IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

SOLMETEX, LLC,

Plaintiff, No. 1:24cv954

vs.

ASCENTCARE DENTAL PRODUCTS, INC.,

Defendant.

Before:

THE HONORABLE ROBERT J. JONKER
U.S. District Judge
Grand Rapids, Michigan
Wednesday, April 16, 2025
R16 Proceedings

APPEARANCES:

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On behalf of the Plaintiff;

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On behalf of the Defendant.

REPORTED BY: MR. PAUL G. BRANDELL, CSR-4552, RPR, CRR

04/16/2025

(Proceedings, 4:00 p.m.)

THE CLERK: The United States District Court for the Western District of Michigan is now in session. The Honorable Robert J. Jonker, United States District Judge, presiding.

THE COURT: All right. Welcome everyone. We are here on the case of Solmetex against -- is it Ascentcare? Is that the right way? Ascentcare Dental Products, 1:24cv954, for a Rule 16. Let's start with appearances, please.

MR. AZZI: Good afternoon, Your Honor. Mike Azzi for Warner Norcross, and with me is Angelo Christopher of Nixon Peabody on behalf of Plaintiff Solmetex.

THE COURT: All right. Thank you.

MR. SPORTEL: Good afternoon, Your Honor. Nathan Sportel from Miller Johnson, along with Andy Portinga, and we are representing Ascentcare Dental.

THE COURT: Okay. Thank you. Well, unfortunately you responded to my notice of impending dismissal and got everybody here. So now I have a new patent case. But I don't -- I don't mean to denigrate the patent cases. They just tend to be a lot more work on the civil side than most cases in areas that somebody like me doesn't understand as much as obviously all of you do.

So let me start with something that I do understand, which is easy, and that's supplemental jurisdiction. You know,

you have got the patent cases. You have got the issues on Lanham Act in both directions. Why do any of you even want the state law claims? What do they give you that you don't already have? I'll start with Mr. Azzi or Mr. Christopher.

MR. CHRISTOPHER: I'll start for Plaintiff. Your Honor, we do agree that the claims are essentially coextensive. In other words, if there is a Lanham Act violation there is also a corresponding violation of the Michigan State law. I think the reason it's in the case is they are potentially different remedies under the Lanham Act and the state law claim that might became pertinent later in the case, and that's why we have asserted both claims, both the federal and the state claim.

THE COURT: All right. Like what kind of remedies? Usually the Lanham Act is pretty comprehensive.

MR. CHRISTOPHER: Yes. But again, we think that there may be different remedies available under state law and so that's why we pled both of them.

THE COURT: Like what concretely? What do you think you can get under the state that you couldn't get under the Lanham Act?

MR. CHRISTOPHER: Off the top of my head I am not precisely sure. I think there may be a remedy in the form of disgorgement of profits that may not be available under the Lanham Act, but that's not something we've -- that's not

1 something I am prepared to speak on today.
2 THE COURT: Okay. From your perspective at the
3 Defense table?
4 MR. PORTINGA: Attorney's fees, Your Honor.
5 THE COURT: Say it again?
6 MR. PORTINGA: Attorney's fees, Your Honor.
7 THE COURT: I see. Well, there is attorneys fees
8 under the Lanham Act, too. You are saying they are easier to
9 get under state law?
10 MR. PORTINGA: I believe the standards are different.
11 Yes.
12 THE COURT: All right. Okay. Well, I am ultimately
13 going to decline the exercise of supplemental jurisdiction over
14 both sides' state law claims. Even assuming, without knowing
15 for sure, that there might be an easier standard for attorney's
16 fees under the state remedy, even assuming, without knowing for
17 sure, that there might be a remedial option under the state
18 that you couldn't get under the Lanham Act, it seems to me that
19 this case is complicated enough with the patent claims, with
20 the Lanham Act claims, that subjecting a jury to an additional
21 ride-along state claim is really needlessly distracting. It's
22 going to be hard enough to focus the parties' briefs and
23 presentations to either the Court or the jury, I think, on the
24 federal claims alone. So I am going to decline supplemental
25 jurisdiction of the state law claims and dismiss those without

prejudice, which still leaves probably 99.5 percent of the case here. And moving to that.

MR. PORTINGA: Your Honor, may I make a statement on that?

THE COURT: Sure.

MR. PORTINGA: There may be diversity jurisdiction here as well.

THE COURT: So if there is diversity jurisdiction you are going to have to show me because nobody has done that yet. So if that happens then I am stuck with it.

MR. PORTINGA: We just don't know.

THE COURT: If you don't know, it doesn't have jurisdiction. The only way it's here now is supplemental. It's the only thing people have pleaded. There is no facts of record to support diversity. So if you are going to go there you'll have to make the showing.

MR. PORTINGA: Thank you, Your Honor.

THE COURT: On the case here, the patent case, and the Lanham Act case, from my perspective one piece of good news is, I think, for the most part the parties really have hammered out an agreed schedule and agreed protocol for their production pretty much everything except by my count, you know, two issues. An issue on whether or not the Plaintiff has a rebuttal obligation on the early contentions, and how exactly the claims will get winnowed on the Plaintiff's side and when?

