

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

DENTSPLY SIRONA INC.
Petitioner

v.

OSSEO IMAGING, LLC.
Patent Owner

U.S. PATENT NO. 8,498,374
IPR2025-00787

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION FOR
DISCRETIONARY DENIAL**

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EXHIBIT LIST

No.	Description
Ex. 1001	U.S. Patent No. 8,498,374 (the “374 patent”).
Ex. 1002	U.S. Patent No. 6,381,301 (the “301 patent”).
Ex. 1003	U.S. Patent No. 6,944,262 (the “262 Patent”).
Ex. 1004	U.S. Patent No. 8,498,374 (the “374 patent”) Prosecution History.
Ex. 1005	U.S. Patent No. 6,381,301 (the “301 patent”) Prosecution History.
Ex. 1006	U.S. Patent No. 6,944,262 (the “262 Patent”) Prosecution History.
Ex. 1007	Declaration of Dr. Milan Sonka (“Sonka”).
Ex. 1008	Curriculum Vitae of Dr. Milan Sonka.
Ex. 1009	Markman Order, Dkt. 46, <i>Osseo Imaging, LLC v. Planmeca USA Inc.</i> , 1-17-cv-01386 (D. Del. 2017).
Ex. 1010	Markman Memorandum, Dkt. 44, <i>Osseo Imaging, LLC v. Planmeca USA Inc.</i> , 1-17-cv-01386 (D. Del. 2017).
Ex. 1011	Markman Transcript, Dkt. 41, <i>Osseo Imaging, LLC v. Planmeca USA Inc.</i> , 1-17-cv-01386 (D. Del. 2017).
Ex. 1012	Summary Judgment Hearing Transcript, Dkt. 143, <i>Osseo Imaging, LLC v. Planmeca USA Inc.</i> , 1-17-cv-01386 (D. Del. 2017).
Ex. 1013	U.S. Patent No. 6,118,842 (“Arai”).
Ex. 1014	Cann, et al., “Precise Measurement of Vertebral Mineral Content Using Computed Tomography,” <i>Journal of Computer Assisted Tomographs</i> 4(4) 493–500 (August 1980) (“Cann”).
Ex. 1015	International Publication No. WO 94/10908 (“Pelc”).
Ex. 1016	Stephen L.G. Rothman, DENTAL APPLICATIONS OF COMPUTERIZED TOMOGRAPHY: SURGICAL PLANNING FOR IMPLANT PLACEMENT (Quintessence Books 1998) (“Rothman”).

No.	Description
Ex. 1017	International Publication WO 01/39667 (“Massie”).
Ex. 1018	U.S. Patent No. 5,533,080 (“Pelc ‘080”).
Ex. 1019	U.S. Patent No. 6,363,163 (“Xu”).
Ex. 1020	International Publication WO 98/36683 (“Milestone”).
Ex. 1021	Jerrold T. Bushberg, <i>THE ESSENTIAL PHYSICS OF MEDICAL IMAGING</i> (Williams & Wilkins 1994) (“Bushberg”).
Ex. 1022	Genant <i>et al.</i> , “Bone Densitometry: Current Assessment,” <i>Osteoporosis International</i> S:91–97 (1993) (“Genant 1993”).
Ex. 1023	Genant <i>et al.</i> , “Current State of Bone Densitometry for Osteoporosis,” <i>Radiographics</i> 18(4):913–918 (1998) (“Genant 1998”).
Ex. 1024	U.S. Patent No. 5,214,686 (“Webber”).
Ex. 1025	21 C.F.R. § 1020.31 (April 1998).
Ex. 1026	U.S. Patent No. RE 36,162 (“Bisek”).
Ex. 1027	U.S. Patent No. 6,243,439 (“Arai ‘439”).
Ex. 1028	Godfrey N. Hounsfield, “Computed Medical Imaging,” Nobel Lecture (Dec. 8, 1979), <i>available at</i> https://www.nobelprize.org/uploads/2018/06/hounsfield-lecture.pdf .
Ex. 1029	Grant, “TOMOSYNTHESIS: A Three-Dimensional Radiographic Imaging Technique,” <i>IEEE Transactions on Biomedical Engineering</i> , BME-19(1):20–28 (Jan. 1972) (“Grant”).
Ex. 1030	U.S. Patent No. 6,073,044 (“Fitzpatrick”).
Ex. 1031	Hosie <i>et al.</i> , “A Gamma Ray Computed Tomography Scanner for the Quantitative Measurement of Bone Density,” <i>Journal of Biomedical Engineering</i> 7:30–34 (Jan. 1985) (“Hosie”).

