

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 PGR2015-00019
Patent 8,876,991 B2

Before JOSIAH C. COCKS, HYUN J. JUNG, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 CFR § 42.5

In a conference call on December 3, 2015, Petitioner requested authorization to file a Reply to Patent Owner's Preliminary Response (Paper 14).

Petitioner contends in its Petition (Paper 1) that the Notice of Allowance for the '991 patent shows that the Examiner had mistakenly reviewed the wrong claims. *See* Paper 1, 2–4, 6–11. In the Preliminary Response, Patent Owner argues that the Notice of Allowance contained a mere clerical error. *See* Paper 14, 10. Petitioner's proposed Reply would respond to Patent Owner's argument by discussing a rejection from the prosecution of another pending application, which Petitioner asserts contradicts Patent Owner's argument in the Preliminary Response. Patent Owner opposes Petitioner's request to file a reply brief, but requests authorization to file a sur-reply if Petitioner is permitted to file a reply brief.

Reply and sur-reply briefing before a decision on institution is not standard procedure. The Board has three months after the filing of a preliminary response to study the parties' submissions and render a decision on institution. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,757 (Aug. 14, 2002) ("The Board acting on behalf of the Director will determine whether to institute a trial within three months of the date the patent owner's preliminary response was due or was filed, whichever is first."). Permitting additional briefing following the preliminary response compresses the amount of time that the Board has to consider all the briefing in rendering its decision on institution. While there are situations in which additional briefing between the preliminary response and a decision on institution is helpful, this is not such a case. Specifically, we are not persuaded, at this time, that further briefing on the nature of the error the Examiner made in the Notice of Allowance (i.e., was it a mere clerical error or does it reveal a

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misunderstanding of the claims being allowed?) would aid our analysis in rendering a decision on institution in this case.

Accordingly, it is hereby:

ORDERED that Petitioner's request to file a Reply to the Preliminary Response is *denied*.

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