IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

SMART DENTURE CONVERSIONS, LLC,	)	
Plaintiff,	)	
v.	)	C.A. No. 24-507-MN
STRAUMANN USA, LLC,	)	
Defendant.	)	

DEFENDANT STRAUMANN USA, LLC'S OPENING BRIEF IN SUPPORT OF ITS MOTION TO DISMISS PLAINTIFF'S COMPLAINT FOR FAILURE TO STATE A CLAIM FOR RELIEF UNDER FED. R. CIV. P. 12(b)(6)

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I. NATURE AND STAGE OF PROCEEDINGS

On April 23, 2024, plaintiff Smart Denture Conversions, LLC ("SDC") filed a complaint against defendant Straumann USA, LLC ("Straumann"), alleging infringement of U.S. Patent No. 11,937,992 (the "'992 patent"). D.I. 1. On June 18, 2024, the Court granted the parties' joint stipulation to extend Straumann's deadline to answer, move or otherwise respond to SDC's complaint to July 29, 2024. D.I. 8. Straumann now respectfully moves to dismiss SDC's complaint with prejudice pursuant to Federal Rule of Civil Procedure 12(b)(6), for the reasons set forth in this opening brief.

II. SUMMARY OF ARGUMENT

Straumann's motion to dismiss presents a single, discrete, straightforward legal issue that does not implicate any fact or claim construction issues, that is case dispositive, and that can and should be decided now.

1. SDC's complaint fails to state a claim for relief and should be dismissed because all of the claims of the '992 patent are indefinite as a matter of law under 35 U.S.C. § 112(b).

2. All of the claims of the '992 patent are indefinite because they are all directed to an apparatus but also include a method step and therefore are impermissibly directed to two different statutory classes of patentable subject matter under 35 U.S.C. § 101.

3. All of the claims of the '992 patent are directed to an apparatus ("[a] dental system") that comprises four components ("an implant abutment," "a definitive screw," "a coping" and "a temporary screw") and include limitations that require the "temporary screw" to "hold" the "coping" in "alignment with" (claim 1) or in "position against" (claim 9) the "implant abutment." However, all of the claims also recite a method step that must be performed by the dentist when using the claimed "dental system" during a denture conversion procedure with a patient: The dentist must apply an "axial force" during "pick-up processing" (*i.e.* when

removing the dentures from the jaw) that "releases" the "coping" and the "temporary screw" from the "implant abutment."

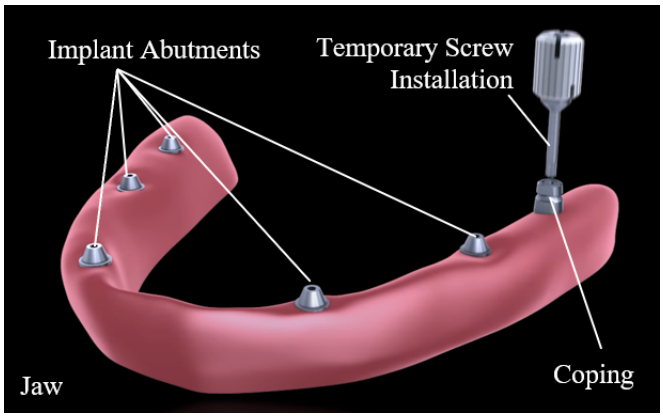
4. Under Federal Circuit precedent, these "hybrid" claims that are directed to an apparatus but also include a method step are indefinite because they are directed to two different statutory classes of patentable subject matter, so it is unclear whether they are infringed when the claimed apparatus is made or sold or instead only when a user uses the apparatus including performing the recited method step.

5. Because all of the claims of the '992 patent are indefinite as a matter of law, SDC's complaint fails to state a claim for relief and should be dismissed with prejudice.

