

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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STRAUMANN USA, LLC,  
Petitioner,

v.

SMART DENTURE CONVERSIONS, LLC,  
Patent Owner.

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Case No. IPR2025-00956  
U.S. Patent No. 11,937,992

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**PETITIONER STRAUMANN USA, LLC'S OPPOSITION BRIEF  
IN RESPONSE TO PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL**

September 2, 2025

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## **Regulations**

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## UPDATED LIST OF EXHIBITS

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                                                         |
|--------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1001               | U.S. Patent No. 11,937,992                                                                                                                                                 |
| 1002               | Expert Declaration of John B. Brunski, Ph.D.                                                                                                                               |
| 1003               | U.S. Patent Application Pub. No. US 2017/0202649 A1<br>(Bernhard)                                                                                                          |
| 1004               | U.S. Patent No. 6,283,752 (Kumar)                                                                                                                                          |
| 1005               | U.S. Patent Application Pub. No. US 2016/0045290 A1 (Poovey)                                                                                                               |
| 1006               | A. Gracco et al., “Effects of Thread Shape on the Pullout Strength of Miniscrews,” 142 <i>Amer. J. Orthodontics &amp; Dentofacial Orthopedics</i> , 186–90 (2012) (Gracco) |
| 1007               | Declaration of Lindsay Allen re Gracco                                                                                                                                     |
| 1008               | PCT Patent Application No. WO 2013/030839 A1 (Derey)                                                                                                                       |
| 1009               | U.S. Provisional Patent Application No. 62/742,942                                                                                                                         |
| 1010               | U.S. Provisional Patent Application No. 62/774,402                                                                                                                         |
| 1011               | U.S. Provisional Patent Application No. 62/818,082                                                                                                                         |
| 1012               | U.S. Patent Application No. 16/596,361                                                                                                                                     |
| 1013               | U.S. Patent No. 11,311,354 (Kofford)                                                                                                                                       |
| 1014               | Smart Denture Conversions Webpage – Separable Fastener                                                                                                                     |
| 1015               | Prosecution History of U.S. Patent Application No. 18/328,730                                                                                                              |
| 1016               | Smart Denture Conversions – Technique Guide                                                                                                                                |
| 1017               | Complaint, D.I. 1 (April 23, 2024), <i>Smart Denture Conversions, LLC v. Straumann USA, LLC</i> , No. 1:24-cv-00507-JCB (D. Del.)                                          |

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                 |
|--------------------|------------------------------------------------------------------------------------------------------------------------------------|
| 1018               | U.S. Patent Application No. 17/691,108                                                                                             |
| 1019               | NeoConvert Brochure                                                                                                                |
| 1020               | U.S. Patent No. 7,938,046 (Nino)                                                                                                   |
| 1021               | German Published Patent Application (Offenlegungsschrift) DE 3808238 A1 (Ruetschi)                                                 |
| 1022               | Certified English Translation of German Published Patent Application (Offenlegungsschrift) DE 3808238 A1 (Ruetschi)                |
| 1023               | U.S. Patent No. 1,725,109 (Starkey)                                                                                                |
| 1024               | U.S. Patent No. 2,626,029 (Guterman)                                                                                               |
| 1025               | Declaration of Georg C. Reitboeck in Support of Notice of Intent to Designate a Provisionally Recognized PTAB Attorney             |
| 1026               | Declaration of Mark A. Chapman in Support of Notice of Intent to Designate a Provisionally Recognized PTAB Attorney                |
| 1027               | Declaration of Christopher F. Gosselin in Support of Notice of Intent to Designate a Provisionally Recognized PTAB Attorney        |
| 1028               | Declaration of George Koskinas re NeoConvert system                                                                                |
| 1029               | U.S. Patent App. Pub. 2002/0094255 A1 (Neuhengen)                                                                                  |
| 1030               | Straumann's Motion For a Conditional Stay, dated July 18, 2025                                                                     |
| 1031               | Straumann's Opening Brief In Support of Its Motion For a Conditional Stay, dated July 18, 2025 (public version) (without exhibits) |

| <b>Exhibit No.</b> | <b>Description</b>                                                                            |
|--------------------|-----------------------------------------------------------------------------------------------|
| 1032               | Straumann’s Reply Brief In Support of Its Motion For a Conditional Stay, dated August 8, 2025 |
| 1033               | District of Delaware Stay Motion Statistics (January 1, 2019 to September 2, 2025)            |
| 1034               | Median Time-to-Trial Statistics (January 1, 2020 to March 31, 2025)                           |

## **I. INTRODUCTION**

SDC's request for discretionary denial of Straumann's IPR petition should be denied because the considerations relevant to the Director's exercise of discretion collectively weigh against granting SDC's denial request.

In particular, SDC does not have any "settled expectations" against Straumann's challenge because the '992 patent issued in 2024. This important "settled expectations" consideration weighs strongly against granting SDC's denial request, yet SDC ignored it altogether in its brief.

In contrast to SDC, Straumann does have "settled expectations" that weigh against SDC's denial request. Straumann's affiliate developed, and Straumann launched, the NeoConvert product (that SDC accuses of infringement) before the '992 patent issued and first became public. The NeoConvert product has a different design than any of the embodiments described or claimed in the parent '354 patent that was public before the NeoConvert was developed and launched. As a result, Straumann had "settled expectations" that SDC would not sue Straumann for infringement. However, SDC went back to the PTO to file a continuation application to obtain new claims in an attempt to cover the NeoConvert product, and then sued Straumann for infringement after the '992 patent issued.

As explained in Straumann's petition, these new claims in the '992 patent are not supported because they go well beyond what the inventors invented and

described, and therefore the parent '354 patent is prior art that anticipates and/or renders the claims obvious. As such, the Examiner committed a material error by not rejecting the claims for failing to comply with the written description and enablement requirements. Straumann's petition also presents new, non-cumulative prior art that the Examiner did not consider and that would have resulted in the claims being rejected.

Moreover, the factors that SDC did address in its brief also collectively weigh against granting its denial request. The District of Delaware is likely to stay the parallel litigation pending the outcome of Straumann's IPR (and its co-pending PGR of the related '781 patent<sup>1</sup>). Although the parties will have just completed fact discovery by the Board's institution decision deadline on December 2, 2025, the bulk of the work in the litigation, including claim construction, expert discovery, dispositive motions and trial, will lie ahead. Moreover, Straumann's *Sotera* stipulation will eliminate overlap with the litigation. Finally, the merits of Straumann's petition are strong.

In sum, the considerations relevant to the Director's exercise of discretion

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<sup>1</sup> Straumann's opposition to SDC's request for discretionary denial of Straumann's PGR petition challenging the related '781 patent (PGR2025-00054) is due on September 25, 2025.

collectively weigh against granting SDC's denial request. But even if any of them did support SDC, the "settled expectations" consideration tips the balance against granting SDC's denial request.

## **II. ARGUMENT**

### **A. SDC Does Not Have Any "Settled Expectations" Against Straumann's Challenge Because the '992 Patent Issued In 2024**

SDC's request for discretionary denial should be denied because SDC has not developed any "settled expectations" against Straumann's challenge—much less "strong settled expectations"—given that the '992 patent issued on March 26, 2024. *See, e.g., Zhuhai CosMx Battery Co., Ltd. v. Ningde Amperex Tech. Ltd.*, IPR 2025-00385, Paper 9 at 2–3 (Director July 2, 2025) (denying requests to deny petitions after concluding that "the considerations counseling against discretionary denial outweigh those that favor it" because patent owner "has not developed strong settled expectations" given that patents issued in 2021, 2023 and 2024); *see also Google LLC v. Brodti Inc.*, IPR2025-00472, Paper 19 at 2 (Act. Dep. Ch. Admin. J. June 25, 2025) (denying request to deny petition challenging patent that issued in 2022 because "[e]arly challenges favor robust, predictable patent rights and weigh against discretionary denial.").

Many discretionary denial requests have been denied based at least in part on the patent owner's lack of "settled expectations" because the petition challenged a patent that issued in 2024, like the '992 patent. *See, e.g., MIM Software Inc. v.*

*Progenics Pharms., Inc.*, IPR2025-00630, Paper 13 at 2 (Director July 24, 2025); *Shenzen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 at 2 (Director July 17, 2025); *RØDE Microphones, LLC v. Zaxcom, Inc.*, IPR2025-00557, Paper 11 at 2 (Director July 17, 2025); *ResMed Corp. v. Cleveland Med. Devices, Inc.*, IPR2025-00246, Paper 10 at 2 (Director June 12, 2025); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11 at (Director June 12, 2025).

Indeed, many denial requests have been denied at least in part based on the patent owner’s lack of “settled expectations” for patents that issued between 2019 and 2023—up to five years before the ’992 patent issued. *See, e.g., Revvo Techs., Inc. v. Cerebrum Sensor Techs. Inc.*, IPR 2025-00632, Paper 12 at 2 (Director July 24, 2025); *MIM Software*, IPR2025-00630, Paper 12 at 2; *Revvo Techs., Inc. v. Tire Stickers LLC*, IPR 2025-00631, Paper 12 at 2 (Director July 24, 2025); *Stratasys*, IPR2025-00438, Paper 10 at 2; *Shenzhen Root Tech. Co., Ltd. v. Willow Blossom Holdco Limited*, IPR2025-00554, Paper 15 at 2 (Director July 17, 2025); *Embodiment, Inc. v. Lifenet Health*, IPR2025-00248, Paper 13 at 2–3 (Director June 26, 2025); *Yealink Network Tech. Co., Ltd.*, IPR2025-00491, Paper 18 at 3 (Director June 25, 2025); *Micron Tech., Inc. v. Yangtze Memory Techs. Co., Ltd.*, IPR2025-00190, Paper 21 at 3 (Act. Dep. Ch. Admin. J. June 25, 2025); *Imperative Care, Inc. v. Inari Med., Inc.*, IPR2025-00289, Paper 9 at 2 (Director June 12, 2025).

