

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3D DIAGNOSTIX, INC.,
Petitioner,

v.

WATSON GUIDE IP LLC,
Patent Owner.

Case PGR2024-00040
U.S. Patent No. 11,806,209

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

PETITIONER'S EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 11,806,209
1002	File History of U.S. Patent No. 11,806,209
1003	Declaration of Douglas Erickson, DDS, MS
1004	Curriculum Vitae of Douglas Erickson, DDS, MS
1005	Provisional Patent Application No. 62/508,377
1006	U.S. Patent Application Publication No. 2017/0252126 to Llop ("Llop126")
1007	<i>Watson Guide IP, LLC v. 3D Diagnostix, Inc.</i> , Case No. 1:24-10518-LTS, Dkt. No. 30 (D. Mass. July 8, 2024)
1008	China Patent Application Publication No. CN 105686886A to Sichuan University ("Sichuan")
1009	Certified translation of Sichuan
1010	U.S. Patent Application Publication No. 2017/0265963 to Yau ("Yau")
1011	U.S. Patent No. 9,504,533 to Groscurth ("Groscurth")
1012	Scherer, "Clinical Demonstration: All-on-4 nSequence Guided Prosthetics Surgical Technique with Zest Anchors Chairside Attachment Processing Material", https://www.youtube.com/watch?v=VOWRdFpfngI , posted October 23, 2015 (accessed May 21, 2024) ("Scherer") (Part 1)
1013	Scherer, "Clinical Demonstration: All-on-4 nSequence Guided Prosthetics Surgical Technique with Zest Anchors Chairside Attachment Processing Material", https://www.youtube.com/watch?v=VOWRdFpfngI , posted October 23, 2015 (accessed May 21, 2024) ("Scherer") (Part 2)

Exhibit	Description
1014	File History of U.S. Patent No. 11,173,016 (excerpts)
1015	Declaration of Kathryn Talbot
1016	Internet Archive, http://nsequence.com , archived February 7, 2016 (accessed May 21, 2024)
1017	“Fundamentals of CHROME GuidedSmile”, downloaded from https://guidedsmile.com/get-your-introduction-to-chrome-guidedsmile-ebook-today/ on June 20, 2024
1018	Internet Archive, http://www.nsequence.com/2013/11/08/all-on-x-cases-immediate-provisionalization , archived March 10, 2016 (accessed June 28, 2024)
1019	Webpage printout: All-on-4® nSequence® Implant Surgical Technique Using Zest Chairside® Attachment Processing Material – YouTube, https://www.youtube.com/watch?v=VOWRdFpfGI , (accessed June 24, 2024)
1020	Webpage printout: “Why You Should Choose Metal Over Plastic”, https://www.youtube.com/watch?v=tlOWzK4h1Nc&t , posted April 15, 2021 (accessed July 10, 2024)
1021	Definition of “Enclose” from Oxford English Dictionary (accessed Nov. 5, 2024)
1022	Definition of “Enclose” from Merriam-Webster Dictionary (accessed Nov. 5, 2024)
1023	Definition of “Enclose” from Dictionary.com (accessed Nov. 5, 2024)

Pursuant to the Board's email of November 5, 2024, Petitioner submits this reply to Patent Owner's ("PO") Preliminary Response ("POPR"), in which PO argues that the Board should: a) construe the term "surround at least a portion of the teeth of the patient" away from its plain meaning; and b) find that the cited prior art lacks the element under PO's proposed construction. No construction is needed for the term, and in any event, the prior art teaches the claim element.

I. PO'S CONSTRUCTION IS UNNECESSARY AND ERRONEOUS

PO construes "surround at least a portion of the teeth of the patient" to mean "enclose at least some teeth of the patient." POPR at 13–14. PO gives no reason as to why this term requires a special construction. PO only suggests, without law or argument, that construction of the term is needed because, "it played a critical role in the allowance of these claims." POPR at 13. But the term's alleged significance during prosecution does not make the term any less easily understood.

PO gives no evidence for why a POSA would think "surround" means anything other than "surround." Nor does PO show that "surround" has a particular meaning in the dental industry. The single instance of "surround" in the specification (EX1001, col. 4, lns. 63–67) also suggests no special definition.

There is no reason to replace "surround" with a different word "enclose." The entries for the word "enclose" in the same extrinsic dictionaries cited by PO

indicate that the term essentially means “surround.” EX1021, EX1022, EX1023.

PO is silent as to why the claim term of choice should be swapped out for a different, synonymous, term. “[M]erely rephrasing or paraphrasing the plain language of a claim by substituting synonyms does not represent genuine claim construction.” *CR Bard, Inc. v. US Surgical Corp.*, 388 F. 3d 858, 863 (Fed. Cir. 2004) (noting “Courts...regularly forgo detailed dictionary analyses” of commonplace terms.)

PO's definition of “a portion of the teeth” introduces ambiguity. PO added “at least a portion” as a broadening amendment to the claim during prosecution, presumably to indicate that not all teeth need to be fully surrounded by the mouthpiece. EX1002, 175, 160. PO now argues that “surround at least a portion of the teeth” means something else: that at least some teeth are fully enclosed. POPR at 24–25. But the plain language could also mean that at least some teeth are partially surrounded, that all teeth are partially surrounded, or that at least a part of at least one tooth is surrounded. Petitioner and the public should not be required to divine from PO's prosecution disclaimer the meaning and breadth of this phrase.

II. THE PRIOR ART TEACHES THE LIMITATION

Even accepting PO's proposed construction, the cited prior art teaches that “at least some teeth” are “enclosed” by a mouthpiece. Petitioner and its expert

explain, for example, “The Sichuan mouthpiece includes precise recesses for the cusps of each tooth, thereby surrounding them” in a “hand and glove” relationship as the claims require. EX1003, ¶ 125; Pet. at 46, 56–58. The Sichuan biteplate is made from a digital “Boolean operation” that “result[s] in tooth prints on the biteplate that conform precisely to the shape of the teeth, and that they would thus surround each of the patient’s teeth.” *Id.*, ¶ 153. PO gives no explanation as to why this “surrounding” does not also “enclose” the teeth. PO only asserts, without support, that the depth of Sichuan’s biteplate is insufficient to “enclose” teeth, even if surrounding them. POPR at 25–26 (“[T]he biteplate disclosed by Sichuan teaches tooth prints that are only 1 to 2 mm deep and that therefore only touch small portions of a patient’s teeth.”)

Yau also teaches a mouthpiece with precise cuspal recesses, thereby surrounding at least a portion of the teeth, and a POSA would understand Yau’s “tooth mold” that is fitted for “tight engagement with the natural teeth” to be surrounding them. EX1003, ¶ 215; Pet. at 79–85. PO offers only an unsupported assertion that Yau’s engagement with teeth is “totally different” than the claim limitation. POPR at 29.

The claim term at issue is easily understood on its face, and the prior art still discloses it, even as proposed by PO. Institution of trial is warranted.

Respectfully Submitted,

Date: November 13, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petitioner's Reply to Patent Owner's Preliminary Response, including all Exhibits, was served on November 13, 2024, on the following correspondence address of record via email:

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