

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
Permitting the Addition of Real Parties-In-Interest
37 CFR § 42.5

1. Introduction

Petitioner, US Endodontics, LLC (“US Endo” or “Petitioner”), filed a “Petitioner’s Motion For Leave to Add Two Real Parties-In-Interest.” Paper 15 (“Motion” or “Mot.”). Patent Owner, Gold Standard Instruments, LLC (“GSI” or “Patent Owner”) filed a “Patent Owner’s Opposition to Petitioner’s Motion for Leave to Add Two Real Parties In Interest.” Paper 25 (“Opposition” or “Opp.”)¹

In its Motion, US Endo “requests leave to identify two additional real parties-in-interest (“RPIs”)—Guidance Endodontics, LLC (“Guidance”) and Edge Endo, LLC “Edge Endo”— [as real parties-in-interest].” Mot. 1. US Endo also “requests that the Board maintain US Endo’s original January 30, 2015 filing date.” *Id.* US Endo represents, however, that “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.” *Id.*

In its Opposition, GSI “requests that the Board deny Petitioner’s Motion for Leave to Add Two Real Parties in Interest (Paper 15) to its Petition for *Inter Partes* Review of Patent 8,727,773, and dismiss its Petition.” Opp. 1. Alternatively, GSI requests that “in the event that the Board does grant Petitioner’s motion, then, under Rule 42.106(a), the Petition and Patent Owner’s Preliminary Response both should be accorded a new filing date that is the same date that the identification is corrected.” *Id.* at 10.²

For the reasons set forth below, we *grant* US Endo’s Motion to the extent that it may add Guidance and Edge Endo as real parties-in-interest.

¹ We authorized the filing of the Motion and Opposition. Paper 10.

² In making its alternative request, GSI cites to *Askeladden LLC v. McGhie*, IPR 2015-00122, slip op. at 2 (PTAB Mar. 16, 2015) (Paper 34).

2. Discussion

By statute, a petition filed under § 311 “may only be considered” if the petition “identifies all real parties in interest.” 35 U.S.C. § 312. By rule, a petition will not be accorded a filing date until the petition satisfies various requirements, including identifying all real parties-in-interest. 37 C.F.R §§ 42.106, 42.104, and 42.8(b)(1). Thus, to be eligible for consideration, and to be accorded a filing date, a petition must identify all the real parties-in-interest. With such requirement in mind, given the circumstances presented in this proceeding, it seemingly would not be an appropriate course of action to permit belated designation of additional real parties-in-interest that could have been designated before, while yet also maintaining the filing date initially accorded to the Petition.

We are mindful that our rules provide for the following:

A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.

37 C.F.R. § 42.104(c).

Here, however, it is clear that any mistake in the designation of the real parties-in-interest made with respect to the Petition in this proceeding did not arise due to a “clerical or typographical error.” Indeed, that is clear from the content of US Endo’s motion, itself, which requests leave to name additional real parties-in-interest, yet also “disputes” that such naming is necessary. Mot. 1. That show of reluctance, at this stage, discounts the existence of a clerical or typographical error. Thus, US Endo’s professed “dispute[,]” and its representation that “it is willing to concede the issue” (Mot. 1), coupled with its proffered Motion as a whole, conveys that US Endo’s request to add real parties-in-interest did not arise due to a typographical or clerical error.

We construe our rules to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). Although GSI primarily seeks dismissal of the Petition in its Opposition, the circumstances presented here convey that such dismissal would frustrate the pursuit of a just, speedy, and inexpensive resolution to this proceeding. In that respect, as represented by US Endo, there is, presently, no statutory bar arising under 35 U.S.C. § 315(b) or (e), which would preclude US Endo from simply filing a new Petition adding real parties-in-interest. *See* Mot. 1. In such circumstance, the panel would be faced with the same consideration of the merits of the Petition only at some future date. The parties also would remain at their current posture only temporally offset, and having incurred additional expense. The facts involved in this proceeding with respect to the real party-in-interest issue do not establish an appropriate backdrop to dismiss the Petition.

We may excuse late action “upon a Board decision that consideration of the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3). In considering the interests of justice, we provide US Endo the opportunity to add Guidance and Edge Endo as real parties-in-interest in connection with the Petition by filing updated Mandatory Notices. Should US Endo file updated Mandatory Notices designating those additional real parties-in-interest, the filing date accorded the Petition *will be vacated*, and a new filing date will be accorded. *See Askeladden LLC v. McGhie*, IPR 2015-00122, slip op. at 2 (PTAB Mar. 16, 2015) (Paper 34). As requested by GSI, in that circumstance, GSI’s “Patent Owner’s Preliminary Response” (Paper 9) will also be treated as if filed on the same date as the new filing date accorded the Petition. *See id.*; Opp. 10.

3. Order

Accordingly, it is

ORDERED that the portion of US Endo's Motion seeking to add two real parties-in-interest is *granted* to the extent that US Endo is permitted to update its Mandatory Notices pursuant 37 C.F.R. § 42.8(b)(1) to identify Guidance and Edge Endo as real parties-in-interest;

FURTHER ORDERED that if updated Mandatory Notices are filed identifying Guidance and Edge Endo as real parties-in-interest, the filing date accorded the Petition and the Preliminary Response *will be vacated*, and a new filing date will be accorded to each;

FURTHER ORDERED that updated Mandatory Notices filed in accordance with this Order will be considered corrections to the Petition; and

FURTHER ORDERED that US Endo is not required to resubmit the information contained in the original Petition filings.

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.