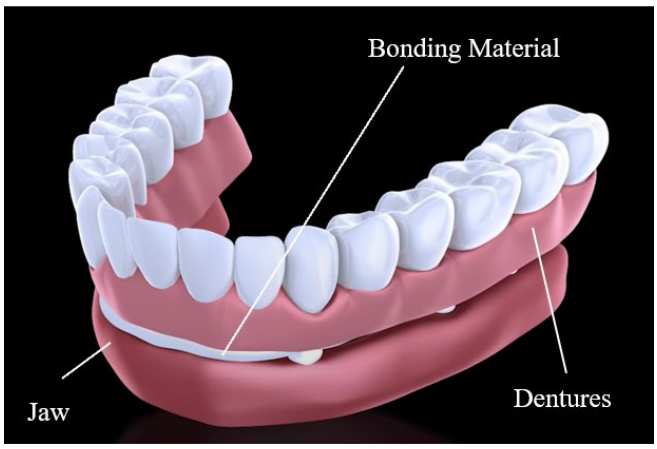
III. STATEMENT OF FACTS

SDC's complaint alleges that "[t]he '992 patent discloses systems and methods for converting removable dentures into fixed prostheses." D.I. 1, ¶ 10. SDC's complaint describes the sequence of steps performed by the dentist in a procedure to convert removable dentures into fixed prostheses as follows:

SDC's complaint first states that "SDC's patented technology works by using temporary screws to connect copings to abutments installed on the dental implants in the jaw." *Id.*, ¶ 17. Below this allegation is the following image that depicts a temporary screw being installed to connect a coping to an implant abutment in a patient's jaw:



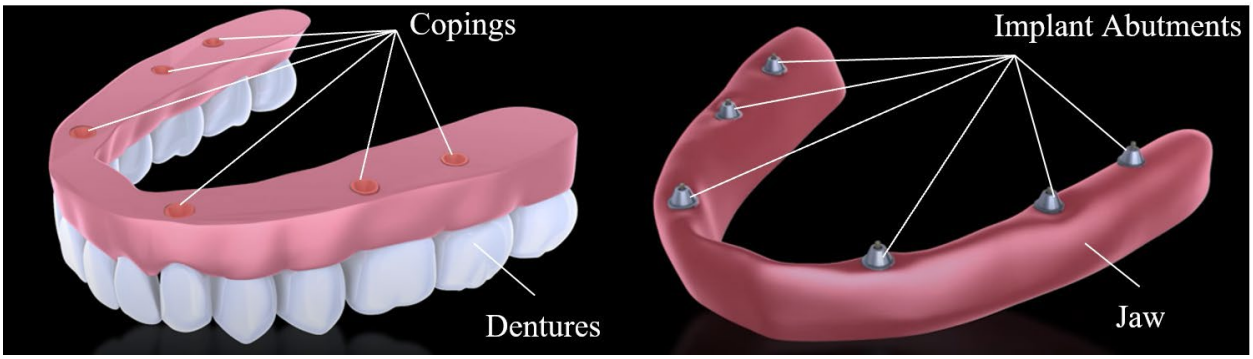
SDC's complaint next alleges that "[t]he dentures are then set on the jaw with bonding material, so that the copings become bonded to the dentures." *Id.*, ¶ 18. Below this allegation is this image:



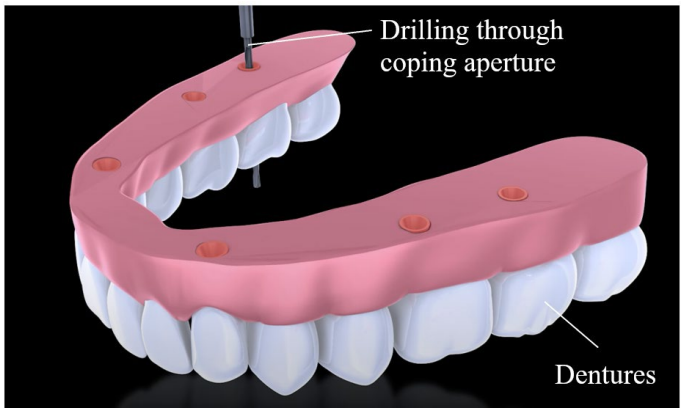
SDC's complaint then describes the next step in which the temporary screws release the copings from the abutments when the dentist removes the dentures from the patient's jaw:

> Once the copings are bonded to the dentures, the dentures can be removed. The temporary screw will release the coping from the implant abutments, allowing the dentures to "pick up" the copings. Now, the dentures have the copings installed, which are accurately aligned with the implant abutments.