First of all, are there other issues I am missing or from a scheduling point of view? Are those basically the two that the parties see?

MR. CHRISTOPHER: Your Honor, there is one other issue.

THE COURT: Okay.

MR. CHRISTOPHER: Which is we have proposed a deadline for the substantial completion of document production --

THE COURT: Okay.

MR. CHRISTOPHER: -- and fact discovery, and we think the Court should put that in the first scheduling order in this case to keep the case on track while we are perhaps waiting for a Markman order so the case will be ready for the experts and dispositive motions after the Markman hearing.

THE COURT: Thanks. I forgot that. But those three would pretty well cover from your perspective?

MR. CHRISTOPHER: Yes, Your Honor.

THE COURT: How about Defense?

MR. SPORTEL: That's right.

THE COURT: Go ahead and give me your pitch on the Plaintiff's table for those three and we'll hear from the Defense.

MR. CHRISTOPHER: Thank you, Your Honor.

So I'll start with the claim winnowing issue. Solmetex has committed to narrowing asserted claims in this

case. We have committed to narrowing asserted claims down to 32 after the parties have exchanged their infringement and invalidity contentions but before claim construction. So Your Honor is going to need to address those terms when it comes time to address claim construction. And then we have agreed to a second narrowing of the asserted claims later in the case after claim construction, and we haven't agreed yet with Defendant on the precise limits, but that's something we have agreed to address at the second scheduling conference.

Now, Ascentcare has argued that we should be limited to only 50 claims in our initial infringement contentions, and we think it's too early in the case for that. We cited some case law in the joint status report. Cases from Texas which cite a federal circuit case, In Re: Katz, which says that each claim in a patent embodies a separate property right, and so there are some due process concerns here. And the court cautioned that courts should not narrow the asserted claims too early in the process before the patentee can determine which claims implicate different infringement and invalidity issues, and so that's the problem with Ascentcare's proposal, which is at the time we would need to select 50 claims we would not have Ascentcare invalidity contentions. Our position is the appropriate time to narrow the case is after both parties present their intentions. We can determine intelligently which of the asserted claims implicate different issues, and we can

make the case more efficient.

There is one other issue with respect to claim narrowing, Your Honor, which is that there are two different product designs at issue in this case. There was a first product design. Solmetex put Acentcare on notice of infringement, and then subsequent to that Ascentcare changed the product design, and so different claims in different of the patents may implicate different products, and that's why we need the flexibility at least at the very outset of the case to assert more claims.

There is one other issue with respect to claim narrowing, which is whether the design patents should count against the limits, the 32 claim limit I mentioned for the first narrowing? From our perspective, a design patent is a different type of patent. It only has one claim. It's a set of drawings, and so we can't narrow if we start with four design patents. If you count them as four claims -- if we -- we can't narrow, unlike the utility claims where we would start, and our patents are utilities that have 142 claims, obviously we are committed to narrowing that down, but we can't narrow it down relative to design. So we think the limit should apply to the utilities.

Unless Your Honor has any questions on that I'll turn to the initial response to the invalidity contentions. This is a deadline. We are not aware of any cases in this district

that has imposed this deadline on a patentee, and we understand Ascentcare's proposal comes from the local patent rules in the Northern District of Illinois, but there are many other --

THE COURT: You know, I just changed my mind. Rather than hear you on all three, there is probably enough distinction that it makes sense to hear the other side on winnowing, and then we'll go back and pick up the next issue. So thank you.

MR. CHRISTOPHER: Sure.

THE COURT: Let's go ahead.

MR. SPORTEL: Thank you, Your Honor.

THE COURT: Is it Mr. Sportel, is that it?

MR. SPORTEL: Sportel.

THE COURT: Sportel. Thank you. Go ahead.

MR. SPORTEL: No problem.

As you said, this case is complicated enough. There is a ton of claims that are -- that could potentially be asserted, and there is 10 patents, and what Ascentcare care is going to have to do is prepare invalidity contentions for all of those claims they assert, which is a huge, massive undertaking. It involves analyzing the minor differences between each of the claim sets. It means looking at prior art for all of them, putting together combinations, charting all of them. It's a big, big undertaking, and we know we're going to get cut down quite a bit later on, so we are simply asking that

the Court set a limit now so that we don't have to chart 146 potential claims here, or even 70, which is a huge number. I mean, one of the cases that the other side cited there was an initial limiting to 40, which is actually less than we proposed. So we think it's complicated enough. We think 50 is more than enough coverage to cover both products and all of the patents that they assert. So we think 50 is a reasonable limit, especially in view of the guidance of some other adjacent jurisdictions.

THE COURT: Okay. So I'll put one other question out there for both of you to react to on the winnowing issue.

Well, no. I won't. We'll wait with that. Let's go ahead and hear each of you on the next question, the rebuttal contentions for lack of a better term. Go ahead.

MR. CHRISTOPHER: Thank you, Your Honor.

