

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3D DIAGNOSTIX, INC.
Petitioner,

v.

WATSON GUIDE IP, LLC,
Patent Owner

PGR2024-00040
Patent 11,806,209 B2

Record of Oral hearing
Held: October 29, 2025

BEFORE: SHERIDAN K. SNEDDEN, JAMES A. TARTAL, and
LISA L. TSANG, Administrative Patent Judges.

PGR2024-00040
Patent 11,806,209 B2

APPEARANCES:

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The above-entitled matter came on for hearing on October 29, 2025,
commencing at 1:30 p.m.

P R O C E E D I N G S

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JUDGE TARTAL: We are convened for oral arguments in 3D Diagnostix, Incorporated versus Watson Guide IP, LLC, PGR2024-00040, which pertains to patentability challenges of claims in U.S. Patent Number 11,806,209 B2, which we will refer to as the '209 Patent. I'm Judge Tartal. And I'm joined by Judge Tsang in the hearing room. Also appearing remotely is Judge Snedden. Let us get started with appearances for both parties.

If you could announce who will be arguing today and also introduce anyone joining you, either in person or remotely, who will not be speaking. If you could identify them as well, that would be helpful. And we'll start with Petitioner.

MR. FEIGELSON: Thank you, Your Honor. Aaron Feigelson of Leydig, Voit & Mayer, representing Petitioner 3D Diagnostix. With me today is Mr. Khaled Elsaid, the founder and CEO of 3D Diagnostix.

JUDGE TARTAL: Okay. Thank you. And for Patent Owner, who do we have today and who do you have with you, if anyone?

MR. KARISH: Good afternoon, Your Honors. My name is Marc Karish of Orbit IP. And I represent the Patent Owner, Watson Guide IP, LLC. There's no one here presently with me. But one of my co-counsel, Bruce Chapman, may be listening in on whatever line is available.

JUDGE TARTAL: Okay. Well, welcome to the USPTO's Alexandria office. Today's hearing provides an opportunity for counsel to orally advocate for your positions on the patentability of the challenged

1 claims, as raised in the petition. Recording of any PTAB hearing is
2 prohibited. The court reporter will provide a transcript of the hearing that
3 will be part of the record in the proceeding at a later date.

4 We have the demonstratives as well as the briefs and evidence
5 available to us on our computers. To ensure the transcript of this hearing is
6 as clear and accurate as possible, we ask you to please speak directly into the
7 microphone when talking and in particular, to identify specific slides,
8 numbers, numbering and figures when referring to the demonstratives so that
9 we have the ability to look at the transcript and correspond that to what you
10 were discussing during the hearing.

11 Please note that public access to this hearing has been provided to
12 enable public attendance. We understand certain information was filed
13 under seal. If the parties want to discuss confidential information, please
14 notify us before discussing anything confidential. It may be that the
15 particular number of confidential information doesn't need to be disclosed or
16 addressed in the public hearing, we can refer to it. And as I indicated, we
17 have access to the materials so we will know what you're talking about, if
18 you can avoid the need to discuss confidential information. If you do, just
19 let us know ahead of time and we will take appropriate precautions.

20 We issued a hearing order as Paper 21 in this proceeding, which
21 granted the parties' joint request that each party be provided a total of 45
22 minutes to present argument in this case. Petitioner will open the argument
23 and may reserve rebuttal time, which may not exceed more than half of
24 Petitioner's total argument time. Similarly, Patent Owner will then respond
25 to Petitioner's arguments and may reserve surrebuttal time, also not to
26 exceed more than half of Patent Owner's total argument time. We ask the

1 parties not to interrupt each other and to instead hold any objections to
2 opposing arguments until it is your time at the podium, at which point you
3 may address any objections that you would like to raise.

4 We will maintain a clock that will provide a running time count of
5 the time that's available. We'll also seek to give you a warning as we
6 approach the end of your time available. The visible timer includes a light
7 that changes to yellow when you're nearing the end of the time that's been
8 allocated as well as a red indicator when you've run out of time. Petitioner,
9 do you request to reserve any of the rebuttal time out of the 45 minutes?

10 MR. FEIGELSON: We'll reserve 10 minutes, please.

11 JUDGE TARTAL: So I will set the clock at 35 minutes to begin
12 with and that will include the provision for the additional 10 minutes of
13 rebuttal time as well as any time you don't use in the argument in the first
14 portion. To clarify, do you intend to address any confidential information in
15 your initial argument?

16 MR. FEIGELSON: We do not.

17 JUDGE TARTAL: Okay. Very good. You may begin when you
18 are ready.

19 MR. FEIGELSON: Good afternoon. May it please the Board.
20 This PGR involves U.S. Patent Number 11,806,209 entitled fixation base
21 and guides for dental prosthesis installation.

22 And turning to Slide 3, although there are technically six grounds
23 of institution, only two are really at issue today. The same primary
24 reference, Llop126, or just Llop here, is used for both of those grounds. I'll
25 also note that not all of the '209 Patent claims are at issue in this PGR, so
26 just those that were asserted in co-pending litigation. So at the end of the

1 day, the '209 Patent will survive this PGR in some form.

2 As we'll see in a moment, the Patent Owner does not contest that
3 Llop discloses all but two elements of the independent claims. So those two
4 elements have been the main focus of the PGR briefing to date, and it will be
5 today as well. Specifically, those two elements relate to the first dental
6 guide that is used to position the fixation base, and that's shown on Slide 4.
7 Those elements are 1[d] and 1[e], which are a mouthpiece that attaches to
8 the fixation base and is configured and dimensioned to surround at least a
9 portion of the teeth of the patient.

10 Now, the Patent Owner has suggested particular constructions for
11 both of these terms and its argument about whether the prior art discloses
12 those elements is dependent on those proposed constructions. In contrast,
13 the Petitioner shows that even if we assume Patent Owner's constructions,
14 the prior art nevertheless discloses those elements.

15 On Slide 5, we see that while the claim construction and teaching
16 the prior art is the main focus, the Patent Owner has also attempted to
17 challenge the motivation to combine the references. And it's also suggested
18 that there are secondary considerations that favor non-obviousness. Now,
19 the Petitioner has shown in its papers why there's a strong motivation to
20 combine the references and why Patent Owner's secondary considerations
21 should be given little to no weight.

22 On Slide 7 -- I'm not going to talk much about the contents of the
23 '209 Patent, I assume that the Board is familiar with that. I'll just say that it
24 relates generally to a system for installing a dental prosthesis which, here, is
25 a set of teeth. Claim 1 is representative and it's written as a method. And
26 you can see the two disputed elements highlighted here in yellow and green.

1 Again, the other 14 elements of this claim are not in dispute. But these two
2 elements are the terms that Patent Owner say in the -- Patent Owner says
3 need construction.

4 I'm looking at Slide 8, and the first term that Patent Owner says
5 needs construction is "a mouthpiece." Patent Owner says that the
6 mouthpiece means a device that is inserted into the mouth and worn over the
7 teeth. Now, Petitioner does not believe that construction is necessary for
8 this term. But instead, we note that the Patent Owner provides no reason
9 why construction is needed. And Patent Owner provides no support
10 whatsoever for that second part of its construction, worn over the teeth. That
11 limitation, just there's -- then that should be the real focus here.

12 The Petitioner submits that the term has to be broad enough to
13 include a denture clone or tissue borne guide. And that's found in the
14 prosecution history of the '209 Patent. We'll get into those details in a little
15 bit, but I'll note for now that the Patent Owner did not identify this term as
16 requiring construction in its preliminary Patent Owner response. It was only
17 identified after the PGR was instituted.

18 On Slide 9, we see the other term that Patent Owner says requires
19 construction and that is a -- "surround at least a portion of the patient's
20 teeth." Again, the Patent Owner's proposed construction for this term -- but
21 Petitioner doesn't think that any construction is necessary. And we'll talk
22 about this term first because it was the original term that Patent Owner
23 proposed construction for in its preliminary response and the discussion is
24 fairly simple and short.

25 I'm on Slide 10. And part of the reason for this simplicity of the
26 discussion is that the Board has already considered this term and the issue

1 and they ruled on it in the Institution Decision Paper 9. Specifically, after
2 receiving three briefs on the issue, the Board agreed that no construction was
3 necessary and that the proposed construction of Patent Owner just replaced
4 one word, “surround,” for another word, “enclosed.” Patent Owner since
5 then has not introduced any new evidence to support that construction other
6 than a bare statement from its expert who relies on exactly the same
7 dictionary definitions that were presented in the preliminary response.

