

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

Before JOSIAH C. COCKS, HYUN J. JUNG, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

1. Introduction

On May 20, 2015, a conference call was held between counsel for the respective parties and Judges Cocks, Jung, and Goodson. US Endodontics, LLC (“Petitioner”) was represented by Jeffrey Ginsberg. Gold Standard Instruments, LLC (“Patent Owner”) was represented by Joseph Hynds, Elizabeth Brenner-Leifer, and Steven Lieberman¹. The purpose of the call was to discuss:

(1) Petitioner’s request for authorization to file a motion to identify two additional parties as real parties-in-interest; and (2) Petitioner’s objection to certain exhibits submitted by Patent Owner as allegedly being incomplete.

Petitioner had arranged for a court reporter on the call. When available, Petitioner should file a transcript of the call using its next available exhibit number.

2. Discussion

During the call, Petitioner explained that Patent Owner’s Preliminary Response (Paper 9) had raised a challenge to the Petition as failing to identify two additional entities – Edge Endo, LLC and Guidance Endodontics, LLC – as real parties-in-interest. Although Petitioner does not agree that those entities need to be so identified, it sought leave to file a motion naming them as real parties-in-interest as a matter of efficiency. Petitioner represented that it is still not barred by the provision of 35 U.S.C. § 315(b). Patent Owner indicated that, if Petitioner is authorized to file the motion, Patent Owner will oppose the motion.

After conferring, the panel determined to authorize the filing of Petitioner’s requested motion. The panel also authorized Patent Owner to file an opposition. Petitioner’s motion is due no later than Wednesday, May 27, 2015, and shall not

¹ A “Motion for Admission *Pro Hac Vice* of Steven Lieberman” currently is pending before the Board. See Paper 6. Counsel for Petitioner did not object to Mr. Lieberman’s participation in the call.

exceed ten (10) pages in length. Patent Owner's opposition is due no later than June 3, 2015, and shall not exceed ten (10) pages in length.

During the call, Petitioner also raised objections to certain of Patent Owner's exhibits as being only portions of larger documents. Petitioner expressed a desire for Patent Owner to file the absent content. After inquiry, the panel determined that the issue is premature. The parties have not yet discussed the issue between themselves, and both parties indicated that agreement likely could be reached without Board involvement.

3. Order

It is

ORDERED that Petitioner is authorized to file its requested motion, which is due no later than Wednesday, May 27, 2015, and shall not exceed ten (10) pages in length;

FURTHER ORDERED that Patent Owner is authorized to file an opposition to the motion, which is due no later than Wednesday, June 3, 2015, and shall not exceed ten (10) pages in length; and

FURTHER ORDERED that Petitioner must file a copy of the transcript of the call, when it becomes available, as an exhibit.

IPR2015-00632
Patent 8,727,773

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