

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

**PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a)**

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Pursuant to 37 C.F.R. § 42.123(a), Petitioner US Endodontics, LLC (“US Endo”) submits the following motion to submit supplemental information in IPR2015-00632. Specifically, US Endo seeks to submit the prosecution history of Patent Owner’s subsequently issued U.S. Patent No. 8,876,991 (“the ’991 patent”), which includes statements that are relevant to the claims for which the trial has been instituted. US Endo requested authorization from the Board to file this motion on August 26, 2015, which the Board granted on August 28, 2015. Patent Owner stated that it would not oppose the filing of this motion.

I. BACKGROUND

On January 30, 2015, US Endo filed a petition for *inter partes* review of claims 1-17 of U.S. Patent No. 8,727,773 (“the ’773 patent”), owned by Gold Standard Instruments, LLC (“Patent Owner” or “GSI”). In the petition, US Endo explained that, if the “wherein” clause of claims 1 and 13 is considered to be a claim limitation,¹ it can be met “by a heat-treated file with an austenite finish temperature above mouth temperature.” Paper 2 at 7-8. This understanding was

¹ Specifically, claims 1 and 13 of the ’773 patent claim a method of manufacturing an endodontic instrument “wherein the heat treated shank has an angle greater than 10 degrees of permanent deformation after torque at 45 [°/degrees] of flexion when tested in accordance with ISO Standard 3630-1.”

supported by the applicant's statements in the prosecution histories of both the '773 patent and other related patents, which admitted that a shank with a transformation (austenite finish ("A_f")) temperature above body temperature would satisfy the limitations of the "wherein" clause. *Id.* at 13-14. Based, in part, on this understanding, the Board granted US Endo's petition and instituted a trial on Grounds 5, 6, 7, and 11 on August 5, 2015. Paper 29 at 19, 30 and 32.

II. SUPPLEMENTAL INFORMATION TO BE SUBMITTED

The present motion seeks to submit the prosecution history of the '991 patent, which includes statements that are relevant to the claims for which trial has been instituted. The application resulting in the '991 patent is a continuation of the application that led to the '773 patent. GSI is the owner of both of these related patents. The supplemental information requested to be entered is included as Exhibit 1030, submitted herewith.

III. ARGUMENT

US Endo's motion to submit supplemental information should be granted because it satisfies the requirements of 37 C.F.R. § 42.123(a), and because the supplemental information does not (i) change the grounds of unpatentability upon which trial has been instituted, (ii) change the evidence initially presented, or (iii) unfairly prejudice GSI. *See, e.g., Taiwan Semiconductor Mfg. Co., Ltd. v. DSS Tech. Mgmt., Inc.*, IPR2014-01030, Paper 11 at 3 (PTAB Feb. 3, 2015); *Palo Alto*

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