8 Now, on Slide 11, we see that in the sur-reply brief, that Patent
9 Owner filed at the end of August, the Patent Owner does change course a
10 little bit and they try to deflect away from this surround versus enclose
11 substitution and they try to focus on that second part of the phrase, at least a
12 portion of the teeth. What does that mean? So this is a new argument. Even
13 though the Petitioner had flagged it in its reply to the preliminary response
14 and the institution's decision acknowledged that flagging of the issue.
15 Nevertheless, Patent Owner chose not to address this until its sur-reply brief.
16 So in the end, we say there's no reason for the Board to disturb its previous
17 decision, that this term does not need construction.

18 JUDGE TARTAL: Quickly, and I think this is -- this has been
19 addressed. But does Petitioner concede that “enclose” and “surround” are
20 synonyms and mean the same thing, or does Petitioner have a basis to argue
21 that enclose somehow means something different than surround and that
22 that's a reason not to --

23 MR. FEIGELSON: We believe they're synonymous. And I think
24 that the Petitioner -- the Patent Owner has agreed -- and the Patent Owner's
25 expert has agreed. We haven't seen anyone try to distinguish those terms.
26 And in the institution decision, that seemed to be what the Board thought as

1 well, that these are synonymous terms and there's no -- the Patent Owner has
2 not provided a reason to substitute one for the other, especially when one is
3 included in the specification and the other's not.

4 JUDGE TARTAL: So just to be clear, from Petitioner's
5 perspective, whether we apply a meaning of “surround” that's plain and
6 ordinary meaning or apply a meaning of surround that's enclosed, the merits
7 of the arguments are the same.

8 MR. FEIGELSON: We believe so, yes. We believe a prior art
9 teaches this element, regardless of whether it's surround or enclosed.

10 JUDGE TARTAL: Thank you.

11 JUDGE TSANG: Mr. Feigelson, what is Petitioner's position on
12 the meaning of “at least a portion of the teeth”?

13 MR. FEIGELSON: So that's not so clear. I think, we -- when we
14 flagged that issue, that uncertainty that comes from trying to impose a
15 construction on this term. But one -- and for that reason, it should try to
16 encompass all those possibilities. It could be that it's some part of at least
17 one tooth. It could be all of at least one tooth, or all at least of some teeth.
18 It's not clear. But the plain meaning of the term, at least a portion of the
19 patient's teeth, I think is clear on its face that you have the patient's teeth and
20 at least some portion of those teeth are enclosed or surrounded, I would say.

21 JUDGE TARTAL: Okay.

22 JUDGE TSANG: I see you made that argument in the Preliminary
23 Reply. Did you maintain that argument in your Reply?

24 MR. FEIGELSON: In the reply -- I don't know if that's
25 specifically in the reply. It's certainly in our response to the preliminary. It's
26 in our reply to the preliminary response. And since there wasn't much that

1 was added on then I don't know if we addressed that specifically because I
2 don't know if there was a need to.

3 JUDGE TARTAL: And can I just follow up on that, which is in
4 terms of the art that is being asserted by Petitioner, can you explain how that
5 relates to what you at least suggested were possible constructions of “at least
6 some teeth”? In other words, is any of the art that's being asserted directed
7 to a single tooth? Is there -- what is the correspondence between the
8 possibility of definitions that you've identified and the art that you're actually
9 relying upon in this proceeding?

10 MR. FEIGELSON: Yeah. I think we'll see that more in a bit. But
11 all of the -- but both of the references that we are using to teach this
12 particular element, that is the Sichuan reference and the Yau reference, have
13 multiple teeth that are being surrounded. And it might be, to different
14 extents, that they're surrounded. One talks about having tight engagement
15 with the teeth, the other has a tooth mold where the -- more than the tips of
16 the teeth are going into that mold. But they all deal with multiple teeth that
17 are being surrounded.

18 JUDGE TARTAL: And so just to wrap up the question, looking at
19 page 11 of -- excuse me, Slide 11 -- page 11 of 35, Slide 11, where you say,
20 Petitioner further argues that surround at least a portion of the teeth, the
21 patient encompasses scenarios -- and you list several there. Where does the
22 art that you're asserting fall under those different scenarios?

23 MR. FEIGELSON: I'm sorry, I don't know if I've understood your
24 questions.

25 JUDGE TARTAL: On page 11 --

26 MR. FEIGELSON: Yes. I'm looking at the slide.

1 JUDGE TARTAL: -- you have the cutout of the POPR --

2 MR. FEIGELSON: That's actually from the institution decision.

3 JUDGE TARTAL: Oh, from the institution decision, excuse me,
4 it's quoting the preliminary response --

5 MR. FEIGELSON: Right.

6 JUDGE TARTAL: -- where it says that Petitioner suggests that
7 surround at least a portion of the teeth encompasses scenarios in which at
8 least some teeth are partially surrounded -- that all teeth are partially
9 surrounded, or that at least a part of at least one tooth is surrounded.

10 MR. FEIGELSON: Yup.

11 JUDGE TARTAL: So the question was, you've given three
12 scenarios there --

13 MR. FEIGELSON: Yeah.

14 JUDGE TARTAL: -- is there a correspondence between the art
15 that you're relying upon and which of those scenarios corresponds to that
16 particular art, as opposed to just generically speaking about what the term
17 might mean?

18 MR. FEIGELSON: Yeah. So certainly, I think that the Sichuan
19 reference would satisfy all three of those, regardless of if we have to choose
20 one of those three, which I don't think we do. I think the Sichuan reference,
21 it wouldn't matter what you picked. Yau reference also probably does. I'm
22 not sure if it shows that all of the teeth are being partially surrounded or not
23 -- certainly, multiple teeth are, to some extent.

24 So we'll turn to Slide 12, and that brings us to the mouthpiece.
25 And at a high level, there are some significant issues that are worth noting
26 here. And again, Patent Owner did not think that construction was

1 necessary, that it was so important, I should say, that it needed to be
2 included in its preliminary response. Now, that's a little bit surprising
3 because the Patent Owner, they barely used a third of the 18,700 words they
4 had available in that preliminary response.

5 JUDGE TARTAL: Counsel, I would just note that the opportunity
6 for Patent Owner to provide a preliminary response doesn't necessarily
7 correspond to what they argue in its response. And so I don't think we take a
8 whole lot of weight to whether or not an issue is raised in the Patent Owner
9 preliminary response because it just gives them an opportunity to raise initial
10 issues and they can actually change or modify what their arguments are
11 based on institution. And so just as an insight, we won't fault Patent Owner
12 for not raising it in the Patent Owner preliminary response. It's critical that
13 it's addressed in the response itself.

14 MR. FEIGELSON: Thank you, Your Honor. But I think you hit
15 on a good point, that there certainly was a course correction of sorts, that
16 there was a -- I think Patent Owner felt a need to try to get something -- it
17 could be over the teeth, as they put here, or something surrounding or
18 enclosing the teeth. And if it didn't work in the first attempt they had with
19 the -- with a construction for surrounding the teeth, they're trying to
20 essentially work in a similar limitation through this mouthpiece construction.

21 So the Patent Owner also -- and this is probably most important,
22 they don't provide a reason why construction is needed, that most the Patent
23 Owner says the term must be ascribed significantly because it played a
24 critical role in allowance. And that's in their response at 6. But the Patent
25 Owner doesn't cite any law for that proposition and that's probably because
26 that law just doesn't exist.

1 The Patent Owner also selectively looks to only one definition
2 from one general, non-medical dictionary to support its construction, and
3 that's the yellow that's highlighted here. I think it's the American Heritage
4 Dictionary. But you can see the Patent Owner ignores the primary definition
5 from that same dictionary as well as other dictionaries that are inconsistent
6 with its position. As you can see the term "mouthpiece" is much more
7 generally used to refer to something that is in or near the mouth and it's not
8 limited to being over the teeth.

9 And I'll say that this -- it appears that the Patent Owner actually
10 gets its construction from this extrinsic evidence, it's not otherwise in the
11 record. This seems to be the source of their construction, so that's extrinsic.
12 So what about the intrinsic evidence? If we look at the intrinsic evidence,
13 it's not surprising that the Patent Owner didn't say so much. Instead, the
14 Patent Owner only pointed to the figures of the '209 Patent and one passage
15 that it says were consistent with its definition. But they don't show -- they
16 don't point to anything that they say compels a construction.

17 But in its sur-reply brief, however -- again, filed at the end of
18 August, to which Petitioner didn't have an opportunity to respond -- the
19 Patent Owner made a statement that I'd like to address here. So I'm going to
20 put that up. So in the -- so this is the Patent Owner's sur-reply brief that was
21 filed. And if you look at the bottom of page 1 of that brief, Patent Owner
22 makes this statement, the only disclosure of mouthpiece in the '209 Patent is
23 of a, quote, "a device that is inserted into the mouth and worn over the
24 teeth." And you'll see there's no citation there for that quoted language.
25 And that's because that language is not found anywhere in the '209 Patent.

