

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIGN TECHNOLOGY, INC.,
Petitioner,

v.

3SHAPE A/S,
Patent Owner.

Case IPR2019-00118
Patent 9,962,244 B2

Before SALLY C. MEDLEY, IRVIN E. BRANCH, and
JESSICA C. KAISER, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314 and 37 C.F.R. § 41.108

Align Technology, Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 321–329 requesting an *inter partes* review of claims 31, 32, and 34 of U.S. Patent No. 9,962,244 B2, issued on May 8, 2018 (Ex. 1001, “the ’244 patent”). Paper 1 (“Pet.”). 3Shape A/S (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we deny Petitioner’s request and do not institute an *inter partes* review of any challenged claim.

I. ANALYSIS

Prior to filing this Petition for *inter partes* review, Petitioner filed a petition for post-grant review (“PGR”) challenging the same claims of the ’244 patent based on nearly identical challenges. *See* PGR2018-00104, Paper 2 (“PGR2018-00104 Pet.”). Petitioner acknowledges that this petition for *inter partes* review presents “nearly identical arguments” as PGR2018-00104. Pet. 4. Petitioner further states that it “has purposely filed nearly identical prior art [g]rounds against the claims in the PGR[] and IPR[] knowing that one of the two types of proceedings must fail under the law,” with the issues being identical except “which proceeding type is proper.” *Id.* at 5. In other words, Petitioner filed a nearly identical petition here so that the Board would still address Petitioner’s challenges even if the Board determines either at institution or during the trial that the ’244 patent is not eligible for PGR. Thus, Petitioner asks us to institute both types of proceedings with nearly identical challenges as to the claims at issue. *Id.*

In PGR2018-00104, we determined Petitioner had sufficiently shown the '244 patent is PGR eligible and that we would not exercise our discretion to deny review under § 325(d), but we nevertheless determined not to institute a post grant review of any challenged claim. *See* PGR2018-00104, Paper 8, at 9–13, 24 (“PGR2018-00104 Dec.”). In particular, applying the standard set forth in 35 U.S.C. § 324(a), which requires demonstrating that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable, we determined Petitioner failed to adequately show that the references in its asserted challenges, alone or in combination, teach “the data processing system also configured to derive surface color information for the block of said image sensor pixels from at least one of the 2D images used to derive the surface geometry information,” as recited in independent claims 31, 32, and 34. PGR2018-00104 Dec. 13–23; Ex. 1001, 22:58–62, 23:20–24, 24:13–17.

In this case, Petitioner’s analysis of that limitation is substantially similar to its analysis in PGR2018-00104. *Compare* PGR2018-00104 Pet. 26–28, 33, 37, 60–62, 65, and 68, *with* Pet. 19–21, 25, 29, 50–51, 54, and 57. We have reviewed Petitioner’s evidence and argument in light of the different standard for institution of an *inter partes* review. 35 U.S.C. § 314(a) (We may not institute an *inter partes* review unless the information presented in the petition and any response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”). Application of the different standard for institution of *inter partes* review, as compared to post-grant review, does not change our conclusions as to the merits of Petitioner’s substantive arguments. Accordingly, based on our review of the same arguments and

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evidence under the standard for institution of *inter partes* reviews, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to at least one challenged claim for the same reasons we discussed in PGR2018-00104. *See* PGR2018-00104 Dec. Accordingly, we deny Petitioner's request and do not institute an *inter partes* review of any challenged claim.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all challenged claims and no trial is instituted.

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