

In Complete Victory for Rothwell Figg Client Dentsply Sirona, PTAB Denies Institution of Four IPR Proceedings

The Patent Trial and Appeal Board (“PTAB”) denied institution of four IPR petitions filed by Edge Endo LLC, resulting in a complete victory for the patent owners, who were represented by Rothwell Figg.

In the underlying district court case, Dentsply Sirona filed a patent infringement suit against Edge Endo in the District of New Mexico, alleging infringement of U.S. Patent Nos. 8,882,504, 8,932,056, 9,351,803, and 9,801,696, which cover revolutionary advances in endodontic file technology. In response to Dentsply Sirona’s claim of patent infringement, Edge Endo filed IPR petitions challenging each of the four asserted patents. The district court litigation was stayed while the four petitions were being adjudicated. Because the PTAB has now denied all four of Edge Endo’s IPR petitions, the stay is expected to be lifted.

The IPR petitions were opposed by the patent owners on the grounds that: (1) the petitions presented the same art or arguments that had previously been considered by the Patent Office during examination; and (2) the combinations of references cited in the petitions failed to establish a reasonable likelihood that any of the challenged claims were unpatentable. The PTAB issued a string of decisions denying institution of all four IPRs, finding that Edge Endo had rehashed art and arguments already considered by the Patent Office, and agreeing with patent owners that Edge Endo had “fail [ed] to address, let alone explain sufficiently, why the allegedly overlooked portions of [the references] demonstrate Examiner error.” The IPRs are IPR2018-01320, IPR2018-01321, IPR2018-01322, and IPR2018-01349.

The lead partner on the case, Steven Lieberman, stated that “Dentsply Sirona is very pleased by these excellent decisions from the Patent Trial and Appeal Board. They are a complete victory for our clients.”

Dentsply Sirona is the world’s largest manufacturer of professional dental products and technologies, with over a century of innovation and service to the dental industry and patients worldwide. Dentsply Sirona develops, manufactures, and markets comprehensive

Key Contacts

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Related Areas of Practice

Inter Partes Review (IPR) and Post Grant Review (PGR)

Technologies

Dental Devices

solutions including dental and oral health products as well as other consumable medical devices under a strong portfolio of world class brands.

Dentsply Sirona was represented in this case by Rothwell Figg attorneys Steven Lieberman, Joseph Hynds, and Rachel Echols.