

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*.

DECISION
Petitioner's Request for Rehearing
37 CFR § 42.71

I. INTRODUCTION

Petitioner, US Endodontics, LLC (“US Endo” or “Petitioner”), filed a “Petitioner’s Request for Partial Rehearing of the Board’s Decision Instituting *Inter Partes* Review.” Paper 32 (“Request” or “Req.”). In particular, US Endo requests partial rehearing of the Decision on Institution (Paper 29, “Decision” or “Dec.”) concerning the panel’s determination not to institute trial with respect to claims of U.S. Patent No. 8,727,773 B2 (“the ’773 patent”) in connection with proposed grounds of unpatentability based on Luebke¹ and Gao².

For the reasons stated below, US Endo’s Request is *denied*.

II. DISCUSSION

In determining whether to institute an *inter partes* review, the Board may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b). When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing has the burden of showing the decision should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

Here, US Endo contends that the panel “abused its discretion in concluding that the challenged claims are entitled to claim priority to the PCT Application”^[3]; and, in doing so, “abused its direction by not instituting Grounds 1 through 4 on the basis that Luebke 2008 and Gao are not prior art.” Req. 7, 14.

¹ US 2008/0032260 A1 published February 7, 2008 (Ex. 1012)

² US 2011/0271529 A1 published November 10, 2011 (Ex. 1014)

³ The referenced “PCT application” is PCT/US2005/019947 filed June 7, 2005 and published as WO2005/122942 A1 on December 29, 2005. That PCT application appears in the record as a part of Exhibit 1009, and also as Exhibit 2003.

As set forth in the Decision, we were not persuaded by US Endo’s Petition that the ’773 patent should be deprived of an effective filing date stemming from the filing date of the PCT application. *See* Dec. 13–14. Because we were not persuaded in that regard, we also were not persuaded that Luebke 2008 or Gao constituted prior art to the ’773 patent. *Id.* at 14–15.

In reaching our conclusion with respect to the prior art status of Luebke 2008 and Gao, we took note of GSI’s contentions that the PCT application describes heat treatment as a part of a coating process “in a non-inert, or reactive, atmosphere—nitrogen gas and titanium,” and the citation to various portions of the PCT application, including paragraphs 35–42, and Figures 3–7. *Id.* at 13. In that regard, the portions of the PCT application referenced by GSI describe examples of heat treatment of medical instruments, such as files, made of nickel and titanium “at 500°C for 75 minutes.” *See, e.g.*, Ex. 2003 ¶ 36. Although that particular exemplary heating temperature and duration is offered expressly in the context of a particular reactive atmosphere, i.e., argon, the PCT application also describes that files are coated with titanium nitride “using physical vapor deposition with an inherent heat-treatment.” *Id.* There is no apparent dispute that such disclosed process in the context of physical vapor deposition is accomplished in an atmosphere that is reactive with a file made from nickel and titanium.⁴

Thus, the record before us conveys that examples of specific heat treatments of nickel-titanium files include temperatures at 500 °C for 75 minutes, and that

⁴ As we observed previously (Dec. 13), US Endo relayed in its Petition that the heat treating process with respect to the coated instrument is understood as a reactive atmosphere for the involved instrument. *See* Pet. 16 (“Every discussion of heat treatment in the earlier applications, *except in the context of optionally heat treating coated instruments*, specifies that an unreactive atmosphere is used.”) (*emphasis added*).

when coated files are involved, the coating process results in additional “inherent heat treatment” of those files in atmospheres recognized as reactive to the files. The logical inference from the disclosure of the PCT application is that the “inherent heat treatment” resulting from the coating process occurs at the temperatures and durations discussed with respect to “heat treatment” generally. Indeed, the PCT application equates heat-treatment provided “separately” or “as [used] in the coating process,” and describes that each of those techniques provides particular benefits to an instrument such as “higher resistance to heat degradation,” and “reliev[ing] stress in the instrument.” Ex. 2003 ¶ 32. Moreover, we observe that elsewhere, the PCT application conveys that various heat treatment temperatures and durations were contemplated by the inventors, including “400°C up to but not equal to the melting point of the titanium alloy, “from 475°C to 525°C,” and “approximately 1 to 2 hours.” *Id.* at ¶ 25.

As a part of its Request for Rehearing, US Endo also contends that we overlooked an argument in the Petition that earlier applications, including the PCT application “do not disclose the *combination* of elements recited in the Challenged Claims,” citing to the Petition at pages 19–20. Req. 14. We, however, did not, and do not, find the argument persuasive. US Endo’s position generally amounts to an assertion that a single example, i.e., Example 4, set forth in earlier applications, including the PCT application, does not account for the “combination” of all the features of the claims of the ’773 patent. Yet, that position does not, in our view, account adequately for what the totality of the prior applications, including the PCT application, convey with respect to the inventors’ knowledge or possession of the claimed invention.

Accordingly, we have considered US Endo’s position that we “should grant rehearing on the effective filing date issue,” and also on our “decision not to

institute grounds 1 through 4” based on Luebke 2008 and Gao. Req. 15. Although US Endo may disagree with our course of action in that regard as set forth in the Decision, we are not persuaded that we misapprehended or overlooked any matter in taking that action.

In any event, as we noted in the Decision:

There is no requirement that an *inter partes* review proceeding must proceed on all grounds of unpatentability asserted by a petition. *See* 37 C.F.R. § 42.108(a) (“When instituting inter partes review, the Board may authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim.”). Furthermore, we construe our rules “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b); *see also* 35 U.S.C. § 316(b) (regulations for post-grant proceedings take into account “the efficient administration of the Office” and “the ability of the Office to timely complete [instituted] proceedings”).

Dec. 31.

We instituted trial on all of the claims of the ’773 patent to which the grounds based on Luebke 2008 and Gao are directed based on other prior art. US Endo has not shown that, in the circumstances presented here, our decision not to institute on the additional grounds based on Luebke 2008 and Gao constituted an abuse of discretion.

III. ORDER

It is

ORDERED that US Endo’s Request for Rehearing is *denied*.

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