

## PTAB Probes Claim Construction Standard In Dental IP Case

By Britain Eakin

*Law360 (April 15, 2020, 10:26 PM EDT)* -- The Patent Trial and Appeal Board grappled Wednesday with whether it can reach its own construction of key terms in Align Technology Inc. dental scanning patents, or if it's bound by those 3Shape put forth in its petitions challenging them.

Denmark-based 3Shape A/S and its U.S. subsidiary argued during a telephone hearing in three consolidated cases that the board has latitude to reach its own conclusion on claim construction, regardless of Align's contention that the board is limited to the various means-plus-function constructions 3Shape put forth in its petitions.

California medical device maker Align, which makes the popular teeth straightening technology Invisalign, argued that under the U.S. Supreme Court's decision in *SAS Inst. Inc. v. Iancu*, the board is constrained by the constructions 3Shape put forth in its original petitions.

Align attorney Pauline M. Pelletier of Sterne Kessler Goldstein & Fox PLLC, however, stressed during the hearing that her client doesn't believe the means-plus-function constructions "are legally or factually correct," so there is no basis to rule in favor of 3Shape anyway.

U.S. Patent Trial and Appeal Board Judge Brian J. McNamara pressed Pelletier on the implication of her assertion.

"By advocating that the constructions are not means-plus-function ... what are you conceding?" the judge asked.

"Nothing," Pelletier responded, adding that 3Shape chose to bring its challenges in a particular way, so it can only prevail under the theory put forth in its petitions.

3Shape contests that, saying the board is free to veer because Align put forth its own claim constructions in its preliminary patent owner response, creating a claim construction dispute. 3Shape attorney Roger Lee of Buchanan Ingersoll & Rooney PC argued that that gives the board the freedom to construe the claims however it wishes, because both parties have been put on notice and have had an opportunity to respond.

That means the board wouldn't violate the Administrative Procedure Act if it struck out on its own, Lee

said. Still, Lee argued that his client believes it met its burden to show why the claims should be construed as means-plus-function.

Such claims are written in a way that describes a means for performing a certain function and must include a "corresponding structure" that performs the function, otherwise they're invalid as indefinite under Section 112(6) of the Patent Act. Similarly, when a petitioner construes patent terms as means-plus-function, they must show that an equivalent structure exists in the prior art in order to prove unpatentability.

Align attorney Pelletier argued that the terms aren't means-plus-function, and even if the board decided they are, she said 3Shape failed to identify corresponding structures in the prior art, so the petitions should still fail.

Pelletier conceded during the hearing that she thinks the board is permitted by the APA to adopt non-means-plus-function constructions, though she said there isn't evidence to support a finding of unpatentability.

But if the board is going to invalidate the claims, she said the board can't adopt non-means-plus-function constructions because there's only one set of invalidity contentions in the petitions, which she said are inextricably intertwined with 3Shape's means-plus-function constructions.

3Shape has not preserved an alternative claim construction position, she added, having noted earlier in the hearing that all of 3Shape's "eggs are in the means-plus-function basket."

Wednesday's consolidated hearing was followed in the afternoon by two additional hearings over two related Align patents. They mark the latest development in a sprawling legal battle between the parties, which has ping-ponged between the International Trade Commission, the PTAB and Delaware federal court.

Last March, the ITC launched an investigation into dental scanners imported by 3Shape, following complaints by Align that the foreign products are knockoffs of its own oral imaging products. The investigation was initiated in response to Align's complaint alleging that 3Shape's imported scanners, which can create virtual three-dimensional models of a patient's teeth, rip off claims in five of its patents.

The investigation was at least the third the ITC initiated in response to petitions by Align, which filed two complaints with the commission in November 2017. Align has also sued 3Shape for patent infringement in Delaware federal court.

The patents-in-suit are U.S. Patent Nos. 8,638,447; 8,638,448; 9,615,901; 9,299,192 and 9,451,873.

U.S. Patent Trial and Appeal Board Judges Brian J. McNamara, Neil T. Powell and Elizabeth M. Roesel sat on the panel.

3Shape is represented by Todd R. Walters and Roger Lee of Buchanan Ingersoll & Rooney PC.

Align Technology is represented by Pauline M. Pelletier and Kristina Caggiano Kelly of Sterne Kessler Goldstein & Fox PLLC.

The cases are 3Shape A/S v. Align Technology Inc., case numbers IPR 2019-00134; IPR 2019-00148; IPR2019-00150; IPR2019-00151; and IPR2019-00152, at the U.S. Patent Trial and Appeal Board.

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