26 Instead, there are two passages in the '209 Patent that do relate to

1 the mouthpiece and the Patent Owner did not cite. And I'd like to put those
2 up. So this is the '209 Patent and I'm looking at column one and specifically
3 lines 43 to 48 where it's described that the mouthpiece is formed to more of
4 the maxillary or mandibular structure than that contacted by the fixation base
5 from the images and assists in appropriately setting the fixation base in
6 appropriate location. There's no mention of teeth there and there's certainly
7 not a mention of anything going over the teeth.

8 The second uncited portion of the '209 Patent comes a few
9 columns later, in column 6 at the bottom and lines -- column 6, lines 56 to
10 63. I'll highlight those here, wherein the mouthpiece complements fixation
11 base 100 by conforming to some surfaces of the mouth of the patient not
12 covered by the fixation base 100. The method may further comprise using
13 the mouthpiece to assist in locating fixation base 100 appropriately. Again,
14 no mention of teeth or anything going over the teeth, just that the
15 mouthpiece is formed to some surfaces of the patient's mouth and is used to
16 help place the fixation base with no teeth needed.

17 JUDGE TSANG: Where is this argument made in the brief?

18 MR. FEIGELSON: So this is in response to the sur-reply brief that
19 Patent Owner filed at the end of August. So if the Patent Owner had
20 suggested this for construction, something about conforming to surfaces of
21 the mouth, maybe that would have been acceptable. But that's not what
22 Patent Owner did. Patent Owner instead used this language over the teeth.
23 In any event, the Patent Owner statement that we saw in the sur-reply is
24 simply not true.

25 JUDGE TARTAL: And you may want to just address this when
26 you get to the particular grounds that are being asserted, but one of the

1 questions that comes to mind for me is to what extent any of this matters.
2 You're arguing over the meaning of "mouthpiece." If you could clarify why
3 the art you're asserting doesn't conform with Patent Owner's proposed
4 definition or it does, that would be helpful. But it may be easier to address
5 once you're dealing with the particular grounds. But a broader topic, our
6 idea is helping us identify what actually has to be resolved versus what the
7 parties may disagree upon but doesn't alter the merits of the outcome.

8 MR. FEIGELSON: Yeah. Thank you, Your Honor. Again, we
9 submit that regardless of that construction, that the prior art is not going to
10 -- it's not going to be affected in our arguments. However, I know that you
11 will be hearing from the Patent Owners shortly that will make these
12 arguments.

13 So going back to the slides, in Slide 13, this understanding that
14 teeth are not required for the mouthpiece, that's confirmed with more
15 intrinsic evidence in, namely, the file history. So in the parent '016 Patent's
16 prosecution, the applicant had two different claims that were covering the
17 mouthpiece. One was Claim 4, shown here in Slide 13, which mirrored the
18 language that we just saw from the specification about conforming to some
19 surfaces of the mouth but no mention of teeth. And the other was Claim 15,
20 which included the configured and dimensioned to surround teeth language.

21 So the applicant certainly was aware then of the distinction and
22 that the mouthpiece, in at least some embodiments, did not need to involve
23 teeth. And by the way, I should say the originally filed claims for the '209
24 Patent also did not include any mention of teeth with respect to the
25 mouthpiece element. Those were added by amendment later on in
26 prosecution.

1 Going back still further in the file history, we have the '377
2 provisional application as shown in Slide 14. Now, the provisional
3 application explicitly refers to two different kinds of mouthpieces: one is a
4 tooth-borne guide that uses the patient's existing teeth, and that's shown on
5 the left; the other is a tissue-borne guide or a denture clone, and that's on the
6 right. And that is used in a -- right, what's called a fully edentulous patient,
7 a patient that doesn't have teeth, at least on one part.

8 So here, the patient's (INDISCERNIBLE - TECHNICAL
9 DIFFICULTY). There's an occlusion between that denture and the lower
10 teeth and that is used to then set that fixation base to the proper position. So
11 even though the provisional application is very clear about these different
12 kinds of mouthpieces, under the Patent Owner's construction about going
13 over the teeth, that fully edentulous embodiment is completely read out.

14 Now, I know the Patent Owner makes an argument in its sur-reply
15 brief that the '209 Patent specification deletes references to that denture
16 clone embodiment, and they cite some recent Federal Circuit cases for
17 support. But there are two very important points of distinction to distinguish
18 those cases from the present case: the first one is shown in Slide 15 here.
19 And this is from the file history of the parent '016 Patent.

20 And there, the applicant submitted new figures during prosecution.
21 And the examiner said that those figures were unsupported by the '377
22 provisional, that they included new matter. The applicant responded to that
23 new matter rejection by pointing to the provisional application and
24 explaining that there was support. And they pointed specifically to the
25 denture clone, and that's what you see here in Figure 2b. They said that that
26 denture clone was supporting the new figures that were added in for the '016

1 Patent.

2 And the applicant referred to that denture clone as a mouthpiece in
3 the '016 Patent application. They clearly did not wish to disclaim that
4 embodiment. Instead, they embraced it in order to show support for its new
5 figures.

6 The second instance that we have from the file history to
7 distinguish over these other cases is shown in Slide 16. And here, we talk
8 about incorporation by reference. The '016 Patent, the parent patent to this
9 '209 Patent, it claimed priority to that '377 provisional. But for some reason,
10 it didn't incorporate it by reference. We see that in the box on the left, the
11 cutout, there's no incorporation by reference of the contents of the '377
12 provisional. However, when the continuation patent was filed -- that became
13 the '209 Patent -- the applicant added that back in. They added in an explicit
14 incorporation by reference to the '377 provisional.

15 So for this patent, the one that's at issue today, the applicant
16 intentionally reintroduced the content of the '377 provisional with that
17 expressed incorporation reference. And what that means is that a person of
18 skill in the art, looking at the file history, would understand that the
19 applicant did not intend to remove that edentulous mouthpiece from the '209
20 Patent. Instead, there was actually an intention to include those
21 embodiments.

22 So if there was any evolution of the applicant's intended meaning
23 of a mouthpiece, it was to even more clearly include the edentulous
24 mouthpieces. The intrinsic evidence, we believe, is very solid on this point.

25 So we can look at the extrinsic evidence and that's in Slide 17.
26 And the parties agree that mouthpiece does not have a particular meaning in

1 the dental field. There's not any dental dictionary that has been cited for the
2 definition of mouthpiece, for example. However, when Patent Owner's
3 expert was shown these search results about mouthpiece from this Henry
4 Schein online dental catalog, he couldn't recognize any that fit his definition.

5 So in sum, Petitioner does not believe construction of mouthpiece
6 is necessary. And the intrinsic and extrinsic evidence both demonstrate that
7 any construction cannot include this over the teeth limitation that Patent
8 Owner has proposed.

9 JUDGE TARTAL: Counsel, can I ask, if a mouthpiece must be
10 configured and dimensioned to surround at least a portion of the teeth of the
11 patient, would that mouthpiece necessarily be a device that is inserted into
12 the mouth and worn over the teeth?

13 MR. FEIGELSON: That's a good question. I don't know if it's one
14 that was fully addressed. It certainly would be inserted in the mouth. I don't
15 know if it would need to go over the teeth. It could be something that goes
16 -- it might be -- depends on what over the teeth means. We'd have to
17 construe that, right? I can imagine a device that might clasp onto the sides
18 of teeth, or maybe part of it goes on the top. I think that it begs another
19 question and possibly that construction would require additional
20 construction, another reason not to go forward with it.

21 So we'll turn to the merits of the obviousness challenge. And on
22 Slide 19, again, as mentioned, there are 16 elements in Claim 1. Fourteen
23 them are not at issue today, there's no dispute on those. For the other two,
24 there is a dispute, and it's whether those two are disclosed by these -- the
25 secondary references, Sichuan or Yau.

26 So turning to Slide 20, we see the Sichuan reference. It discloses

1 this mouthpiece in the form of a bite plate that's shown in green. And that is
2 configured in dimension to surround patient's teeth because it has those
3 precise tooth prints that were, you know, created as negatives of the teeth
4 and they conform to the teeth, and they keep that bite plate in place.
5 Attached to that green mouthpiece are connector rods that are white, which
6 are in turn connected to guide plates, the yellow guide plates, number 3.

7 And by using the bite plate, those guide plates are precisely
8 positioned on the patient's jaw in precisely planned locations through digital
9 imaging, where they can then be attached to the patient's jaw using pins
10 going through those holes, number 6. Once those guide plates are attached,
11 the connector rods and bite plates are removed leaving the guide plates, and
12 the surgeon can perform the osteotomy procedure.

