

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DENTAL IMAGING TECHNOLOGIES CORPORATION,  
Petitioner,

v.

3SHAPE A/S,  
Patent Owner.

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IPR2023-00388  
Patent RE48,221 E

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Before HUBERT C. LORIN, FRANCES L. IPPOLITO, and  
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION  
Settlement Prior to Institution of Trial  
*37 C.F.R. § 42.74*

## I. INTRODUCTION

Petitioner filed a Petition (Paper 2) requesting *inter partes* review of U.S. Patent No. RE48,221 E (Ex. 1001, “the ’221 patent”). Subsequently, on April 20, 2023, the parties filed a joint motion to terminate the above-identified proceeding pursuant to a settlement agreement. Paper 5 (Joint Motion to Terminate *Inter Partes* Review). The parties also filed a copy of their settlement agreement made in connection with the termination of the instant proceeding. Ex. 1045. In a concurrently filed paper, the parties jointly requested the settlement agreement to be treated as business confidential and to be kept separate from the file of the involved patent under 35 U.S.C. § 317(b)<sup>1</sup> and 37 C.F.R. § 42.74(c). Paper 6 (Joint Motion to Keep Confidential and Separate). We authorized the filing of the jointly-filed papers in an e-mail dated April 17, 2023. Ex. 3001.

## II. DISCUSSION

The instant proceeding is in an early stage, and the Board has not determined whether to institute trial. The parties represent that Exhibit 1045 is “a true and accurate copy” of their settlement agreement, which “fully resolv[es] this matter with respect to the ’221 patent, including both this proceeding and Patent Owner’s assertion of the ’221 patent in the related district court litigation.” Paper 5, 2. The parties further represent that “there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present

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<sup>1</sup> In their request, the parties cite 35 U.S.C. § 271(b) on one page and 35 U.S.C. § 217(b) on another page. Paper 6, 1–2. These citations appear to be typographical errors, and we instead apply 35 U.S.C. § 317(b).

proceeding.” *Id.* In view of the foregoing, we determine that it is appropriate to dismiss the Petition and terminate the proceeding.

Further, after reviewing the parties’ settlement agreement, we find that the settlement agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the settlement agreement as business confidential information and to keep it separate from the file of the patent in the above-identified proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision under 35 U.S.C. § 318(a).

### III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate *Inter Partes* Review (Paper 5) is *granted*, the Petition (Paper 2) is *dismissed*, and the proceeding is *terminated*; and

FURTHER ORDERED that the Joint Motion to Keep Confidential and Separate (Paper 6) is *granted*, and the settlement agreement (Exhibit 1045) shall be treated as business confidential information, kept separate from the file of the above-identified patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2023-00388  
Patent RE48,221 E

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