No.	Description
Ex. 1032	World Health Organization, “Assessment of Fracture Risk and Its Application to Screening for Postmenopausal Osteoporosis,” WHO Technical Report Series 843 (1994) (“WHO 94”).
Ex. 1033	Venkatesh <i>et al.</i> , “Cone Beam Computed Tomography: Basics and Applications in Dentistry,” <i>Journal of Istanbul University Faculty of Dentistry</i> , 51(3 Suppl 1): S102-121 (December 2017) (“Venkatesh”).
Ex. 1034	Summary Judgment Answering Brief in Opposition, Dkt. 131, <i>Osseo Imaging, LLC v. Planmeca USA Inc.</i> , 1-17-cv-01386 (D. Del. 2017).
Ex. 1035	Mozzo <i>et al.</i> , “A new volumetric CT machine for dental imaging based on the cone-beam technique: preliminary results,” <i>Eur. Radiol.</i> , 8: 1558-64 (1998) (“Mozzo”).
Ex. 1036	Noo <i>et al.</i> , “Stable and Efficient Shift-Variant Algorithm for Circle-Plus-Lines Orbits in Cone-Beam C.T.,” <i>Institute of Electrical and Electronics Engineers</i> , Conference Date: Sept. 19, 1996 (“Noo”).
Ex. 1037	Lindh <i>et al.</i> , “Quantitative computed tomography of trabecular bone in the mandible,” <i>Dentomaxillofacial Radiology</i> , 25:146–150 (1996) (“Lindh”).
Ex. 1038	Sonka, M., & Fitzpatrick, J. M. (Eds.). (2000). <i>Handbook of Medical Imaging, Volume 2: Medical Image Processing and Analysis</i> . SPIE Press. (“SPIE”).
Ex. 1039	Correspondence between Patent Owner and Petitioner

I. INTRODUCTION

Dentsply Sirona Inc., (“Petitioner”) hereby respectfully requests that the Board deny Osseo’s (“Patent Owner” or “PO”) request to discretionarily deny this *inter partes* review (IPR) of U.S. Patent No. 8,498,374 (“the ’374 Patent”).

First, the Patent Owner fails to address the critical fact that the Petitioner has settled expectations, given that the Board has already indicated that the claims are likely unpatentable when it previously instituted an IPR on similar grounds.

Second, the Board during that same Institution Decision already provided findings in relation to discretionary denial, and found institution warranted. Third, the

proposed rejections are based on new technology and Patent Owner admissions, which Patent Owner fails to rebut, showing the strength of the current challenge.

Fourth, and finally, the understanding between the parties was that Petitioner would not be subject to a lawsuit by Patent Owner, and Patent Owner is the one who broke the understanding between the parties. These four primary points, as well as other arguments presented below, weigh in favor of denying the current motion for discretionary denial.

First, Patent Owner’s Request for Discretionary Denial discounts the most critical fact, which is that the Board, in a prior IPR, has already determined there is a reasonable likelihood that the ’374 Patent is unpatentable. Patent Owner does not provide a rationale as to why the Director should deny an IPR on a patent that the

Board has already stated is likely to be found unpatentable. Further, the Petition presents prior art based on a different technology than previously considered in other forums, including in district court. It is this prior art that the Board has previously found raises a reasonable likelihood of prevailing on the merits. Thus, the issues here are straightforward, and the only tribunal to have looked at them is the Board, which found against the Patent Owner.

Second, Patent Owner fails to address the Board’s prior discretionary denial decision based on the same art and similar circumstances. In a prior proceeding, the Board stepped through each of the factors for discretionary denial and found that the currently applied art is different than what was addressed in the Planmeca district court litigation, and the test weighed in favor of Institution. Patent Owner provides no new facts that should disrupt the Board’s prior decision. The Board was aware of the Planmeca district court litigation, familiar with the art and arguments presented, and knowledgeable about claim constructions; yet, it still found Institution was warranted. With the Board already aware of the Planmeca litigation and finding it to involve different art and arguments, resolution of the Planmeca case has little impact on the analysis the Board has already undertaken. Most importantly, Patent Owner provides no argument that the Board should overturn its prior decision. *See* IPR2025-00370, Paper 10 at 3 (“It is an appropriate use of Office resources to provide consistency and predictability to the public, and

to ensure that a patent applicant or owner does not take action inconsistent with the judgment in a prior Office proceeding.”) Patent Owner simply ignores the prior ruling and hopes the Board will deny this IPR, allowing a patent that the Board has found likely to be unpatentable to escape review.

Third, Patent Owner cannot dispute that the validity challenge is strong, as previously found by the Board. Instead, Patent Owner now seeks discretionary denial to avoid having to contend with the compelling merits of the instant Petition. The Board should deny the present motion and remain consistent with the settled expectations between the parties that the Board believes the claims of the ’374 Patent are likely not patentable.

