

Filed on behalf of Patent Owner

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DENTAL IMAGING TECHNOLOGIES CORPORATION
Petitioner

v.

3SHAPE A/S
Patent Owner

Case No. IPR2023-00388
Patent RE48,221

**PATENT OWNER'S MANDATORY NOTICE INFORMATION
PURSUANT TO 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8(a)(2), Patent Owner 3Shape A/S hereby files the following mandatory notices.

I. REAL PARTY-IN-INTEREST (37 C.F.R. § 42.8(b)(1))

Patent Owner certifies that 3SHAPE A/S is the real party-in-interest.

II. RELATED MATTERS (37 C.F.R. § 42.8(b)(2))

The following is a list of judicial and administrative matters that would affect, or be affected by, a decision in this proceeding.

A. Related District Court and PTAB Matters

1. *Align Technology, Inc. v. 3Shape A/S et al.*, Civil Action No. 6:20-cv-00979 (W.D. Tex.) filed on October 19, 2020 (settled);
2. *3Shape A/S v. Carestream Dental LLC*, Civil Action No. 1:22-cv-01829 (N.D. Ga.) (pending) which was transferred from the Western District of Texas (*3Shape A/S v. Carestream Dental LLC*, Civil Action No. 6:21-cv-01110 (W.D. Tex.));
3. *Align Technology, Inc. v. 3Shape A/S*, Petition for *Inter Partes* Review of U.S. Patent No. RE48,221, IPR2022-00144, filed on November 9, 2021 (settled); and
4. *Align Technology, Inc. v. 3Shape A/S*, Petition for *Inter Partes* Review of U.S. Patent No. RE48,221, IPR2022-00145, filed on November 9, 2021 (settled).

B. Related Applications

U.S. Patent No. RE48,221 issued from U.S. Patent Application No. 16/526,281, filed on July 30, 2019, which is a reissue of U.S. Patent No. 9,329,675 (U.S. Patent Application No. 13/991,513), which is a U.S. National Stage of PCT/DK2011/050461, filed on December 5, 2011, and claims priority to U.S. Provisional Application No. 61/420,138, filed on December 6, 2010 and DK Application No. 2010 01104, filed on December 6, 2010.

U.S. Patent Application No. 17/003,692, filed on August 26, 2020 (pending) is a reissue continuation of U.S. Patent Application No. 16/526,281.

C. Additional Related Matters

1. PTAB Matters Involving U.S. Patent No. 9,329,675

1. *Align Technology, Inc. v. 3Shape A/S*, Petition for *Inter Partes* Review of U.S. Patent No. 9,329,675, IPR2018-00197, filed on November 22, 2017 (Final Written Decision entered May 29, 2019); and

2. *Align Technology, Inc. v. 3Shape A/S*, Petition for *Inter Partes* Review of U.S. Patent No. 9,329,675, IPR2018-00198, filed on November 22, 2017 (institution denied).

III. LEAD AND BACKUP COUNSEL (37 C.F.R. § 42.8(b)(3))

Patent Owner hereby identifies its lead and backup counsel as follows:

Lead Counsel:

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IV. SERVICE INFORMATION (37 C.F.R. § 42.8(b)(4))

Patent Owner consents to e-mail service at the addresses listed above.

Date: January 6, 2023

Respectfully submitted,

/Todd R. Walters/

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PATENT OWNER MANDATORY NOTICE INFORMATION PURSUANT TO 37 C.F.R. § 42.8** is being served on counsel for Petitioner by electronic mail this 6th day of January, 2023 as follows:

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