UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

SOLMETEX, LLC,

Plaintiff/Counter-Defendant,

v.

ASCENTCARE DENTAL PRODUCTS, INC.,

Defendant/Counter-Plaintiff.

Case No. 1:24-cv-00954-RJJ-MV

Hon. Robert J. Jonker

DECLARATION OF NATHAN P. SPORTEL IN SUPPORT OF DEFENDANT/COUNTER-PLAINTIFF'S MOTION TO STAY

I, Nathan P. Sportel, state as follows:

1. I am lead counsel for Defendant/Counterclaimant Ascentcare Dental Products, Inc. in the above-styled litigation. My testimony in this declaration is based on personal knowledge, information, and belief relating to this litigation.

2. Attached as **Exhibit A** is a true and correct copy of U.S. Patent No. 6,974,321 owned by Zyris Inc. This patent expired on March 1, 2019.

3. Attached as **Exhibit B** is a true and correct copy of U.S. Patent No. 8,911,232, parent to seven of the asserted patents.

4. Attached as **Exhibit C** is a true and correct copy of the continuity data from the United States Patent and Trademark Office Patent Center, showing all child applications to U.S. Patent No. 8,911,232.

5. Attached as **Exhibit D** is a true and correct copy of an amendment filed during prosecution of U.S. Patent No. 11,744,686 showing claim amendments made in January 2021, one month after Ascentcare announced its dental mouthpiece in December 2020. On page 2 of Ex. D, Applicant amended independent claim 1 of the patent application that became U.S. Patent No. 11,744,686 to remove the limitation "a side wall extending from the exterior edge of the anterior wall to the corresponding exterior edge of the posterior wall".

6. Attached as **Exhibit E** is a true and correct copy of a letter sent by Ascentcare's former counsel responding to Solmetex's Cease and Desist Letter.

7. Attached as **Exhibit F** is a true and correct copy of excerpts from the *Inter Partes* Review Petition filed by Ascentcare challenging the validity of U.S. Patent No. 11,589,969.

8. Attached as **Exhibit G** is a true and correct copy of excerpts from the Post-Grant Review Petition filed by Ascentcare challenging the validity of U.S. Patent No. 12,167,948.

9. To date, no depositions have occurred in the case. Ascentcare has provided initial responses to Solmetex's first requests for production and first set of interrogatories. Other than the file histories required with the infringement contentions, Solmetex has not yet provided a single document in response to Ascentcare's first requests for production.

10. I filed an IPR Petition challenging the validity of U.S. Patent No. 11,589,969 on May 20, 2025. I filed an IPR Petition challenging the validity of U.S.

Patent No. 11,589,970 on May 28, 2025. I filed an IPR Petition challenging the validity of U.S. Patent No. 11,744,686 on May 28, 2025. I filed an IPR Petition challenging the validity of U.S. Patent No. 11,826,217 on June 6, 2025. I filed an IPR Petition challenging the validity of U.S. Patent No. 12,011,329 on June 7, 2025. I filed a PGR Petition challenging the validity of U.S. Patent No. 12,167,948 on June 19, 2025. I filed an IPR Petition challenging the validity of U.S. Patent No. 12,290,418 on June 24, 2025.

11. Attached as **Exhibit H** is a true and correct copy of "PTAB Trial Statistics FY24 End of Year Outcome Roundup IPR, PGR" published by the USPTO.

12. Attached as **Exhibit I** is a true and correct copy of "PTAB Trial Statistics May 2025" published by the USPTO.

13. IPRs, though typically cheaper than litigation, are still expensive and time-consuming to prepare, requiring hundreds of hours of attorney time to address every claim of all seven patents.

14. I began searching for prior art and considering grounds for invalidity in February 2025. After searches were run and I evaluated the prior art, I began drafting IPR petitions in April 2025.

15. Attached as **Exhibit J** is a true and correct copy of an amendment filed during prosecution of U.S. Patent No. 11,589,970 showing claim amendments made in January 2021, one month after Ascentcare announced its dental mouthpiece in December 2020. On page 5 of Ex. J, Applicant amended independent claim 21 of the

patent application that became U.S. Patent No. 11,589,970 to remove the limitation "a side wall connecting the anterior wall to the posterior wall".

16. Attached as **Exhibit K** is a true and correct copy of an amendment filed during prosecution of U.S. Patent No. 11,589,969 showing claim amendments made in January 2021, one month after Ascentcare announced its dental mouthpiece in December 2020. On page 5 of Ex. K, Applicant amended independent claim 21 of the patent application that became U.S. Patent No. 11,589,969 to remove the limitation "a superior wall connecting the exterior edge of the anterior wall across a superior wall span to the corresponding exterior edge of the posterior wall on a first side, wherein at least part of the superior wall comprises a first set of perforations into the interior of the pocket, and wherein the superior wall span between the anterior wall and the posterior wall is less than a width of the anterior wall, an inferior wall connecting the exterior edge of the anterior wall across an inferior wall span to the corresponding edge of the posterior wall on a second side".

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I hereby declare under penalty of perjury that the above statements are true to the best of my knowledge. I understand that any intentional false statements may subject me to fine and/or imprisonment under the laws of the State of Michigan and the laws of the United States.

Executed the 11th day of July, 2025.

Nathan P. Sportel (P87032)