So with respect to the response to the invalidity contentions that Ascentcare has proposed, we are not aware of any cases in the district that have imposed that requirement. Again, we understand their proposal is coming from the Northern District of Illinois rules. There are many other jurisdictions with local patent rules that don't have this requirement, and I think that makes sense, because if you look at what the proposal would require from us, it requires us to admit or deny for all of the limitations and all of the prior art that they chart, whether that limitation is present in the prior art, and

if we deny it we have to explain why. And so if you think it it's effectively the same as if they have served hundreds if not thousands of requests for admissions, and it's even more burdensome for that because not only do we have to admit or deny we have to explain the basis. I think that's inconsistent in a sense with the statutory presumption of validity, the fact that they have to meet their burden by clear and convincing federal district case law that says a patentee need not be rebuttal evidence, yet this proposal would force us into this binary question of admit or deny for everything.

Ascentcare has also argued that it would be fair to require Solmetex to respond to the invalidity contentions because they have agreed to respond to our infringement contentions, but there really isn't a symmetry there, and the prior dealings of the parties I think illustrate that, because again, Solmetex put -- and this is in our complaint. This is Exhibit J to our amended complaint. You can see the letter. We put them on notice of these patents almost two years ago. They responded with noninfringement arguments. And so we think they know what their noninfringement arguments are, and in fact, in the initial disclosures that Ascentcare served after the joint status report they referred to an opinion of counsel letter, and so we think they know what their noninfringement arguments are.

By contrast, we don't know what our response to the

1 invalidity contentions are because we haven't seen them and we
2 would only have a month to do this detailed response with the
3 admissions and denials, whereas Ascentcare has had almost a
4 two-year head start on developing its noninfringement
5 positions. And so for all these reasons we don't think that
6 the response to invalidity contentions would be appropriate for
7 this case.
8 THE COURT: All right. Go ahead.
9 MR. SPORTEL: Thank you, Your Honor.
10 Yeah. We view this as just a narrowing of the issues,
11 right? So the -- there is entirely a realm of possibility
12 where one of Solmetex's validity positions takes an implied
13 claim construction position, and before we have to propose
14 terms, we have to kind of understand what they are trying to
15 propose perhaps from a claim construction position. So we
16 think it's only right that we should know what their position
17 is in regard to our invalidity contentions and why they think
18 that their claims remain valid in view of that prior art and
19 those prior art combinations.
20 We also -- they mentioned the letter that they gave us
21 almost over -- almost two years ago I should say. However,
22 they have cited new patents. The new patents have come out
23 since that letter was issued, and we have a new product.
24 Ascentcare has never seen any claim charting or any reason why
25 our new product infringes any of the patents that they have

1 cited. So we are kind of in the dark here about how this
2 product that we designed in a new way infringes their patents.
3 So -- and they are mentioning amount of time. We are
4 happy to rediscuss and give them more time to respond to our
5 invalidity contentions if that's what they want. That never
6 came up as a problem during the 26(f) process, but if that's
7 the key issue here we are willing to discuss that.
8 THE COURT: All right. On this issue I do have a
9 couple follow-up questions for both of you to respond to. So I
10 don't think it's controlling whether or not any court in the
11 Western District of Michigan has used the Northern District of
12 Illinois local rules or not, but in fact, I have. And so if
13 you go back to a case that still gives me nightmares, Striker
14 against Zimmer, we did include it in the first case management
15 order. That's case 1:10cv1223, ECF 25 at page ID 333. And I
16 think that page ID is to the Rule 16 transcript.
17 So we included it wasn't exactly the version of the
18 local rules that are currently in effect. It was an earlier
19 iteration I think, but we included it because both sides
20 shrugged and said, it's good by us. We want it. So that was a
21 complicated case. It didn't have as many potential claims if
22 we are talking about 143 at the Plaintiff's table, at least as
23 I recall. We certainly didn't go to trial on that many. But
24 from a practical standpoint at both tables, why isn't it good
25 for both of you at some point in the process to get an initial

1 reaction at least to the other side's either infringement or
2 invalidity contentions? So that's one caveat. I have used it.
3 I haven't used it exclusively, and it wasn't really contested
4 in the case where I did use it.
5 Second and related on the timing issue, I can see why
6 you might want to push it back, both sides frankly, but
7 certainly the Plaintiff, but what if you pushed back a response
8 date to, you know, later in the case, like, after you get your
9 election of claims for the Markman toward the end of September,
10 and then you update the charts at that point so you know going
11 in at least by the time you get through Markman you've got some
12 hint or by that time you have already learned from each other
13 and other sources all you need to know? So I'll give
14 Mr. Christopher a chance to go first on that.
15 MR. CHRISTOPHER: Thank you, Your Honor.
16 I do think that pushing the deadline back later in the
17 case would alleviate some of our concerns with this deadline.
18 I think our other concern is really tied to this admit or deny,
19 this binary proposition in it. If the purpose is for us to
20 disclose the factual basis for our validity rebuttal, in other
21 words, to preview what our expert would say in his validity
22 rebuttal report, which limitations he is going to say are not
23 present in the prior art, which secondary considerations are
24 nonobviousness he is going to address in his report akin to an
25 interrogatory, that level of detail, I think we would have less

of a problem with it. It's this idea of forcing us to admit that something is in the prior art that in our view is inconsistent with the statutory presumption of validity on the appropriate burdens here. And so I think to answer your question, if we pushed it back till after claim construction, and it were designed in a way in which we merely had to disclose the rebuttal positions that we would give without having to admit to things, I think that that's something that would be far more acceptable to Solmetex.