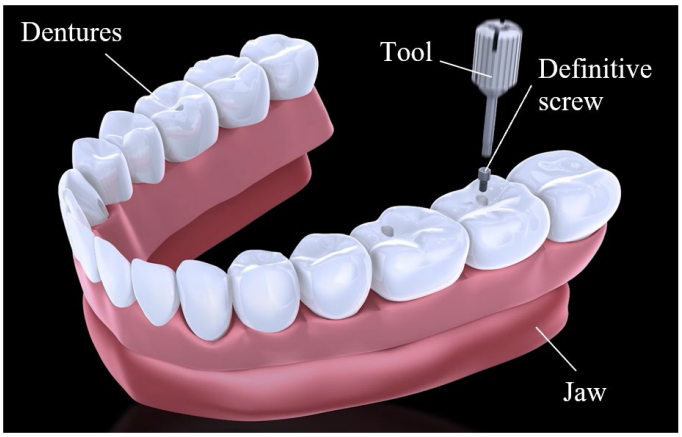
Id., ¶ 19. Below this allegation is this image that depicts the copings in the dentures after the dentist has removed the dentures and the copings have been released from the implant abutments in the jaw:



SDC's complaint then states that "[t]he next step is to drill clearance holes in the dentures" and that "[t]hese holes will be used to screw the dentures into the jaw. *Id.*, ¶ 20. Below this allegation is this image that depicts a hole being drilled through the aperture of one of the copings in the dentures:



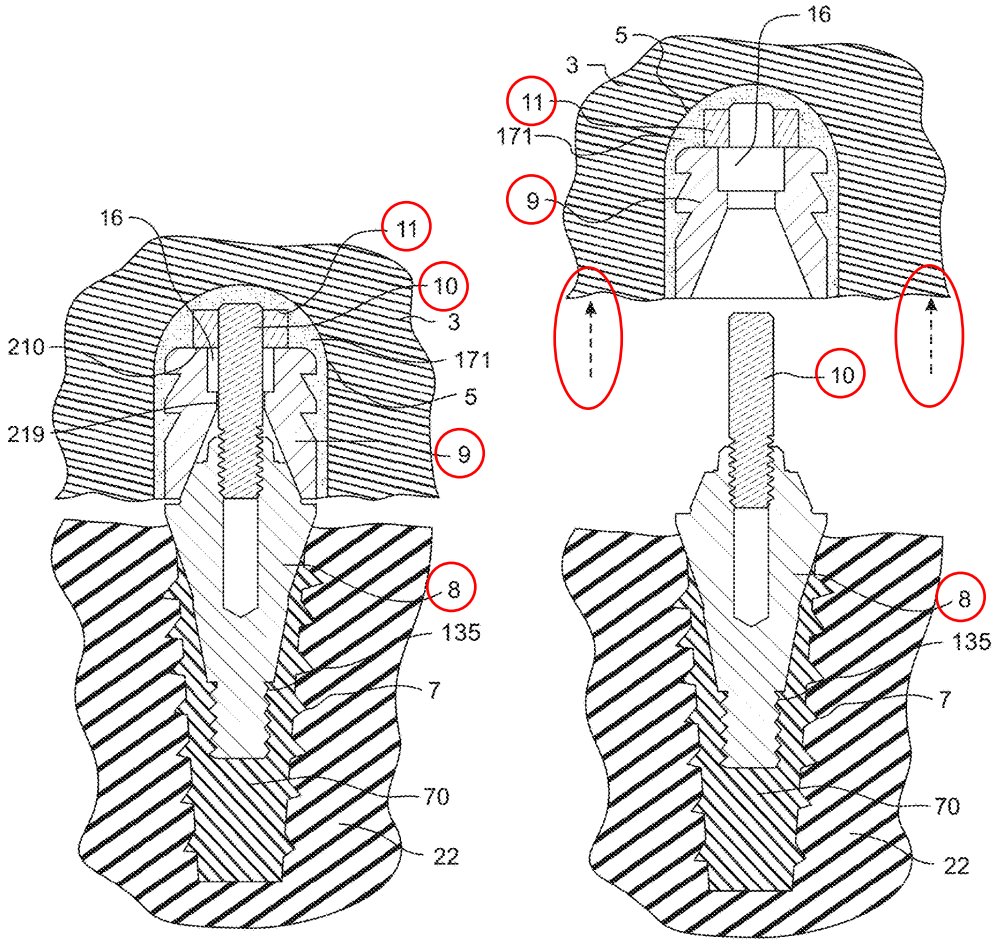
SDC's complaint next alleges that "[a]fter drilling, the dentures are placed back on the jaw, with the copings and implant abutments accurately aligned, and a definitive screw is used to attach the dentures to the implant abutment." *Id.*, ¶ 21. Below this allegation is this image:



The specification of the '992 patent[1] describes the step in the procedure when the dentist removes the dentures from the jaw and applies the force that causes the temporary screws to release the copings from the abutments as a "pick-up process." D.I. 1, Ex. A ('992 patent), 6:1–

[1] A copy of the '992 patent is attached as Exhibit A to SDC's complaint. D.I. 1, ¶ 9; *id.*, Ex. A.

8, 8:40–44, 12:64–13:8, 14:41–43. Figure 5 of the ’992 patent (below) shows the temporary screw (post 10 and cap 11) holding the coping 9 against the implant abutment 8 “prior to the pick-up process”; Figure 6 (below) shows the coping 9 and cap 11 released from the abutment 8 and the post 10 by the force applied by the dentist (upward arrows) “after the pick-up process”:



Id., 8:40–44, Figs. 5, 6 (annotated).

The specification of the ’992 patent describes this “pick-up process” further, with reference to Figures 5 and 6, as follows:

> FIG. 5 through FIG. 9 show example cross-sectional views of some of the different stages of installation of the temporary fastener system into a denture. FIG. 5 shows a cross-sectional view of the assembly of the first embodiment <u>during the initial phase of the coping pick-up process</u>. As illustrated, the implant

> abutment 8 is attached to a schematic implant 70. The implant 70 has an interface 7 (shown schematically) that is attached to the patient's jawbone 22. The coping 9 is held against the implant abutment 8 through the temporary screw comprising the post 10 and cap 11. . . . After the pick-up material 171 has set up, the prosthesis 3, coping 9 and temporary screw cap 10 [sic – cap 11] are pulled off as an assembly off the patient's jaw as shown by the arrows in FIG. 6. The coping 9 and cap 11 are released from the implant abutment 8 and post 10, while the threads of the post 10 keep it engaged in the implant abutment 8. The post 10 is subsequently removed to make the abutment threads 18 available for holding the prosthesis in proper alignment with a definitive screw.

Id., 14:39–64 (emphasis added).

The specification of the '992 patent further describes, with reference to Figure 75, an embodiment in which a temporary screw can "be inserted through rotation" but "may be subsequently extracted with a separation force in the axial direction":

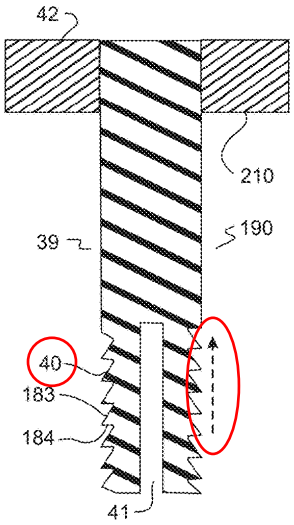


FIG. 75

> [A]s shown in FIG. 75 an alignment fastener post 39 may contain a separable threaded or serrated portion 40 that engages the screw threads in the abutment for pick-up, but that will release with axial force after. FIG. 75 shows a temporary fastener 190 with a head 42 portion and an attachment post portion 39. The attachment post portion 39 is shown as having a slot 41 and asymmetric threads or serrations 40 that have proximal flank 183 and a distal flank 184. This asymmetric threading still allows the temporary attachment post portion 39 to be inserted through rotation like other temporary screw embodiments for alignment for coping pick-up. The post 39 may be subsequently extracted with a separation force in the axial direction.