13 Now, this is exactly the same technique that is described in the
14 '209 Patent, right? Now, the Patent Owner tries to argue that this bite plate
15 is not a mouthpiece, even though it is consistent with their construction, that
16 it does go over teeth. But Patent Owner also argues that there's not a
17 motivation to combine Sichuan with Llop because one is for an oral surgery
18 procedure, while Llop and the '209 Patents are for dental implant surgery.
19 The Patent Owner doesn't cite any law in making this argument, but the
20 relevant precedent makes clear that Sichuan is indeed analogous art.

21 One of those cases we put up that's on Slide 21, this is the Airbus
22 case, and it says that art can be analogous in one of two ways. We submit
23 that Sichuan is analogous and actually, in the first way that it is in the same
24 field of endeavor. But even if it's not, it's certainly reasonably pertinent to
25 the particular problem that was being addressed.

26 And we'll see that now in Slide 22. Why is it addressing the same

1 problem? Both the '209 Patent and Sichuan are trying to get a precise
2 mounting of a guide onto a patient's jawbone for dental surgery. They both
3 use a registration mechanism of a mouthpiece to do that.

4 But you know what, you don't have to take our word for it because
5 the Patent Owner's expert actually said that in deposition testimony, shown
6 on Slide 23. He discussed the '209 Patent in Exhibit 1047 at pages 46 to 48,
7 and he discusses Sichuan on pages 58 to 63 of that exhibit. And he agrees
8 that the Sichuan bite plate is used to allow for the precise positioning of the
9 guide plates that are installed on a patient's jawbone, exactly the same as
10 -- for the '209 Patent. So Sichuan is analogous art, at least through the
11 second Airbus test.

12 As to the first part of Airbus, we'll look at Slide 24. It's notable
13 here that Patent Owner, they stopped short of saying that a person of skill in
14 the art wouldn't be at least aware of the subapical osteotomy procedure,
15 Sichuan. That's because it really is from the same field of endeavor as
16 dental implant surgery. It uses similar common language, involves common
17 areas of the body and the skull. So we submit that it actually is analogous
18 art under the first prong of Airbus.

19 We also would point out in Slide 25 that this combination was
20 suitable to address the problem. And although the Petitioner and our expert,
21 Dr. Erickson, explained why that combination was an improvement over
22 both Llop and the '209 Patent, that is for visibility and manipulation, that's
23 actually more than the law requires. The Patent Owner hasn't cited any law
24 to say that a strict improvement is needed.

25 In Slide 26, we see that the Llop-Sichuan combination is also
26 actually very similar to something that the Patent Owner is doing itself with

1 its own product. And they use a mouthpiece there that has a negative
2 impression of teeth in order to fix the fixation base. So as you see here, this
3 is for an edentulous patient. In this case, they have no teeth on the top, but
4 they have some teeth on the bottom. And they use a bite plate for those
5 bottom teeth in order to fix the fixation base on the upper teeth, very similar
6 to Sichuan. So this is clearly a workable solution, the Sichuan-Llop
7 combination.

8 The other reference, the other ground we have with Yau, we show
9 it briefly on page 28 of the slides. And we won't go into much detail on that.
10 It works a little bit differently. It describes tooth molds, in green, as being in
11 tight engagement with patient's teeth here, it's engagement with the upper
12 teeth. And this is for -- also for edentulous patients. So in this case, the
13 patient doesn't have lower teeth. But once in place with that green
14 mouthpiece, that yellow guide is then placed on the gum below and is
15 pinned to the patient's jawbone for subsequent surgery.

16 I'd like to spend a little -- the last few minutes here talking about
17 secondary considerations. In Slide 30 and in our reply brief, we cited this
18 Quanergy case. But there are plenty of other Federal Circuit cases that we
19 could cite for the same standard about co-extensiveness. A big one is the
20 Fox Factory versus SRAM case at 944 F.3d 1366 from 2019. The bottom
21 line is that the Patent Owner has not shown that its specific product is co-
22 extensive with the features of the '209 Patent claims so it is not entitled to a
23 presumption of nexus.

24 And there are several reasons for this lack of presumed nexus.
25 We'll see on page 31 and also in Petitioner's reply brief. We'll focus on three
26 of those today. The first reason is that there is no detailed analysis that's

1 mapping the patent claims to the Patent Owner's specific product. At best,
2 we have the Patent Owner's business president, who's not a dentist, generally
3 pointing to claim features in its family of products. But that's not enough.
4 There's no detailed mapping.

5 The second reason is that the family of products that the Patent
6 Owner identifies includes products that are not covered by the '209 Patent
7 claims, such as edentulous pin guides and sequential guides that are not
8 attached to the fixation base. I'll also note that these edentulous pin guides
9 are offered under the CHROME GuidedSMILE label because the Patent
10 Owner has tried to make that distinction, and that's seen on the lower left. I
11 can blow this up a little bit. But this is taken from their literature. It talks
12 about the pin guide for CHROME GuidedSMILE and talks about a case
13 where you use it for edentulous patients.

14 So then on Slide 32, the Patent Owner has other patents that cover
15 critical features that are not recited in the '209 Patent claims. Those features
16 include a floating fixation base that is only in front of and not behind the
17 patient's bone. And that feature is found in all of the claims of the parent
18 '016 Patent and the child '755 Patent. But it's conspicuously absent here.

19 You can see it in Claim 1 of the '016 Patent here, that's Exhibit
20 1048 in the lower left corner. And you can see how it was described during
21 prosecution, in the box above that, as a key feature that avoided undesirable
22 properties of prior systems. And by the way, the Patent Owner's president
23 also testified that this floating guide was also a key feature of its product,
24 and that's at Exhibit 1046 on page 45.

25 The other critical feature that's claimed in other patents of the
26 Patent Owner is the use of metal. And it's using metal for the drill guide and

1 for the fixation base. Now, as you know or maybe you're familiar, you
2 remember there had been claims originally in this '209 Patent directed to
3 metal fixation bases and metal drill guides. But the Patent Owner expressly
4 disclaimed those claims early on with its preliminary response in this PGR
5 proceeding.

6 But the child '755 patent still has claims to metal, that's shown on
7 the right of Slide 32. And the Patent Owner's test -- president again testified
8 at length about the importance of metal. Yet metal is not recited in the '209
9 Patent claims anymore.

10 And without a presumption of nexus, Patent Owner's remaining
11 arguments and evidence fall far short of showing that the evidence of
12 secondary considerations is the direct result of the unique characteristics of
13 the claimed invention. And that's the standard that's set forth in the Fox
14 Factory case that I mentioned earlier.

15 We can summarize some of those failed arguments in Slide 33. So
16 for long-felt need, the Patent Owner doesn't provide any corroboration for its
17 president's anecdote, and he doesn't link that anecdote to any unique
18 characteristics of the claimed invention. For commercial success, Patent
19 Owner admits that its single revenue chart is over-inclusive and contains
20 sales of unpatented products.

21 The Patent Owner significantly also increased its marketing efforts
22 for newer products with lots of social media posts. Patent Owner's evidence
23 of praise is not reliable. It looks more like advertisements in a trade
24 magazine. And as to copying, the Patent Owner only points to one feature
25 that's allegedly in common between its product and the Petitioner's, while it
26 ignores significant differences between those products.

1 So in sum, there's just no evidence that is -- that ties the unique
2 characteristics of the claimed invention to the evidence here, there's no
3 linkage. So in conclusion, Slide 35, Patent Owner's constructions are not
4 necessary. The mouthpiece needs to be broad enough to include at least
5 these denture clones and shouldn't -- over the teeth is too narrow.

6 The combinations between Llop and Sichuan and Llop and Yau do
7 disclose that mouthpiece that attaches to a fixation base and it's configured
8 dimension to surround at least a portion of a patient's teeth. The motivation
9 to combine here is strong and any secondary indicia of non-obviousness
10 should be given very little weight. And with that, I will yield the rest of my
11 time and save it for rebuttal.

12 JUDGE TARTAL: Counsel, can I --

13 MR. FEIGELSON: Yes?

14 JUDGE TARTAL: ask, is the asserted art limited to the use of
15 denture clones?

16 MR. FEIGELSON: Are they limited to the use of denture clones?

17 JUDGE TARTAL: Yes, or is the asserted art also used with teeth?

18 MR. FEIGELSON: Well, they're being used with teeth. Both the
19 Yau reference and the Sichuan reference are being used with teeth.

