

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 No. IPR2015-00632
U.S. Patent No. 8,727,773 B2

**PETITIONER'S MOTION FOR LEAVE TO ADD
TWO REAL PARTIES-IN-INTEREST**

Petitioner US Endodontics, LLC (“Petitioner” or “US Endo”) respectfully requests leave to identify two additional real parties-in-interest (“RPIs”)—Guidance Endodontics, LLC (“Guidance”) and Edge Endo, LLC (“Edge Endo”)—that Patent Owner Gold Standard Instruments, LLC (“Patent Owner” or “GSI”) asserts in its preliminary response were improperly omitted from US Endo’s Petition. US Endo further requests that the Board maintain US Endo’s original January 30, 2015 filing date.

A. Introduction

Although US Endo disputes that either Guidance or Edge Endo is actually an RPI (while each is owned by the majority owner of US Endo, they are separate entities that did not exert any control over this proceeding and had no involvement in the filing of the petition), it is willing to concede the issue in order to streamline the proceeding and avoid unnecessary litigation. Petitioner US Endo’s request would not implicate any of the considerations under 35 U.S.C. § 315(b) or (e), even if it is assigned a new filing date.

Patent Owner GSI’s only claim of prejudice raised during the May 20, 2015, telephone conference—that it “had to do the work and spend the money” to prepare its argument—lacks merit. Although GSI may have spent money addressing the RPI issue in its preliminary response, parties routinely spend resources addressing issues that are ultimately conceded or otherwise resolved in

litigation. Indeed, that is one of the main goals of all IPRs—to narrow the issues and proceed to a final written decision as efficiently and expeditiously as possible. *See* 37 C.F.R. § 42.1(b). Further, GSI’s claim of prejudice is belied by the fact that it seeks to pursue discovery on this issue, thereby subjecting the parties to additional time, money and expense, when it could just consent to the addition of Guidance and Edge Endo as RPIs.

During the May 20 teleconference, GSI also asserted that granting US Endo’s request would set bad policy and encourage petitioners in future proceedings to intentionally omit RPIs. This claim also lacks merit since both parties and practitioners owe a duty of candor and good faith to the Board. In any event, petitioners would not generally engage in the conduct that GSI suggests since it would often trigger the time bar provision of 35 U.S.C. § 315(b). *See GEA Processing Eng’g, Inc. v. Steuben Foods, Inc.*, IPR2014-00041, Paper 140 (Feb. 22, 2015) (“*Steuben*”).

Pursuant to 37 C.F.R. § 42.5, good cause exists to maintain US Endo’s original January 30, 2015, filing date. First, assigning a new filing date would needlessly restart the entire process and delay ultimate resolution of the patentability issues raised in the petition in contravention to 37 C.F.R. § 42.1(b). *See also* 77 Fed. Reg. 48,615. Second, US Endo’s motion is intended to avoid unnecessary litigation, reduce costs, and focus the proceeding on whatever

patentability issues the Board might institute for trial. Further, US Endo has already identified the owner of both Guidance and Edge Endo, Dr. Charles J. Goodis, as an RPI in this proceeding.

Accordingly, the Board should grant US Endo's motion for leave to add Guidance and Edge Endo as additional RPIs, and maintain US Endo's original filing date.

B. Facts

Petitioner US Endo is a manufacturer of endodontic files that is owned by Dr. Charles Goodis (70%) and Mr. Bobby Bennett (30%). Edge Endo markets and sells products manufactured by US Endo and other entities, while Guidance only sells filler material (gutta percha points) and drying material (paper points) used in root canals manufactured by companies other than US Endo. Edge Endo and Guidance are each owned by Dr. Goodis. Neither company has any ownership interest in US Endo. Edge Endo and Guidance did not exert any control over this proceeding and had no involvement in the filing of the petition.

On June 24, 2014, Petitioner US Endo was sued in the U.S. District Court for the Eastern District of Tennessee by Dentsply International, Inc. ("Dentsply") for alleged infringement of the U.S. Patent No. 8,727,773 ("the '773 patent").¹

¹ Dentsply was initially identified as the licensee of Patent Owner GSI.

Dentsply later moved to amend its complaint to add Tulsa Dental Products, LLC as

Petitioner was served with the complaint on June 25, 2015. Neither Edge Endo nor Guidance is a party to the pending district court litigation.

On January 30, 2015, Petitioner filed a petition for *inter partes* review of all claims of the '773 patent. IPR2015-00632, Paper 2. The petition identified US Endo as a RPI. On February 25, 2015, Petitioner, with the Board's permission and without objection from GSI, submitted corrected mandatory notices, identifying both Dr. Goodis and Mr. Bennett as additional RPIs. Paper 8. GSI filed its preliminary response on May 11, 2015. In its preliminary response, GSI argues that Petitioner should have also identified Edge Endo and Guidance as RPIs (in addition to US Endo, Dr. Goodis and Mr. Bennett). Specifically, Patent Owner argues that Guidance and Edge Endo are all owned and controlled by Dr. Goodis and that they share many of the same resources. Paper 9 at 55.

On May 20, 2015, the Board held a teleconference regarding US Endo's request to add Edge Endo and Guidance as additional RPIs. Ex. 1028. The Board granted US Endo leave to file a motion, not to exceed 10 pages, and granted GSI the same number of pages for its responsive brief. Ex. 1028 at 30:19-31:3.

an additional plaintiff. The named inventor of the '773 patent, Dr. Luebke, is the president of GSI. Ex. 1029.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.