Also, the Director has recently explained that evidence of material error by the Office can outweigh other discretionary denial factors. IPR2025-00318, *Microsoft Corp. v. Partec Cluster Competence Center GMBH*, Director’s Decision, Paper No. 9 at 3 (“Ordinarily, a scheduled district court trial date that precedes the date projected for a Board final written decision weighs in favor of exercising discretion to deny the Petition. Here, however, the Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error.”). As evidenced by the previous Institution Decision, there is objective evidence that the Office made a material error in granting the

'374 Patent, this error favors denying Patent Owner's Motion for Discretionary Denial.

In addition, the PTAB has set out in precedential decisions that the “patent system and the public benefit from instituting challenges where there is a showing of unpatentability by compelling merits... when other considerations favor discretionary denial.” *Commscope Tech. LLC, v. Dali Wireless, Inc.* IPR2022-01242 Paper 23 at 3-4 (PTAB Feb 27, 2023)(Precedential) citing *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102, 49 (PTAB Oct. 4, 2022)(Precedential).

The underlying policy considerations in those cases, which address facially invalid patents, are similar to those in the present case. The '374 Patent admits that much of the claim scope was known at the time of filing, and the Petition is built on the same prior art combinations and issues that have already been found to provide a reasonable likelihood of prevailing on the merits. The legal and factual showing here satisfies the material error or compelling merits standard. Under the rationale of the *Microsoft* and *CommScope* decisions, that determination alone outweighs other concerns, and accordingly, the denial of the current Motion is appropriate.

Further to this point, the Petition cited multiple sections of the '374 Patent which admit that the claimed technology was well known to a person of skill in the

art, thereby reducing the issues that need to be decided by the Board. One of Patent Owner's primary arguments is that a district court, considering different art based on a different technology and a different evidentiary standard, found that those different prior art references were not combinable. Rather than being dispositive, this finding in the district court is entirely irrelevant to the prior art at issue in this IPR, which the Board has already found to be combinable. The Board's technical expertise makes it well-positioned to understand that different art is being applied and that combining different art can result in a distinct outcome.

Fourth, Patent Owner argues that the Petitioner was aware of the '374 Patent for a long period of time, thereby forming an understanding between the parties. However, Patent Owner fails to mention that the timing of Petitioner's filing of this IPR is due to Patent Owner's years-long delays in responding to Petitioner's correspondence. For instance, when Patent Owner informed Petitioner of the currently asserted patents, Petitioner provided evidence to Patent Owner that the patent was not infringed and it was invalid. Patent Owner appeared to accept this fact on multiple occasions, ceasing communications for years at a time. This established the understanding between the parties that Petitioner did not need to file an IPR against the '374 Patent because the dispute was resolved without requiring adjudication by the Board. It was reasonable for Petitioner to conclude that Patent Owner agreed that the patent was not infringed and/or invalid and was

choosing not to assert the patent against the Petitioner, given Patent Owner's years of silence. The fact that Patent Owner broke this understanding, not Petitioner, weighs in favor of denying Patent Owner's Request for Discretionary Denial, as Patent Owner is the party that violated the understanding between the parties.

II. Factual Background Weighs Against Discretionary Denial

Petitioner filed the current Petition against the '374 Patent as well as two Petitions on related patents challenging a family of patents that the Patent Owner recently asserted in a district court litigation. This assertion is despite Patent Owner's years of knowledge that the Petitioner's products do not infringe and the claims are unpatentable.

Petitioner and Patent Owner exchanged 19 letters starting in 2009 and ending in the winter of 2021. *See* Ex. 1039. Initially, at the end of 2009 and into the beginning of 2010, Petitioner and Patent Owner exchanged letters, in which Petitioner explained why infringement was impossible and that the claims were invalid. Ex. 1039 at 1-22. In 2010, Petitioner thought the matter was resolved because there was no communication for four years after the last letter. Ex. 1039 at 23-47. However, after the four-year gap, Patent Owner began sending letters again, asserting that a newly issued '374 patent has claims that removed the elements Petitioner had identified as making it impossible for Petitioner to infringe. Based on this assertion by Patent Owner, Petitioner understood that the previous assertion

from half a decade prior had been disposed of, as Patent Owner needed to receive new claims just to continue its assertions.

Acting in good faith, on the understanding that new claims were at issue, the Petitioner again explained that even the new claims were still not infringed and that the prior art still rendered the new claims invalid, attaching prior art to support this assertion. Patent Owner again seemed to concede that the analysis was correct, as communication ceased for a period of two years.

Apparently undaunted by the delay, Patent Owner hired new counsel and sent another letter rehashing the same stale assertions that were once again refuted by Petitioner. Ex. 1039 at 48-51. After addressing this same assertion again, Patent Owner once again went silent, and Petitioner assumed this matter had finally been put to bed. Unfortunately, that was not the case.