20 JUDGE TARTAL: Okay.

21 MR. KARISH: May I please reserve five minutes for rebuttal?

22 JUDGE TARTAL: We will set the clock initially at 40 minutes.

23 MR. KARISH: Thank you very much.

24 JUDGE TARTAL: You can begin when you're ready, Counsel.

25 MR. KARISH: Thank you, Your Honor. Good afternoon, Your
26 Honors. Thank you for your consideration today. My name is Marc Karish.

1 And I'm here on behalf of the Patent Owner, Watson Guide IP, LLC. Let me
2 just start off by saying I'll be referring today to my -- the Patent Owner's
3 demonstrative exhibits, which have previously been submitted as Exhibit
4 2011. So all of the page numbers that I'll be referring to are with reference
5 to Exhibit 2011.

6 This post grant review proceeding comes down primarily to the
7 construction of two different terms, as Petitioner has previously been
8 discussing. The two terms the Patent Owner submits need construction are
9 "mouthpiece" and "surround at least a portion of the teeth." Looking at
10 Petitioner's demonstratives, at the end of Slide 4, it seemed to say that even
11 under our proposed -- the Patent Owner's proposed constructions, the prior
12 art discloses those elements. So I would just submit if it doesn't matter, then
13 I would request that the Board adopt the Patent Owner's proposed
14 constructions.

15 Turning to Slide 3 of Exhibit 2011, Petitioner has proposed a
16 construction of mouthpiece as "any dental device placed in the mouth." And
17 that construction is so broad as to be nonsensical, as we previously pointed
18 out in Patent Owner's sur-reply, patent -- I'm sorry, Paper 18 at page 5.
19 Their definition is wrong. And they're clearly trying to back away from it
20 now by now arguing that it doesn't need construction but that it should
21 incorporate tissue-borne and denture clone devices.

22 And they're understandably trying to get away from it. Their
23 experts said that a toothpick and a toothbrush falls within their proposed
24 definition of mouthpiece. But then the Petitioner's expert admitted that he
25 had never heard the term mouthpiece used in that way.

26 Moving on to Slide 4 --

1 JUDGE TARTAL: Counsel, if I can interrupt just briefly --

2 MR. KARISH: Of course.

3 JUDGE TARTAL: -- on Slide 3 or page 3, your citation is to D.N.
4 16 at 5.

5 MR. KARISH: Yes.

6 JUDGE TARTAL: Can you confirm what that is?

7 MR. KARISH: So that is the Petitioner's reply brief is document
8 six, number 16. And we referred to it in the Patent Owner's sur-reply at
9 page 5. Sorry for any confusion.

10 So it's our position that the nonsensical definition of mouthpiece
11 proposed by the Petitioner defeats the purpose of the claim language, that the
12 term mouthpiece in the claims has a definition. And if you use Petitioner's
13 definition, it defeats that narrowing purpose. It essentially makes the claim
14 language read utilizing the first dental guide, wherein the first dental guide is
15 any dental device placed in the mouth. And that's just totally inconsistent
16 with the claim language. So just applying their proposed definition to the
17 claim -- moving on to Slide 5 of Exhibit 2011 -- we can see that any -- again,
18 they're proposing that mouthpiece be construed as any dental device placed
19 in the mouth. That would certainly cover the dental prosthesis itself. It
20 would cover the fixation base. It would even cover fasteners that hold the
21 fixation base to the jaw.

22 JUDGE TARTAL: Counsel, if I can just interrupt.

23 MR. KARISH: Yes.

24 JUDGE TARTAL: The issue I have with that is the claim
25 language itself includes additional language, though, that explains what is
26 required of the mouthpiece. So it isn't any mouthpiece. It just says in Claim

1 1, for example, "a mouthpiece configured and dimensioned to surround at
2 least a portion of the teeth of the patient."

3 And so it would be helpful to perhaps understand how you're
4 construing mouthpiece in conjunction with that additional limiting language
5 to provide meaning to the claim term overall. Because clearly, a screw is
6 something that goes in your mouth or a toothbrush. Those items are not
7 items that would satisfy that additional limitation of being configured and
8 dimensioned to surround at least a portion of the teeth of the patient.

9 MR. KARISH: Well, let me move forward then and move to Slide
10 9 of Exhibit 2011, where we're going to talk about what the Patent Owner
11 believes mouthpiece stands for. So the bottom line is that this "mouthpiece"
12 language and the rest of that language "surround at least a portion of the
13 patient's teeth" were both explicitly relied on by the examiner to distinguish
14 Llop. So we think that the whole phrase needs construction.

15 The patent is a rather simple document in terms of it teaches a
16 mouthpiece that looks like something a boxer wears that they put over their
17 teeth, that is attached to the fixation base. And once that mouthpiece is
18 placed over the teeth, the fixation base is in the proper position for fastening
19 to the jawbone.

20 So again, we think that there's a dispute over what that term means
21 clearly between the Petitioner and the Patent Owner. They think it covers
22 things -- that cover dentures and just tissue. And we totally disagree, and I
23 will kind of explain why that is in a few minutes. But regardless, there's a
24 serious dispute over this term and we believe it needs to be construed in
25 order to apply the prior art to the patent in suit.

26 So the '209 Patent does not teach any mouthpiece that is used on

1 toothless or what they're calling edentulous patients, and that was admitted
2 by Petitioner's own expert. The inventor deliberately excluded any
3 discussion of edentulous patients or dentures in the '209 Patent. There is
4 discussion and images of that in the provisional. They were intentionally
5 excluded.

6 And then again, the Petitioner's own expert admitted that the
7 inventor deleted numerous instances, language, and drawings regarding the
8 edentulous patients from the provisional. And I think what this really comes
9 down to is it's a contest between experts, where their expert says it should
10 have this very broad construction that's not what he's ever heard as one skill
11 in the art versus Patent Owner's expert who says, hey, I read this patent and
12 this is how one of skill in the art would understand this language.

13 So moving on to Paper 8 -- I'm sorry, Slide 10. The case law is
14 very clear that when a Patent Owner materially alters the specification from
15 a provisional, one skilled in the art would understand that alteration to
16 indicate an evolution of the applicant's intended meaning of the claim term.
17 And there are several cases there on this. There are a couple of them on
18 -- cited on Slide 10. But there are a couple things to keep in mind.

19 FMC Corp. v. Sharda makes clear two important points. It says
20 that it does not matter if the change broadens or narrows the scope of the
21 claims, that the change can indicate either of those things. And secondly, it
22 cites -- FMC Corp. cites to Finjan LLC versus ESET for the very clear
23 conclusion that it doesn't matter if the patent incorporates the provisional by
24 reference. It's just not relevant to the determination of whether the material
25 alteration indicates an evolution in the intended meaning of the claim term.

26 And here, we think it's very clear that all of the instances were

1 taken out. And on top of that, the language itself references teeth, the rest of
2 the claim. There's nothing here about edentulous patients. These claims
3 don't apply to edentulous patients. There's nothing in the patent about
4 edentulous patients.

5 So before I move on to the next "surround at least a portion of the
6 teeth." I just want to give you -- ask if you have any questions about this.

7 Okay. So moving on to the term "surround at least a portion of the
8 teeth," Patent Owner contends that this should be construed as enclose at
9 least some teeth of the patient. Again, this construction is evident from the
10 specification. It states that the mouthpiece is configured in dimension to
11 surround teeth of the patient. And that is what is shown, as I'll demonstrate
12 in Figures 12a through 12d. And the accompanying portion of the
13 specification relating to those figures, the mouthpiece is shown in additional
14 detail. Turning to Slide 12, Figure 12c --

15 JUDGE SNEDDEN: If we can pause, I may have lost video
16 connection.

17 MR. KARISH: Of course.

18 JUDGE SNEDDEN: (INDISCERNIBLE - TECHNICAL
19 DIFFICULTY).

20 MR. KARISH: Okay. No problem.

21 JUDGE TARTAL: Before you continue on, let's confirm that we
22 have him connected.

23 MR. KARISH: He does look very stationary. Does the clock keep
24 running, Your Honor? It's okay. But I mean, I think I should have time.

25 JUDGE TARTAL: Okay. You're fine if you need additional time.

26 MR. KARISH: I don't think it'll be an issue.

1 JUDGE SNEDDEN: Thank you. I'm back now.

2 MR. KARISH: Actually, before I move on to the second claim
3 term, I just want to go back to this provisional. So let me move it over to the
4 screen so that you can see it if I can figure out how to do that. So here is the
5 exhibit that is the provisional patent application. And in this provisional,
6 there's a Figure 2b that is relied on by the Petitioner to discuss a tissue-borne
7 guide.

8 But that's actually not what the picture shows. The picture actually
9 shows a tooth-borne or denture clone. So the portion of the parent
10 application that the Petitioner is referring to that says, hey, our tooth-borne
11 embodiment is supported by this figure of the provisional is because it says
12 tooth-borne or denture clone. And they are just doing belt and suspenders in
13 support of their tooth-borne mouthpiece.