SDC tellingly does not address the “settled expectations” consideration at all

in its brief, even though this consideration is important, plainly applies in this case, and weighs strongly against granting SDC's denial request. By ignoring this consideration altogether, SDC tacitly concedes that this consideration weighs strongly against its denial request.

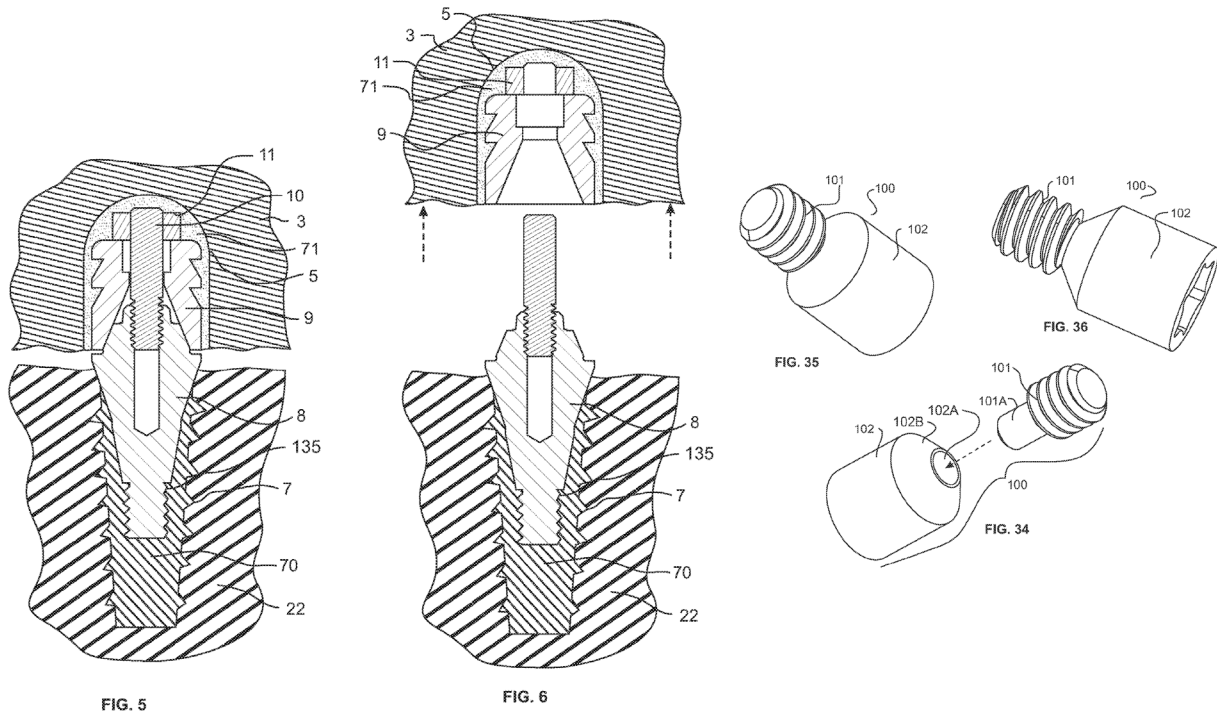
Moreover, as explained in Sections II.B to II.H below, the other considerations also collectively weigh against granting SDC's denial request. But even if any of them did support SDC, SDC's lack of "settled expectations" "tip[s] the balance against discretionary denial." *See Zhuhai*, IPR2025-00385, Paper 9 at 2–3 ("However, the considerations counseling against discretionary denial outweigh those that favor it. In particular, the challenged patents have not been in force for a significant period of time (issued in 2024, 2023, and 2021), and, accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial. Although there may be some inefficiencies with two proceedings operating in parallel, the early challenges to the patents tip the balance against discretionary denial.") (citation omitted).

**B. Straumann Has "Settled Expectations" That Weigh Against Granting SDC's Denial Request**

In contrast to SDC, Straumann does have "settled expectations" that weigh against granting SDC's denial request and in favor of permitting Straumann to present its challenge to the '992 patent to the Board.

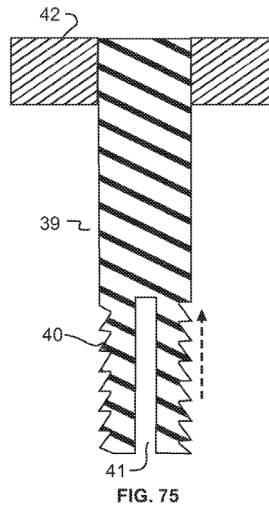
SDC alleges in the co-pending parallel litigation that the NeoConvert system sold by Straumann infringes the '992 patent challenged in Straumann's IPR petition and the '781 patent challenged in Straumann's co-pending PGR petition (PGR2025-00054). Ex. 2001. However, Straumann's affiliate designed, and Straumann publicly disclosed and launched, the accused NeoConvert system before the '992 and '781 patents issued and first became public. In particular, Straumann disclosed a prototype of the NeoConvert system at an industry conference in May 2023, and then launched the NeoConvert system in January 2024: before the '992 patent issued and first became public on March 26, 2024 and before the '781 patent issued and first became public on December 3, 2024. Ex. 1028 (Koskinas Declaration), ¶¶ 4–5.

Before the '992 patent issued on March 26, 2024, SDC's only published patent was the parent U.S. Patent No. 11,311,354 (Ex. 1013), which issued on April 26, 2022. Ex. 1013. SDC has never asserted the '354 patent against Straumann. Nor could it. The '354 patent is directed to and claims SDC's "separable fastener" device, which has a cap that separates from the threaded post, so that when the coping is removed from the abutment, the cap is removed with the coping, while the threaded post remains screwed into the abutment. *Id.*, 8:33–37, 14:17–39, Figs. 5, 6, 34–36 (shown below).



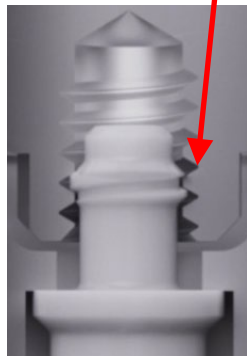
Accordingly, all of the claims of the '354 patent require a “separable screw” with a threaded “post” and a “cap” that can move relative to one another in the axial direction of the screw. *Id.*, 24:53–5.

The '354 patent also discloses another embodiment in Figure 75 (shown below), in which the entire temporary screw can be pulled out of the abutment without being unscrewed because of the screw’s asymmetric buttress threads 40 and the deflecting legs of the split-post structure created by slot 41. *Id.*, 5:24–28, 11:21–24, 22:36–41, 23:67–24:1, Fig. 75.



In contrast, the accused NeoConvert “Pin Capture” device sold by Straumann has a different structure and uses a completely different release mechanism that is not described or claimed in the ’354 patent. The “Pin Capture” device does not have a separable cap and post or a split-post structure with an asymmetric buttress thread and deflecting legs. Instead, the entire “Pin Capture” device can be screwed into the abutment but then pulled out without being unscrewed because its threads detach from the post when it is pulled out (shown below right). Petition at 38–39.

**threads intact**



**“Pin Capture”**

**(inserted in abutment)**

**threads detached**



**“Pin Capture”**

**(pulled out of abutment)**

Given these differences between the NeoConvert system and the '354 patent embodiments, when Straumann's affiliate designed and Straumann launched the NeoConvert system, Straumann had "settled expectations" that SDC had no basis to sue Straumann for infringement.

As noted above, SDC could not and did not sue Straumann for infringement of the '354 patent. However, unbeknownst to Straumann, after Straumann publicly disclosed the NeoConvert system in May 2023, SDC went back to the PTO and filed new continuation applications to obtain the '992 patent and the related '781 patent in an attempt to cover the NeoConvert system. In particular, SDC filed the application that issued as the '992 patent on June 3, 2023, followed by the application that issued as the '781 patent on January 26, 2024. SDC sued Straumann a few weeks after the '992 patent issued on March 26, 2024, and then added the '781 patent to the litigation after it issued on December 3, 2024. Ex. 2003; Ex. 2001.

Straumann's petition explains that the new claims that SDC obtained in the '992 patent are anticipated and/or rendered obvious by the parent '354 patent, which is prior art because the claims are not entitled to the earlier priority date of the '354 patent or any of the other priority applications. The claims are not supported by any of the priority applications because the claims go well beyond

what SDC's inventors invented and described, and therefore do not comply with the written description and enablement requirements. Petition at 32–43.

Straumann's "settled expectations" against being sued by SDC for infringement weigh against granting SDC's denial request and in favor of permitting Straumann to present its challenge to the patentability of these new claims that the PTO only recently issued.

