

## Fed. Circ. Affirms PTAB Nix Of Root Canal Patent As Obvious

By **Steven Trader**

*Law360, New York (August 17, 2017, 4:34 PM EDT)* -- The Federal Circuit on Thursday affirmed the Patent Trial and Appeal Board's invalidation of a patent covering a method for making root canal instruments, agreeing that the patented method was obvious in view of prior art.

The appellate panel was unpersuaded by Gold Standard Instrument LLC's argument that the prior art references the board relied on in its invalidating decision — the so-called Kuhn and Matsutani references — actually taught away from the heat treatment process for nickel titanium endodontic files that its own patent described.

Gold Standard's invention, U.S. Patent No. 8,727,773, calls for the heat treatment of the entire shank of the file, which is used in root canal procedures to reduce the superelasticity of the files so that when they are bent to fit the shape of a tooth canal, they hold their shape rather than springing back to their original form. On the other hand, the Matsutani reference warned that heat-treating the entire shank could cause a problem, Gold Standard had noted.

But the PTAB was correct to point out in its invalidation decision that Matsutani teaches that the heat treatment of an endodontic shank is known to be variable, the panel said. The board also got it right by relying on the testimony of Dr. A. Jon Goldberg, who concluded that a person skilled in the art would have been motivated to perform the claims of the '773 patent.

"While acknowledging the potential problem Matsutani identified, the board properly credited Dr. Goldberg's testimony that an ordinarily skilled artisan would have inferred that Matsutani's heat-treating procedures may be used for the entire shank," the Federal Circuit wrote Thursday. "Because substantial evidence supports the board's findings, we conclude that claims 1–17 are obvious in view of the Matsutani ground."

The panel's decision marked a win for New Mexico-based U.S. Endodontics LLC, which was sued in Tennessee federal court in 2014 for infringing two Gold Standard patents, but successfully lodged an America Invents Act review.

"We are pleased that the Federal Circuit affirmed the board's decision that all 17 claims of the '773 patent are unpatentable, finding that substantial evidence supported the board's decision," Endodontics attorney Jeff Ginsberg of Patterson Belknap Webb & Tyler LLP told Law360. "We believe that the same prior art applies with full force to the remaining patent in the related district court action and will be

seeking dismissal of that action in its entirety.”

Attorneys for Gold Standard on Thursday did not immediately return a request for comment.

Chief Judge Sharon Prost and Judges William C. Bryson and Kara F. Stoll served on the federal circuit panel.

Gold Standard is represented by Stephen M. Lieberman, Christine Gifford, Derek F. Dahlgren and Rachel Echols of Rothwell Figg Ernst & Manbeck PC.

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

The case is Gold Standard Instruments LLC v. US Endodontics LLC, case number 16-2597, in the U.S. Court of Appeals for the Federal Circuit.

--Additional reporting by Jimmy Hoover. Editing by Alyssa Miller.