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Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@law360.com

Dental Supply Co.'s Rival Loses Bid To Nix Patents In IP Suit

By **Tiffany Hu**

Law360 (June 24, 2020, 9:26 PM EDT) -- A New Mexico federal judge has upheld parts of Dentsply Sirona Inc.'s dental drilling tool patents asserted against a dental equipment rival, finding that the competitor failed to show that prior inventions rendered the patent claims invalid.

In a 24-page order issued Tuesday, U.S. District Judge Joseph F. Bataillon ruled that DSI successfully showed that a number of claims in three patents were not invalid for being obvious over a combination of earlier patents, as rival Edge Endo LLC had argued.

Judge Bataillon also rejected Edge's bid for summary judgment that its EdgeTaper Encore products did not infringe DSI's patents, finding that there are "clearly material facts" with regard to the issues of infringement and the doctrine of equivalents, which holds that infringement can be found when a product is "equivalent" to a patent.

The judge allowed DSI's willful infringement claim against Edge to go to a jury trial, which is scheduled for August, saying there was "too much conflicting evidence" to make the finding.

"When did the defendants know or when should they have known?" Judge Bataillon wrote. "Was defendant willfully blind to the patents-in-suit prior to the filing of the lawsuit? Did defendants continue to willfully infringe during the pendency of the lawsuit? These are all questions of material fact. The court cannot ascertain who knew what when."

Steven Lieberman of Rothwell Figg Ernst & Manbeck PC, an attorney for DSI, said in a statement that the judge's decision "cut to the heart of the case and recognized that many of Edge's non-infringement and invalidity defenses are wholly without merit."

Counsel for Edge did not immediately respond to a request for comment Wednesday.

The patent dispute between the companies dates to October 2017, when DSI lodged a lawsuit accusing Edge of infringing three patents covering its ProTaper Next endodontic files — which it said it has sold since 2013 — and marketing them as Edge's own.

According to the lawsuit, Edge's founder Chuck Goodis ordered a shipment of the ProTaper Next products soon after their release, and two more later that year. In the spring of 2017, Edge announced that it would offer a product called the EdgeTaper Next, DSI says.

Edge was eventually convinced to change the product name to EdgeTaper Encore, but DSI says that the competing product was still just a lower-quality version of its original product.

In March 2018, DSI filed an amended complaint that asserts an additional patent that was issued after the original complaint. Both parties subsequently filed their respective motions for summary judgment, though the briefs were filed under seal.

The patents-in-suit are U.S. Nos. 8,932,056, 9,351,803, 8,882,504; and 9,801,696.

DSI is represented by Steven Lieberman, Sharon Davis, Rachel M. Echols, Eric D. Blatt and Caitlin

Wilmot of Rothwell Figg Ernst & Manbeck PC and Douglas A. Baker of Atkinson Baker & Rodriguez PC.

Edge is represented by Jeffrey S. Ginsberg, Abhishek Bapna, Julie Simeone and William F. Cavanaugh, Jr. of Patterson Belknap Webb & Tyler LLP and Richard W. Hughes and Reed C. Bienvenu of Rothstein Donatelli LLP.

The case is Dentsply Sirona Inc. et al. v. Edge Endo LLC et al., case number 1:17-cv-1041, in the U.S. District Court for the District of New Mexico.

--Editing by Abbie Sarfo.

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