

Watson Guide IP, LLC
Patent No. 11,806,209 – PGR2024-00040

Filed on behalf of Watson Guide IP, LLC

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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

**PATENT OWNER'S SUR-REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

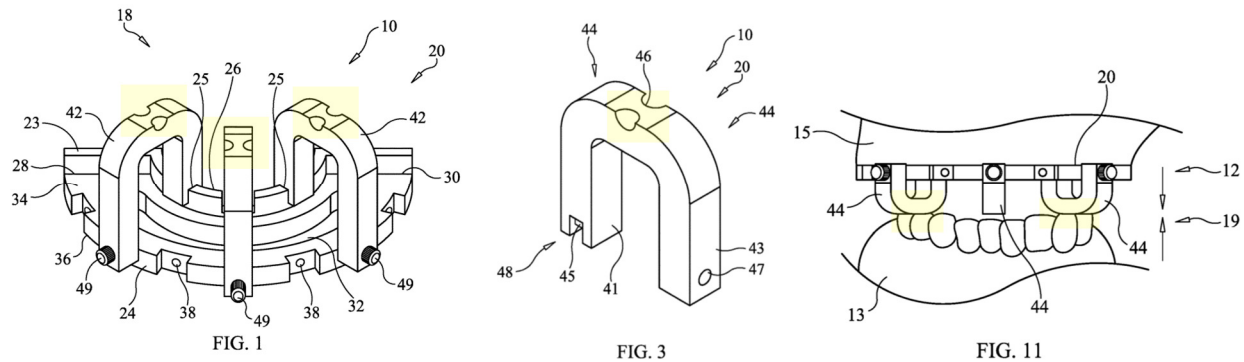
TABLE OF EXHIBITS

Exhibit	Description
2001	Disclaimer of Claims 11 and 13 of U.S. Pat. No. 11,806,209
2002	Definition of “Surround” from New Webster’s Dictionary
2003	Definition of “Surround” from Oxford English Dictionary
2004	Definition of “Surround” from Merriam-Webster Dictionary
2005	Definition of “Surround” from Dictionary.com

The construction of the term “surround at least a portion of the teeth of the patient” in independent claims 1, 7 and 17 is required to resolve certain of the unpatentability grounds presented in the petition. As is clear from Petitioner’s Reply, the parties have an actual dispute regarding the proper scope of this language and the dispute should be resolved through claim construction. *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008)(“When the parties raise an actual dispute regarding the proper scope of these claims, the court, not the jury, must resolve that dispute.”)

Petitioner’s arguments inherently deprive “surround at least a portion of the teeth of the patient” of any substantial meaning. If the term was broadly interpreted to cover any mouthpiece that went around any portion of any tooth of a patient, as Petitioner suggests, then the application would not have been allowed over U.S. Patent Application Publication No. 2017/0252126 to Llop (“Llop”). Llop, the primary reference in the Petition, was also the primary reference cited against the application during prosecution. EX1002, pp. 122-134.

Llop teaches three removable struts used to further position the fixation base in the patient’s mouth. EX1006, ¶98. Each strut “may have at its outer apex 44 one or more indentations 46 that can match one or more portions of gum, dentition or both as shown in Figs. 1, 3 and 11 below.



There is little doubt that when teeth are fit into the indentations 46, those indentations “surround” at least some small portion of any remaining teeth, as Petitioner’s argument uses the term. In response to an Office action citing Llop, Applicant added the language “configured and dimensioned to surround teeth of the patient” and stated that the patient’s existing teeth fit with the claimed mouthpiece in a “hand and glove” relationship. EX 1002, pp. 160-164, 166, 167. While Applicant later further amended the claim language to recite “configured and dimensioned to surround at least portion of the teeth of the patient”, Applicant and the Examiner were both still mindful of Llop and construed that language to mean something other than a mouthpiece that “went around any portion of any tooth of a patient.”

As explained in Patent Owner’s Preliminary Response, the proposed construction of the phrase “surround at least a portion of the teeth of the patient” as “enclose at least some teeth of the patient” is consistent with the specification and prosecution history. EX1001, 4:61-67; ex1002, pp. 166, 167. As further explained

in its POPR, Watson further submits that this construction is consistent with dictionary definitions of the term “surround”. Indeed, Petitioner’s argument that “enclose” is merely a synonym for “surround” demonstrates that Petitioner’s arguments have deprived “surround” of any substantial meaning, in contrast to the plain meaning of the word. Patent Owner’s proposed construction merely restores the plain meaning of “surround,” as it was used during prosecution.

Once properly construed, it is clear that none of Llop, Sichuan or Yao teach or suggest a mouthpiece “configured and dimensioned to surround at least a portion of the teeth of the patient.” Indeed, Petitioner’s expert’s declaration that the Sichuan mouthpiece surrounds teeth in a “hand and glove” relationship is untenable. Gloves made consistent with Sichuan would only cover 1 to 2 mm of a wearer’s fingertips. Likewise, Yau fails to teach or suggest a mouthpiece that surrounds any teeth of the patient.

Conclusion

All of the references in the Petition, considered alone and in combination fail to teach or disclose a mouthpiece “configured and dimensioned to surround at least a portion of the teeth of the patient” as recited in all of the challenged claims. Given this deficiency, Patent Owner respectfully requests that the Board deny institution.

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Dated: November 19, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a true copy of the foregoing document was filed electronically and served via email to all parties in this proceeding at the addresses indicated:

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