Presumably because correspondence with Petitioner's counsel was unsuccessful and despite knowing Petitioner was represented by counsel, Patent Owner sent a follow-up letter directly to Petitioner, circumventing counsel, rehashing the same refuted arguments for infringement. Ex. 1039 at 52-55. When Patent Owner was informed, once again, that their assertions were meritless and that it was inappropriate to contact represented clients, Patent Owner once again disappeared and failed to press their case, again marking what should have been the end of this case between the parties. Instead, Patent Owner waited an additional

three years and then served the current litigation, which necessitated the IPR petitions that are the basis of this motion. At the end of each of these letter-writing sequences, Petitioner had a reasonable belief that the multi-year long delays indicated that Patent Owner acceded to the reality that the patents were not infringed and/or invalid.

Despite this repeated delay and gamesmanship, Patent Owner is now asserting that the Board should not get involved with this dispute and let the Courts handle the matter. Patent Owner should not be rewarded for its delay and obfuscation by abusing the rules for discretionary denial. Instead, this is a case that should be handled expeditiously by the Board so that Petitioner can finally be rid of the nuisance of defending itself against meritless claims that have burdened Petitioner for more than 15 years at this point. The Board is well-positioned to step in and handle disputes of this nature, particularly those with straightforward prior art-based invalidity that have already been deemed reasonably likely to prevail.

III. *FINTIV* FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

Fintiv instructs the Board to “balance considerations such as system efficiency, fairness, and patent quality.” *Fintiv* at 5. The *Fintiv* decision identifies certain non-exclusive factors that the Board looks at, and notes that “[t]hese factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel

proceeding.” *Id.* at 6. These overarching policy considerations expressed in *Fintiv* are vitally important in the instant case, including taking a “holistic view” that considers overall efficiency, merit, and patent quality. *Fintiv* at 6 (citing Consolidated Trial Practice Guide November 2019 at 58).

When all the facts are considered holistically, the Board should *not* exercise its discretion to deny institution of the instant IPR.

A. Unpatentability Challenge Merits Institution

1. The Board Found the Art and Arguments Persuasive

The Board has already reviewed the currently presented prior art combinations and found that there is “reasonable likelihood it would prevail in establishing the unpatentability of” the challenged claims. Ex. 2011 at 55. The Board has already reviewed the currently applied prior art and found that it presented a persuasive case of unpatentability of the challenged claims. Specifically, for the ‘374 Patent, the Board issued a 56-page opinion providing a detailed analysis of how the current art and arguments render the challenged claims obvious. The claims have not changed, the art has not changed, and there is no reason why the Board should alter the outcome it has already reached by denying Patent Owner’s Motion and instituting the present Petition.

Furthermore, the Board has already conducted an analysis of discretionary denial under 35 USC 314(a), examining each of the *Fintiv* factors. The Board’s

analysis in the previous case was issued on June 10, 2020, prior to the Interim Procedure that the Guidance Memo altered. See Ex. 2011 at 1. Accordingly, the Board has already undertaken the very analysis that the Guidance Memo recommends. Notably, Patent Owner failed to raise in its Motion the fact that it had already raised these same procedural grounds for discretionary denial, which the Board, after taking a holistic view of the factors, found weighed against discretionary denial. One factor that is significant based on Patent Owner's current arguments, the Board has already found that "[b]ecause the Petition 'includes materially different grounds, arguments, and/or evidence than those presented in district court,' this factor weighs against exercising discretion to deny institution." Ex. 2011 at 17 (quoting *Fintiv*, Paper 11 at 12-13). Accordingly, the Patent Owner's primary arguments, that "the Osseo Patents have already been confirmed to be valid several times over substantially the same arguments presented here" is wrong. Motion at 1. The Board has already found the art and arguments are not "substantially the same" and instituted an IPR based on the currently presented art and arguments.

Patent Owner argues that the Board's previous decision is inapplicable because they did not have the experience of reviewing the District Court's proceedings from the *Planmeca* case when it previously instituted Review based on the current art. Motion at 14-15. However, this is not an accurate representation of

the Board's previous decision. The Board repeatedly references the Planmeca proceeding as well as its trial date. Ex. 2011 at 11, 14-21. Patent Owner points to no issue from the Planmeca litigation that would change the outcome the Board has already reached.

Instead of providing an argument that a change in situation or fact requires the Board to reassess its prior opinion, Patent Owner merely asserts that they have not provided substantive comments to the Board. Motion at 15. The fact that Patent Owner previously and currently fails to provide any substantive argument to alter the prior decision cannot be used to their benefit now. By foregoing any substantive arguments, Patent Owner chose to let the Board undertake the appropriate analysis based on the record in that proceeding. The fact that they now regret not filing substantive responses is of no consequence. By failing to make substantive arguments before and providing no argument now as to how any substantive arguments would alter the outcome, the Parties and the Board are left in the exact same position. The Board has previously instituted an IPR based on the current grounds, and nothing material has changed since that Decision.