THE COURT: All right. So let me follow up that last point. And I don't think I raised this specifically, but at least the current version of the local rule in the Northern Illinois doesn't require exactly the phrasing that has been proposed at the Defense table. It does say, if I am reading it right, with respect to invalidity issues the initial response shall contain a chart responsive to that earlier chart, states as to each identified element in each asserted claim, to the extent then known whether the party admits to the identity of elements in the prior art and if not the reason for such denial. Is that more in the nature of what you were thinking or is your thinking something even softer than that?

MR. CHRISTOPHER: Slightly softer than that, which is that rather than admitting we would simply indicate for the limitations we intend to dispute that this is the limitation we intend to dispute.

THE COURT: Okay.

MR. CHRISTOPHER: It's that admission aspect of it that we find objectionable.

THE COURT: Okay. Do you have a response?

MR. SPORTEL: Yeah. My main objection is the proposed timing that you mentioned. I think you said something about putting it after Markman.

THE COURT: No. Like September 30, which would be after you have selected your claim -- the terms for construction but before the Markman process is resolved.

MR. SPORTEL: Sure. So still, that's kind of my point. I am sort of lumping that whole process in Markman and I apologize.

I am talking about the initial proposal of claim terms. Some of those terms that we end up proposing may depend on some of what I call implied constructions that the other side may be taking in order to preserve validity of some of their claims. It may or may not occur, but the point is, it would be -- it would be in our best interest to know what their validity positions would be in response to our invalidity positions before we started proposing claims for claim construction. So if we wanted to move that back I would propose we move all of the Markman exchange leading up to it, including the initial proposal and everything basically after September 5 in our proposed schedule back in response to

whatever the change in the deadline for response to invalidity contentions may become.

THE COURT: All right. Let's go onto the third issue, which is the substantial completion deadline.

MR. CHRISTOPHER: Yes, Your Honor.

So what we have proposed in our schedule is that the Court set a deadline for the substantial completion of document production and to exchange privilege logs and to disclose reliance on opinion of counsel defense, and that would be December 3rd, 2025, which is approximately seven and-a-half months from today, and then to also set a deadline for the close of fact discovery. We have proposed January 31st, 2026, which is approximately nine and-a-half months from today. That appears to be in line with prior schedules entered by the Court. And the reason we think it would be appropriate to add those to the schedule is just to keep the case on track, because we are going to have a second scheduling conference to determine the deadlines for experts and dispositive motions and trial after the Markman order, but while the parties are waiting on the Markman order, the claim construction order, it would make sense that they continue through fact discovery, finish that up, and so when we have the second scheduling conference the case is ready to proceed and move forward.

THE COURT: Okay. Thanks.

MR. SPORTEL: Yeah. Our position is pretty simple.

It's just that the Markman ruling may not be available before the date that they propose. So then we are talking about perhaps having to open back up fact discovery to discover new things in view of the Markman ruling. The Markman ruling may change some of the positions that the parties have taken. So we think that just everything after Markman should be dependent on the date that that ruling is issued.

THE COURT: All right. Thank you, both.

Let me look at Exhibit A with you, which is your agreed dates or a couple of those that you don't agree on. But at least as I am looking at the chart, with the exception of what we just talked about, the no event versus August 15 issue, and then the items you just described on substantial completion or close of fact discovery, I am reading all these dates and I think you are agreeing on all of them, is that right?

MR. CHRISTOPHER: That's correct, Your Honor.

MR. SPORTEL: Correct.

THE COURT: Okay. And so the second thing I think I am understanding you are agreeing on is the some modified limits, but not many really, 30 requests for admission, 30 interrogatories, 10 deps per side, basically the standard limits on depositions if I am reading it right. Am I right on that, too?

MR. CHRISTOPHER: Correct, Your Honor.

MR. SPORTEL: That's correct.

THE COURT: Okay. And then you have even gone so far as to specify with some clarity what you expect in terms of form of document production, and that's helpful, but is there anything we need to talk about on that?

MR. CHRISTOPHER: Nothing from Solmetex.

MR. SPORTEL: Not at this time.

THE COURT: Okay. You going to give patent lawyers everywhere a bad name because you are supposed to disagree on everything, aren't you?

All right. Before we make some rulings on the scheduling, are there other things that would be helpful for me to know about the case before we move on? I have read -- I haven't read everything in the case yet, I certainly haven't read all the patents, and you know, try to get a little sense of things. The background from each side's perspective you have touched on a little bit, but why don't I give each of you a chance to give me a 30,000 foot view of where you see the case going, and that might help as well as I make some final calls.

