

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

US ENDODONTICS, LLC,
Petitioner,

v.

GOLD STANDARD INSTRUMENTS, LLC,
Patent Owner.

Case IPR2015-00632
Patent 8,727,773 B2

Held: April 5, 2016

BEFORE: JOSIAH C. COCKS, HYUN J. JUNG, and
TIMOTHY J. GOODSON, Administrative Patent Judges.

The above-entitled matter came on for hearing on Tuesday, April 5, 2016, commencing at 2:00 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

Case IPR2015-00632
Patent 8,727,773 B2

APPEARANCES:

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1 JUDGE COCKS: And, Mr. Lieberman, will you be
2 giving the presentation today for the Patent Owner?

3 MR. LIEBERMAN: I will be.

4 JUDGE COCKS: Okay. Thank you.

5 MR. LIEBERMAN: Thank you, Your Honor.

6 JUDGE COCKS: Now, as is set forth in the trial
7 hearing order, each side has 45 minutes of argument time. The
8 Petitioner bears the burden of showing unpatentability and will
9 give their case first and may reserve rebuttal time. The Patent
10 Owner will then argue their opposition to Petitioner's case, and
11 we will end with the Petitioner using any time they have reserved
12 for rebuttal to respond to Patent Owner's case.

13 So, Mr. Ginsberg, that being said, whenever you're
14 ready, you may begin.

15 MR. GINSBERG: Thank you, Your Honor. And we
16 would like to reserve 10 minutes for rebuttal.

17 JUDGE COCKS: Ten minutes, okay.

18 MR. GINSBERG: Good afternoon, Your Honor.

19 JUDGE COCKS: Before you begin, actually, I would
20 ask the parties to please try and remember to refer to the slide of
21 your slide deck for Judge Goodson's benefit.

22 MR. GINSBERG: Yes, Your Honor. As mentioned,
23 my name is Jeff Ginsberg, I represent Petitioner, U.S.
24 Endodontics. As Your Honors are aware, this IPR proceedings
25 concerns U.S. Patent Number 8,727,773.

1 Turning to slide 3, the '773 patent contains 17 claims, of
2 which claims 1 and 13 are independent. Claim 1 is directed to a
3 method for manufacturing an endodontic instrument for use of
4 performing endodontic therapy on a tooth. The method provides
5 two steps. The first step is providing an elongated shank having a
6 cutting edge, the shank comprising a superelastic titanium alloy,
7 and the second step is heat-treating the entire shank at a
8 temperature of 400° Celsius up to but not including the melting
9 point of nickel-titanium.

10 And, finally, the claim concludes with a wherein clause
11 that recites, "wherein the heat-treated shank has an angle greater
12 than 10° of permanent deformation after torque at 45° of flexion
13 when tested in accordance with ISO Standard 3630-1."

14 Moving to slide 4, this is independent claim 13, it's
15 similar to claim 1, but is limited to heat-treating at a specific
16 temperature range, specifically 475° Celsius to 525° Celsius.

17 Now, in this proceeding, Patent Owner does not
18 challenge Petitioner's evidence that the prior art identified in the
19 instituted grounds teaches or discloses the composition
20 limitations recited in dependent claims 7, 12 and 17. Nor does
21 Patent Owner challenge Petitioner's evidence that the prior art at
22 issue discloses the atmosphere limitations of claims 4 to 6 and 16,
23 the size limitation of claim 8, or the requirement that the claimed
24 heat treatment occur at a single temperature restated in claims 9,
25 10, 11 and 15.

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