

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDGE ENDO, LLC,
Petitioner,

v.

MICHAEL SCIANAMBLO,
Patent Owner.

Case IPR2018-01322
Patent 9,351,803 B2

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

POLLOCK, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Edge Endo, LLC (“Petitioner”)¹ filed a Petition for an *inter partes* review of claims 1, 3–6, 10–17, 20, and 21 of U.S. Patent No. 9,351,803 B1 (“the ’803 patent,” Ex. 1001). Paper 1 (“Pet.”). Michael Scianamblo (“Patent Owner”) timely filed a Preliminary Response arguing, *inter alia*, that the Board should exercise its discretion to deny the Petition under 35 U.S.C. § 325(d). Paper 14 (“Prelim. Resp.”), 4–19.

We have jurisdiction under 35 U.S.C. § 314. For the reasons provided below, we deny the Petition for an *inter partes* review under 35 U.S.C. § 325(d).

A. Related Patents and Proceedings

According to the parties, the ’803 patent, along with co-owned, related patents, U.S. 8,882,504 (“the ’504 patent”) and U.S. 8,932,056 (“the ’056 patent”), are at issue in *Dentsply Sirona Inc. v. Edge Endo, LLC*, Case No. 1:17-CV-01041 (D.N.M.). Pet. 1; Paper 12, 2–3.² In addition to the present IPR involving the ’803 patent, Petitioner challenges the ’504 and ’056 patents in IPR2018-01320 and IPR2018-01321, respectively. The three patents share substantially the same specification and are related as follows.

¹ Petitioner further identifies US Endodontics, LLC, Charles Goodis, Bobby Bennett, Edge Holdings, LLC and Guidance Endodontics, LLC as real parties-in-interest. Pet. 1. Petitioner further states “that Edge Endo, LLC and US Endodontics, LLC are owned by Edge Holdings, LLC, which is majority owned by Peter Brasseler Holdings, LLC, which is majority owned by SG Healthcare Corp., which is owned by Henry Schein, Inc.” *Id.*

² Patent Owner further notes that U.S. Patent No. 9,801,696, owned by Maillefer Instruments Holding S.A.R.L., is also asserted in the *Dentsply litigation* and is the subject matter of *Edge Endo, LLC v. Maillefer Instruments Holding S.a.r.l.*, Case IPR2018-01349 (PTAB). *Id.*

The '803 patent issued May 31, 2016, from Application No. 14/632,920 (“the '920 application”) filed February 26, 2015, which is a continuation of Application No. 14/455,636, filed August 8, 2014, which is a continuation of Application No. 13/804,084 (“the '804 application”), filed March 14, 2013, and which issued as the '504 patent on November 11, 2014. The '804 application is a continuation of Application No. 11/402,207, filed April 10, 2006, and which issued as the US Patent No. 8,454,361 (“the '361 patent”) on June 4, 2013. The '803, '504, '056, and '361 patents further claim the benefit of priority of U.S. Provisional Application No. 60/669,409, filed April 8, 2005. Records of the United States Patent and Trademark Office also indicate that examination of the '803, '504, and '056 patents was conducted by the same Primary Examiner.

B. The '803 Patent

The '803 patent issued to Michael J. Scianamblo for “Endodontic Instruments with Offset Centers of Mass.” Ex. 1001, [54], [71]. In accord with the title, the 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.” *Id.* at Abstract. The '803 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 1:20–21. The '803 patent further states that “[t]he present invention provides methods and apparatus for providing swaggering endodontic instruments for preparing [an ECS].” *Id.* at 3:56–58. The Specification explains “swagger” in terms of

a transverse mechanical wave, which can be modified, and is comparable to the transverse wave that can be produced along a stretched rope or string. If one ties the loose end of a long rope to a stationary point, stretches the rope out horizontally, and then gives the end being held a back-and-forth transverse motion, i.e., provide an excitation force, F , the result is a wave pulse that travels along the length of the rope.

Id. at 18, 47–56. “In one aspect, 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. Illustrative Claims

Among the challenged claims, only claim 1 is independent
(paragraphing added for clarity):

1. An endodontic instrument for preparing an endodontic cavity space, the endodontic instrument comprising:
 - a shank configured for attachment to a motor to drive the endodontic instrument about a first axis; and
 - a body extending from the shank by a length, the body being solid and having a tip end and a shank end and a working surface between the shank end and the tip end,
 - the working surface including multiple edges, at least a portion of the body with the working surface being tapered such that the tip end has a diameter that is less than a diameter of the shank end,
 - the body comprising a plurality of transverse cross-sections, each transverse cross-section of the body having a center of mass and multiple sides,
 - the body having a center of mass path defined by the centers of mass of the plurality of transverse cross-sections of the body, each side of the multiple sides intersecting two edges of the multiple edges,

wherein at least a portion of the center of mass path between the tip end and the shank end spirals around the first axis along a length of the first axis, and

wherein the body is configured such that when the endodontic instrument is driven within the endodontic cavity space about the first axis, at each transverse section of at least a portion of the length of the body, one or more edges of the multiple edges are out of contact with a wall of the endodontic cavity space.

Ex. 1001, 38:59–39:17.

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 3–4):

Ground	Claim(s)	Basis	Reference(s)
1	1, 3–6, 10–12, 15–17, 21	§ 102	McSpadden ³
2	10	§ 103	McSpadden
3	13, 14, 20	§ 103	McSpadden and Garmin ⁴
4	1, 3–6, 10–11, 16, 17, 21	§ 102	Rouiller ^{5,6}
5	10	§ 103	Rouiller
6	12–15, 20	§ 103	Rouiller and Garman
7	1, 3–4, 10–12, 16, 17	§ 103	Badoz ^{7,8}
8	5–6, 13–15, 20, 21	§ 103	Badoz and Garmin

In support of its patentability challenges, Petitioner relies on the Declaration of Gary Garman (“Garman Declaration”). Ex. 1003.

³ McSpadden, US 2004/0023186 A1, published Feb. 5, 2004 (“McSpadden”). Ex. 1004.

⁴ Garmin, US Pat. No. 6,299,445, issued Oct. 9, 2001. Ex. 1005.

⁵ Rouiller, WO 02/065938, published in French on Aug. 29, 2002. Ex. 1006.

⁶ Unless otherwise indicated, we refer herein to the certified English-language translation of Rouiller, Ex. 1007.

⁷ WO 01/19279 A1, published March 22, 2001 (“Badoz”). Ex. 1008.

⁸ Unless otherwise indicated, we refer herein to the certified English language translation of Badoz, Ex. 1009.

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