

## Dental Instrument Patent Claims Found Invalid In PGR

By **Matthew Bultman**

*Law360, New York (January 3, 2017, 9:35 PM EST)* -- US Endodontics LLC has proven claims in a dental instrument patent are invalid, the Patent Trial and Appeal Board ruled following a recent post-grant review, finding the invention had not been adequately described within the patent.

The PTAB found on Dec. 28 that several claims in Gold Standard Instrument LLC's patent were invalid for lack of an adequate written description, as well as lack of enablement. Enablement requires a patent describe how to make and use the invention.

In addition, the board decided the claims were anticipated.

"Upon consideration of the evidence and arguments of both parties, we determine that petitioner has shown by a preponderance of the evidence that [five claims] of the [patent] are unpatentable," the board wrote.

Gold Standard's patent covers a dental instrument that it said was designed to overcome problems that can arise when cleaning and enlarging a curved root canal.

New Mexico-based US Endodontics was sued in Tennessee federal court in 2014 for infringing two related Gold Standard patents. The lawsuit was filed by a company called Dentsply International Inc., a dental products maker that is the exclusive licensee.

The PTAB previously invalidated claims in one of those asserted patents following an inter partes review, or IPR. The district court case has been put on hold pending further appeals.

Post-grant review is different from the more common IPR in that it allows for a wider array of invalidity challenges, such as the patent claims being indefinite. PGR is only available for patents filed on or after March 16, 2013 — the day the America Invents Act switched the U.S. to a system in which patents are awarded to the first inventor to file an application, rather than the first to invent something.

Here, the application that gave rise to the Gold Standard patent was filed in January 2014. But Gold Standard argued its claims were entitled to an effective filing date in 2005, when a related patent application was filed. If true, this would have made the patent ineligible for post-grant review.

US Endodontics countered that the 2014 application didn't adequately support the challenged claims. Neither did the earlier applications, which shared the same disclosure, it said. As such, the company

argued that Gold Standard wasn't entitled to a pre-AIA filing date.

The PTAB agreed in its decision Wednesday.

"We determine that petitioner has shown that [the challenged claims] are not adequately supported by the disclosure of the [2014] application," the board wrote. "Because it is undisputed that the [2014] application has the same disclosure as the earlier applications to which the [patent] claims priority, we also determine that petitioner has shown that [the claims] are not entitled to an effective filing date earlier than January 29, 2014."

The patent at issue is U.S. Patent Number 8,876,991.

US Endodontics is represented by Jeffrey Ginsberg and Abhishek Bapna of Patterson Belknap Webb & Tyler LLP.

Gold Standard is represented by Joseph Hynds, R. Elizabeth Brenner-Leifer, Jason Nolan and Christine Gifford of Rothwell Figg Ernst & Manbeck PC.

The case is US Endodontics LLC v. Gold Standard Instruments LLC, case number PGR2015-00019, before the Patent Trial and Appeal Board.

--Editing by Aaron Pelc.

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