**C. The Examiner Committed A Material Error and Did Not Consider New, Non-Cumulative Prior Art Presented In Straumann's Petition**

In allowing the claims of the '992 patent, the Examiner committed an error material to patentability by overlooking the lack of support for the claims, and also did not consider the new, non-cumulative prior art presented in Straumann's petition. Both of these facts further weigh against granting SDC's denial request.<sup>2</sup> *See Ecto World, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 3 (Director May 19, 2025) (precedential) (denial under 35 U.S.C. § 325(d) is not warranted if "the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims") (citing *Advanced Bionics, LLC*

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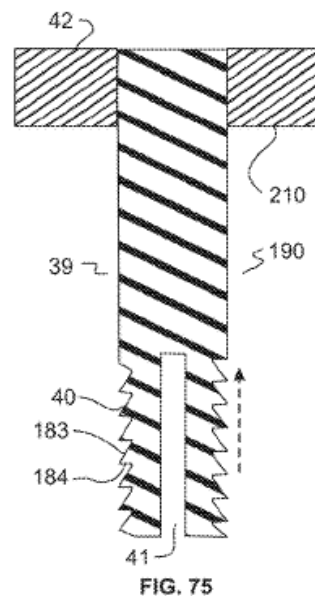
<sup>2</sup> SDC does not argue in its discretionary denial brief that Straumann's petition should be denied under 35 U.S.C. § 325(d).

*v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential)).

### **1. The Examiner Overlooked That the Claims Are Not Supported**

First, the Examiner should have rejected all of the claims for failing to comply with the written description and enablement requirements because, as explained in Straumann's petition, the claims go well beyond what the inventors invented and described. Petition at 32–43.

After SDC filed the continuation application that issued as the '992 patent, it elected to prosecute claims directed to the species of Figure 75 (shown below). Ex. 1015 at 174–182; Petition at 28; Ex. 1001, Fig. 75.



As explained in Straumann's petition, the priority applications explain that this temporary screw embodiment can be screwed into the abutment but then pulled out

without being unscrewed because of the screw's asymmetric buttress threads 40 and the deflecting legs of the split-post structure created by slot 41:

[T]he threaded end of the post portion of the temporary fastener has a deflecting feature that allows the post to engage or disengage the abutment threads through axial motion instead of a rotary screw motion. ...

FIG. 75 is a cross-sectional view of a temporary screw embodiment incorporating a split post that has deflecting sections with screw threads shaped to facilitate axial separation without unscrewing the post threads. ...

FIG. 75 shows a temporary attachment post 39 having a slot 41 and asymmetric threads or serrations 40 that allow the temporary attachment post to be inserted through rotation for alignment for coping pick-up but may be subsequently extracted with a separation force in the axial direction. ...

[T]he split post bottom structure shown in FIG. 75 which allows axial extraction ...

Ex. 1012 at 67, 78, 97, 100, Fig. 75; Petition at 24–27.

As explained in the petition, the claims of the '992 patent are not supported because: (1) the claims encompass temporary screws with any difference in thread pattern instead of just an asymmetric buttress thread as described (Petition at 32–37, 41–42); and (2) the claims do not require the temporary screw to have a split-

post structure with deflecting legs as described even though the claims do require the screw to be pulled out of the abutment without being unscrewed (*id.* at 37–41, 42–43).

In view of the foregoing, the Examiner should have rejected the claims for failure to comply with 35 U.S.C. § 112(a) but instead overlooked this issue and allowed the claims. As a result, as explained in the petition, the claims are not entitled to the earlier priority date of the parent '354 patent or any of the other priority applications, and the parent '354 patent is prior art that anticipates and/or renders obvious all of the claims. Petition at 32–54 (Grounds 1–3).

This material error by the Examiner weighs against granting SDC's denial request. *See, e.g., Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 2–3 (Director July 17, 2025) (denying request for denial because “Petitioner provides persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims”); *Bayer CropScience LP et al. v. Corteva Agriscience LLC*, IPR2023-01036, Paper 11 at 52 (P.T.A.B. Dec. 19, 2023) (declining to deny institution in part because petitioner was “reasonably likely to prevail” in showing that Examiner applied incorrect priority date because priority applications did not support claims).

## **2. The Examiner Did Not Consider the New, Non-Cumulative Prior Art Presented In Straumann's Petition**

Second, Straumann's petition presents new, non-cumulative prior art that the Examiner did not consider.

Ground 4 of Straumann's petition is based on Bernhard, Poovey and Gracco; Ground 5 adds Derey; and Ground 6 adds Ruetschi. Petition at 6, 54–84.

Bernhard and Poovey were cited (along with 113 other references) in an IDS submitted by SDC during prosecution. Ex. 1015 at 762–74; *id.* at 769. However, the Examiner did not apply or discuss either Bernhard or Poovey.

Moreover, Gracco, Derey and Ruetschi were not of record during prosecution, so the Examiner was not aware of these references. Therefore, the Examiner did not consider the combinations of Bernhard with Poovey and Gracco in Ground 4, Bernhard with Poovey, Gracco and Derey in Ground 5, and Bernhard with Poovey, Gracco and Ruetschi in Ground 6.

Each of these combinations presented in Grounds 4 to 6 includes materially different disclosures than Bernhard and Poovey. Bernhard does not disclose a threaded temporary screw, and although Poovey does, it does not disclose a temporary screw with a thread pattern that is different than the definitive screw thread pattern, which is a requirement of every claim. Ex. 1001, 25:53–55, 26:51–54. However, the combinations of Bernhard, Poovey and Gracco (Ground 4),

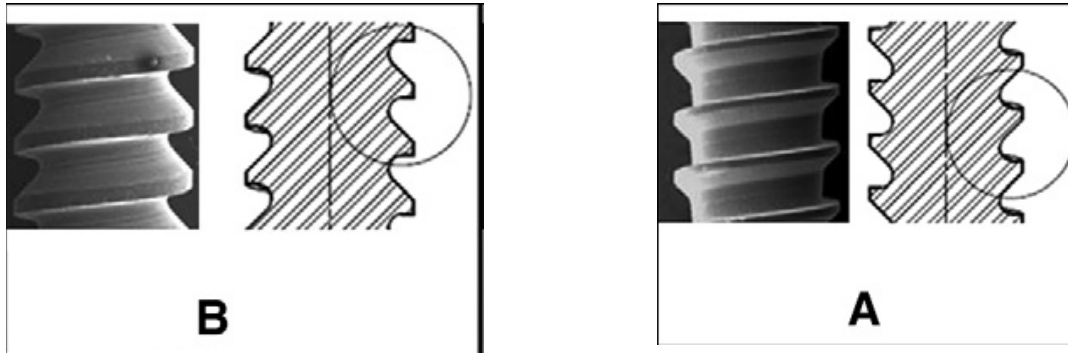
Bernhard, Poovey, Gracco and Derey (Ground 5), and Bernhard, Poovey, Gracco and Ruetschi (Ground 6) each disclose this limitation. Petition at 66, 74–75.

Each of the combinations presented in Grounds 4 to 6 also includes materially different disclosures than the prior art that the Examiner did discuss.

In the Notice of Allowance, the Examiner stated that the closest prior art references were Lannan, Lazzara, Neuhengen, Berrevoets and Otaki. Ex. 1015 at 1038–40. The Examiner concluded that Lannan and Lazara did not disclose, among other limitations, a temporary screw with a different thread pattern than the definitive screw. *Id.* at 1038–39; *cf.* Ex. 1001, 25:53–55, 26:51–54. The Examiner also concluded that Neuhengen, Berrevoets and Otaki did not disclose, among other limitations, a coping and a temporary screw that holds the coping in position against the implant abutment for pick-up processing. *Id.* at 1039–40; *cf.* Ex. 1001, 25:57–61, 26:59–60. The combinations of Bernhard, Poovey and Gracco (Ground 4), Bernhard, Poovey, Gracco and Derey (Ground 5), and Bernhard, Poovey, Gracco and Ruetschi (Ground 6) each disclose these limitations. Petition at 66, 67, 74–75, 76.

The Examiner also concluded in the Notice of Allowance that Neuhengen discloses a screw with “asymmetric threading.” Ex. 1015 at 1039. However, as explained below, Gracco’s disclosure is materially different than Neuhengen’s disclosure.

As explained in Straumann’s petition, Gracco discloses that a screw with an asymmetric buttress thread (Figure 1B shown below left) requires less force to pull out without being unscrewed than a screw with a reverse buttress thread (Figure 1A shown below right).<sup>3</sup>

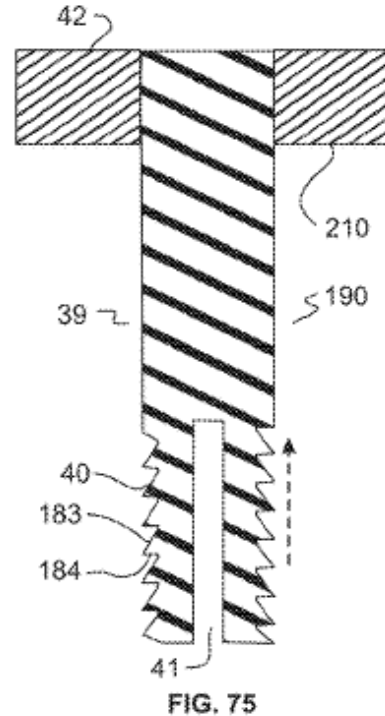
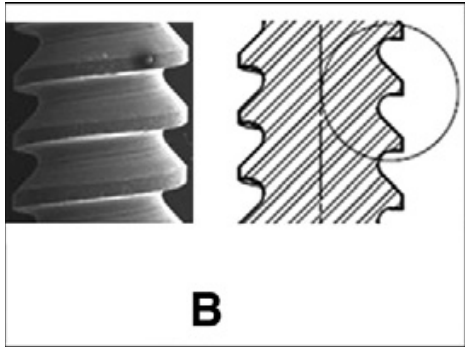


Gracco explains that the buttress thread (Figure 1B) “with thread peaks inclined toward the miniscrew tip” exhibited a “significant reduction in pullout force” compared to the reverse buttress thread (Figure 1A), and that “[t]his result could be explained by the geometry of the [buttress] thread that was inclined toward the tip, thus reducing the resistance to removal in an axial direction.” Ex. 1006 at 187, 189, Fig. 1(A, B); Petition at 17–18.

