

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

EXOCAD GMBH AND EXOCAD AMERICA, INC.,  
Petitioner,

v.

3SHAPE A/S,  
Patent Owner.

---

Case IPR2018-00788  
Patent 9,336,336 B2

---

Before SALLY C. MEDLEY, IRVIN E. BRANCH, and  
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge*.

ORDER

Granting-in-Part Petitioner's Motion to Submit Supplemental Information  
37 C.F.R. § 42.123

## I. INTRODUCTION

We authorized Petitioner to file a motion to submit supplemental information and Patent Owner to file an opposition. Paper 12 (“Order”), *see* Ex. 1021. Petitioner filed its Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(a) (Paper 9, “Motion”) and corresponding Exhibits 1014–1019 on November 16, 2018. Patent Owner filed an Opposition to Petitioner’s motion (Paper 13, “Opposition”) on November 30, 2018.

Upon consideration of the documents and the parties’ arguments, and for the reasons stated below, Petitioner’s motion is granted-in-part.

## II. PETITIONER’S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION AND PATENT OWNER’S OPPOSITION

Petitioner’s Motion seeks to submit the following as supplemental information: 1) a declaration confirming the accuracy of the translation of Wiedmann (Ex. 1014); 2) exhibits about the public accessibility of Wiedmann, including declarations of Oliver and Manfred Wiedmann (Exs. 1016 and 1017); 3) letters from the German National Library of Medicine (Ex. 1018) and German National Library (Ex. 1019); 4) a webpage from Livivo.com (Ex. 1020); and 5) a supplemental declaration of Dr. Mundy (Ex. 1015). The relevance of each Exhibit is discussed below.

Patent Owner’s Opposition specifically addresses only the supplemental declaration of Dr. Mundy (Ex. 1015). *See* Opposition.

### A. *Analysis*

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information if the following requirements are met: (1) a request for

authorization to file such motion is made within one month of the date the trial was instituted; and (2) the supplemental information must be relevant to a claim for which trial has been instituted.

With respect to the first requirement of § 42.123(a), trial was instituted in this proceeding on October 3, 2018. Paper 7. Petitioner requested authorization to file a motion to submit supplemental information on November 2, 2018, and thus, Petitioner's request was made within one month of the date the trial was instituted. *See* Paper 12.

*a. Declaration Confirming the Accuracy of the Translation of Wiedmann (Ex. 1014)*

Petitioner argues that “[t]he declaration about the accuracy of the Wiedmann translation (Ex. 1014) is relevant because it is offered to clarify or cure the issue of whether the affidavit originally attached to the Wiedmann translation (Ex. 1007 at 0009) complies with 37 C.F.R. § 42.63, and it does not change any grounds of unpatentability.” Motion 2. Petitioner contends that Patent Owner failed to timely object to the translation accuracy and that allowing the declaration would “nonetheless cure[] any potential issues with the translation.” *Id.* at 2–3 (citing *LG Display Co. v. Surpass Tech Innovation LLC*, IPR2015-00885, Paper 9 at 10 (Sept. 8, 2015); 37 C.F.R. § 42.64(b)(1); *Volkswagen Group of Am., Inc. v. Emerachem Holdings, LLC*, IPR2014-01555, Paper 20 at 4–7 (Mar. 16, 2015); *Ford Motor Co. v. Cruise Control Techs. LLC*, IPR2014-00281, Paper 17 at 6–7 (July 2, 2014)).

As discussed above, we are persuaded that Petitioner's request is timely (*see* 37 C.F.R. 42.123(a)(1)) and that it is relevant to a claim for which the trial has been instituted. Accordingly, we grant Petitioner's

Motion with respect to Exhibit 1014. Exhibit 1014 is allowed into the record.

*b. Exhibits Concerning the Publication and Public Availability of Wiedmann (Exs. 1016, 17, 18, 19, and 20)*

The supplemental information in Exhibits 1016–1020 consists of evidence relating to the public availability of Wiedmann<sup>1</sup>, which is a prior art reference in instituted grounds in this proceeding. *See* Paper 7. Exhibits 1016 and 1017 are declarations from Oliver Wiedmann and Manfred Wiedmann, respectively, which according to Petitioner attest to the publication and public availability of Wiedmann in April 2008. Mot. 4–5; Exs. 1016–1017. Exhibits 1018 and 1018 are letters from the German National Library of Medicine (Ex. 1018) and German National Library (Ex. 1019), which Petitioner contends shows that Digital\_Dental.News journal was available at these libraries. Motion. 5. Exhibit 1020 is a webpage from Livivo.com, which Petitioner asserts further shows the dates the journal was received there. *Id.*

Petitioner contends that Exhibits 1016–1020 concerning the publication and public availability of Wiedmann are relevant, do not change any grounds of unpatentability, and “do not change the evidence initially presented in the proceeding because they merely confirm public accessibility.” Motion 5 (citing *Palo Alto Networks, Inc v. Juniper Networks, Inc.*, IPR2013-00369, (Feb. 5, 2014) and *Creston Elecs., Inc. v. Intuitive Building Controls, Inc.*, IPR2015-01379, (Feb. 26, 2016) as

---

<sup>1</sup> Wiedmann, Oliver, “According to the Laws of Harmony ... to find the right tooth shape with the assistance of the computer,” Digital Dental News, 2nd Volume, April 2008 (Ex. 1007, “Wiedmann”).

precedent that “[s]uch evidence has repeatedly been found to be proper supplemental information”).

With respect to the second requirement of § 42.123(a), the supplemental information Petitioner seeks to admit generally relates to the public accessibility of the Wiedmann reference, which is a basis for the grounds of unpatentability in this proceeding, and is therefore relevant to the claims of the ’336 patent for which this trial was instituted. Accordingly, we grant Petitioner’s Motion with respect to Exhibits 1016–20. These Exhibits are allowed into the record.

*c. Supplemental Declaration of Dr. Mundy (Ex. 1015)*

Regarding Exhibit 1015, Petitioner argues “[t]he Supplemental Mundy Declaration (Ex. 1015) is relevant because it addresses the Board’s statement in its Institution Decision that the 3D model depicted in the figures in Wiedmann is not of ‘at least part of an oral cavity of the patient’ because the 3D model is from a database search, rather than the patient’s pre-restoration oral cavity.” Motion 3 (citing Paper 7, 31). Petitioner contends “[s]ubmitting the supplemental information now, rather than with a reply, means that the Patent Owner will have an opportunity to cross-examine Dr. Mundy relating to the supplemental information and will have time to review and respond to the supplemental information in the Patent Owner Response.” *Id.* at 2.

Patent Owner opposes the Motion because “Petitioner provides no explanation as to why it could not have presented the contents of the Supplemental Mundy Declaration with its Petition” and “because the unpatentability theory offered in the Supplemental Mundy Declaration is not relevant to the theories set forth in the Petition.” Opposition 3, 5.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.