In addition, under the Board's current guidance memorandum issued on March 24, 2025 ("Guidance Memo"), the Board considers discretionary denials under the policies set out in *Fintiv* and related decisions issued prior to the June 21, 2022, Interim Procedure memo ("Interim Procedure"). See Guidance Memo at 1

(current guidance is “to restore policy in this area to the guidance in place before the Interim Procedure”). As noted above, one of *Fintiv*’s primary policy considerations is to improve “patent quality”. *Fintiv* at 6. Indeed, the Supreme Court noted that improving “patent quality” was an “important congressional objective” underlying the creation of the IPR process. *Cuozzo Speed Techs. v. Com. for Intellectual Prop.*, 579 U.S. 261, 272 (2016) (quoting H.R. REP. 112- 98, pt. 1, at 45, 48 and citing 157 Cong. Rec. 9778 (2011)).

Consistent with this policy goal to improve patent quality, prior to the Interim Procedure, the Board had a history of refusing to discretionarily deny under *Fintiv* when the merits were particularly strong. *See, e.g., Illumina Inc. v. Trs. of Columbia Univ.*, IPR2020-00988, Paper 20 (PTAB Dec. 8, 2020) (declining to deny under *Fintiv* in light of strong evidence on the merits even though four factors weighed in favor of denial and remaining factor was neutral); *SyntheGo Corp. v. Agilent Techs., Inc.*, IPR2022-00402, Paper 11 (PTAB May 31, 2022) (granting institution as efficiency and integrity of the system would not be served by denying institution of petition with particularly strong evidence on the merits); *Samsung Elecs. Co. v. Scramoge Tech., Ltd.*, IPR2022-00241, Paper 10 (PTAB June 13, 2022) (*Fintiv* analysis concluded that “very strong” evidence on the merits outweighs concurrent litigation involving earlier scheduled trial date and significant overlap in proceedings).

The Guidance Memo states that the Board should restore policy to the guidance in place before the June 21, 2022, Interim Procedure, so the Board should now adopt the reasoning of these prior decisions and refuse to discretionarily deny the current Petition based on the strong evidence of the merits in the Petition

2. The Merits are Reasonably Likely to Prevail

In addition to the Board already agreeing that the current art and arguments had a reasonable likelihood of prevailing, the arguments themselves support the Board's Institution Decision. This is a rare case where the patent's background essentially admits that the primary elements argued as patentable were known at the time of filing. As explained in the Petition, the '374 Patent itself explains that CT imaging equipment was known, that CT densitometry was known, and that these processes can be implemented via commercially available equipment and software. Petition at 13-15.

The Office confirmed these admissions when the Examiner rejected claims in the parent application concluding that the only element argued as "lacking" is using the "system for dental tomographic imaging." Petition at 17-18 (citing Ex. 1005, prosecution history at 43). In response, Patent Owner added limitations in the parent application purporting to claim a comparison between past and present densitometry models. Petition at 18-19. Accordingly, there is limited subject matter for Patent Owner to point to as even being relevant to patentability.

To teach the elements of the current claims, the Petition relies on two new primary references to teach or suggest the features of the challenged claims, none of which were part of the Planmeca litigation. The two primary references teach or suggest the claimed features. See Petition at 33-56 (applying Arai to the challenged claims) and 56-72 (applying Pelc to the claims). Accordingly, Arai and Pelc disclose or teach the features claimed in the '374 patent.

The Board's previous Institution Decision is supported by the evidence in the Petition, which points to Patent Owner admissions that the teachings are present as well as explicit references in the art to technology that creates the claimed models. There is no reason to disrupt the Board's previous Decision.

B. Compelling Public Health Interests

The current patent is asserted against the leading award-winning dental imaging devices currently available to dental practitioners. The fact that Patent Owner is attempting to encumber the use of these devices through meritless assertions of patent rights can have a significant impact on public health. Making dental imaging devices more expensive, when medical costs are already soaring, could cause patients to forego needed and doctor-recommended imaging. Some of the features of currently accused products include centralized diagnostic software that provides real-time collaboration for improved patient care, while promoting clinical efficiency and usability to enhance treatment, reduce costs, and improve

patient satisfaction. Patent Owner argues there is no impact on the public.

However, when the costs of providing the best healthcare to the public increase due to baseless patent assertions, the public loses. Protecting public health is a crucial aspect of the discretionary denial analysis, and Patent Owner has chosen to overlook the vital role that imaging plays in the day-to-day operations of dentists, enabling them to provide the best care to their patients.

Patent Owner argues that there are no compelling economic or public health interests. Motion at 18-20. However, Patent Owner's meritless lawsuit directly impacts public health through the abuse of the patent system, and Patent Owner is now attempting to prevent the Petitioner from having the merits of its invalidity case heard by the Board. The Board should reject this argument and deny Patent Owner's Motion.

C. Conclusion

After the Board considers the issues holistically, the weighing test favors denying the motion and instituting the present proceeding.