Id., Fig. 75 (annotated), 23:10–23 (emphasis added).

SDC's complaint alleges that Straumann infringes "at least claim 1 of the '992 patent." D.I. 1, ¶¶ 33–40. The '992 patent has 12 claims. '992 patent, 25:35–27:16. Claims 1 and 9 are the only independent claims. *Id.* Claims 2-8 depend from claim 1 and include all of its limitations, including those discussed below. *Id.*, 25:65–26:33. Similarly, claims 10-12 depend from claim 9 and include all of its limitations, including those discussed below. *Id.*, 27:3–16.

Independent claims 1 and 9 both recite an apparatus ("[a] dental system") that comprises four components ("an implant abutment," "a definitive screw," "a coping" and "a temporary screw"). *Id.*, 25:36–64, 26:34–27:2. Both claims also include limitations that require the "temporary screw" to "hold" the "coping" in "alignment with" (claim 1) or in "position against" (claim 9) the "implant abutment." *Id.*, 25:59–61, 26:59–60.

However, both independent claims also recite a method step that must be performed by the dentist when using the claimed dental system with a patient.

Specifically, claim 1 recites the following method step: "wherein an <u>axial force</u> in a proximal direction from pick-up processing <u>releases</u> the coping and the temporary screw from the implant abutment." *Id.*, 25:62–64 (emphasis added). Thus, claim 1 requires the dentist to apply an "axial force in a proximal direction" during "pick-up processing," which "releases the coping and the temporary screw from the implant abutment." *Id.*

Similarly, claim 9 recites the following method step that requires the dentist to apply an "axial pick-up force" "during pick-up processing" that "release[s]" the temporary screw (and therefore the coping) from the implant abutment: "wherein threads of the male threading of the post <u>release</u> from threads of the female threading of the implant abutment with a predetermined <u>axial pick-up force</u> in a proximal direction in response to and/or during pick-up processing." *Id.*, 26:65–27:2 (emphasis added).

Claim 1 is set forth below, with the "dental system" and its four components highlighted in blue and the method step (including the present tense verb "releases") highlighted in yellow:

> 1. A dental system comprising:
>
> an implant abutment having threads;
>
> a definitive screw having an axis with a length measured along the axis and a width measured perpendicular to the axis, the definitive screw having a proximal head end having a tool interface and a distal post portion having threads configured to engage the threads of the implant abutment;
>
> a coping having a proximal end with an aperture, wherein the aperture is larger than the distal post portion of the definitive screw and smaller than the proximal head end of the definitive screw; and
>
> a temporary screw having an axis with a length measured along the axis and a width measured perpendicular to the axis, the temporary screw comprising:
>
> > a proximal head portion with a width larger than the aperture of the coping; and
> >
> > a distal shaft portion with threads in a pattern that is shaped differently from a pattern of the threads of the definitive screw,
>
> wherein the temporary screw is rotatable in a distal direction whereby the distal shaft portion of the temporary screw engages the threads of the implant abutment to a predetermined torque which causes the proximal head portion of the temporary screw to hold the coping in alignment with the implant abutment, and
>
> wherein an axial force in a proximal direction from pick-up processing **releases** the coping and the temporary screw from the implant abutment.

Id., 25:36–64 (emphasis added).

Claim 9 is set forth below, with the "dental system" and its four components highlighted in blue and the method step (including the present tense verb "release") highlighted in yellow:

> 9. A dental system for attachment of a coping to a threaded implant abutment comprising:
>
> an implant abutment having female threading having an implant abutment thread profile;
>
> a definitive screw having a longitudinal axis and a length measured along the axis and a width measured perpendicular to the axis, the definitive screw comprising:

