted, the IP Ownership Case will be before the Court of Appeals for the Ninth Circuit within several months. And if 3DS’s procedural machinations all fail, Intrepid’s counterclaims against 3DS are set for a Final Pretrial Conference on November 21, 2025, with an expected trial date this winter. Whatever the outcome of the jury verdict, the IP Ownership Case will be before the Ninth Circuit well before the issuance of a Final Written Decision.

B. Settled Expectations

3DS has had actual knowledge of Intrepid’s patent family since January 2020, and since the May 2021 inception of the IP Ownership Case through today, 3DS has consistently maintained that it has ownership rights in the ’301 and ’511 Patents. While “settled expectations” ordinarily is based on the amount of time that the

challenged patent has been in force, settled expectations may arise under other circumstances. *See Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 at 2 (Director July 24, 2025) (“there may be good reasons why a patent owner has strong settled expectations in a patent that has only been in force for three years”). This case presents one such circumstance. Given that (1) 3DS had actual notice of the parent application of the asserted Intrepid patent family since January 2020 (Ex. 2002 ¶ 95); (2) 3DS alleged in May 2021 in its Complaint that the parent application contains details regarding a 3DS system developed by another 3DS employee, Guthrie Cooper, such that he should have been named a joint inventor (Ex. 2004); and (3) 3DS consistently maintained that it has an ownership interest in the ’301 and ’511 Patents (Ex. 2011 at 18, 48), Intrepid reasonably had settled expectations that 3DS would not challenge the validity of patents that it claimed to own. The fact that 3DS made a strategic decision in May 2021 to seek ownership of the ’301 and ’511 Patents in lieu of challenging their patentability confirms that the settled expectations of the Parties was that the ’301 and ’511 Patents were valid.

C. Incomplete Overlap of Invalidity Issues

3DS’s “*Sotera*” stipulation should be afforded little weight. The purpose of a *Sotera* stipulation is to establish that the IPR proceeding provides a “true alternative” to the district court litigation. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (“Petitioner’s broad stipulation ensures

that an *inter partes* review is a ‘true alternative’ to the district court proceeding.”). Though 3DS filed a *Sotera* stipulation in the Patent Case, 3DS’s subsequent filing of its Answer and Counterclaims in the Patent Case reveals that institution of IPR proceedings would not provide a “true alternative” to the district court proceedings.

3DS filed a notice in the Patent Case on July 28, 2025, stating that “if the PTAB institutes an IPR proceeding as to any claims of either the ’301 or ’511 Patents, 3DS will not pursue in this litigation any invalidity arguments that were raised or reasonably could have been raised on those instituted claims in the respective petitions now pending before the PTAB.” Ex. 2013.

However, three weeks later, 3DS advanced several invalidity arguments in its August 19, 2025 Answer and Counterclaims that cannot be raised in the IPR proceedings. For example, 3DS contends that the ’301 and ’511 Patents are invalid for improper inventorship. Ex. 2011 at 62-63. As IPR proceedings do not permit patent challenges based on improper inventorship, institution would not provide a “true alternative” to the district court litigation.

Moreover, 3DS argues in its Answer and Counterclaims that system art, including the “Autodesk Ember 3D Printer system,” constitute invalidating prior art. *Id.* at 61. The Autodesk Ember system specifically referred to in 3DS’s Answer and Counterclaims is a commercial embodiment of the Greene reference that 3DS submitted in support of its IPR petitions. *See* Ex. 1006 at [0056] (expressly

referencing the Autodesk Ember system). Because prior use or sale of a system cannot be raised in an IPR proceeding, 3DS's *Sotera* stipulation does not prevent 3DS from taking two bites of the apple – (1) 3DS argues invalidity based on the Greene reference in the IPR, and (2) if unsuccessful in the IPR, 3DS makes the same invalidity arguments regarding Greene again in the litigation, but this time through the use of the Autodesk Ember system art instead of the Greene reference itself.

Because 3DS's *Sotera* stipulation is largely ineffective here, it should not be given any weight. *See, e.g., Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (Director Mar. 28, 2025) (“Petitioner’s stipulation does not ensure that these IPR proceedings would be a ‘true alternative’ to the district court proceeding.”); *SAP America, Inc. v. Cyandia, Inc.*, IPR 2024-01495, Paper 13 at 9 (April 7, 2025) (“[W]e do not consider the presence of the *Sotera* stipulation in our case to ensure that *inter partes* review would be a “true alternative” to the Litigation.”).

IV. CONCLUSION

The United States District Court for the Southern District of California has already been adjudicating the dispute between the parties since May 2021. The purpose of the Director’s interim processes for PTAB Workload Management is to “improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, reduce pendency in *ex parte* appeals, and promote consistent application of

discretionary considerations in the institution of AIA proceedings.” March 26, 2025 Memorandum at 3. Institution of this IPR proceeding does nothing to further those goals.

For the reasons set forth above, Patent Owner Intrepid respectfully requests discretionary denial under 35 U.S.C. § 314(a).

Dated: September 5, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION and supporting Exhibits was served on September 5, 2025 by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) and via electronic mail upon counsel of record for the Petitioner as follows:

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