MR. CHRISTOPHER: Sure. Thank you, Your Honor.

So I'll just give you a very brief overview of the case. A lot of this is in the papers so you have seen it. The case is about these dental isolation mouth pieces. You have seen some pictures of them. They are a little bit hard to describe, but they kind of curl up. They go in your mouth.

1 You bite it. They do the little suction thing that you have in
2 the dentist office, and so it assists the dentist.
3 So Solmetex sells a dental isolation system called
4 DryShield. There are mouth pieces for it. Ascentcare also
5 sells a dental isolation system under the name VacuLUX. They
6 have mouth pieces -- dental isolation system under the name
7 VacuLUX. VacuLUX. And so Ascentcare has been advertising its
8 mouth pieces as compatible with the DryShield Solmetex system.
9 Obviously, we believe they infringed the patents. We believe
10 there is some false advertising here.
11 Thankfully we have largely agreed with Ascentcare on
12 the procedure for this case. We are going to exchange our
13 infringement contentions in the coming months, the invalidity
14 contentions. We're hopeful that will then narrow down the
15 case. We have had settlement discussions with Ascentcare both
16 with prior counsel and current counsel. We continue to be open
17 to have those discussions. And I think I would leave it at
18 that at this point, Your Honor.
19 THE COURT: Tell me a little bit more about Solmetex
20 generally. I'm sure you do more than just make this particular
21 mouth insert. What kind of business is it? What markets do
22 you serve?
23 MR. CHRISTOPHER: It's dental supply, Your Honor, so
24 there is a number of different products that Solmetex provides.
25 They provide a water treatment solution for dentists office to

clean out some of the lines, the suction lines in the office that are very important. They provide a different product line.

There is this filtration system that dentists are actually required to have under the EPA rules to filter out mercury from the waste water, because there is actually mercury in a lot of people's fillings still even to this day, and so the EPA requires you to filter it out. So another area that Solmetex is in is that it sells these systems that can filter out the mercury. It goes into a cartridge. It gets disposed in an appropriate facility.

So there are a number of different dental products that they sell both in filtration, water treatment, water testing. There is this line of business, which is the dental isolation mouth pieces, which help the practitioners perform their procedures. There is a number of different products but those are the ones that come to mind, Your Honor.

THE COURT: So near a hundred percent, maybe a hundred percent of the business is focused on dentists and supplying dentists?

MR. CHRISTOPHER: I believe that is the case, Your Honor.

THE COURT: Okay. Any other patented products besides these in the portfolio or is this the patented part of the supply chain for your --

MR. CHRISTOPHER: Solmetex does have patents on its other products. The one that comes to mind is on the filtration system I described because there was another patent litigation matter involving Solmetex and that patent, which I was involved in, so I could tell you about that one because I know that one.

THE COURT: Yeah. Please don't, but thank you.

MR. CHRISTOPHER: Fair enough, Your Honor.

THE COURT: All right. Thank you.

Let me go over to Defense, same kind of 30,000 foot view, and also a little bit more about Ascentcare if you would.

MR. SPORTEL: Sure. Yeah. I can start with a little bit more about Ascentcare if that's all right with you, Your Honor.

THE COURT: Sure.

MR. SPORTEL: So Ascentcare started in 2020 or 2019 I think, where the CEO and head inventor, Austin Ritter, just happened to live next to a dentist multiple times in his life, and he would talk to them in their front yard, and they would share stories, and he would kind of hear complaints that these dentists would have. And he started thinking, well, shoot, I feel like I could fix some of those problems, even though he was not known as an inventor before. I think he owned a payroll company or something like that before.

And so he came up with this, which was to solve one of

the issues, was that a lot of the suction connectors -- which you have probably seen one of these before in the dentist's office, right? And that was fully HVE, where the whole pipe got all the way down wide enough to be fully HVE. These sold like hot cakes because COVID happened, right? And HVE was the hot hot thing when COVID hit because everybody was worried about aerosol reduction, right? Airborne viruses in the air was the big scary topic back then. Nobody knew how much COVID was spreading in the air. We were all terrified of it.

I mean, you might remember all the different machines the dentist office had to try and protect patients and their staff. In fact, I think there is some article out there that said a dentist's office was the number one place in terms of danger you could be in from the COVID standpoint because people's mouths were open the whole time and you are spraying water everywhere, which creates even more aerosols.

So he created this and it started selling really well. And his customers said, well, we don't have -- do you have a mouth piece for it? And he says, no, we don't have it. And then he started recommending various options for who they could buy from, which included DryShield and some of the others in the art. But eventually he said, why am I not making my own? So they made this.

The way that this works is you put it in your mouth sideways, right? So the suction connector comes in over here,

and you bite down on this bite block part, and then this middle part isolates the tongue so that the area that you work on over here is clean, and then this would be a cheek retractor that holds back the tissue. This was the original design, and I have the DryShield designs, too. If you'd like to see these I'm happy to bring them up.

MR. PORTINGA: They have not been in anyone's mouth.

