

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3SHAPE A/S and 3SHAPE INC.
Petitioner

v.

ALIGN TECHNOLOGY, INC.
Patent Owner

IPR2019-00157, Patent 8,363,228
IPR2019-00159, Patent 8,451,456
IPR2019-00160, Patent 8,675,207

**REQUEST FOR CONSOLIDATION
OF IPR2019-00157, -00159, AND -00160**

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U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-145

To preserve judicial economy and party resources, Align respectfully requests that the Board consolidate all substantive briefing, as well as the oral hearing, into one proceeding for IPR2019-00157 ('228 patent), IPR2019-00159 ('456 patent), and IPR2019-00160 ('207 patent).

As will be demonstrated below:

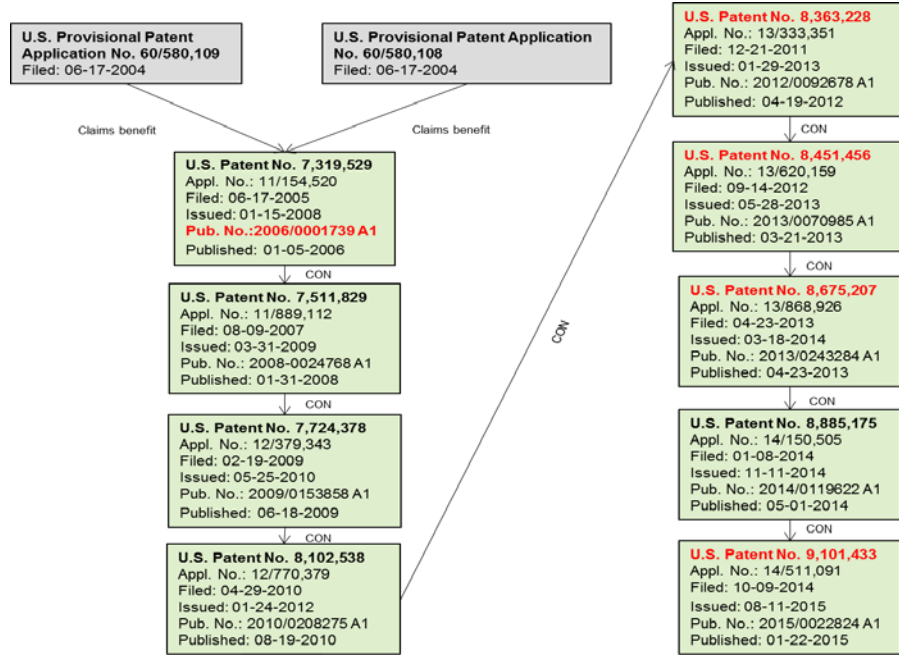
1. The '228, '456, and '207 patents share a common specification;
2. For the '228, '456, and '207 patents, the Petitions challenge the claims nearly identically and can be addressed in a single proceeding;
3. For the '228, '456, and '207 patents, the Petitions rely on the same references to meet the claim features; and
4. For the '228, '456, and '207 patents, the Petitions rely on declarations from the same expert, and those declarations are nearly identical, and all differences can be addressed in a single proceeding.

For these reasons, and in the interest of judicial economy, the Board should consolidate the three above-referenced IPR proceedings into a single proceeding.

ARGUMENT

I. There Are Few Differences Across the Specification and Grounds.

The specifications of all the patents are identical, except priority sections, as they are continuations of each other. The following family tree is illustrative:



The following charts demonstrate that the proposed grounds of unpatentability are identical.

IPR2019-00157 ('228 Patent) - Ground	References	Claims
1	Babayoff, Okamoto, and Engelhardt	1-5, 7, 26
2	Babayoff, Okamoto, Engelhardt, and Sachdeva	6
IPR2019-00159 ('456 Patent) - Ground	References	Claims
1	Babayoff, Okamoto, and Engelhardt	1-7, 12-17
2	Babayoff, Okamoto, Engelhardt, and Sachdeva	7 and 18
IPR2019-00160 ('207 Patent) - Ground	References	Claims
1	Babayoff, Okamoto, and Engelhardt	1-7, 12-17, 19-21
2	Babayoff, Okamoto, Engelhardt, and Sachdeva	7 and 18

In the interest of judicial efficiency, the Board should consolidate the three IPRs into a single proceeding. The rules governing IPR proceedings should be construed “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). The Board is authorized to depart from the rules, when appropriate. 37 C.F.R. § 42.5(a). Consolidation allows efficiencies:

1. A single set of pleadings;
2. A single deposition of each Parties’ expert (**already conducted**);
3. A single oral hearing;
4. A shortened, combined record;
5. Lowering the risk of duplicating time, labor, resources, and arguments.

These combined efficiencies merit consolidation. To effectively deal with the proposed consolidation, the Parties accordingly ask that the word or page limits for major substantive pleadings be increased. The time allotted for oral hearing should be increased as well. Specifically, the Parties request the following changes:

1. Pursuant to 3Shape’s condition for non-opposition, each side will file one pleading for Due Dates 1-7 with word/page limits at 200% of the word/page limits found in 37 C.F.R. § 42.100 et seq.
2. The Oral Hearing for the consolidated proceedings will be 1 hour total for each side, 2 hours total, on March 11, 2020.
3. ’157 will be the base case; any exhibits in ’159/’160 missing from ’157 will be filed within 15 days of the Board granting this request.
4. Refer to the Petitions and Decision on Institution as: 157Pet, 157DI, 159Pet, 157DI, 160Pet, and 160DI, respectively.

Date: August 22, 2019

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

Respectfully submitted,

/Jason D. Eisenberg/

Jason D. Eisenberg (Reg. No. 43,447)
Attorney for Patent Owner

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