The buttress thread in Figure 1B of Gracco (shown below left) is similar to the buttress thread of the temporary screw in Figure 75 (shown below right).

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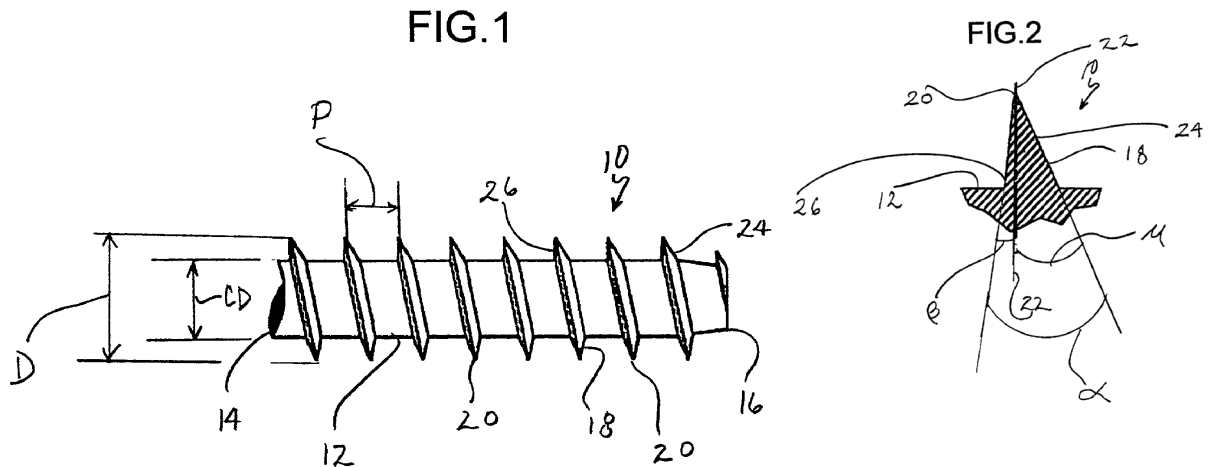
<sup>3</sup> In these images from Gracco, the proximal end of the screw with the driver head is above the image and the pointed distal end of the screw is below the image, so the screws were pulled out in the upward direction.



Ex. 1006, Fig. 1(B); Ex. 1001, Fig. 75. As further explained in Straumann’s petition, it would have been obvious in view of Bernhard, Poovey and Gracco to modify Bernhard’s system to temporarily connect the coping to the abutment with a temporary screw with flexible threads in a buttress thread pattern, and thereby arrive at the claimed subject matter. Petition at 54–62.

In contrast, the Neuhengen reference discussed by the Examiner discloses a self-tapping or thread-forming screw, for insertion into hard plastic material, that is “designed to have increased resistance to pullout.” Ex. 1029, [0008]. Neuhengen’s screw’s asymmetric thread is not a buttress thread with a smaller proximal thread angle that facilitates pullout as in Gracco (and Figure 75), but rather a reverse buttress thread with a larger proximal thread angle (shown in Figures 1 and 2

below), as a result of which “resistance to pullout is increased.” *Id.*, [0015]–[0017], Figs. 1, 2.<sup>4</sup>



Thus, Neuhengen discloses a thread-forming screw with a reverse buttress thread that is designed to be more difficult to pull out, whereas Gracco teaches the opposite: a screw with a buttress thread that is easier to pull out—just like Figure 75 and the claimed temporary screw.<sup>5</sup>

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<sup>4</sup> In Figure 1 of Neuhengen shown here, the proximal end of the screw with the driver head is to the left of the image and the pointed distal end of the screw is to the right of the image.

<sup>5</sup> Moreover, SDC told the Examiner that Neuhengen was different than the allowed claims in its comments on the reasons for allowance, where it stated the following: “Neuhengen ... discloses a self-tapping or thread forming screw especially for hard plastic materials. Objectives are to not cause cracking of the plastic and to have

In sum, Straumann’s petition presents new, non-cumulative prior art that the Examiner did not consider. Had the Examiner been aware of this materially different prior art, the Examiner would have rejected all of the claims, based on the combinations presented in Grounds 4 to 6 of the petition.

The fact that the Examiner did not consider this material prior art weighs against granting SDC’s denial request. *See, e.g., Ecto World*, IPR2024-01280, Paper 13 at 5 (“[A] petitioner may argue that it satisfies the second part of *Advanced Bionics* because the asserted prior art was not a basis for rejection during examination, is not substantially the same as prior art the Examiner applied, and includes specific teachings that ‘impact patentability of the challenged claims.’”) (citing *Advanced Bionics*, IPR2019-01469, Paper 6 at 8 n.9); *Embody*, IPR2025-00248, Paper 13 at 2 (denying request to deny because petition presented new, non-cumulative prior art not previously considered by PTO, and patent owner did not have “strong settled expectations” because patent issued in 2022); *Microsoft Corp. v. Edge Networking Sys., LLC*, IPR2025-00617, Paper 12 at 2 (Director July 31,

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increased resistance to pullout. In embodiments of the present application, threads are pre-formed in the implant abutment specifically to mate with the threading of the definitive screw and providing a temporary screw configured to function without causing damage to implant abutment threads.” Ex. 1015 at 1098.

2025) (denying request to deny because petitioner “provides persuasive reasoning, supported by evidence, that discretionary denial under 35 U.S.C. § 325(d) is not appropriate” including new, non-cumulative prior art in petition, and patent owner did not have “strong settled expectations” because patents issued in 2020, 2021 and 2023); *Oticon Medical AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 20 (P.T.A.B. Oct. 16, 2019) (precedential) (declining to deny institution under 35 U.S.C. § 325(d) because “[t]here is new, noncumulative prior art asserted in the Petition”).

**D. The District of Delaware Is Likely to Grant Straumann’s Motion to Stay the Parallel Litigation (*Fintiv* Factor 1)**

As of the date of this opposition (September 2, 2025), the District of Delaware has not yet ruled on Straumann’s motion to stay the litigation if the Board institutes this IPR of the ’992 patent (and Straumann’s related PGR of the ’781 patent).

SDC’s argument that the court is “unlikely” to stay the litigation because Straumann filed its stay motion before institution (SDC Brief at 9–11) should be rejected because Straumann’s motion seeks a conditional stay that would take effect if and when the Board institutes, not a stay that would take effect before institution. Ex. 1030 (Straumann motion); Ex. 1031 (Straumann opening brief); Ex. 1032 (Straumann reply brief). As such, the cases cited by SDC (SDC Brief at 9–10) are

not on point<sup>6</sup> because in those cases, the motions did not seek a conditional stay that would take effect upon institution. Instead, the motions either requested a stay that would take effect before institution<sup>7</sup> or the motions were filed after institution.<sup>8</sup>

SDC's argument that it is "improbable" that the court will stay the litigation because the stay factors weigh against a stay (SDC Brief at 11–12) should also be rejected. To the contrary, as explained below, the District of Delaware is likely to grant Straumann's stay motion.

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<sup>6</sup> SDC's arguments regarding *Fintiv* factor 1 should also be rejected because they are based primarily on decisions from district courts other than the District of Delaware (SDC Brief at 9–12) where the litigation is pending. Judge Barker, as a visiting judge, will apply precedent from the District of Delaware.

<sup>7</sup> See *Force Mos. Tech., Co. v. ASUSTek Computer, Inc.*, No. 22-CV-00460-JRG, 2024 WL 1586266, at \*1 (E.D. Tex. Apr. 11, 2024); *Trover Grp., Inc. v. Dedicated Micros USA*, No. 13-cv-1047-WCB, 2015 WL 1069179, at \*6 (E.D. Tex. Mar. 11, 2015).

<sup>8</sup> See *IOENGINE, LLC v. PayPal Holdings, Inc.*, No. 18-452-WCB, 2019 WL 3943058, at \*6 (D. Del. Aug. 21, 2019); *British Telecomm'ns PLC v. IAC/InterActiveCorp*, No. 18-366-WCB, 2019 WL 4740156, at \*5 (D. Del. Sept. 27, 2019).

The District of Delaware typically grants a stay if the Board institutes an IPR or PGR of the asserted patent(s), including for example in the decisions cited by SDC (SDC Brief at 10). *See IOENGINE*, 2019 WL 3943058 at \*6 (granting stay); *British Telecomm ’ns*, 2019 WL 4740156 at \*5 (granting stay); *cf. Wilson Wolf Mfg. Corp. v. Brammer Bio, LLC*, No. 19-2315-RGA, 2020 WL 13119694, at \*2 n.7 (D. Del. Dec. 8, 2020) (“I note that it has become fairly routine to stay cases after IPRs have been instituted.”).

Indeed, a report generated using Docket Navigator shows that since 2019, the District of Delaware has granted approximately 70% of motions to stay pending PTAB proceedings (72% in 2019, 74% in 2020, 77% in 2021, 71% in 2022, 58% in 2023, 65% in 2024, and 67% in 2025 (through September 2)). Ex. 1033 (stay motion statistics). Given these statistics, the District of Delaware is likely to grant Straumann’s stay motion as well because the motion requests a stay that would take effect if and when the Board institutes. This weighs against granting SDC’s denial request. *See Twitch Interactive, Inc. v. Razdog Holdings LLC*, IPR2025-00307, Paper 19 at 2–3 (Director May 16, 2025) (denying request to deny petition in part because “there is good reason to believe that a stay will be granted” based on statistics that in recent years the district court “granted or partially granted 76%” of motions to stay pending IPR).

