

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDGE ENDO, LLC,
Petitioner,

v.

MICHAEL SCIANAMBLO,
Patent Owner.

Case IPR2018-01320
Patent 8,882,504 B2

Before BART A. GERSTENBLITH, ROBERT A. POLLOCK, and
RICHARD J. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. §§ 314(a), 325(d)

I. INTRODUCTION

Edge Endo, LLC (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–4, 6–11, and 14 of U.S. Patent No. 8,882,504 B2 (Ex. 1001, the “’504 patent”). Paper 1 (“Pet.”). Michael Scianamblo (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 14 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314. Based on the particular circumstances of this case, we exercise our discretion under 35 U.S.C. § 325(d) and do not institute *inter partes* review of the challenged claims.

A. *Related Proceedings*

Petitioner states that “[t]he ’504 patent is asserted in *Dentsply Sirona Inc., et al. v. Edge Endo, LLC, et al.*, No. 1:17-CV-01041 (D.N.M.) [the *Dentsply* litigation].” Pet. 1. Petitioner further states that it “has also filed petitions for IPR [*inter partes* review] of related U.S. Patent Nos. 8,932,056 (Case No. IPR2018-01321) and 9,351,803 (Case No. IPR2018-01322), which are asserted in [the *Dentsply* litigation].” *Id.* Petitioner also indicates that Patent Owner “has a related pending patent application that might be affected by this proceeding: U.S. Pat. Appl. Ser. No. 15/607,066.” *Id.*

Patent Owner identifies the following related matters:

a. The *Dentsply* litigation, involving U.S. Patent No. 8,882,504, and related U.S. Patent Nos. 8,932,056 and 9,351,803. U.S. Patent No. 9,801,696, owned by Maillefer Instruments Holding S.A.R.L., is also asserted in that litigation and is the subject matter of *Edge Endo, LLC v. Maillefer Instruments Holding S.a.r.l.*, Case IPR2018-01349 (PTAB);

b. *Edge Endo, LLC v. Michael Scianamblo*, Case IPR2018-01321 (PTAB) involving related U.S. Patent No. 8,932,056;

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c. *Edge Endo, LLC v. Michael Scianamblo*, Case IPR2018-01322 (PTAB) involving related U.S. Patent No. 9,351,803;

d. U.S. Provisional Patent Application Serial Number 60/669,409, filed on April 8, 2005 (Expired);

e. U.S. Patent Application Serial Number 11/402,207, issued as U.S. Patent No. 8,454,361 on June 4, 2013;

f. U.S. Patent Application Serial Number 14/455,636, filed on August 8, 2014 (Abandoned);

g. U.S. Patent Application Serial Number 14/632,930, issued as U.S. Patent No. 9,351,803 on May 31, 2016;

h. U.S. Patent Application Serial Number 15/166,770, issued as U.S. Patent No. 9,662,181 on May 30, 2017; and

i. U.S. Patent Application Serial Number 15/607,066, filed on May 26, 2017 (Pending).

Paper 12, 2–3.

B. The '504 Patent (Ex. 1001)

The '504 patent describes endodontic instruments that “have at least a section with a center of mass offset from an axis of rotation so that when the instrument is rotated, the section bends away from the axis of rotation.” Ex. 1001, Abstract.

The '504 patent states that “[e]ndodontic instruments can be used for cleaning and enlarging the endodontic cavity space (“ECS”), also known as the root canal system of a human tooth.” *Id.* at 1:17–19. The '504 patent further states that “[t]he present invention provides methods and apparatus for providing swaggering endodontic instruments for preparing [an ECS].” *Id.* at 3:52–54. According to the '504 patent, one aspect of the invention is directed to “an endodontic device having a tapered body having a tip end and a shank end, wherein the tip end has a diameter that is less than a

diameter of the shank end and the body has an axis of rotation extending from the tip end to the shank end.” *Id.* at 3:55–59.

C. *Prosecution History of the '504 Patent*

1. *The '207 Application*

U.S. Application No. 11/402,207 (“’207 Application”) was filed on April 10, 2006, and issued as U.S. Patent No. 8,454,361 (“’361 patent”) on June 4, 2013. Ex. 1001, 1; Ex. 2005, 1. The ’207 Application is the parent of U.S. Application No. 13/794,629 (“’629 Application”), that matured into U.S. Patent No. 8,932,056 B2 (“’056 patent”), and U.S. Application No. 13/804,084 (“’084 Application”), that matured into the ’504 patent. *See* Ex. 1002 (file history of the ’504 patent); Ex. 2007 (file history of the ’056 patent). The ’207 Application, the ’629 Application, and the ’084 Application were examined by the same Examiner. *Id.*; *see also* Ex. 2005 (file history of the ’361 patent).

During prosecution of the ’207 Application, the Examiner issued rejections on February 26, 2009, of several claims as anticipated by McSpadden,¹ that included a discussion of Figures 3A–3D thereof, and other claims as obvious based on U.S. Patent No. 5,897,316 issued to Buchanan and McSpadden (“Feb. ’09 OA”). Ex. 2005, 307–11. Patent Owner responded to the Feb. ’09 OA on June 26, 2009, and specifically addressed the anticipation and obviousness rejections based on McSpadden, including a discussion of Figures 3A and 3C of McSpadden. *Id.* at 272–75.

On February 19, 2009, the Examiner considered certain references cited in an Information Disclosure Statement (“IDS”). *Id.* at 315–17. That

¹ McSpadden, US 2004/0023186 A1, published Feb. 5, 2004 (“McSpadden”). Ex. 1004.

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IDS indicated consideration of document number “FR 2 798 277 – A1/ WO 01/19279 A1.”² *Id.* at 316.

In an Office Action dated October 6, 2009, the Examiner rejected several claims as obvious over McSpadden, including reference to Figures 3A, 3C, and Fig. 4F, and paragraphs 36, 45, 60, 62, 63, and 66 of McSpadden (“Oct. ’09 OA”). *Id.* at 250–51. Patent Owner responded to the Oct. ’09 OA on February 8, 2010, again discussing McSpadden, including Figures 3A and 3C and paragraphs 36, 37, 44 and 52 thereof. *Id.* at 236–38.

On February 19, 2010, the Examiner rejected certain claims as anticipated by the Related Rouiller Reference³ and as obvious over the Related Rouiller Reference in view of U.S. Patent No. 5,882,198 issued to Taylor et al. (“Feb. ’10 OA”). *Id.* at 218–20. On June 13, 2010, Patent Owner responded to the Examiner’s rejection and discussed the Related Rouiller Reference. Ex. 2005, 199–200. Patent Owner also specifically discussed the Related Rouiller Reference with the Examiner during an interview on June 29, 2010. *Id.* at 182.

² WO 01/19279 A1, published Mar. 22, 2001 (“Badoz”). Ex. 1008. Badoz is in French and the IDS indicates that it was accompanied by a translation. Ex. 2005, 316. FR 2 798 277 is the French priority application to Badoz. *See* Ex. 1008; Ex. 2010. US 2004/0185414 A1, published Sept. 23, 2004, was also noted as considered on the IDS (Ex. 2005, 315), and is a continuation-in-part that claims foreign priority to FR 2 798 277. Ex. 2011.

³ US Patent Publication No. 2004/0131993 A1, published July 8, 2004 (“Related Rouiller Reference”). Ex. 1018. The Related Rouiller Reference is the U.S. Application corresponding to PCT Publication No. WO 02/065938 A1, published Aug. 29, 2002 (“Rouiller”). Ex. 1007; *see also* Pet. 10 n.7.

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