

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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US ENDODONTICS, LLC,  
Petitioner,

v.

GOLD STANDARD INSTRUMENTS, LLC  
Patent Owner.

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Case IPR2015-00632  
Patent 8,727,773 B2

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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 August 28, 2015, a conference call was held between counsel for the respective parties and Judges Cocks, Jung, and Goodson. US Endodontics, LLC (“US Endodontics”) was represented by Jeffrey Ginsberg. Gold Standard Instruments, LLC (“Gold Standard”) was represented by Joseph Hynds. The purpose of the call was to discuss Petitioner’s request for authorization to file a motion to submit supplemental information (“Motion”) pursuant to 37 C.F.R. § 42.123.

### *2. Discussion*

During the call, US Endodontics stated that it was seeking to submit the prosecution history of U.S. Patent No. 8,876,991, another patent owned by Gold Standard. US Endodontics explained that it believed that statements made by Gold Standard in that prosecution history are relevant to the claims for which trial has been instituted in this proceeding.

Gold Standard stated that it does not oppose US Endodontics’s request for authorization to file the noted Motion. Gold Standard represented that it also would not oppose the Motion if filed.

37 C.F.R. § 42.123 states, in part, the following:

§ 42.123 Filing of supplemental information.

(a) *Motion to submit supplemental information.* Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

(1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date for which the trial has been instituted.

(2) The supplemental information must be relevant to a claim for which the trial has been instituted.

In this case, because US Endodontics has met those requirements, and because Gold Standard does not oppose the request to file, or the filing of, the Motion, the panel authorized US Endodontics to file the Motion. US Endodontics subsequently filed the Motion as Paper 37.<sup>1</sup>

During the call, Gold Standard also requested that it be permitted to file objections to evidence (“Objections”) that it had served timely on US Endodontics, but had neglected to file as now required by 37 C.F.R. § 42.64(b)(1). Gold Standard explained that it had not taken into account appropriately the recent change in the rules requiring the filing of the objections. After inquiry from the panel as to any objection to such filing, US Endodontics stated that it desired to confer with its client. The panel indicated that if US Endodontics does object, it should schedule a conference call with the panel and opposing counsel. US Endodontics has not arranged for such a call, and subsequently has conveyed to Board personnel via e-mail, that it does not object to the late filing of Gold Standard’s Objections to evidence.

Because US Endodontics does not object to the filing of the noted Objections, and US Endodontics is not prejudiced by the late filing of the Objections, we authorize Gold Standard to file the Objections.<sup>2</sup>

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<sup>1</sup> Given the circumstances of this case, the panel also authorized US Endodontics to file provisionally the documents that it is seeking to have entered as supplemental information. Those documents have been entered provisionally as Exhibit 1030.

<sup>2</sup> In this case, our authorization is retroactive, as Gold Standard has filed the Objections as Paper 35.

*3. Order*

It is

ORDERED that US Endodontics is authorized to file its requested Motion to submit supplemental information; and

FURTHER ORDERED that Gold Standard is authorized to file its Objections to US Endodontics's evidence.

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