

From: [Director Discretionary Decision](#)
To: [Mortazavi, Sheila](#); [Kelsey Nix](#); [Director Discretionary Decision](#)
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Subject: RE: IPR2025-00956 – request for confirmation that discretionary arguments raised only in POPR will not be considered, or, alternatively, for leave to submit a supplemental brief to address new discretionary arguments
Date: Thursday, September 18, 2025 7:43:31 AM

Patent Owner's arguments relating to discretionary considerations raised only in the Patent Owner Preliminary Response will not be considered for discretionary denial purposes.

From: Mortazavi, Sheila <SMortazavi@haugpartners.com>
Sent: Wednesday, September 10, 2025 12:10 PM
To: Kelsey Nix <knix@smithlaw.com>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: dan.whittle@patentleverage.com; akasneovich@kdwfirm.com; lelhamawy@kdwfirm.com; Reitboeck, Georg <GReitboeck@haugpartners.com>; Chapman, Mark A. <MChapman@haugpartners.com>; Gosselin, Christopher <CGosselin@haugpartners.com>; DeBonis, Caroline <CDeBonis@haugpartners.com>
Subject: IPR2025-00956 – request for confirmation that discretionary arguments raised only in POPR will not be considered, or, alternatively, for leave to submit a supplemental brief to address new discretionary arguments

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Dear Director Stewart,

Petitioner Straumann USA, LLC respectfully submits this short response to clarify two incorrect assertions in Patent Owner Smart Denture Conversions, LLC's email of earlier today.

First, SDC incorrectly asserts that Straumann had an opportunity to respond to SDC's belatedly-raised new section 325(d) arguments in the POPR because SDC happened to file its POPR one business day early, on a Friday evening over a holiday weekend. The Director's procedures authorized Straumann to file an opposition brief to respond to SDC's discretionary denial brief, not to respond to arguments in SDC's POPR due on the same day as Straumann's opposition. SDC is effectively treating its POPR as an unauthorized supplemental discretionary denial brief and arguing that Straumann had an obligation to respond to this new brief in one business day. A Patent Owner plainly cannot unilaterally shorten a Petitioner's response time on discretionary factors to a single business day and call that a fair opportunity for a response.

Second, SDC incorrectly asserts in its second point that Straumann's denial opposition brief "did address" the section 325(d) issues raised in SDC's POPR due on the same day. Straumann's

opposition did not address any section 325(d) arguments by SDC because SDC's denial brief (Paper 8) did not make any such arguments (see Paper 10 at 10 n.2). As a result, Straumann's section 325(d) arguments in its opposition were based on the prosecution history and explained that: (1) the Examiner overlooked that the claims do not comply with section 112(a) (*id.* at 11–13); and (2) Straumann's petition presents new, non-cumulative references that the Examiner did not consider and that are materially different than the references that the Examiner concluded in the notice of allowance were the closest prior art (*id.* at 14–20). SDC's POPR makes different section 325(d) arguments that the new references in the petition are cumulative to several other references cited in an IDS (Paper 9 at 12–26). Straumann's opposition did not address these other references because the Examiner did not discuss them. If SDC's arguments in its POPR based on these other references will be considered, Straumann respectfully requests a supplemental brief to respond to them.

Respectfully submitted,

Sheila Mortazavi
Counsel for Petitioner Straumann USA, LLC

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From: Kelsey Nix <knix@smithlaw.com>
Sent: Wednesday, September 10, 2025 9:23 AM
To: Director_Discretionary_Decision@uspto.gov
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Subject: IPR2025-00956, Patent 11,937,992 – Request for Discretionary Denial

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Dear Director Stewart,

Patent Owner writes in response to Petitioner's September 8, 2025 email (below). Patent Owner respectfully acknowledges that it included § 325(d) arguments in the POPR (Paper 9) that were better placed in its discretionary denial brief (Paper 8) and apologizes for the oversight. Patent Owner respectfully requests that the Director nevertheless consider these arguments in connection with

Patent Owner's request for discretionary denial for the following reasons:

First, Petitioner is incorrect to assert it "has never had an opportunity to respond to these § 325(d) arguments that Patent Owner raised for the first time in its POPR." Because Patent Owner's POPR was filed early (on August 29, four days before Petitioner filed its opposition brief), Petitioner did have an opportunity to respond.

Second, not only did Petitioner have the opportunity to address § 325(d) issues, but Petitioner **did address the issues**. Petitioner's opposition brief (Paper 10) argued in detail that "The Examiner Committed A Material Error and Did Not Consider New, Non-Cumulative Prior Art Presented in Straumann's Petition." IPR2025-00956, Paper 10, at 10 (discussing 35 U.S.C. § 325(d) analysis and citing *Ecto World, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 3 (Director May 19, 2025) (precedential)). Petitioner devoted **ten (10) pages to its 35 U.S.C. § 325(d) arguments** despite noting at the beginning that "SDC does not argue in its discretionary denial brief that Straumann's petition should be denied under 35 U.S.C. § 325(d)." Paper 10, at 10 n.2. Nor can Petitioner claim it had insufficient space to respond, because its opposition brief was 3,015 words below the limit.