> a shaft with male threading, wherein the male threading has a male threading profile that matably threadably engages and which matches the female threading of the implant abutment; and
>
> a head with a definitive screw drive interface;
>
> a coping having a proximal end with an aperture sized to allow the definitive screw shaft to pass through; and
>
> a temporary screw having a longitudinal axis and a length measured along the axis and a width measured perpendicular to the axis, the temporary screw comprising:
>
> a post comprising male threading, wherein the male threading has a male threading profile that is different from the male threading profile of the shaft of the definitive screw, and wherein the aperture of the coping is sized and configured to allow the post to pass through; and
>
> a head with a temporary screw drive interface, wherein the head is integral to or coupled to the post,
>
> wherein the temporary screw holds the coping in position against the implant abutment for pick-up processing,
>
> wherein the male threading of the post of the temporary screw is configured to enter the implant abutment and rotatably engage the the [sic] female threading of the implant abutment to a predetermined pick-up processing torque, and
>
> wherein threads of the male threading of the post **release** from threads of the female threading of the implant abutment with a predetermined axial pick-up force in a proximal direction in response to and/or during pick-up processing.

Id., 26:34–27:2 (emphasis added).

IV. ARGUMENT

A. Legal Standards

1. A Patent Claim Is Indefinite As a Matter of Law If It Is Directed to an Apparatus But Also Includes a Method Step

A patent claim is indefinite under 35 U.S.C. § 112(b) if it "fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). In particular, a claim is indefinite as a matter

of law if it is directed to an apparatus but also includes a method step. *See IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1383–84 (Fed. Cir. 2005). This type of claim is indefinite because it is impermissibly directed to two different statutory classes of patentable subject matter under 35 U.S.C. § 101, *i.e.* a "machine" and a "process."[2] *See Rembrandt Data Techs., LP v. AOL, LLC*, 641 F.3d 1331, 1339 (Fed. Cir. 2011) (claim directed to "a data transmitting device" held indefinite because it recited components of the device and the method step of "transmitting the trellis encoded frames").

Such a "hybrid" claim that covers an apparatus but also includes a method step is indefinite because it is unclear whether the claim is infringed when the claimed apparatus is made or sold or instead only when a user uses the apparatus including performing the claimed method step. *See In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1318 (Fed. Cir. 2011) (claims held indefinite because they "create confusion as to when direct infringement occurs because they are directed both to systems and to actions performed by 'individual callers'"); *IPXL Holdings*, 430 F.3d at 1384 (claim held indefinite because it "recites both [a] system . . . and a method for using that system" and therefore "it is unclear whether infringement . . . occurs when one creates a system that allows the user to change the predicted transaction information or accept the displayed transaction, or whether infringement occurs when the user actually uses the input means to change transaction information or uses the input means to accept a displayed transaction").

However, a claim is not indefinite if the limitation in question merely describes a capability of the claimed apparatus instead of a method step that requires user action. *See*

[2] *See* 35 U.S.C. § 101 ("Whoever invents or discovers any new and useful <u>process, machine,</u> manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.") (emphasis added).

MasterMine Software, Inc. v. Microsoft Corp., 874 F.3d 1307, 1315–16 (Fed. Cir. 2017) (claims held not indefinite because they "do not claim activities performed by the user" but instead "claim the system's capability to receive and respond to user selection").

2. A Court May Grant a Rule 12(b)(6) Motion to Dismiss Based on a Dispositive Question of Law Including Indefiniteness

Whether a claim of a patent is indefinite, including because it is a "hybrid" claim impermissibly directed to two different statutory classes, is a question of law. *See IPXL Holdings*, 430 F.3d at 1380; *Teva Pharms. U.S., Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1341 (Fed. Cir. 2015). "Rule 12(b)(6) authorizes a court to dismiss a claim on the basis of a dispositive issue of law." *Neitzke v. Williams*, 490 U.S. 319, 326 (1989). In particular, a court may grant a Rule 12(b)(6) motion to dismiss a patent infringement complaint that turns on a dispositive question of law, such as indefiniteness. *See, e.g.*, *In re TLI Commc'ns LLC Patent Litig.*, 87 F. Supp. 3d 773, 798–805 (E.D. Va. 2015) (granting Rule 12(b)(6) motion to dismiss based on finding that claims are indefinite); *DSS Inc. v. Nichia Corp.*, No. 19-08172, 2024 WL 3515886, at *3-4 (C.D. Cal. July 12, 2024) (same).