14 So with that, let me return to what I -- oops, struggling -- where is
15 the mouse? There it is. Okay. So let me go back to this. Okay. So moving
16 on to the limitations "surround at least a portion of the teeth," returning back
17 to that 12c -- and the reason I want to address this candidly, Your Honors, is
18 the institution decision focused on Figure 4 of the '209 Patent. And it
19 referenced that it was a little bit unclear from Figure 4 exactly what the
20 mouthpiece covered. And so I just want to make sure that it's clear that
21 Figures 12c and 12d show that the mouthpiece goes completely over the
22 teeth.

23 Again, like a mouthpiece worn by a boxer, it is attached -- so the
24 mouthpiece is 122, it is attached to the fixation base, which is labeled as 100
25 in those figures. And the whole thing goes completely over the teeth. The
26 drill -- there are holes drilled in the fixation base. And then pins are driven

1 into the holes. And then the mouthpiece is removed from the fixation base,
2 which is then used for the remainder of the procedure.

3 JUDGE TSANG: Mr. Karish --

4 MR. KARISH: Yes?

5 JUDGE TSANG: -- it almost looks like those are cutouts in the
6 mouthpiece because you can see that in one of them, there's a curved line
7 that maybe looks like a portion of a tooth?

8 MR. KARISH: That is correct, Your Honor. It is illustrating some
9 windows in the mouthpiece so that you can see if the teeth are fully inserted
10 into -- certain the teeth at least are fully inserted into the mouthpiece.

11 JUDGE TSANG: So then how do you reconcile that with the
12 argument that the mouthpiece completely encloses the teeth?

13 MR. KARISH: Well again, I think the proper construction is that
14 it completely encloses at least some teeth. And that's why that language is in
15 there, so that if there is a window that's partially open on one or more of the
16 teeth it doesn't impact the fact that certain of the teeth are completely
17 enclosed.

18 I also just -- we talked briefly during the -- in the Petitioner's
19 statement about how this limitation "surround at least a portion of the teeth"
20 is capable of multiple different meanings. It could be a little bit of some
21 -- of one of the teeth, a little bit of all of the teeth. It could mean a lot of
22 different things.

23 And I just would like to remind the Court of the Phillips v. AWH
24 case, which states that if there are multiple different claim constructions that
25 are possible, that the claim should be construed in a way that preserves
26 validity. And again, I think this phrase mouthpiece that "surrounds at least a

1 portion of the teeth" was explicitly relied on by the examiner to distinguish
2 Llop, and that shouldn't be disturbed.

3 So let me move on to Slide 13. It is the Patent Owner's position
4 certainly that neither Llop nor Sichuan teach a mouthpiece, as that term is
5 properly construed as a device that is inserted into the mouth and worn over
6 the teeth, in view of the patent and the file history. Again, during argument,
7 the Patent Owner made it clear that that mouthpiece fits like a hand in a
8 glove, and that is not how any of the Llop, Sichuan, or Yau devices work.

9 So moreover, regardless of mouthpiece is ultimately construed, we
10 submit that neither Llop nor Sichuan teach a mouthpiece that is dimensioned
11 and configured to surround at least a portion of the teeth, which again, Patent
12 Owner believes should be construed as enclose at least some teeth of the
13 patient.

14 We kind of illustrate that in Slide 14. Looking at Llop, the -- Llop
15 has struts which -- so let me just back up. Page 14 shows two figures of
16 Llop. Figure 1 on the left side is the embodiment that has struts that have
17 indentations at the top of them. And Llop is clear that those indentations can
18 match portions of the teeth of the patient. And clearly, those struts -- well,
19 let me actually -- on the right side of the page is Figure 29. It shows a tooth
20 mold, a prosthesis that, again, mates with the teeth on the opposing jaw of
21 the patient. So there's no doubt that when it mates with those opposing
22 teeth, there's contact there between those teeth.

23 And so either the struts on the left or the prosthesis on the right
24 would fall under a mouthpiece according to the Patent Owner's definition.
25 And they're of course not described as a mouthpiece in that -- in the Llop
26 Patent. But the examiner saw that and understood that the claim language

1 meant something else.

2 And so even when you -- so moving on to the next Slide 15, even
3 when you combine Llop and Sichuan, Sichuan has these tiny impressions in
4 a bite plate. I don't know why those would be considered any different than
5 the indentations in the struts of Llop or the prosthesis of Llop. Why is it any
6 better? Why does it have a mouthpiece that surrounds at least some of the
7 teeth? It doesn't. It just has little indentations, which is exactly what the
8 examiner agreed was different from Llop.

9 Moving on to Slide 16. A person of skill in the art would not have
10 been motivated to combine Llop and Sichuan. And basically, Petitioner has
11 talked about how Patent Owner's expert agreed that they were the same
12 -- they were directed to the same thing. The expert never agreed to that at
13 all. The expert made it clear that a person of ordinary skill in the art of
14 implant dentistry is not trained to perform a subapical osteotomy, is not
15 qualified to perform a subapical osteotomy and would never perform one.
16 And there's no evidence to the contrary.

17 JUDGE TARTAL: Counsel, can I just ask you, are you making a
18 non-analogous art argument? I'm not sure if you use those words in the
19 briefing.

20 MR. KARISH: Yes.

21 JUDGE TARTAL: But is your argument --

22 MR. KARISH: Yes.

23 JUDGE TARTAL: -- that it's non-analogous art and did you
24 address the two prongs as to what non-analogous art constitutes?

25 MR. KARISH: Well, we think that this is for a totally different
26 type of surgery. And we think that although it's attaching something to a

1 jaw, it's attaching something totally different and it's outside the realm of
2 what a normal implant dentist would do.

3 And again, the parties kind of agreed on who someone of skill in
4 the art was for this case. There was no dispute about that. And so that
5 person would have no exposure to this. And so the best that the Petitioner
6 could do was argue that there might be some information about this
7 procedure in a dental school library. And they just -- that's not based on
8 anything. They just thought maybe that's where you would find it. So
9 again, we just don't see how a person of skill in the art looks at this Sichuan
10 reference at all. So that's all I have on that.

11 So moving on to Slide 17 of Exhibit 2011. Neither Llop nor Yau
12 teach a mouthpiece as a -- as properly construed as a device that is inserted
13 into the mouth and worn over the teeth. And again, regardless of how
14 mouthpiece as a term is construed, neither Llop nor Yau teach a mouthpiece
15 dimensioned and configured to surround at least a portion of the teeth, which
16 again, as Patent Owner contends, that should be construed as "enclose at
17 least some teeth of the patient."

18 Moving to Slide 18. Again, the examiner noted that the struts and
19 the tooth molds taught by Llop do not constitute a mouthpiece configured in
20 -- sorry, dimensioned and configured to surround at least a portion of the
21 teeth. And Llop combined with Yau is no better.

22 Moving to Slide 19. We, again, show the prosthesis version of
23 Llop on the left, where you have simulated teeth that again mate with the
24 teeth on the upper jaw and theoretically contact surfaces of those upper
25 teeth. That's the whole point of the prosthesis of Llop. So when you add
26 this bite plate of Yau, again, you don't end up with a mouthpiece as claimed

1 that encloses at least some teeth of the patient.

2 I don't want to belabor this, but the bottom line is that Patent
3 Owner's expert Jeff Elo, Dr. Jeff Elo states that no one would be motivated
4 to modify the anchoring struts of Llop or the -- sorry, the prosthesis of Llop
5 to have the tooth mold of Yau. He just didn't see any reason why anyone
6 would -- it doesn't change anything, why would someone do it? So --

7 JUDGE TARTAL: Just to clarify, Counsel.

8 MR. KARISH: Yes.

9 JUDGE TARTAL: Is it your understanding or your argument in
10 terms of page 19 that on Llop on the left-hand side of Figure 29, it's showing
11 -- I don't have the numbering in front of me, but let's assume it's 204 or the
12 teeth at the top of the figure that are being used to engage the upper jaw.
13 And then on the right-hand side, Yau is showing in green what --

14 MR. KARISH: I think it's -- Yau is actually a little bit unclear as
15 to exactly what that green tooth mold entails, whether it is a mirror of the
16 upper teeth or whether it is an image of the lower teeth that mate with the
17 upper teeth. But again, either way, it only touches a very small amount of
18 the teeth on that opposite jaw.