Third, Patent Owner could have included its § 325(d) arguments in the discretionary denial brief (Paper 8) without exceeding the word limit; Patent Owner's discretionary denial brief was 7,628 words below the limit. Consideration of the § 325(d) arguments presented in the POPR therefore would not permit Patent Owner to present more arguments than it otherwise could if these arguments had been included in its discretionary denial brief. In addition, as the USPTO's FAQs (<https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>) make clear in FAQ #8, "[t]he Director will receive each petition, discretionary denial brief, opposition brief, and POPR, as well as any evidence the parties have made of record in support of their papers" and considers them all together. Therefore, **these same materials** would have been considered by the Director in making her discretionary denial decision regardless. (The USPTO website likewise makes clear in FAQ #10 that the Director is not "limited to the arguments the parties raise in their briefs," and, indeed, 35 U.S.C. § 325(d) does not condition the Director's discretion on any party's submissions.)

In view of the foregoing, Patent Owner submits that consideration of its § 325(d) arguments would not burden the Director nor prejudice the Petitioner. Patent Owner believes no supplemental briefing is necessary because Petitioner has already responded to Patent Owner's 35 U.S.C. § 325(d) arguments. However, should the Director determine Petitioner did not have a full opportunity to respond to Patent Owner's § 325(d) arguments (which Patent Owner does not concede), this could be more equitably cured by granting supplemental briefing than striking Patent Owner's arguments.

Respectfully submitted,

Kelsey I. Nix (Registration No. 33, 119)
Counsel for Patent Owner, Smart Denture Conversions, LLC

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From: Mortazavi, Sheila <SMortazavi@haugpartners.com>

Sent: Monday, September 8, 2025 1:16 PM

To: Director_Discretionary_Decision@uspto.gov

Cc: Kelsey Nix <knix@smithlaw.com>; dan.whittle@patentleverage.com; akasnevich@kdwfirm.com; lelhamawy@kdwfirm.com; Reitboeck, Georg <GReitboeck@haugpartners.com>; Chapman, Mark A. <MChapman@haugpartners.com>; Gosselin, Christopher <CGosselin@haugpartners.com>; DeBonis, Caroline <CDeBonis@haugpartners.com>

Subject: IPR2025-00956 – request for confirmation that discretionary arguments raised only in POPR will not be considered, or, alternatively, for leave to submit a supplemental brief to address new discretionary arguments

External:

Dear Director Stewart,

We represent Petitioner Straumann USA, LLC in IPR2025-00956. Patent Owner Smart Denture Conversions, LLC (“SDC”) has filed both a discretionary denial brief and a Patent Owner Preliminary Response (“POPR”) in this proceeding. IPR2025-00956, Paper Nos. 8, 9. Petitioner opposed the discretionary denial request by the Sept. 2, 2025 deadline. IPR2025-00956, Paper No. 10.

In its discretionary denial brief, SDC never addressed discretionary factors under 35 U.S.C. §325(d), and instead only argued that the petition should be discretionarily denied under 35 U.S.C. §314(a). In its POPR, however, SDC for the first time raised discretionary factors under 35 U.S.C. §325(d) and devoted 20 pages of its POPR to these discretionary factors, despite the guidance on the USPTO website that the parties should not present discretionary considerations in either the petition or the POPR, and instead should only address the merits and non-discretionary factors in the petition, POPR, and any reply or sur-reply authorized by the Board. See Paper No. 9 (arguing on pages 10-30 of the POPR, under the heading “The Board Should Deny Institution Under 35 U.S.C. § 325(d),” that the petition relies on the same or substantially the same prior art as considered during prosecution). Because of the bifurcated nature of the Interim Director Discretionary Process and corresponding

deadlines, Petitioner has never had an opportunity to respond to these §325(d) arguments that Patent Owner raised for the first time in its POPR. In its POPR, SDC even criticizes Petitioner for failing to address §325(d) discretionary factors in the petition (Paper No. 9 at 26-30), despite the USPTO's express directive that the petition itself should not address such factors.

Petitioner seeks to confirm its understanding, based on the guidance on the USPTO website as well as the now-archived FAQs regarding the Interim Director Discretionary Process, that the Board and the Director will not consider SDC's arguments relating to §325(d) discretionary considerations raised only in the POPR. In the event that Petitioner's understanding is incorrect, and such discretionary arguments are going to be considered despite being raised only in the POPR, Petitioner respectfully requests leave to file a supplemental brief on discretionary factors to respond to Patent Owner's new §325(d) arguments.

Respectfully submitted,

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Counsel for Petitioner Straumann USA, LLC

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