In ruling on a motion to dismiss under Rule 12(b)(6), a court must accept all well-pled factual allegations in the complaint as true and view them in the light most favorable to the plaintiff. *See Mayer v. Belichick*, 605 F.3d 223, 229 (3d Cir. 2010). However, "a court need not 'accept as true allegations that contradict matters properly subject to judicial notice or by exhibit,' such as the claims and the patent specification." *Secured Mail Sols. LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 913 (Fed. Cir. 2017) (quoting *Anderson v. Kimberly-Clark Corp.*, 570 F. App'x 927, 931 (Fed. Cir. 2014)). Dismissal under Rule 12(b)(6) is appropriate if a complaint does not contain "sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v.*

Twombly, 550 U.S. 544, 570 (2007)); *see also Fowler v. UPMC Shadyside*, 578 F.3d 203, 210 (3d Cir. 2009).

B. The Claims of the '992 Patent Are Indefinite As a Matter of Law Because They Are Apparatus Claims That Include a Method Step

Independent claims 1 and 9 (and their dependent claims 2–8 and 10–12) are indefinite as a matter of law because they are each impermissibly directed to both an apparatus and a method. *See Rembrandt*, 641 F.3d at 1339; *Katz*, 639 F.3d at 1318; *IPXL Holdings*, 430 F.3d at 1383–84.

Independent claims 1 and 9 both recite an apparatus ("[a] dental system") comprised of four components ("an implant abutment," "a definitive screw," "a coping" and "a temporary screw"). However, both claims also include a method step that must be performed by the dentist when using the claimed dental system with a patient. Specifically, claim 1 requires the dentist to apply an "axial force in a proximal direction" during "pick-up processing," which "releases the coping and the temporary screw from the implant abutment." '992 patent, 25:62–64 ("wherein an <u>axial force</u> in a proximal direction from pick-up processing <u>releases</u> the coping and the temporary screw from the implant abutment") (emphasis added). Similarly, claim 9 requires the dentist to apply an axial force during pick-up processing that releases the temporary screw and the coping from the implant abutment. *Id.*, 26:65–27:2 ("wherein threads of the male threading of the post <u>release</u> from threads of the female threading of the implant abutment with a predetermined <u>axial pick-up force</u> in a proximal direction in response to and/or during pick-up processing") (emphasis added). It is unclear whether the claims of the '992 patent are infringed when the claimed "system" is made or sold, or instead only when the dentist applies the "axial force" that "releases" the coping and the temporary screw. Because claims 1 and 9 both recite an apparatus but also include a method step, they are indefinite. *See Rembrandt*, 641 F.3d at 1339; *Katz*, 639 F.3d at 1318; *IPXL Holdings*, 430 F.3d at 1383-84.

Indeed, these method steps in claims 1 and 9 are similar to the method steps in the apparatus claims held indefinite by this Court in *Courtesy Prods., LLC v. Hamilton Beach Brands, Inc.*, No. 13-2012-SLR, 2015 U.S. Dist. LEXIS 155572 (D. Del. Nov. 18, 2015). In that case, the claims were directed to an apparatus ("a beverage brewing system") comprised of several components ("a beverage brewing machine" having "a housing," "a water reservoir," "an electrical heating element" and "a location to receive a brew basket," "a plurality of filter packs" and "a plurality of single serving disposable brew baskets"). *Id.* at *13–14. However, the claims also recited two method steps: (1) "the brewing machine heating water from the water reservoir;" and (2) "the brew baskets being inserted into the location in the beverage brewing machine." *Id.* The Court held that the claims were indefinite because, "[l]ike the system claim in *IPXL*," the claims at issue "are system claims, but recite method steps of heating water and inserting a brew basket." *Id.* at *14 (citing *IPXL Holdings*, 430 F.3d at 1384). The Court explained that "a person of ordinary skill in the art would not understand whether the claims at bar are infringed by an apparatus capable of heating water and having brew baskets inserted or when a person actually uses the beverage brewing system to heat water and inserts a brew basket." *Id.* at *15.[3]