19 JUDGE TARTAL: Okay. Thanks.

20 MR. KARISH: So I want to address the Patent Owner's evidence
21 of secondary indicia. So the Patent Owner submitted a -- again, in contrast
22 to the representation by the Petitioner, it's clear in the -- I'm sorry, in the
23 declaration of Alan Banks, again, it's -- Exhibit 2006 is the Banks'
24 declaration. He does provide a detailed mapping of the claimed invention
25 onto one of the products, the CHROME GuidedSMILE products. Expert
26 testimony is not required to do this.

1 It is -- we cited some case law there. But in many patent cases,
2 expert testimony is not necessary because the technology is easily
3 understandable without the need for expert testimony. I think this is clearly
4 one of those cases. This is just a simple mechanical invention. So there's
5 certainly no expert testimony required.

6 Moving on to Slide 22. Again, the GuidedSMILE family of
7 products is not relevant. Banks' declaration is directed to the CHROME
8 GuidedSMILE products, and no other GuidedSMILE family members are
9 mentioned in the Banks' declaration. There's no declaration evidence about
10 sequential guides versus -- this is a stackable -- what they call a stackable
11 guide system. There's nothing in the -- CHROME GuidedSMILE product
12 has nothing to do with sequential guides.

13 And just to be clear, again, sequential guides, you put in this
14 fixation base and you drill some holes. Then you take that off. And you put
15 in another guide. And you use those same holes to attach the next thing.
16 Then you take that off. Then you keep going. So that's a sequential system.
17 This is a stackable system. And he is directing this to a specific product.

18 Petitioner rightly brings up some features of Patent Owner's
19 products that were the subject of other patents and some of those features
20 were used to distinguish some prior art in those patents. But there's no
21 evidence that those features are relevant to the secondary indicia factors, that
22 they affected sales or the public perception of the device.

23 JUDGE TARTAL: Counsel, I think this goes to the co-
24 extensiveness issue that Petitioner raises. And I guess the first question is,
25 can you explain to us how you've addressed that in the context of secondary
26 considerations? And then in reference to the Patent Owner response -- I'm

1 looking at pages 52 and 53 -- on page 53 of the Patent Owner response, it
2 pretty explicitly says the fixation base is designed using patent-pending
3 floating guide technology, meaning the guide does not contact the one that is
4 supported by divergent pin placement, which is not a limitation at issue in
5 the '209 Patent here.

6 So Patent Owner's own briefing identifies patent-pending floating
7 guide technology that's part of the product that is not claimed here. How do
8 you reconcile that in terms of whether or not the patent you're relying upon
9 -- or excuse me, the product you're relying upon is co-extensive with the
10 limitations of the '209 Patent?

11 MR. KARISH: I'm sorry, Your Honor, can you tell me which
12 pages you were referring to again? 53?

13 JUDGE TARTAL: At the top of page 53 of the Patent Owner
14 response, which is Paper 12.

15 MR. KARISH: Okay. Where it says the fixation base is -- uses
16 patent-pending floating guide technology -- I see it now. Again, I'm not sure
17 -- I don't -- this is an unclaimed feature of the product, but it is not
18 necessarily different than other products in the marketplace. It's not
19 necessarily something that has anything to do with why these products are
20 successful in the market. I mean it's marketing puffery, I grant you. But
21 again, products in the marketplace pin these guides to the jaw.

22 JUDGE TARTAL: How does it relate to the co-extensiveness
23 issue, though, whether or not the product is co-extensive with the limitations
24 of the '209 Patent, or instead a product that includes additional features that
25 are not co-extensive with the '209 Patent?

26 MR. KARISH: So I do think it -- there are certain features beyond

1 the '209 Patent, but I don't think they're significant. And again,
2 unfortunately it falls on the panel to try to figure out what is significant and
3 what is not. I would urge the panel, as the Patent Owner, that these features
4 are not the reasons behind the secondary indicia of non-obviousness
5 presented.

6 So let me just return to this. Sorry, I am now on Slide 23. Mr.
7 Banks testifies in his declaration that there is evidence of long-felt need here.
8 Even though Petitioner tries to muddy the water here with regard to this
9 evidence, I think it has to be considered. And so I'll just leave it at that.

10 Mr. Banks' testimony about commercial success is evidence of
11 commercial success independent of the sales chart that was submitted as part
12 of Patent Owner's response. And I think there's been strong interest in the
13 CHROME GuidedSMILE product as shown. Even if Petitioner is correct
14 and that some of these awards are based on interest of readers, that itself
15 shows that there's something potentially new and non-obvious here that
16 people are interested in.

17 So moving to page 24, I think the last thing is evidence of copying
18 by the Petitioner itself. And so the bottom line is, Petitioner had a sequential
19 system on the left and a system that didn't use a mouthpiece like the one
20 being claimed. And then after this patent came out and plaintiff's products,
21 presumably -- I'm sorry, Patent Owner's products, presumably, the Petitioner
22 changed their design to have a mouthpiece that fits over the teeth to set the
23 fixation base. So I think there's significance -- there's significant evidence
24 here of secondary indicia of non-obviousness.

25 So let me wrap up on Slide 25. Again, mouthpiece should be
26 construed as a device that is inserted into the mouth and worn over the teeth,

1 as laid out in Exhibit 2007 by witness Dr. Jeff Elo. And the term "surround
2 at least a portion of the teeth" should be construed as enclose at least some
3 teeth of the patient. All of the references in the petition, considered alone
4 and in combination, fail to teach or disclose a mouthpiece configured in
5 dimension to surround at least a portion of the teeth of the patient as recited
6 in all of the challenged claims. Additionally, there is substantial evidence of
7 non-obviousness supporting the patentability of the claims.

8 So for each of those reasons, the Patent Owner respectfully
9 requests the Board to confirm the patentability of the challenged claims.
10 And with that, just again let me say thank you for your consideration. And
11 do you have any questions for me?

12 JUDGE SNEDDEN: No questions.

13 MR. KARISH: Okay.

14 JUDGE TARTAL: We will reserve about five minutes of your
15 time in addition to your rebuttal time.

16 MR. KARISH: Thank you very much, Your Honors.

17 JUDGE TARTAL: That is five minutes in addition to the ten
18 minutes you already reserved.

19 MR. KARISH: Understood, Your Honor. Thank you.

20 MR. FEIGELSON: Thank you, Your Honor. And I'll start just by
21 addressing my surprise or even shock that the -- I believe Patent Owner's
22 counsel just called one of their core features of the floating guide called it
23 marketing puffery, which the record clearly shows it's not. I'll show that in a
24 minute.

25 But going back to the claim construction on mouthpiece -- and
26 there's something that's markedly missing from Patent Owner's presentation,

1 and that's really just first principles of claim construction. Patent Owner has
2 put forward this proposed construction of mouthpiece as being something
3 that goes in the mouth and goes over the teeth. That is just unsupported.
4 There's nothing that's pointed to in the claims or in the specification or in the
5 prosecution history to support that. Instead, the only thing potentially
6 driving that particular construction is a second definition from the American
7 Heritage Dictionary to the exclusion of anything else, that just doesn't seem
8 right.

9 Again, the Patent Owner here was its own lexicographer. And if
10 they wanted to draft the claims in a more limited manner, they certainly
11 could have done that and drafted mouthpiece in the way that they would,
12 like now. But they didn't do that. There's also nothing at all in the
13 specification or the prosecution history about mouthpiece that's used by a
14 boxer or other sports player, that's not there. That's something which
15 seemed to be grafted on as well. So a lot of the Patent Owner's argument
16 seems to be what I would call a straw man argument.

17 And Patent Owner has said that Petitioner has suggested a
18 definition for the term and proposed a definition. That's just not the case.
19 Right. Petitioner has never put forward a definition proposed for
20 mouthpiece. Petitioner has said that it doesn't think construction is
21 necessary. However, to the extent that you are going to potentially construe
22 that term, it has to be broad enough to include that denture clone that was
23 found in the provisional, that was expressly reintroduced by reference in this
24 patent, in the '209 Patent, so that's one.

25 The other straw man that I'd like to point out has to do with Llop
26 -- and I'll put this on the screen. So Petitioner -- Patent Owner, in their Slide

1 14, put up this picture and made the comment that the Llop on the left, that
2 the examiner allowed the claims of the '209 Patent over Llop by
3 distinguishing the -- that Llop struts. And then he said also the indentations
4 on top as not being a mouthpiece that's configured and dimensioned to
5 surround teeth.

6 That's partially correct, but it's partially not correct. And the
7 reason it's not correct is because the examiner did not consider those
8 indentations at all in its -- in allowing the claims. The examiner was focused
9 on the language "being configured and dimensioned to surround teeth of the
10 patient." And the argument that was raised by the applicant was that there
11 were no teeth to go around. And it wasn't that the indentations weren't a
12 mouthpiece. It didn't sufficiently, you know, go over teeth or anything like
13 that. It was that because in the applicant's view, Llop was limited to an
14 edentulous case. There weren't any teeth, so it couldn't surround teeth.
15 That's what the examiner allowed. The examiner didn't consider the
16 indentations on top. The examiner also didn't consider them tooth molds, as
17 has been represented by the Patent Owner.

