

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 REQUEST FOR PARTIAL REHEARING OF THE
BOARD'S DECISION INSTITUTING *INTER PARTES* REVIEW**

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Patent Trial and Appeal Board
US Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Submitted Electronically via the Patent Review Processing System

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Pursuant to 37 C.F.R. § 42.71(c) and (d), US Endodontics, LLC (“Petitioner” or “US Endo”) respectfully requests partial rehearing of the Board’s August 5, 2015 decision instituting *Inter Partes* Review in IPR2015-00632 (Paper 29). In particular, US Endo requests rehearing of the Board’s determinations that (1) U.S. Patent No. 8,727,773 (“the ’773 patent”) is “entitled to an effective filing date that is the filing date of the PCT application,” and (2) US Endo has not shown a reasonable likelihood of prevailing on proposed grounds of unpatentability 1 through 4 because the Luebke 2008 and Gao references are not properly considered prior art. Paper 29 at 13-15.

The Petition provides two reasons why the ’773 patent claims are not entitled to priority to earlier-filed applications: (1) the earlier applications do not demonstrate that the inventor possessed “heat-treating” in an atmosphere reactive with the nickel-titanium (“Ni-Ti”) shank, and (2) the earlier applications do not disclose the claimed combination of elements. Paper 2 at 15-20.

The Board rejected the first argument, finding that the PCT application’s disclosure of applying a titanium-nitride coating to a shank by physical vapor deposition (“PVD”) showed possession of heat-treating in a reactive atmosphere. In doing so, the Board was apparently misled by Patent Owner’s arguments regarding the nature and extent of the PCT application’s disclosure of such PVD coating process. That disclosure does not describe heat-treating in a reactive

atmosphere at a temperature within the ranges recited in the '773 patent claims. It discloses no temperature whatsoever for the PVD coating procedure. Thus, even if the PCT application discloses heat-treating in a reactive atmosphere, which Petitioner disputes, it does not disclose the *claimed* heat-treating in a reactive atmosphere, which requires heat-treating at temperatures from at least 400°C.

Moreover, the reaction that Patent Owner asserts occurs during the PVD coating process is between nitrogen and a titanium rod used for the coating; the reaction is not with the Ni-Ti shank itself. It therefore does not expand the PCT application's explicitly limited disclosure of heat-treatment in an atmosphere "unreactive *with the shank*." Because the claimed "heat-treating" encompasses, under the broadest reasonable construction standard, heat-treating in "any atmosphere," including one reactive with the shank, the PCT application's disclosure does not demonstrate that the inventor possessed the full scope of the '773 patent claims.

Regarding Petitioner's second priority date argument—i.e., the earlier applications do not disclose the claimed combination of elements—the Board apparently overlooked this argument altogether.

I. STANDARD FOR REHEARING

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