

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EDGE ENDO, LLC,  
Petitioner,

v.

MAILLEFER INSTRUMENTS HOLDING S.A.R.L.,  
Patent Owner.

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Case IPR2018-01349  
Patent 9,801,696 B2

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

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

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

## I. INTRODUCTION

### A. *Background*

Edge Endo, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of *inter partes* review of claims 1, 2, 5, and 8–10 of U.S. Patent No. 9,801,696 B2 (Ex. 1001, “the ’696 patent”). Maillefer Instruments Holding S.A.R.L. (“Patent Owner”) filed a Preliminary Response (Paper 14, “Prelim. Resp.”) along with a Declaration by Dr. John McSpadden (Ex. 2001) in support thereof.

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” *See* 37 C.F.R. § 42.108(c).

Upon consideration of the Petition and the Preliminary Response, we exercise our discretion pursuant to 35 U.S.C. § 325(d) and do not institute *inter partes* review because the same or substantially the same prior art previously were presented to the Office.

### B. *Related Proceedings*

Petitioner and Patent Owner identify the following related matter: *Dentsply Sirona, Inc., et al. v. Edge Endo, LLC, et al.*, No. 1:17-CV-01041 (D.N.M.). Paper 10, 1; Paper 12, 2. The parties also identify U.S. Patent Application Serial No. 15/710,869, filed September 21, 2017. Paper 10, 1; Paper 12, 3. Additionally, Petitioner challenges patents with similar subject matter to the ’696 patent in IPR2018-01320, IPR2018-01321, and IPR2018-01322. Paper 10, 1; Paper 12, 2–3.

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*C. Real Parties in Interest*

Petitioner identifies the following as real parties in interest: Edge Endo, LLC; US Endodontics, LLC; Charles Goodis; Bobby Bennett; Edge Holdings, LLC; Guidance Endodontics, LLC; Peter Brasseler Holdings, LLC; SG Healthcare Corp.; SavDen Corp.; and Henry Schein, Inc.”  
Paper 10, 1. Patent Owner identifies “Maillefer Instruments Holding S.a.r.l.” and “Tulsa Dental Products LLC d/b/a Dentsply Sirona Endodontics” as real parties in interest. Paper 12, 2.

*D. The References*

Petitioner relies upon the following references:

U.S. Patent Application Publication No. US 2004/0023186 A1, published February 5, 2004 (Ex. 1004, “McSpadden”);

U.S. Patent No. 6,299,445 B1, issued October 9, 2001 (Ex. 1005, “Garman”);

U.S. Patent Application Publication No. US 2006/0228669 A1, published October 12, 2006 (Ex. 1006, “Scianamblo”);

International Publication Number WO 01/19279 A1, published March 22, 2001 (Exs. 1007, 1008; “Badoz”);<sup>1</sup> and

U.S. Patent No. 5,882,198, issued March 16, 1999 (Ex. 1009, “Taylor”).

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<sup>1</sup> Petitioner filed an English-language translation (Exhibit 1008), including a certificate of translation, of Exhibit 1007. References and citations to Badoz refer to Exhibit 1008, unless otherwise indicated.

*E. The Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of claims 1, 2, 5, and 8–10 of the '696 patent on the following grounds:

Reference(s)	Basis	Claims Challenged
McSpadden	§ 102	1, 2, 5, and 8
McSpadden	§ 103(a)	1, 2, 5, 8, and 10
McSpadden and Garman	§ 103(a)	9
Scianamblo	§ 103(a)	1, 2, 5, 8, and 10
Scianamblo and Garman	§ 103(a)	9
Badoz and Taylor	§ 103(a)	1, 2, 5, and 10
Badoz, Taylor, and Garman	§ 103(a)	8 and 9

Petitioner supports its challenge with a Declaration by Mr. Gary Garman, dated June 28, 2018 (Ex. 1003).

*F. The '696 Patent*

The '696 patent is directed to an instrument for drilling dental root canals. Ex. 1001, 2:15–16. The '696 patent explains that “treatment of an infected dental root is carried out by extracting the pulp using special instruments, then by shaping the root canal using successive drilling procedures, traditionally carried out with instruments of varying size and conicity. The final operation consists of filling the root canal.” *Id.* at 1:11–15. The '696 patent teaches that a typical instrument for drilling root canals is a tapered rod, which rotates, fitted into a handle. *Id.* at 1:20–24. The '696 patent identifies several problems associated with prior art instruments:

Used in continuous rotation, this type of instrument may have a tendency to screw itself into the canal. Apart from the screwing action, another problem occurring in the production of instruments for drilling root canals is that of the strength and flexibility of the instruments. Indeed, when the instrument is too

flexible it may bend or break before the practitioner has been able to complete the operation and when the instrument is too rigid, it follows the curvature of the dental root canal only with difficulty. *Id.* at 1:25–33. Thus, the '696 patent aims to “produce an instrument which is flexible while being strong, reliable and effective and which makes it possible at the same time to respect the initial path of the root canal to be treated and to ensure optimum dimensioning of the canal in its apical portion after treatment.” *Id.* at 2:4–11.

Figure 1 is shown below:

Fig.1

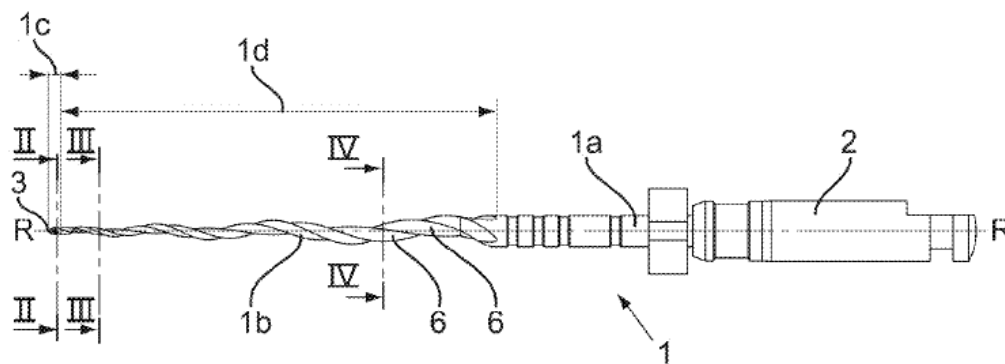


Figure 1 of the '696 patent illustrates a first embodiment of an instrument for drilling root canals in accordance with the invention. *Id.* at 2:23–24. The '696 patent explains:

In a first embodiment shown in FIG. 1 the instrument in accordance with the invention comprises a rod 1 fitted at one of its ends 1a in a handle 2 permitting either manual actuation of the instrument or preferably its engagement in a hand-held part providing mechanical driving of the said instrument. In particular, the instrument 1 is intended to be driven in rotation about its axis of rotation R.

The rod 1 has an active part 1b extending to the other end 3—the point 3—of the rod 1. Said active part 1b is preferably tapered and conical, narrowing to the point 3 of the

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