Moreover, contrary to SDC’s arguments (SDC Brief at 11–12), and as

explained in Straumann’s stay motion briefs (Ex. 1031, Ex. 1032) and more succinctly below, the stay factors that the court will consider collectively weigh in favor of a stay.

First, if the Board institutes, a stay very likely would simplify the issues in the litigation because Straumann’s petitions challenge all of the asserted claims of both patents-in-suit. As a result, the petitions have the potential to dispose of the litigation entirely, which would result in “the ultimate simplification of issues.” *See VirtualAgility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1314 (Fed. Cir. 2014). In the District of Delaware, this simplification of the issues factor is “[t]he most important factor bearing on whether to grant a stay.” *See British Telecomm’ns PLC v. IAC/InterActiveCorp*, No. 18-366-WCB, 2020 WL 5517283, at \*9 (D. Del. Sept. 11, 2020); Ex. 1031 at 12–14; Ex. 1032 at 6–9.

Second, contrary to SDC’s argument (SDC Brief at 11–12), the stay would take effect before the litigation has progressed to an advanced stage. Straumann’s motion requests a stay that would begin at the end of fact discovery on December 5, 2025: before the parties submit their claim construction briefs between December 19, 2025 and February 20, 2026; before the *Markman* hearing on March 6, 2026;

before the parties conduct expert discovery between April 10 and June 5, 2026;<sup>9</sup> before the parties brief summary judgment and *Daubert* motions between June 19 and July 31; and before the parties do all the other work leading up to the trial scheduled to begin on October 19, 2026. Ex. 2005 (scheduling order) at 1–4.

As such, the cases cited by SDC (SDC Brief at 12) are distinguishable. Unlike in this case, in *Sonrai* and *Intellectual Ventures*, the parties had already briefed claim construction and, in *Sonrai*, they had also completed the *Markman* hearing. See *Sonrai Memory Ltd. v. LG Elecs. Inc.*, No. 21-cv-00168-ADA, 2022 WL 2307475, at \*3 (W.D. Tex. June 27, 2022); *Intellectual Ventures II LLC v. Fedex Corp.*, No. 16-CV-00980-JRG, 2017 WL 4812434, at \*1, \*3 (E.D. Tex. Oct. 24, 2017); Ex. 1031 at 9–10; Ex. 1032 at 14–15.

Third, a stay also would not unduly prejudice SDC (SDC Brief at 11). Although SDC and Straumann are competitors, SDC did not submit sufficient evidence of alleged competitive harm in its opposition to Straumann’s stay motion. Therefore, this factor weighs only slightly against a stay, if at all, and is outweighed by the other factors that weigh in favor of a stay. See *Sirona Dental Sys. GmbH v.*

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<sup>9</sup> Thus, by the Board’s institution deadline on December 2, 2025, the parties will be several months away from the beginning of expert discovery on April 10, 2026, not “in the thick of” expert discovery as SDC incorrectly asserts. SDC Brief at 12.

*Dental Wings, Inc.*, No. 14-460-LPS-CJB, 2016 U.S. Dist. LEXIS 155706, at \*38–39 (D. Del. Mar. 22, 2016) (granting stay after finding that “the lack of evidence as to the nature and extent of competitive injury means that the subfactor is less strong for Sirona than it might have been with a more full record”); *Cypress Semiconductor Corp. v. GSI Tech., Inc.*, No. 13-cv-02013-JST, 2014 WL 5021100, at \*4–5 (N.D. Cal. Oct. 7, 2014) (granting stay after concluding that prejudice factor “weighs against a stay, although not strongly” after finding “no evidence of competitive injury” including “no evidence ... that customers have in fact purchased allegedly infringing GSI parts when they would have otherwise purchased Cypress parts”); *Sec. People, Inc. v. Ojmar US, LLC*, No. 14-cv-04968-HSG, 2015 U.S. Dist. LEXIS 70011, at \*12–14 (N.D. Cal. May 29, 2015) (granting stay after finding the prejudice factor “is either neutral or weighs slightly against a stay” because plaintiff’s declaration “d[id] not provide this Court sufficient evidence to evaluate the degree of prejudice”); Ex. 1031 at 18–19; Ex. 1032 at 12–14.

In sum, given the likelihood of a stay if the Board institutes, *Fintiv* factor 1 weighs against granting SDC’s denial request. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (“A district court stay of the litigation pending resolution of the PTAB trial allays concern about inefficiency and duplication. This fact has strongly weighed against exercising the authority to deny institution ...”).

**E. The Board’s Final Decision Deadline Will Be Only Six Weeks After the Scheduled Trial Date and Seven Months Before the Median Trial Date In the District of Delaware (*Fintiv* Factor 2)**

The Board’s final decision deadline of December 2, 2026 is about six weeks after the scheduled trial date of October 19, 2026. Ex. 2005 at 1. However, as in many patent cases, it is possible (if not likely) that the trial date will be rescheduled to a later date. A report from [uscourts.gov](https://uscourts.gov) shows that since 2020, the median time to trial for civil cases in the District of Delaware has been on average about 39 months (38.8 months in 2020, 40.3 months in 2021, 37.0 months in 2022, 38.6 months in 2023, 40.1 months in 2024, and 41.6 months in the 12 months that ended on March 31, 2025). Ex. 1034 (time-to-trial statistics). If one considers this median time to trial of 39 months,<sup>10</sup> the trial would begin sometime in July 2027, in which case the Board’s final decision deadline would be about seven months before the trial begins.

Moreover, after the verdict, there will be additional time required—likely several months—for the parties to file and brief post-trial motions for JMOL and/or a new trial, and for the district court to decide those motions, before there is a final judgment that can be appealed to the Federal Circuit. In contrast, the Board’s final

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<sup>10</sup> The March 24, 2025 Memorandum explains that “median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides” may be considered. Memorandum at 3.

decision on December 2, 2026 (or earlier) will be immediately appealable to the Federal Circuit. Therefore, even if the trial occurs in October 2026, it is still likely that the Board’s final decision will be earlier than the final judgment in the litigation.

As such, it is just as likely that the trial will be around the same time as the projected statutory deadline, or even later. Therefore, this proximity of trial factor is at worst neutral and the analysis turns on other factors. *See Apple*, IPR2020-00019, Paper 11 at 9 (“If the court’s trial date is at or around the same time as the projected statutory deadline ... , the decision whether to institute will likely implicate other factors ... , such as the resources that have been invested in the parallel proceeding.”); *Clearcorrect Operating, LLC v. Align Technology, Inc.*, IPR2025-00814, Paper 14 at 2 (Director Aug. 29, 2025) (denying request for denial after finding this factor “neither favor[s] nor counsel[s] against discretionary denial” where Board’s final decision deadline of November 8, 2026 was later than scheduled trial date of May 11, 2026 but “time-to-trial statistics suggest that the trial will not begin until November 2027”).

Moreover, even if the trial date occurs before the Board’s final decision deadline, SDC’s lack of “settled expectations” tips the balance against granting SDC’s denial request. Discretionary denial requests have been denied based on the patent owner’s lack of “settled expectations” where the scheduled trial date is one month or even several months before the deadline for the Board’s final decision. *See*,

*e.g.*, *Stratasys*, IPR2025-00438, Paper 10 at 2 (denying requests for denial based on lack of “settled expectations” for patents that issued in 2020, 2020, 2021 and 2024 where trial was scheduled four months before Board’s final decision deadlines); *Multi-Color Corp. v. Brook & Whittle Ltd.*, PGR2025-00025, Paper 10 at 2 (Director July 16, 2025) (denying request for denial based on lack of “settled expectations” for patent that issued in 2024 where trial was scheduled four months before Board’s final decision deadline); *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 2–4 (Director July 16, 2025) (denying request for denial based on lack of “settled expectations” for patents that issued in 2022 and 2023 where trial was scheduled eight months before Board’s final decision deadlines); *Zhuhai*, IPR 2025-00385, Paper 9 at 2–3 (denying request for denial based on lack of “settled expectations” for patents that issued in 2021, 2023 and 2024 where trial was scheduled one to two months before Board’s final decision deadlines).

The cases on which SDC relies (SDC Brief at 13–14) are distinguishable.

In *Stratasys*, the petitioner’s invalidity arguments in the litigation were “more expansive and include[d] combinations of the prior art asserted in [the IPR] with unpublished system prior art, which Petitioner’s [*Sotera*] stipulation [was] not likely to moot.” See *Shenzen Tuozhu Tech. Co. Ltd. v. Stratasys, Inc.*, IPR2025-00354, Paper 11 at 2–3 (Director, June 12, 2025). In contrast, as discussed in Section II.G below, Straumann’s initial anticipation and obviousness contentions in the litigation

present only the same prior art grounds based on the same patents and printed publications as its petition, which will be covered by its *Sotera* stipulation if the Board institutes. Ex. 2007 (invalidity contentions) at 3–9; Ex. 2009 (*Sotera* stipulation).

In *Advanced Micro Devices*, *NXP* and *Lam*, the court and the parties had already conducted a *Markman* hearing (in *NXP* and *Lam*) or would do so before the institution decision deadline (in *AMD*). See *NXP USA, Inc. v. Redstone Logics LLC*, IPR2025-00485, Paper 11 at 2 (Director July 10, 2025); *Lam Research Corp. v. Inpria Corp.*, IPR2025-00256, Paper 12 at 2 (Director July 2, 2025); *Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9 at 2 (Director June 12, 2025). Here the *Markman* hearing is scheduled for March 6, 2026—three months after the Board’s institution decision deadline on December 2, 2025—and the parties will not brief claim construction until after the Board’s institution decision. Ex. 2005 at 3–4.