18 I'll also address the Patent Owner cites a case, we'll turn to
19 secondary considerations. And at the end of Patent Owner's presentation,
20 they cite a case, the Centricut case. And I believe that is on page 21 of its
21 Exhibit 2011. And they -- the Patent Owner says that that case stands for the
22 proposition that expert testimony is not required to show this claim mapping
23 for co-extensivity -- co-extensiveness.

24 In fact, that Centricut case has nothing to do with nexus at all. It's
25 about patent infringement, improving infringement. And the Patent Owner
26 stopped that quote a little too short because if you read that case further, that

1 case actually shows that expert testimony generally is needed unless that
2 technology is easily understandable. Otherwise, for complex technologies,
3 the Court said expert testimony is -- it actually says it's sometimes essential.
4 And again, this in the infringement context, it's not about the nexus context.

5 JUDGE TARTAL: Counsel, can I ask you to turn to Slide 28 of
6 Petitioner's exhibits?

7 MR. FEIGELSON: Petitioner's exhibits, yes.

8 JUDGE TARTAL: And then similar to the question I had asked
9 for Patent Owner, but the slide shows the disclosures of Yau. For our
10 benefit, can you just explain how you contend -- I'm not sure what figure
11 number that is of Yau. But how the figure shown on Slide 28 corresponds to
12 the limitations of the claim as Patent Owner proposes construing them. This
13 corresponds to your contention that regardless of what construction we
14 adopt, the art teaches that feature.

15 MR. FEIGELSON: Yeah, certainly. So in our understanding is
16 that the green, those are tooth molds and Yau says those could be separate
17 pieces. It also says that it could be formed as a single piece. So we can
18 imagine that being a single mouthpiece with those three parts connected.

19 Our understanding is that those are tooth molds that match -- in
20 this case, it would match the upper teeth. So when the upper teeth -- when
21 the patient here bites, those upper teeth would go into those tooth molds and
22 there would be a tight engagement. That's what the patent calls for. And
23 that's what would be used then to properly position that yellow guide that
24 gets placed onto the jawbone.

25 JUDGE TARTAL: And your explanation, the idea being that
26 those tooth molds are molds of the upper teeth that are being placed within

1 the molds -- or are they molds of the lower teeth?

2 MR. FEIGELSON: They're molds of the -- our understanding,
3 again, from the plain language of the patent, it was translated. But from the
4 plain language of the patent, it would appear to be molds of the upper teeth.
5 So when the upper teeth bite down, they go into those molds which then are,
6 you know, configured and dimensioned to surround those upper teeth for
7 tight engagement. And that is what is used to set the yellow guide.

8 JUDGE TARTAL: Thank you.

9 MR. FEIGELSON: So the last thing that I'll point out, a lot more
10 thing about copying. And the Patent Owner here has not alleged -- they
11 haven't -- they didn't allege access, and they also did not allege substantial
12 similarity between the Patent Owner's product and the Petitioner's product or
13 any other product. They just said that a newer version of Petitioner's product
14 had a fixation base that attaches to the mouthpiece. That's all. They didn't
15 say anything else about the other features.

16 And on the other hand, Petitioner showed that there are some
17 substantial differences in the operation of those two things. And under the
18 law, you need to show -- for copying, you need to show more than just one
19 feature which is similar. Otherwise, the test for copying gets conflated with
20 the test for infringement. And that's incorrect under the law. Unless there's
21 any other questions, I'll thank the Board for their time and consideration.

22 JUDGE TARTAL: The panel has no additional questions for
23 Petitioner at this time and we thank you for your argument. Patent Owner,
24 we can turn to you when you're ready. And as I indicated, I think you have
25 15 minutes, you know. So you can begin when you're ready.

26 MR. KARISH: Just momentarily, Your Honor. I'm just struggling

1 with something. Okay. I'm ready, Your Honor. I will confine myself to the
2 points raised in the rebuttal of Petitioner.

3 So the first issue is the term mouthpiece. Again, Petitioner alleges
4 that there's no support whatsoever for plaintiff's -- sorry, Patent Owner's
5 proposed construction and takes the position that there's absolutely nothing
6 in the spec or the file history that would support this. And there are multiple
7 things that I do think support it. And so I want to bring them up.

8 The first is this idea of a hand and glove relationship between the
9 mouthpiece. This was language that was used in the prosecution history of
10 the patent and that clearly the examiner considered important in deciding to
11 allow the claims.

12 Petitioner did put forward a definition of mouthpiece. Again,
13 they're clearly trying to distance themselves from it. They had an expert,
14 and their expert, Dr. Erickson, testified that he thought the -- sorry, I've just
15 got a mess here. Dr. Erickson, again, said that he thought it meant any
16 dental device placed in the mouth. So again, that was the definition they put
17 forth.

18 As to their argument that the limitations of the provisional
19 application were somehow reintroduced by a -- incorporation by reference of
20 the provisional. Again, I think the case law is very clear on this, that that
21 does not apply if looking at the Finjan case. So that's all I have on
22 mouthpiece unless the Board has any questions for me.

23 JUDGE TARTAL: If you can turn to Patent Owner's -- on Slide
24 19 of Patent Owner's exhibits.

25 MR. KARISH: Oh, yeah. Okay.

26 JUDGE TARTAL: Can you perhaps just address what Patent

1 Owner's contentions are as to the extent Yau discloses tooth molds that
2 match the upper teeth, whether that is -- there is not a hand and glove
3 configuration as Patent Owner used those.

4 MR. KARISH: So I don't want to nitpick here. This patent
5 actually wasn't translated. The Yau reference is actually a -- my monitor is
6 not showing the patent, so I can't see it. But you know what, let me just
7 change the way I'm doing this. Maybe this will help it. Sorry, Your Honor.
8 I'm just going to try to pull up the patent. I mean, I have it up, I just need to
9 see it. Okay. Of course it's gone now. I think this is it. So let me just pull it
10 up really fast.

11 This is the Yau Patent. It's in English. If you look at it, it is just a
12 little bit unclear as to whether it is comprising a tooth mold that is the tops of
13 the lower teeth or an imprint of the upper teeth. But Petitioner's counsel is
14 correct. The patent specifies that they are designed for "tight engagement
15 with the natural teeth." But we submit that tight engagement does not
16 necessarily mean surround. It just means it could butt up against those teeth
17 rather than surround, you know, at least a portion of the teeth.

18 And so I don't think it matters if you determine that this is a mold
19 of the upper teeth or a mold of the lower teeth that normally touch the upper
20 teeth. Either way, they don't fit over the teeth, and they don't entirely
21 surround any of the teeth of the patient.

22 JUDGE TARTAL: Thank you. That's all.

23 MR. KARISH: Okay. I just want to touch on Llop briefly.
24 Petitioner's counsel makes a point of saying what the examiner considered.
25 And I just would argue that there's no way of knowing exactly what the
26 examiner considered, but that I presume the examiner fully understood what

1 Llop was teaching and why the mouthpiece of the present invention is
2 different than that mouthpiece.

3 Again, moving to the nexus argument, where Petitioner's counsel
4 discusses the Centricut case. The bottom line is that if a layperson can do a
5 detailed claim chart for purposes of infringement, it's certainly analogous to
6 doing a claim chart for purposes of nexus. And Counsel doesn't point to any
7 errors in that application of the claims to the product by Mr. Banks.

8 And then finally, in terms of the copying by the Petitioner, I think
9 that the Patent Owner statements are sufficient to allege that the Petitioner
10 copied the relevant product of the Patent Owner. And again, the Petitioner is
11 not saying, hey, we didn't have access, or no, we didn't copy it. They're just
12 saying, hey, we have some other things in there. And so I'm just not sure
13 that's relevant.

14 I mean, the test is whether they copied certain features of the
15 product. And as we're talking about, this mouthpiece feature is pretty
16 critical to this product. So that's all I have on this. Your Honors, I just want
17 to, again, thank you for your consideration, unless you guys have any
18 questions for me.

19 JUDGE TARTAL: Thank you, Counsel. The panel does not have
20 any additional questions for the parties at this time. But I just express our
21 appreciation for you appearing before us today and for patiently taking our
22 questions and providing the answers that we were seeking. We'll take this
23 case under advisement and issue our decision in due course. We are
24 adjourned.

25 (Whereupon, the above-entitled matter went off the record at 3:02
26 p.m.)

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Patent 11,806,209 B2

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