Just like the apparatus claims in *Hamilton Beach* that included method steps that required heating water and inserting a brew basket, claims 1 and 9 of the '992 patent are apparatus claims that each include a method step that requires the dentist to apply a force during pick-up processing that releases the coping and the temporary screw from the implant abutment. By their

[3] In this cited opinion in *Hamilton Beach*, the Court issued a number of other claim construction and indefiniteness rulings regarding other claim limitations, in addition to the indefiniteness ruling based on *IPXL* discussed in this brief. *See id.* at *1–13. The Court later granted the plaintiff's motion for reconsideration of one of the Court's other indefiniteness rulings regarding other claim limitations, but the Court was not asked to and did not reconsider its indefiniteness ruling based on *IPXL* discussed in this brief. *See Courtesy Prods., LLC v. Hamilton Beach Brands, Inc.*, No. 13-2012-SLR, 2016 U.S. Dist. LEXIS 7594 (D. Del. Jan. 21, 2016).

plain terms, the present tense verbs "releases" in claim 1 and "release" in claim 9 both require the dentist to actually apply the axial force that causes the coping and the temporary screw to actually release from the implant abutment. Therefore, just like the claims in *Hamilton Beach*, claims 1 and 9 are indefinite. *See Hamilton Beach*, 2015 U.S. Dist. LEXIS 155572 at *13–15; *see also Rembrandt*, 641 F.3d at 1339 (claim directed to "a data transmitting device" held indefinite because it recited components of the device and the method step of "transmitting the trellis encoded frames").

Moreover, these limitations in claims 1 and 9 do not merely require the coping and the temporary screw to be capable of being released upon application of an axial force. *Cf. MasterMine Software*, 874 F.3d at 1315–16 (claims held not indefinite because they "do not claim activities performed by the user" but instead "claim the system's capability to receive and respond to user selection"). The patentee of the '992 patent plainly knew how to draft limitations to recite the capability of components of the claimed dental system. For example, elsewhere claim 1 recites "the definitive screw having . . . a distal post portion having threads configured to engage the threads of the implant abutment." '992 patent, 25:38–43 (emphasis added). Similarly, claim 1 also recites that "the temporary screw is rotatable in a distal direction," *i.e.* that the temporary screw is capable of being rotated in a distal direction. *Id.*, 25:55–56 (emphasis added). In contrast, the patentee chose not to draft the "release" limitations in claims 1 and 9 to recite the capability of components of the claimed dental system. Instead, the patentee chose to draft these limitations as method steps using present tense verbs that require the dentist to actually apply an axial force during pick-up processing and that require the coping and the temporary screw to actually release from the implant abutment. *Id.*, 25:62–64, 26:65–27:2. In

short, these claim limitations are "directed to user actions, not system capabilities," and therefore the claims are indefinite. *Katz*, 639 F.3d at 1318.

In sum, because independent claims 1 and 9 are apparatus claims that also include these method steps, the claims are "hybrid" claims that are impermissibly directed to two different statutory classes of patentable subject matter, and therefore they are indefinite as a matter of law. *See Rembrandt*, 641 F.3d at 1339; *Katz*, 639 F.3d at 1318; *IPXL Holdings*, 430 F.3d at 1383-84; *Hamilton Beach*, 2015 U.S. Dist. LEXIS 155572 at *13–15. For the same reason, dependent claims 2–8 and 10–12, which each incorporate the method step limitation of either independent claim 1 or 9, are also indefinite as a matter of law. Because all of the claims of the '992 patent are indefinite as a matter of law, SDC's complaint fails to state a claim for infringement and should be dismissed with prejudice under Rule 12(b)(6).

V. CONCLUSION

For the reasons set forth above, Straumann respectfully requests that the Court: (i) find all of the claims of the '992 patent (independent claims 1 and 9 and dependent claims 2–8 and 10–12) indefinite as a matter of law under 35 U.S.C. § 112(b); and (ii) dismiss SDC's complaint with prejudice for failure to state a claim under Rule 12(b)(6).

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