MR. SPORTEL: Yes. No. I promise.

And then eventually it was recreated to have a better performing device that is also here.

So that's sort of the history of Ascentcare. They make a lot of products. It's not just mouth pieces. They also make mirrors and all sorts of other tools for dentists to use. It's almost all of the customers are dentists directly.

And then as for the case, you know, we received a letter back in -- I'm sorry. Did you have a question?

THE COURT: Go ahead.

MR. SPORTEL: Okay. I'm sorry. We received their letter back in 2023. We were quite certain that we didn't infringe, and so we continued to do business. We didn't hear back for a while, and eventually it has recropped up. There was some new patents being asserted. And that's where the suit is at.

In terms of our position, we think that what they are doing is continually expanding the scope of something that was

1 relatively narrow to begin with in an attempt to read on some
2 of our products. And so noninfringement, invalidity, all of
3 those things will be an issue dramatically changing the claim
4 scope during prosecution. May involve some other issues like
5 latches and whatnot. So all sorts of defenses.
6 THE COURT: All right. A couple questions following
7 up. With respect to whatever device accomplishes the function
8 that's at issue here, I heard Defense counsel refer to, you
9 know, other options that they looked at, you know, when they
10 were just in the early stages and the neighbor was talking to
11 the dentist about ideas. How many other options are there?
12 There is -- what percent of the market do the two of you
13 control together, if you know? Are there a host of other
14 market opportunities out there?
15 MR. CHRISTOPHER: So Your Honor, I, off the top of my
16 head, do not know the relative market shares. There is one
17 other player in the space for the mouth piece. It's called
18 Isolite, I-s-o-l-i-t-e. I think if you look at some of the
19 comparative advertising that's at issue in our false
20 advertising claims, you can see they are part of that. So you
21 can see the different players in the market through those
22 advertisings that we identified.
23 THE COURT: All right. And if you know, does Isolite
24 have patents on their mouth piece products?
25 MR. CHRISTOPHER: I believe I may have seen some cited

on the face of the Solmetex's patents, meaning that they were considered during prosecution of the Solmetex's patents. I am not familiar, though, with the details.

THE COURT: All right. Do you know -- well, you would know. Does your client have patents on your mouth piece products?

MR. SPORTEL: Yes. We do. And I just want to quick answer, there is at least three other players. One is the Isolate products. There are lots of patents on that, most of which are expired at this point because it was around 2003 or 2001 that those were introduced.

And there is two others. One is called Mr. Thirsty, and the other one is called The Releaf. Leaf, l-e-a-f. So those are just a few of the other options. And in terms of patents we have, yes, we have patents on our mouth pieces and several of our other products.

THE COURT: Okay. You are not asserting any of those in this case?

MR. SPORTEL: We are not.

THE COURT: Okay. Last sort of preliminary question. Sometimes the parties anticipate some kind of further action at the patent office, either patents that are in process and coming or maybe an IPR here on these issues. Is any of that going on here or are we forging ahead with the case and this is where it's going to happen or don't we know yet?

MR. CHRISTOPHER: So Your Honor, there are pending continuations off of this family. I think at this time we are not anticipating asserting a new patent. I think if we did decide to assert a newly issued patent it would be in response to some arguments that Ascentcare made. And I think to Your Honor's point about this being a very complex case, I think we would think very hard about whether we would drop another patent if we were to add a new one to the case before we do that.

THE COURT: Okay.

MR. SPORTEL: Yes. Ascentcare is preparing and has grounds to pursue IPR's on the six utility patents.

THE COURT: On the utility patents?

MR. SPORTEL: That's right.

THE COURT: Okay. If and when those get filed, do the parties have a position on what they want to have happen in this case, if anything?

MR. CHRISTOPHER: So Your Honor, I don't want to presume too much, but I assume that Ascentcare, if they do file them, will ask the Court for a stay. I think a stay would be premature at least until an institution decision, which would be at least six months out. So if they file these IPRs tomorrow it will be at least six months until we got that decision, which would push us until I believe after claim construction. So we would oppose a stay certainly before

1 institution, and I suspect we would after institution, but it's
2 something we'd have to take a look at based on the facts.
3 MR. SPORTEL: Yeah. We would pursue a stay as early
4 as possible.
5 THE COURT: So I have granted a stay sometimes. I
6 haven't other times. I think -- I am going back to check, but
7 I think this is the first time I've had Lanham Act claims that
8 both sides are asserting in the case against each other, and
9 that's a little different. I mean, you don't really need to
10 know anything from the patent office to assert those, do you?
11 MR. CHRISTOPHER: I think that's correct, Your Honor.
12 And there is also four design patents that are asserted in this
13 case, which as I understand it wouldn't be implicated by the
14 IPRs.
15 THE COURT: Okay.
16 MR. CHRISTOPHER: And so I think we could forge ahead
17 with discovery. That's all the same products that we would
18 need whether the utilities are in the case or not in the case.
19 I am not sure there's any efficiencies to be gained certainly
20 before institution.
21 THE COURT: And we are not going to decide a
22 hypothetical stay issue now, but I am just trying to get a
23 sense from your perspective. I mean, what about the Lanham Act
24 claims that are going on or for that matter the design patents?
25 MR. SPORTEL: That's right. The Lanham Acts are

unrelated to the technology of the patented -- the patents at issue. The issue would be whether or not some of the more major discovery milestones that we are talking about here, like invalidity contentions, Markman, all those things need to happen until the patent office has had their bite at the apple first.

