

From: [Trials](#)
To: [Ryan Iwahashi](#); [Trials](#)
Cc: [Andrew Gish](#); [Hayes, Jennifer](#); [Burnham, Daniel](#); [Strong, Allison](#); [Edward Tulin](#); [Christopher, Angelo](#)
Subject: RE: PGR2023-00055 - Leave to file Reply to Preliminary Response
Date: Wednesday, February 28, 2024 5:53:00 AM

Counsel,

From the Board –

Given the unexplained delay in seeking leave to reply to the Preliminary Response filed January 3, 2024, Petitioner's request is denied. *See* 37 C.F.R. § 42.25(b).

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Ryan Iwahashi <ryan@gishpllc.com>
Sent: Tuesday, February 27, 2024 11:35 AM
To: Trials <Trials@USPTO.GOV>
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Subject: PGR2023-00055 - Leave to file Reply to Preliminary Response

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Dear Administrative Law Judges,

Pursuant § 42.108(c), Petitioner Dental Recycling North America, Inc. ("Petitioner") seeks leave to file a short 8-page reply to Patent Owner Solmetex, LLC's ("Patent Owner") Preliminary Response ("POPR"), filed January 3, 2024. Good cause exists because Petitioner's reply would be limited to three issues that could not have reasonably been foreseen.

First, in its POPR, Patent Owner misstated the law for incorporation by reference, which requires: "To incorporate material by reference, the host document must identify [1] with detailed particularity what specific material it incorporates and [2] clearly indicate where that material is found in the various documents." *Advanced Display Sys., Inc. v. Kent State University*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). Patent Owner did not apply this standard. Instead, Patent Owner argued that the earlier applications were incorporated based upon a generic catchall statement that says "[a]ll publications, web-sites, patents and patent applications cited in the specification are hereby incorporated by reference in their entirety **for the disclosure for which they are cited.**" But the earlier applications were not

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Ex. 3001

cited for any disclosure and, therefore, this language fails to meet either prong of the standard. Petitioner could not have anticipated that Patent Owner would fail to apply this test. Good cause therefore exists so Petitioner can apply the correct standard.

Second, Patent Owner claims to have altered the priority date of the challenged patent by amending its still-pending parent application to purportedly supply missing disclosure ***almost two months after*** Petitioner filed its petition. Good cause exists because this is based upon a development ***after the filing of the petition***, and Petitioner seeks leave to address the alleged impact of this development.

Third, Patent Owner misleadingly truncated quotations to Petitioner's counterclaims at the district court to argue that Petitioner has taken inconsistent positions. Good cause exists because Petitioner could not have reasonably anticipated that Patent Owner would misquote Petitioner's positions. Petitioner seeks leave to correct the implication that its positions are inconsistent.

Patent Owner's Position

Patent Owner opposes Petitioner's request. Petitioner unduly delayed seeking leave to file a reply until more than 7 weeks after the PPOR was filed. 37 C.F.R. § 42.25(b) ("Delay in seeking relief may justify a denial of relief sought"). Petitioner's argumentative request is improper and does not demonstrate "good cause." Patent Owner briefly responds to Petitioner's positions below:

1. Petitioner identifies no "misstate[ment]" of law. The PPOR cited the same case cited by Petitioner. PPOR at 59. Petitioner merely disagrees that the '175 patent's parent application incorporates by reference the material Petitioner argued was missing. Petitioner's failure to address this issue in the Petition does not warrant a reply. Additionally, Petitioner's expert apparently relied on the incorporation by reference statement in the '175 patent (PPOR at 60; Ex. 1003, ¶ 57), so Petitioner cannot be surprised by the PPOR's reliance on the same statement.
2. Patent Owner is not claiming "to have altered the priority date" of the '175 patent. The PPOR explains that the parent application's drawings were amended in response to an Office Action mailed September 13, 2023 (before the Petition was filed) to include material that was previously incorporated by reference.
3. The PPOR did not "misquote" Petitioner's counterclaims, which were submitted as Ex. 2010. While Petitioner's anticipation position in this PGR and its non-infringement position in the district court are inconsistent, the PPOR does not ask the Board to deny institution on that basis. Thus, a reply on this issue is unwarranted.

Should the Board grant Petitioner's request, Patent Owner requests authorization to file an equal-length sur-reply limited to the same issues within 10 days of Petitioner's reply. Good cause exists for a sur-reply because Petitioner's reply mischaracterizes the PPOR and the facts, as exemplified above. Petitioner does not oppose this request for a sur-reply.

The parties are generally available February 27, 2024 through March 5 for a telephonic hearing.

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