IV. PETITIONER'S REBUTTAL TO DISCRETIONARY DENIAL

A. Response to "The '374 Patent was repeatedly upheld as valid by other tribunals"

As an initial matter, Patent Owner fails to confront that the Board has already addressed this issue with respect to the prior art relied upon in the Petition. The Board found that they were "Furthermore, the challenges raised in the Petition

are not the same as, or substantially similar to, those about to be litigated in the Planmeca proceeding, which does not involve Petitioner as a party.” Ex. 2011 at 20. The fact that a jury found that other prior art references to be non-combinable does not control the outcome of the present proceeding.

1. “Other Tribunals”

Patent Owner is exaggerating the truth as the prior proceeding is a single district court judgment where a jury found that the relied upon prior art references were not combinable. Motion at 7-9. Apparently, conceding that a single district court upholding validity over different art and arguments was insufficient to make the argument persuasive, Patent Owner embellishes the proceedings, counting a denial of summary judgment, denial of JMOL, and a Federal Circuit affirmance of a jury verdict as separate proceeding and forums in an attempt to inflate the importance of the previous proceeding. *Id.* Furthermore, Patent Owner’s argument was not that there were elements of the claim that were patentable over the prior art. Instead, they argued that even though all the elements of the claim are taught, the prior art relied on was not combinable. Motion at 7-8 (quoting Federal Circuit Opinion). The currently applied art does not suffer from these same deficiencies, as evidenced by the Patent Owner’s lack of argument both in the prior proceeding and the present one raising this issue.

One reason the Board found that the art and arguments are new is that the art relied upon in the current proceeding is a different technology from that in the prior proceeding (tomosynthesis vs. CT imaging) that provides a straightforward and predictable combination. Petition at 24 and 28-30. Dr. Kia, Patent Owner's expert, apparently testified at trial regarding the differences between tomosynthesis and computed tomography. See Motion at 7¹. Nevertheless, the Board has already determined that the art and arguments are not substantially the same, and based on the Motion filed by Patent Owner, Dr. Kia appears to agree, as does the Petitioner. Accordingly, the only argument presented by Patent Owner on appeal, that the references are not combinable, is not present in the current Petition. This is further evidence that the strength of the Petition merits denial of the Patent Owner's Motion.

B. Reply to “Arguments that Substantially Overlap with Petitioner’s Were Already Addressed and Overcome in the Planmeca Action and Have Significant Weaknesses”

The Patent Owner's arguments are without merit. As briefly addressed above, the prior art relied upon in the Petition and the prior art relied upon in Planmeca relate to different technologies, and any effort to equate them is disingenuous. Instead, Patent Owner merely asserts that because some of the

¹ However, Petitioner is unable to confirm because Patent Owner failed to include the relied-upon opinion in Ex. 2005 or the evidence relied upon by the Federal Circuit.

references have similar inventors or similar assignees, the subject matter must be the same. Motion at 9-13. However, the juxtaposition of names cannot substitute for argument and evidence.

1. Prior art in IPR includes information regarding bone density

Patent Owner in its appeal to the Federal Circuit, as reflected in the Federal Circuit's opinion, argued that "evidence at trial showed that Planmeca's Accused Systems calculated HU [Hounsfield Unit] values which, in fact, represent bone density thus satisfying the *densitometry* limitation." Opinion at 9 (emphasis in original). The Federal Circuit goes on to explain that "the Accused Systems' user manual states that HU values are calculated by the Accused systems in operation." And "Dr. Kia, explained that HU values correspond to bone densities." Opinion at 9. Patent Owner provides no explanation as to how calculating HU values, as is done in CT systems, is sufficient for infringement but somehow deficient when it comes to showing invalidity. See *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1378 (Fed. Cir. 2001)("it is axiomatic that which would literally infringe if later anticipates if earlier.").

Patent Owner also mischaracterizes Dr. Pelc's testimony, implying that Dr. Pelc agrees that CT scans cannot be used for densitometry. Motion at 10. However, Dr. Pelc was asked, "Is there a way to use computed tomography to do densitometry. A. Yes, there is." EX2009 at 789:6-8. Then Dr. Pelc goes on to

state, while referencing a paper in his report that “I think this shows that the first bone densitometry conducted with CT was no later than 1980, obviously they had been working on it for a while.” *Id.* at 791:8-10. Patent Owner characterizes this testimony as “CT scans alone *do not* measure quantitative bone density.” Motion at 10 (emphasis in Motion). The testimony speaks for itself.

Further Patent Owner relies on testimony from Dr. Pelc where he testified that linear attenuation coefficient are not equal to bone density “because bone density is mass per unit volume, and the linear attenuation coefficient is a parameter of the tissue that determines, that describes the rate at which the x-ray beam is reduced in intensity as it travels through the material, they’re just different.” Ex. 2009 at 921:1-12. Dr. Pelc also testified that once the linear attenuation coefficient is known, bone density can be calculated. See Ex. 2009 at 920:16-25. So, Patent Owner is taking the testimony out of context in an attempt to use Dr. Pelc’s testimony to support their position. The fact that Patent Owner has to stretch the testimony in this way only weakens their argument. Dr. Pelc testified that computed tomography can be used for densitometry, which supports the invalidity arguments presented in the current Petition, despite Patent Owner’s arguments to the contrary.