THE COURT: Okay. Anything else from either side before we make some decisions?

MR. CHRISTOPHER: Nothing further from Solmetex. Thank you, Your Honor.

MR. SPORTEL: Nothing further, Your Honor.

THE COURT: Okay. Well, the easy things are simply to adopt the schedule that you all agree on. I thank you for that. I think -- honestly, I think it's a little ambitious given the scope of the case, but I am not going to get in the way of what you all have agreed on at this stage anyway.

I am also happy to adopt what you've already incorporated in the joint status report for format of production, the limits on discovery for this case, and I won't reproduce them in the case management order. We'll simply reference what you have already agreed on here.

On the issues that you do disagree on, let me start with the substantial completion deadlines that are proposed by Solmetex and opposed by Ascentcare, being December 3, 2025 for substantial completion of document production and some related

1 things and January 31 next year for close of fact discovery. I
2 am going to include those in the first case management order.
3 It's certainly true that sometimes Markman opinions
4 take longer than either party or the Court expects, but the
5 deadlines do a number of things. They keep shape to the case
6 overall. They give me at least targets if not deadlines for
7 getting my own Markman decisions out. And frankly, given the
8 way these things move and develop, particularly with the
9 prospect of IPR and request for stay, there is a lot of
10 ambiguity and uncertainty in the case and at least getting
11 initial shape around some basis deadlines like that I think is
12 important and useful. So I will go with the Plaintiff's
13 position on that and include those dates in the first case
14 management order.
15 With respect to winnowing, let's go to that next.
16 It's certainly helpful to have winnowing down to the 32 claims
17 whether that includes the design patent claims or not, and I
18 recognize the parties are still working on a later winnowing,
19 which I'm sure will be essential, but it's a little early in
20 the case to figure out how to do that and perhaps even can't do
21 it effectively before claims construction. We'll see. But 143
22 claims at the outset is still a lot, and I do think, you know,
23 giving the Plaintiff some flexibility is important, but I don't
24 see why the Plaintiff's own reluctant limit of 70 is
25 unreasonable. Whether it's 50, whether it's 70, either one of

1 those is a heck of a lot better than 143, and I don't think 70
2 is unreasonable when we are talking about at least a couple
3 different products, one product developed at least partially in
4 response, at least arguably, to an early notice letter, and so
5 I am going to go with 70 claims for the initial infringement
6 contentions.
7 I think that -- oh, and the design patents. I mean, I
8 think each of those count for one claim, but I am not -- I am
9 not sure what your dispute was on that. You said you don't
10 want them to count toward any limit. So 32 plus the four
11 design patents or is what -- that's what you are going to do
12 down the road, but right now you'd want 70 claims?
13 MR. CHRISTOPHER: For the utility patents.
14 THE COURT: For just the utility patents?
15 MR. CHRISTOPHER: Correct, Your Honor.
16 THE COURT: I am fine with that. Design patents are
17 different enough that the 70 would be for the utility patents.
18 With respect to whether to include an obligation on
19 the Plaintiff's part to respond to the invalidity contentions,
20 at least in the current form I am not going to include that for
21 a number of reasons. One, I do think it would be early in the
22 case, too early in the case to be meaningful. And second, I do
23 think that for both sides to get into rebuttals, although
24 Defense is willing to do it, before the initial winnowing, is a
25 little bit unnecessary, but I certainly think it makes sense to

1 you know, push that downstream. But I am not even going to
2 assert -- include a downstream date for that right now because
3 I do think that -- I do think that there is enough going on in
4 the case that at least getting basic infringement and basic
5 invalidity contentions out there will tee things up. If we
6 start to get, you know, into rebuttals and into particular
7 admissions early on, I think what we're going to wind up doing
8 is complicating the early disclosures which are meant to be
9 illuminating, and I think that each side will still have plenty
10 of protection downstream as we get into picking the claims for
11 the Markman hearing and ultimately after the Markman hearing.
12 So I don't think there is any reason that I can see to go with
13 the Northern District of Illinois rule at all here, and
14 certainly not in the particular form that as I would say
15 somewhat amped up what the rule would require and what the
16 Defense is seeking.
17 So for my purposes we'll stick with just the round of
18 infringement contentions from the Plaintiff and the response
19 and then the invalidity contentions from the Defense.
20 I also think another factor, although it's not
21 determinative, but when you are putting feathers on each side
22 of the scale, if there really is going to be an IPR process, I
23 think it's better to let that play out, and I can -- whether we
24 let it play out with a stay or not, I don't mean that. What I
25 mean is before putting the Plaintiff in the position of having

to commit on all of the invalidity issues I think we should wait and see what happens on the IPR up front if something gets filed or not.

