UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIGN TECHNOLOGY, INC.
Petitioner

v.

3SHAPE A/S
Patent Owner

Case IPR2022-00144
U.S. Patent No. RE48,221

PETITIONER'S NOTICE RANKING PETITIONS FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. RE48,221

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I. INTRODUCTION

Petitioner is simultaneously filing two petitions (IPR2022-00144 ("Pet. 1") and IPR2022-00145 ("Pet. 2")) challenging the patentability of claims [1, 19][1] and 20-44 in U.S. Reissue Patent No. RE48,221 ("RE'221"). The Board recognizes that "there may be circumstances in which more than one petition may be necessary." Consolidated Trial Practice Guide (Nov. 2019) ("TPG"), 59. Institution of both petitions is justified given the unique situation presented here since the Board has *already invalidated* the subject matter of the challenged claims. The Board did so when it issued a final written decision invalidating claims 1-19 of U.S. Patent No. 9,329,675 ("the '675 patent") in IPR2018-00197, which 3Shape did not appeal.

II. ORDERING OF PETITIONS

Both petitions are meritorious and justify institution. Petitioner requests that the Board consider its petitions in the following order: (1) Petition 1 based on Serra and (2) Petition 2 based on Boerjes. Petition 1 presents the prior art that the Board

[1] Claims 1 and 19 are not *directly* challenged because they are cancelled, but features of claims 1 and 19 are addressed in substance in each petition as the challenged claims incorporate all of their features.

previously found invalidates the claimed subject matter. Petition 2 presents entirely new grounds.

Rank	Petition	Primary Reference	Claims
1	IPR2022-00144 (Pet. 1)	Serra	[1, 19], 20-44
2	IPR2022-00145 (Pet. 2)	Boerjes	[1, 19], 20-44

III. REASONS WARRANTING ADDITIONAL PETITIONS

A. Material Differences in the Petitions

Different Approaches to the Claim Limitations – The Petitions establish that the challenged claims were obvious in different ways. For example, Petition 1 presents grounds and arguments that the Board previously applied to invalidate the nearly identical, now cancelled claims of the ’675 patent. RE’221 is a reissue of the ’675 patent. In IPR2018-00197, the Board found that ’675 patent claims 1-19 are obvious over Serra and Kriveshko. Here, to the extent claims 20-44 are not identical to those previously invalidated, they add no patentable features because any nominal features added by reissue were well-within the general knowledge of a person of ordinary skill in the art (“POSITA”). Petition 1 includes a single reference obviousness ground supported, in part, with the general knowledge of a POSITA.

Petition 2 asserts three combinations of never before considered references that render obvious the recited motion sensor species and motion sensor

functionality of reissue claims [33.4] and [33.5]. Accordingly, the two petitions have different starting points and different rationales for why the challenged claims are obvious.

New Prior Art – Petition 1 presents grounds including Serra, Kriveshko, and Knighton, which were nominally cited in an information disclosure statement during reissue prosecution, but never applied by the reissue Examiner in a rejection despite the Board finding the '675 patent claims invalid. Petition 1 presents new grounds that include Marvit, which was not applied or considered during prosecution.

Petition 2 presents grounds based on Boerjes, Marvit, Gandyra, and Quadling which were not presented to, or considered by, the Office. These references are not cumulative to art applied or cited during reissue prosecution. The two petitions thus rely on different combinations of art that may be weighed differently depending on how the reissue examination is viewed. Institution of both petitions will allow for full consideration of all these grounds, both those previously found to render the same subject matter invalid and others that confirm the invalidity previously determined.

IV. CONCLUSION

The Board has already invalidated claims that are substantively identical to the reissue claims challenged here. As explained in the petitions themselves, the lack of meaningful examination during reissue prosecution resulted in issuance of claims that have no patentable distinction over those found invalid in IPR2018-00197. This unique situation, and the different approaches to the claim limitations, justifies instituting multiple petitions (IPR2022-00144 and IPR2022-00145).

Respectfully submitted,
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