2. The prior art in the Petition is Different than the Planmeca prior art

Patent Owner asserts that the currently applied prior art is “an exact repeat of the positions argued in the Planmeca Action.” Motion at 10. This is false. As Patent Owner admits, in Planmeca, the prior art relied upon was tomosynthesis prior art. Motion at 7-8, quoting Ex. 2005. In Planmeca, the tomosynthesis prior art was found to be not combinable with the prior art for calculating bone density. Motion at 11. The current prior art is related to CT imaging. Patent Owner presents no evidence, because there is none, that the CT references relied upon in the Petition are not combinable. Furthermore, as stated above, the Board has already determined that the current art and arguments and the art and arguments relied upon in Planmeca, are not the same or substantially similar. Ex. 2011 at 17.

Despite knowing that the Board has already found the prior art was different, Patent Owner provides no argument or new evidence that can be used to overcome this previous finding. Patent Owner instead just asserts that the current combinations should fail for the same reasons that the Planmeca art failed. Motion at 11. However, different art using different technology is combinable for different reasons. The reason to combine prior art references is a question of fact, and Patent Owner fails to provide any facts to support their position. *See e.g., Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1367 (Fed. Cir. 2012).

Finally, Patent Owner argues that Arai, Ex. 1013, is mischaracterized because Arai uses two imagining modes. Motion at 12. Contrary to Patent Owner’s

argument, the first sentence of the Summary of Arai states, “Arai describes a dental X-ray imaging apparatus that can conduct local CT and panoramic tomographic imaging.” Petition at 24. The very next sentence states “But Arai also teaches that its apparatus may be used solely for CT imaging: ‘[I]t is also possible to construct a dedicated partial X-ray CT imaging apparatus by omitting function of conducting the X-ray panoramic imaging in the dual-purpose X-ray imaging apparatus.’ *Id.* at 30:39-42.” Petition at 24. Further, “Arai notes that it would be useful in the field of dental diagnosis ‘if data such as the thickness of the jawbone are previously known prior to an implant operation or the like.’ Ex. 1013 at 1:34-36.” Petition at 35. Accordingly, the Petition does not mischaracterize the art.

3. Reply to “Dr. Pelc Himself Admitted That None of His Patents Relate to Dental Imaging”

It is a bedrock principle of patent analysis that prior art is available for all its teachings and that it is viewed through the lens of a person of ordinary skill in the art at the time of the invention. *See e.g., Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989). Further, arguing about individual references of a combination instead of the references in combination is insufficient to overcome an obviousness combination. *See e.g., In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986). Nevertheless, Patent Owner argues that because the Pelc reference alone does not explicitly use the word “teeth” or because Dr. Pelc didn’t rely on his own patents in a previous litigation, these facts somehow impact

the combinations presented. Motion at 13-14. This argument fails on its face. The question is not whether certain phrases are used, but whether the teachings render the claims obvious to a person of ordinary skill in the art. Patent Owner provides no argument on this latter point.

Further, Patent Owner again mischaracterizes Dr. Pelc's testimony. While Dr. Pelc testified that some particular references are not focused on dental imaging, Dr. Pelc also testified that dental and medical imaging are often cited interchangeably, "Demonstrating that there really isn't a difference between dental imaging and diagnostic or medical imaging when it comes to how the technology works...." Ex. 2009 at 849:2-4. Patent Owner also fails to mention that the '374 Patent itself admits that computed tomography was known and used for dental applications at the time of filing the '374 Patent. Petition at 13-14, citing Ex. 1001 at 2:15-21 and Ex. 1018 at 1:22-35. The prior art cited in the Petition further supports this fact. Ex. 1013 at 1:34-36. Accordingly, there can be no dispute that this technology was known to a person of ordinary skill in the art, and there is ample evidence that computed tomography is useful in medical and dental imaging because "there really isn't a difference".

In place of an argument that the teachings of Pelc are somehow deficient, Patent Owner resorts to trying to impugn the expertise of an expert not currently involved in the proceeding. Patent Owner fails to identify any shortcomings of the

current combinations, and therefore, Dr. Pelc's previous testimony regarding whether specific words are used in a prior art reference is immaterial.