In *Mobile Data*, *Cerence*, *NXP* and *Os-New Horizon*, unlike here, the patent owners had “strong settled expectations” because the patents had been in force between 10 and 12 years. See *Samsung Elecs. Co. Ltd. v. Mobile Data Techs., LLC*, IPR2025-00535, Paper 16 at 2 (Act. Dep. Ch. Admin. Patent J., July 10, 2025); *Samsung Elecs. Co. Ltd. v. Cerence Operating Co.*, IPR2025-00458, Paper 14 at 2 (Act. Dep. Ch. Admin. Patent J., June 25, 2025); *NXP*, IPR2025-00485, Paper 11 at

2; *Samsung Elecs. Co. Ltd. v. Os-New Horizon Personal Computing Sols. Ltd.*, IPR2025-00613, Paper 10 at 2 (Act. Dep. Ch. Admin. Patent J., July 17, 2025).

In *Entegris*, the defendant in the litigation had incorporated by reference all the “arguments, evidence and statements” in the petition, so there was substantial overlap with the litigation. *See Entegris, Inc. v. Inpria Corp.*, IPR2025-00267, Paper 12 at 2 (Director July 2, 2025). However, unlike here, there is no indication in *Entegris* that a *Sotera* stipulation had been filed that would eliminate the overlap.

In *Cisco*, “there [wa]s insufficient evidence that the district court is likely to stay its proceeding” if the Board instituted. *See Cisco Sys., Inc. v. WSOU Invs. LLC*, IPR2025-00429, Paper 15 at 2 (Director June 25, 2025). However, unlike here, in *Cisco* the petitioner had not even filed a motion to stay the litigation, and the stay factors would have been substantially weaker because the petitioner had not filed petitions against all of the patents asserted in the litigation.

Finally, in *Apple*, the Board held that the proximity of trial weighed “somewhat” in favor of denial because the trial was scheduled “approximately two months” before the Board’s final decision deadline. *See Apple*, IPR2020-00019, Paper 15 at 13. However, the Board refused to consider the possibility that the trial could be delayed because, unlike in this case, the trial had “already been postponed by several months.” *Id.*

In sum, *Fintiv* factor 2 is neutral or at worst weighs “somewhat” in favor of

granting SDC's denial request, but in any event the "settled expectations" consideration tips the balance against granting SDC's request.

**F. The Board's Institution Decision Will Precede the Bulk of the Work In the Litigation (*Fintiv* Factor 3)**

By the deadline for the Board's institution decision on December 2, 2025, the parties will have exchanged final infringement and invalidity contentions and will almost have completed fact discovery, which closes on December 5. Ex. 2005 at 4. However, the bulk of the work leading up to and including the trial, and beyond, will lie ahead, including: claim construction and indefiniteness briefs between December 19 and February 20, 2026; the *Markman* hearing on March 6; expert reports and depositions for at least two technical experts (infringement and invalidity) and two damages experts (lost profits and reasonable royalty damages) between April 10<sup>11</sup> and June 5; summary judgment and *Daubert* motions between June 19 and July 31; pre-trial submissions including motions *in limine* and jury instructions between September 1 and October 2; the pre-trial conference and the jury trial on infringement, invalidity, lost profits damages and reasonable royalty damages for

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<sup>11</sup> Therefore, by the institution deadline on December 2, 2025, the parties will be several months away from the beginning of expert discovery on April 10, 2026, not "quickly approaching" expert discovery as SDC incorrectly asserts. SDC Brief at 16.

two patents beginning on October 19; and post-trial motions. Ex. 2005 at 1–4.

As such, the cases cited by SDC (SDC Brief at 16) are distinguishable. In *Keyless*, at the time of the denial decision (*i.e.* several weeks before the institution decision deadline), the parties were already “engaged in the *Markman* process” and fact discovery was already “nearly closed.” Moreover, trial was scheduled to begin almost six months before the Board’s final decision deadline. *See Samsung Elecs. Co. Ltd. v. Keyless Licensing LLC*, IPR2025-00526, Paper 12 at 2 (Act. Dep. Ch. Adm. Patent J., July 17, 2025). In *Kingston*, at the time of the denial decision, the district court had already held its *Markman* hearing. Moreover, the petitioner had not filed a *Sotera* stipulation and the patent owner had “strong settled expectations” because the patent had been in force for more than 10 years. *See Kingston Tech. Co. v. Vervain LLC*, IPR2025-00614, Paper 12 at 2 (Director July 16, 2025).

SDC’s argument that this factor weighs in favor of granting its request because the district court has entered several orders (SDC Brief at 16–17) should be rejected. The court orders relevant under this factor are “substantive orders related to the patent at issue in the petition” including claim construction decisions. *See Apple*, IPR2020-00019, Paper 11 at 9–10. Therefore, the court’s order regulating practice, its scheduling order, and its protective order (SDC Brief at 16) are not relevant because they are routine procedural orders like those issued in every patent litigation.

That leaves the court’s decision to deny Straumann’s motion to dismiss nine

months ago. *See Smart Denture Conversions, LLC v. Straumann USA, LLC*, 759 F. Supp. 3d 555 (D. Del. 2024). That decision should not weigh in favor of granting SDC’s request because it addressed only indefiniteness issues that Straumann could not have raised—and did not raise—in its IPR petition. *See Samsung Elecs. Am., Inc. v. Prisia Eng’g Corp.*, 948 F.3d 1342, 1350 (Fed. Cir. 2020) (“[W]e hold that the Board may not cancel claims for indefiniteness in an IPR proceeding.”). Moreover, the court will not issue its claim construction decision until after the *Markman* hearing on March 6, 2026—at least three months after the Board’s institution decision deadline of December 2, 2025. Ex. 2005 at 3.

SDC’s arguments that this IPR “is not an alternative to litigation” but instead “more litigation in a different forum” that would result in “duplicative efforts” that “revisit the jury’s earlier validity findings” (SDC Brief at 17, 18) are conclusory and demonstrably incorrect. SDC ignores Straumann’s *Sotera* stipulation, which will eliminate duplicative overlap with the litigation. Ex. 2009. Specifically, the jury will not consider any invalidity issues encompassed by the stipulation, so the Board’s final decision will not overlap at all with, much less “revisit,” any jury findings.

SDC’s assertion that Straumann did not file its petition “expeditiously” (SDC Brief at 17–18) is incorrect. Straumann timely filed its petition only five days after receiving SDC’s identification of the asserted claims and initial infringement contentions on April 25, 2025. *See Apple*, IPR2020-00019, Paper 11 at 11 (“If ... the

petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against exercising the authority to deny institution.”).

SDC’s assertion that Straumann’s filing of the petition after SDC served its infringement contentions was “disingenuous” because Straumann “had no difficulty deciding which claims to challenge in its § 112 motion to dismiss” (SDC Brief at 18) should be rejected. Straumann’s motion to dismiss presented one indefiniteness argument directed to one limitation in each of the two independent claims, which necessarily also applied to all the dependent claims because each dependent claim includes all the limitations of the independent claim from which it depends. *See* 35 U.S.C. § 112(d) (“A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”).

Moreover, it was reasonable of Straumann to review SDC’s interpretation of the claim language in its contentions before Straumann finalized its petition, in particular with respect to Straumann’s arguments that the claim scope asserted by SDC goes well beyond what the inventors invented and described, and therefore fails to comply with the written description and enablement requirements, which underlie the priority date arguments for Grounds 1 to 3. Petition at 32–54.<sup>12</sup>

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<sup>12</sup> SDC also ignores the fact that Straumann’s motion to dismiss was pending until

In sum, *Fintiv* factor 3 weighs against granting SDC’s denial request.

**G. There Will Be No Duplication or Overlap With the Litigation Because of Straumann’s *Sotera* Stipulation (*Fintiv* Factor 4)**

If the Board institutes the IPR, there will be no duplication or overlap with the litigation because of Straumann’s *Sotera* stipulation. Straumann’s stipulation tracks the language of the stipulation in the precedential *Sotera* decision, and provides that if the Board institutes the IPR, “Straumann will not pursue in this litigation that the patent claims subject to the instituted IPR are invalid based on grounds that were raised or reasonably could have been raised during the IPR (*i.e.*, any ground that could have been raised under 35 U.S.C. §§ 102 or 103 on the basis of prior art patents or printed publications).” Ex. 2009. Straumann’s petition challenges all of the claims of the ’992 patent. Therefore, if the Board institutes, the *Sotera* stipulation will cover all of the claims of the ’992 patent that SDC asserts in the litigation.<sup>13</sup>

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December 12, 2024. *See British Telecomm’ns*, 2019 WL 4740156, at \*5 (“[I]t was reasonable ... to wait for the Court’s ruling on the motion to dismiss before filing [the] IPR petition.”).

<sup>13</sup> As Straumann will explain in its forthcoming opposition to SDC’s discretionary denial request in the co-pending PGR of the related ’781 patent (PGR2025-00054), Straumann’s PGR petition challenges all of the claims of the ’781 patent, and Straumann also filed a *Sotera* stipulation for the ’781 patent.

Given Straumann’s *Sotera* stipulation, this factor weighs strongly against granting SDC’s request. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020) (precedential) (“Petitioner’s stipulation here mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions. ... Petitioner’s broad stipulation ensures that an *inter partes* review is a ‘true alternative’ to the district court proceeding. Thus, we find that this factor weighs strongly in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a).”).