So if the parties later on decide amongst themselves there's value to getting more information at both tables to limit, you can do that, but in this case management order I am not going to include it.

The other thing I am going to do in the case management order is ask that Ms. Carpenter put a second Rule 16 on the calendar some time for February of 2026, where we'll talk about some of the other downstream dates, experts and the like. In light of where the case stands at that point, I think we'll be in much better position to address that downstream than we are right now.

I know the parties have -- well, anything else on scheduling at this point?

MR. CHRISTOPHER: Nothing else from Solmetex, Your Honor.

MR. SPORTEL: No. Nothing else.

THE COURT: On ADR, both sides have suggested, you know, maybe there is some value to whether it's private mediation I think is the way the Plaintiffs described it. Our local facilitation process is the way the Defense does it. Tell me a little bit more about that and whether you think we ought to do that now or is that something that we have to wait

on until we get deeper into the case? Is that something we discuss and set up at the second Rule 16, or do you want to do something now?

MR. CHRISTOPHER: So from Solmetex's perspective, Your Honor, we are certainly willing to have that discussion early. We are certainly willing to put it off. We had made an offer to Ascentcare. It was rejected. We haven't heard anything since, and so we are not really sure where Ascentcare stands on the settlement front, so I think unless we hear from Ascentcare I am not sure there is going to be much value in doing it in the near term.

THE COURT: All right. What's the position at the Defense table?

MR. SPORTEL: Yeah. We've also made an offer to settle that was also rejected. That was back in '24. So there is potentially some value, but you know, I don't think either party is particularly close at the moment.

THE COURT: All right. From the Plaintiff's perspective, so I am looking at paragraph 10 of the joint status report, Solmetex is open to a private mediation. Is that intended to mean something other than the local facilitative mediation?

MR. CHRISTOPHER: Your Honor, I think -- we are certainly willing to look at the list for the local facilitation, but I think we want to keep our options open to

1 potentially cast a wider net for a mediator. We are certainly
2 willing to look at the list with Ascentcare and see if we can
3 find a mutually agreeable person on the list, but at the same
4 time, we suggested private mediation might let the parties cast
5 a wider net, maybe make it a little bit easier to find a
6 mutually agreeable mediator. That was our thinking on that
7 proposal.
8 THE COURT: Where are you on that at the Defense
9 table, Mr. Sportel?
10 MR. SPORTEL: Our position is that there is very
11 qualified candidates here, and I believe it's a preferred list
12 that's put out by this Court. So that's the list we were going
13 off of.
14 THE COURT: All right. Why don't we do this. I'll
15 ask you to, you know, consult with each other and your clients,
16 and certainly at Plaintiff's table there can be an evaluation
17 of whether you see somebody on the list or not. If you don't,
18 you can propose somebody off the list and the Defense table can
19 think about that and then simply update the Court with your
20 position, whatever it is. We don't want to do it now. We want
21 to do it through facilitation. And we are open to timing. You
22 know, whatever it is, just give me an update, and let's say put
23 that on the calendar for how about May 31, the end of the month
24 of May, is that okay?
25 MR. SPORTEL: May 31?

THE COURT: Yeah. I don't know if that's a day of the week or if that's -- that's a Saturday. Why don't we do May 30th, and then I'll make a call based on what I see.

I think from my perspective that's all I had, but let me just double-check my notes. Oh, two other things.

So on page 5 of your joint status report, paragraph 6 where you look ahead to the 26(a)(3) disclosures, too early to deal with anything like that, but I will say to both parties, I will push you hard not to have deposition transcripts read as part of trial. So when we get to that we'll fight about that, but I did read it and wanted to highlight it.

And then the only other thing is I know you have tendered a protective order. I haven't really gone through it with care yet, so I will and will let you know if I have any problem with it, but hopefully not.

Is there anything either side, you know, wants to present or needs to present on that before I review it?

MR. CHRISTOPHER: Nothing further from Solmetex.

MR. SPORTEL: Nothing, Your Honor.

THE COURT: Okay. So that really is the end of my list. Anything else from Plaintiff?

MR. CHRISTOPHER: Nothing further. Thank you, Your Honor.

THE COURT: Defendant?

MR. SPORTEL: Nothing. Thank you.

THE COURT: Okay. Thank you.

I have a dentist appointment in a few weeks. I think it's going to have a whole new level of interest for me. Hopefully they won't put one of these things in my mouth from either side.

THE CLERK: Court is adjourned.

(Proceeding concluded, 4:49 p.m.)

REPORTER'S CERTIFICATE

I, Paul G. Brandell, Official Court Reporter for the United States District Court for the Western District of Michigan, appointed pursuant to the provisions of Title 28, United States Code, Section 753, do hereby certify that the foregoing is a full, true and correct transcript of the proceedings had in the within entitled and numbered cause on the date hereinbefore set forth; and I do further certify that the foregoing transcript has been prepared by me or under my direction.

/s/ Paul G. Brandell

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