4. Reply to “The Board Did Not Have the Benefit of Referring to Almost Five Years of Litigation Upholding the Challenged Claims When the '672 IPR Was Instituted”

Patent Owner argues that the Board did not have the final judgment of the Planmeca litigation. Motion at 14-16. However, the Board was well aware of the proceedings and explicitly found that the Planmeca litigation was not relevant to Institution because the prior art was materially different. Ex. 2011 at 16-17, 20. Importantly, as stated above, Patent Owner fails to address the fact that the Board has already undertaken an analysis regarding discretionary denial and determined that Institution was warranted. Ex. 2011 at 11-20. Patent Owner is wasting the Board's resources by filing a second motion for discretionary denial without addressing the Board's extensive treatment of these issues with respect to its first motion. Patent Owner points to nothing that has substantively changed with respect to the prior art. The Board found the art and arguments of the current petition to be sufficiently different to warrant Institution. Pointing to the conclusion of a proceeding that the Board already knew about is not a material change that would require redoing the Board's already completed analysis.

5. Patent Owner's reliance on *E-One* is misplaced

Patent Owner's relies on *E-One* to support the proposition that the art and arguments overlap with the Planmeca case. Motion at 9-10. In *E-One*, the Board found that "[t]he issues, evidence, and arguments presented in the Petition essentially duplicate what has been and continues to be litigated in the Parallel District Court Case." *E-One, Inc. v. OshKosh Corp.*, IPR2019-00161, Paper 16, at 9 (P.T.A.B. May 15, 2019). Additionally, in *E-One*, the Board also relied heavily on the fact that "[t]he district court has already expended substantial resources to gain familiarity with and resolved these issues, and is set to complete trial in the Parallel District Court Case before any final decision from the Board is due." *Id.* at 9. Accordingly, *E-One* is distinguishable because there is very limited district court investment, and the Board has already found the art and arguments to be "not the same as, or substantially similar to, those about to be litigated in the Planmeca proceeding, which does not involve Petitioner as a party. Thus, the risk of duplicate work between the Planmeca proceeding and this *inter partes* review is *de minimis*." Ex. 2011 at 20 (italics in original). Accordingly, the facts of *E-One* are inapplicable to the facts of the present proceeding.

C. Reply to "SUBSTANTIALLY THE SAME PRIOR ART WAS PREVIOUSLY PRESENTED TO THE OFFICE"

Patent Owner argues that different references with different disclosures are the same as the currently applied prior art because they share some inventors. Motion at 16-18. However, this is not the test under section 325(d). Section 325(d)

states that the Director, when granting a Petition, may take into account if “the same or substantially the same prior art or arguments previously were presented to the Office.” As referenced above, the Board has already determined the art is not “substantially the same”. See Ex. 2011. From the face of the patents, it is inarguable that the art is different. There are different inventors, they are not related via priority claims, and have different subject matter. Even Patent Owner states that the previously presented prior art is “directed to panoramic tomographic imaging,” whereas the current art is broader and references computed tomography and is not limited to panoramic tomography. Motion at 17; see e.g., Ex. 1013 at 2:3-5. Accordingly, rather than providing a substantive argument regarding how the references are the same or substantially similar, Patent Owner’s argument confirms that the art is different.

D. Reply to “PETITIONER’S EXTENSIVE RELIANCE ON EXPERT TESTIMONY FAVORS DENIAL”

Patent Owner argues that the Petition relies too heavily on Dr. Sonka’s Expert Declaration. Motion at 19. However, Patent Owner mischaracterizes the facts to create a problem where none exists. For example, Patent Owner states that Dr. Sonka’s declaration is 287 pages long, but fails to explain that the Declaration addresses all three of the challenged patents. For example, the section related specifically to the ’374 Patent spans 60 pages. Petitioner is unaware of any authority that would place 60 pages of expert testimony for 21 claims, including

claim language and explanation of how the art teaches each claim element, on the wrong side of a test for reasonableness. The Petition also relies on 18 pages of background and 32 pages summarizing the prior art references. However, again, Patent Owner provides no authority that these amounts are excessive, especially when they are used to support three separate petitions. Instead, under the Board's precedents, Dr. Sonka shows his work for each step, including background information that informs his opinions. *See Xerox IPR2022-00624*, paper 9 at 15. Accordingly, Dr. Sonka's Declaration is permissible and not overly burdensome.

Furthermore, while Patent Owner states that Dr. Kia will apparently provide expert testimony that is contrary to Dr. Sonka's, it is unclear which issues his opinion would contradict. As stated above, Dr. Kia has already provided extensive testimony on how CT scans can be used to calculate bone density, and that by measuring HU, bone density is calculable. Federal Circuit Opinion at 9. Further, the Federal Circuit relied on these statements to uphold the judgment. Because Patent Owner has only provided vague statements that conflict with Dr. Kia's previous testimony, Petitioner argues that this factor weighs in favor of denying the current Motion for Discretionary Denial and weighs in favor of Institution.

V. CONCLUSION

For the foregoing reasons, Petitioner respectfully submits that the Board should deny the request for discretionary denial.

Date: July 16, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the accompanying Petitioner's Opposition to Patent Owner's Motion For Discretionary Denial is being served via electronic mail on July 16, 2025 upon the following:

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