SDC cherry picks the statement in the March 24, 2025 Memorandum that a *Sotera* stipulation is “not dispositive” (SDC Brief at 19) but ignores the adjacent statement in the very same sentence that a *Sotera* stipulation remains “highly relevant.” *See* March 24, 2025 Memorandum at 2–3 (“[A] timely-filed *Sotera* stipulation ... is highly relevant, but will not be dispositive by itself.”).

SDC’s argument that “the value of a *Sotera* stipulation is even less than before” in the wake of *Ingenico* (SDC Brief at 19) is incorrect in this case. In *Ingenico*, the Federal Circuit held that the estoppel created by 35 U.S.C. § 315(e)(2) does not apply to system prior art, even if the system is described in a patent or printed publication, because the system prior art creates a different “ground” that could not have been raised in the IPR. *See Ingenico Corp. v. IOENGINE, LLC*, 136 F.4th 1354, 1366–67 (Fed. Cir. 2025). *Ingenico* does not diminish the “value” of

Straumann's *Sotera* stipulation because Straumann's initial anticipation and obviousness contentions in the litigation present only the same prior art grounds based on the same patents and printed publications as Straumann's petition, which will be covered by its *Sotera* stipulation if the Board institutes. Ex. 2007 at 3–9; Ex. 2009.

In sum, SDC's argument that Straumann's *Sotera* stipulation "will not suffice to prevent substantial overlap between the district court proceedings and any IPR here" (SDC Brief at 19) is demonstrably incorrect, and *Fintiv* factor 4 weighs strongly against granting SDC's denial request.

**H. Other Considerations Weigh Against Granting SDC's Denial Request (*Fintiv* Factor 6 & Director's March 26, 2025 Memorandum)**

The other considerations encompassed by *Fintiv* factor 6 and the Director's March 26, 2025 Memorandum also weigh against granting SDC's denial request.

**1. Straumann's Petition Is Comprehensive and Strong**

Contrary to SDC's arguments (SDC Brief at 21–24), Straumann's petition presents several strong grounds of unpatentability for every claim of the '992 patent. As explained in the petition, all of the claims would have been obvious in view of prior art temporary fasteners that can be pulled out of the abutment, in particular prior art temporary screws with flexible threads that can be pulled out without being unscrewed, and prior art that teaches that an asymmetric buttress thread has a smaller

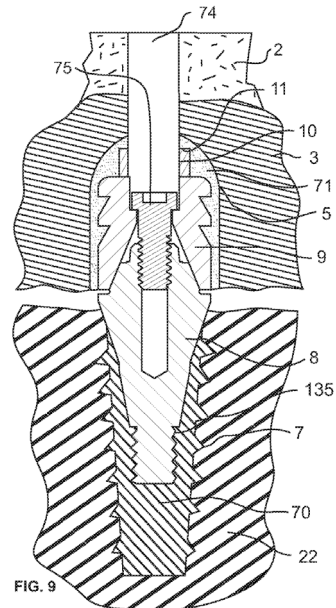
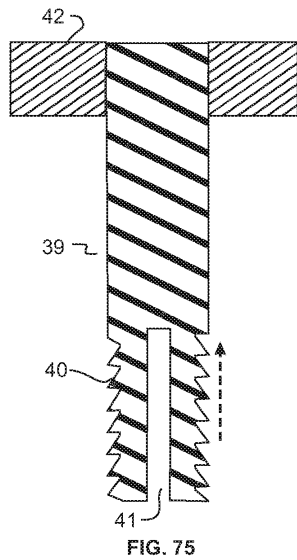
proximal thread angle that makes it easier to pull out. Petition at 54–84. Moreover, all of the claims are also unpatentable because they are much broader than the description in the priority applications, so the claims are not entitled to any earlier priority date, and the parent ’354 patent is prior art that anticipates and/or renders obvious the claims. *Id.* at 32–54.

SDC’s various critiques of Straumann’s petition (SDC Brief at 21–24) are incorrect and should be rejected.

First, SDC incorrectly asserts that Straumann’s petition “relies principally on various combinations of seven prior art references.” *Id.* at 21. In fact, Straumann’s petition presents two independent sets of three grounds based on a total of six references, with only one reference overlapping between the two sets. The first set of grounds presents Kofford (the parent ’354 patent) as an anticipating reference for all 12 claims (Grounds 1 and 3), along with Kofford combined with Poovey for three claims (Ground 2). Petition at 5–6, 32–54. The second set of grounds presents Bernhard combined with Poovey and Gracco for nine claims (Ground 4), with Derey added for two claims (Ground 5), and Ruetschi added for one claim (Ground 6). *Id.* at 6, 54–84.

Second, SDC’s arguments that Kofford is not prior art because the claims are supported and entitled to the earlier priority date (SDC Brief at 21–22) are incorrect. As explained in Section II.C.1 above and in Straumann’s petition, the claims are not

supported by any of the priority applications. Petition at 32–43. In particular, all of the claims require, *inter alia*, that the temporary screw has a different thread pattern than the definitive screw, that the temporary screw is screwed into the abutment, and that the temporary screw is pulled out of the abutment without being unscrewed. The priority applications disclose only one temporary screw embodiment that has all of these features: the temporary screw of Figure 75 (below left), which has an asymmetric buttress thread pattern 40 that is different than the symmetric thread pattern of the definitive screw of Figure 9 (below right):



The priority applications explain that this temporary screw is screwed into the abutment but is pulled out without being unscrewed because of the asymmetric thread pattern 40 and the deflecting legs of the split-post structure created by slot 41. Ex. 1012 ('361 Application) at 67, 78, 97, 100, Fig. 75; Petition at 32–43.

As explained in the petition, the claims are not supported because the claims

encompass temporary screws with any different thread pattern (not just an asymmetric buttress thread as described) and the claims do not require the temporary screw to have a split post with deflecting legs, even though the claims do require the temporary screw to be pulled out of the abutment without being unscrewed. Petition at 32–43.

SDC’s assertion that it “explicitly addressed specification and disclosure issues related to those that Straumann’s Petition raises” (SDC Brief at 4–5) is incorrect. As explained in Section II.C.1 above, the Examiner overlooked the lack of support issues raised in Straumann’s petition and therefore did not reject any of the claims based on these support issues. Moreover, SDC never addressed any of these support issues during prosecution, including in the response that SDC cites in its brief. Ex. 1015 at 295–99.

SDC incorrectly argues that the claims are supported because the applications purportedly disclose “multiple” embodiments, including an embodiment without deflecting legs. SDC Brief at 22–24 (citing Ex. 1012 at 72, 97, 100). None of the statements cited by SDC describe an embodiment that supports the claims. Instead, the cited statements are either generic boilerplate<sup>14</sup> or describe temporary screws that

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<sup>14</sup> Ex. 1012 at 97 (“The drawings featured in the figures are for the purpose of illustrating certain convenient embodiments of the present invention and are not to

are pushed into the abutment instead of screwed into the abutment:

The inventive concepts disclosed are not meant to be restricted to a temporary attachment post with standard screws that both engage and disengage the threads in the implant abutment through rotations.

...

[T]he threads could be designed to provide engagement with the implant abutment threads through axial motion in the opposite direction to the arrow shown in FIG. 75.

...

Although the descriptions above use rotational engagement of the bottom of the post with internal threads of the abutment as a preferred approach, this is not meant to be limiting. Alternate approaches for engaging a temporary attachment post with abutment threads through axial insertion without rotation are considered to be part of this disclosure. For example, the split post bottom structure shown in FIG. 75 which allows axial extraction can also be used for axial insertion. Similarly, an interference fit between the bottom of the post with the threads may also be designed to provide sufficient engagement to provide adequate alignment and fixing of the coping for the pick-up bonding process described earlier.

Ex. 1012 at 97, 100 (emphasis added).

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be considered as a limitation thereto.”); *id.* at 100 (“Various embodiments have been described to illustrate the disclosed inventive concepts, not to limit the invention.”).

None of these statements support the claims because the claims require the temporary screw to be screwed into the abutment, not pushed into the abutment as described in these statements.<sup>15</sup> For example, independent claim 1 recites “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” and independent claim 9 recites “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.” Ex. 1001 (’992 patent), 25:56–59, 26:61–64. The only disclosed temporary screw with a different thread pattern that is screwed into the abutment but pulled out without being unscrewed is the embodiment with a split post with deflecting legs shown in Figure 75, which does not support the full scope of the claims. Petition at 37–41.

The cases cited by SDC (SDC Brief at 24) do not support its arguments. In *Eunsung*, the Board found *Fintiv* factor 6 to be neutral. *See Eunsung Global Corp. v. Hydrafacial LLC*, IPR2024-01491, Paper 17 at 16–17 (P.T.A.B. Apr. 11, 2025). In *Toyota*, the Board “d[id] not find the merits to be particularly strong.” *See Toyota*

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<sup>15</sup> Moreover, contrary to SDC’s conclusory assertions (SDC Brief at 23), none of the cited statements describe a reverse buttress thread pattern; indeed, none of the statements say anything about the thread pattern. Ex. 1012 at 97, 100.

*Motor Corp. v. Emerging Auto. LLC*, IPR2024-00785, Paper 13 at 15–16 (P.T.A.B. Mar. 11, 2025). In contrast, the merits of Straumann’s petition are strong.

In sum, Straumann’s petition is strong, SDC’s critiques are without merit, and the strength of the petition weighs against granting SDC’s request for denial. *See Fintiv*, IPR2020-00019, Paper 11 at 14–15 (this factor weighs against denial “if the merits of a ground raised in the petition seem particularly strong”).

## **2. Straumann’s Petition Is Supported By Appropriate Expert Testimony**

SDC’s conclusory argument (SDC Brief at 25–27) that Straumann’s petition “offer[s] little substance in addition to” its expert’s declaration should be rejected. Straumann’s petition presents arguments and evidence that demonstrate that the claims are not supported and are anticipated and obvious. This evidence includes the disclosures in the priority applications and the prior art references, as well as Dr. Brunski’s expert declaration (Ex. 1002) that explains how a POSA would interpret those disclosures, the knowledge of a POSA, and how and why a POSA would have combined or modified the prior art to arrive at the claimed subject matter. SDC does not explain what additional “substance” the petition should have included.

Moreover, contrary to SDC’s arguments (SDC Brief at 21, 24–25), Dr. Brunski’s expert declaration is not “a subtle attempt to retroactively fill gaps in the prior art.” Dr. Brunski’s declaration appropriately provides expert testimony from the perspective of one of ordinary skill in the art regarding technical subject matter

that is relevant to the patentability issues raised in the petition, including background on the technical field, the level of ordinary skill in the art, the technical disclosures in the priority applications, SDC's characterization of the claimed subject matter during prosecution, the claim language, the technical disclosures in the prior art, the knowledge of a POSA, why the claims are not supported, and why the claims are anticipated and obvious, including the reasons a POSA would have combined or modified the prior art to arrive at the claimed subject matter. In particular, contrary to SDC's arguments, Dr. Brunski's testimony does not "back-fill" "gaps" in the prior art but instead explains "the background knowledge possessed by a person having ordinary skill in the art" and "the inferences and creative steps that a person of ordinary skill in the art would employ," as mandated by the "expansive and flexible approach" of *KSR*. See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007).

It is black-letter law that the patentability issues addressed in Dr. Brunski's declaration must be analyzed from the perspective of a POSA. See, e.g., *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1384 (Fed. Cir. 2019) ("Motivation to combine and the scope of analogous art are both factual inquiries underpinning an obviousness determination that take into account the knowledge and perspective of

an ordinarily skilled artisan.”);<sup>16</sup> *Ariad Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (“[T]he [written description requirement] test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.”).<sup>17</sup> Moreover, expert testimony about these patentability issues must be given by a qualified technical expert witness who has at least ordinary skill in the art, which Dr. Brunski does. *See Kyocera Senco Ind. Tools, Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022) (“To offer expert testimony from the perspective of a skilled artisan in a patent case—like for claim construction, validity, or infringement—a witness must at least have ordinary skill in the art.”).

Finally, 35 U.S.C. § 312(a)(3) required Straumann to present the “evidence

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<sup>16</sup> *See also* 35 U.S.C. § 103(a) (“A patent for a claimed invention may not be obtained ... if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious ... to a person having ordinary skill in the art.”) (emphasis added).

<sup>17</sup> *See also* 35 U.S.C. § 112(a) (“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art ... to make and use the same.”) (emphasis added).

that supports the grounds for the challenge to each claim, including ... affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions,” and 37 C.F.R. § 42.65(a) required Straumann to disclose the “underlying facts or data” upon which Dr. Brunski’s expert testimony is based. *See GD Energy Prods., LLC v. Kerr Mach. Co.*, PGR2025-00031, Paper 11 at 2 (Director June 25, 2025) (“Patent Owner also argues that Petitioner has ‘extensive reliance’ on expert testimony, but Petitioner persuasively responds that the testimony is merely complying with regulations requiring disclosure of ‘underlying facts or data.’”) (quoting 37 C.F.R. § 42.65(a)).

The decisions that SDC cites (with a *cf.*) (SDC Brief at 26–27) are plainly distinguishable and do not support its incorrect argument that Straumann’s petition “repackag[es] expert testimony” in a way that “undercuts” the petition and weighs in favor of granting SDC’s denial request.

In *Xerox*, the Board gave little weight to the expert’s testimony in support of a conclusory statement in the petition because the expert merely repeated verbatim the conclusory statement and did not “provide any technical reasoning to support” it. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15–17 (P.T.A.B. Aug. 24, 2020). SDC does not argue that any of the statements by Dr. Brunski that SDC cites (SDC Brief at 26–27) are conclusory, and none of them are. Throughout his declaration, Dr. Brunski clearly explains his “technical reasoning” in detail. In

particular, in the section of his declaration that includes the excerpt that SDC cites on page 26 of its brief, Dr. Brunski clearly explains in detail why and how a POSA would have modified Bernhard's system to use a temporary screw with flexible buttress threads to temporarily connect the coping to the abutment, based on the teachings of Bernhard, Poovey and Gracco, as well as the knowledge of a POSA. Ex. 1002, ¶¶277–283.

In *Wowza*, the Board explained that the petition and expert declaration were deficient because neither identified the specific prior art disclosures that disclosed the limitation at issue. *See Wowza Media Sys., LLC v. Adobe Sys., Inc.*, IPR2013-00054, Paper 12 at 12 (P.T.A.B. Apr. 8, 2013). SDC does not argue there is any such deficiency in Straumann's petition or Dr. Brunski's declaration, and there is not: they both clearly identify the specific disclosures in the prior art for every limitation.

SDC's argument that disputes between the testimony of Straumann's expert and SDC's expert weigh in favor of granting SDC's denial request (SDC Brief at 27–28) should be rejected. Even if there are disputes between the experts (like in virtually every other IPR), the Judges on the Board with technical expertise are best suited to make credibility determinations and findings of fact regarding these disputes. *See Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (Federal Circuit “defer[s] to the Board's findings concerning the credibility of expert witnesses.”); *In re Gartside*, 203 F.3d 1305, 1313 (Fed. Cir. 2000) (Federal Circuit reviews Board's

fact findings for substantial evidence pursuant to APA).<sup>18</sup>

### **3. The Board Is Best Suited to Review the Patentability of These New Claims That the PTO Recently Issued**

SDC's conclusory assertions that Straumann seeks to "misus[e] the Board's resources for tactical advantage" and has engaged in "gamesmanship" and "a war of attrition" by seeking to make the litigation "expensive for SDC" by filing its petitions (SDC Brief at 28–29) are incorrect and ring hollow. Straumann filed its IPR and PGR petitions and its motion to stay so that the key issue of whether SDC's claims are unpatentable can be decided more efficiently and less expensively by the Board, while the parties avoid the expense of litigating in court not only the invalidity issues in parallel but also the infringement and damages issues that will be moot if the Board finds the claims unpatentable. In other words, Straumann seeks a more efficient and less expensive resolution of its dispute with SDC, consistent with Congress's intent that PTAB proceedings are meant to be "an inexpensive substitute for district court litigation" that "allows key issues to be addressed by experts in the field." 157 Cong. Rec. at S5319 (daily ed. Sept. 6, 2011) (statement of Sen. Jon Kyl). And yet SDC has vigorously opposed both prongs of Straumann's

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<sup>18</sup> The cases cited by SDC (SDC Brief at 28) are off point because they were criminal law or tariff cases in which the jury was the finder of fact responsible for making credibility determinations, just like the Judges on the Board are in an IPR.

effort to make this dispute less expensive and more efficient—by asking the Director and the Board to deny Straumann’s petitions and by opposing Straumann’s stay motion.

Finally, SDC’s conclusory assertions that the accused NeoConvert “Pin Capture” device “replicate[s] the functionality of SDC’s patented system” and is a “knockoff” product (SDC Brief at 3, 29) are incorrect.

As explained above in Section II.B, the “Pin Capture” device has a different structure and uses a completely different release mechanism than the embodiments described in the priority applications. In particular, the “Pin Capture” device does not have a separable cap and post like the “separable fastener” of Figures 5, 6 and 34–36. Moreover, it does not have a split-post structure with an asymmetric buttress thread and deflecting legs like the temporary screw of Figure 75. Instead, the entire “Pin Capture” device can be pulled out of the abutment without being unscrewed because its threads detach from the post. Petition at 38–39.

SDC’s inventors did not invent, and did not describe in any of their applications, any temporary screw that can be pulled out of the abutment without being unscrewed because its threads detach. *Id.* To the contrary, as explained above in Section II.B, SDC went back to the PTO and filed new continuation applications to obtain the ’992 patent and the related ’781 patent in an attempt to cover the “Pin Capture” device, and then sued Straumann.

Straumann's petition explains that the new claims in the '992 patent do not comply with the written description and enablement requirements (and therefore have a later priority date and are anticipated and/or rendered obvious by the parent '354 patent) because the claims go well beyond what SDC's inventors invented and described in the priority applications. Petition at 32–43. Given the Board's expertise and efficiency, it is the forum best suited to review the patentability of these new claims that the PTO only recently issued.

### **III. CONCLUSION**

For the reasons set forth above, Straumann respectfully requests that the Director deny SDC's discretionary denial request and refer Straumann's petition to the Board.

Respectfully submitted,

/s/ Sheila Mortazavi

Sheila Mortazavi

Reg. No. 43,343

*Counsel for Petitioner Straumann USA, LLC*

## **CERTIFICATE OF COMPLIANCE**

This opposition brief complies with the word limit of 14,000 words because it has 10,985 words, excluding the parts exempted by 37 C.F.R. § 42.24(a). This opposition brief also complies with the format requirements of 37 C.F.R. § 42.6(a) and has been prepared with Microsoft Word in 14 point Times New Roman font.

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