

UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF MICHIGAN  
NORTHERN DIVISION

SOLMETEX, LLC,

Plaintiff/Counter-Defendant,

Case No. 1:24-cv-954

v.

HON. ROBERT J. JONKER

ASCENTCARE DENTAL  
PRODUCTS, INC.,

Defendant/Counter-Plaintiff.

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**ORDER**

Plaintiff Solmetex, LLC (“Solmetex”) is a limited liability company that provides dental isolation systems under the DryShield® brand of products, including dental isolation mouthpieces. The DryShield® mouthpiece alone is the subject of numerous U.S. patents owned by Solmetex. Solmetex alleges that Defendant Ascentcare Dental Products, Inc. (“Ascentcare”) violated ten such patents—including seven utility patents, and three design patents—in the marketing and sale of its own VacuLUX mouthpieces, which serve the same functions as the DryShield® mouthpiece and are marketed as compatible with the rest of the DryShield® isolation system. In the operative complaint (ECF No. 33), Solmetex further asserts that Ascentcare engaged in false advertising in marketing its VacuLUX mouthpieces, in violation of the Lanham Act. Ascentcare denies infringement and challenges the validity of the patents. It further denies that it engaged in false advertising and asserts its own false advertising claim against Solmetex. The matter is before the Court on Solmetex’s Motion for Leave to file its Third Amended Complaint in order to dismiss its

false advertising claim, and Ascentcare’s Motion to Stay this action pending possible *inter partes* review of seven of the ten patents currently at issue.

**I. Motion for Leave to Amend**

Leave to amend a complaint “shall be freely given when justice so requires.” Fed. R. Civ. P. 15(a). However, “a party must act with due diligence if it intends to take advantage of the Rule’s liberality.” *United States v. Midwest Suspension & Brake*, 49 F.3d 1197, 1202 (6th Cir. 1995). The Court may deny leave to amend a complaint where the amendment is brought in bad faith, will result in undue delay or prejudice to the opposing party, or is futile. *Crawford v. Roane*, 53 F.3d 750, 753 (6th Cir. 1995), *cert. denied*, 116 S. Ct. 1354 (1996).

Solmetex seeks to amend its complaint to dismiss its false advertising claim against Ascentcare. Solmetex reasons that dismissing the claim will reduce the burden imposed by discovery and streamline this litigation. And “in view of Ascentcare’s removal of the false statements, Solmetex has stipulated that the withdrawal would operate with prejudice.” (ECF No. 46, PageID.3085). Ascentcare takes issue with this “in view of” language, which it says is meant to operate as a condition to the dismissal of Solmetex’s false advertising claim, thereby “flip[ping] a dismissal with prejudice on its head and result[ing] in legal prejudice to Ascentcare.” (*Id.*, PageID.3413). Furthermore, Ascentcare contends that Solmetex’s motivations are not to streamline this litigation, but rather to deprive Acentcare of its insurance-funded defense. (ECF No. 52, PageID.3412). Should the Court grant Solmetex’s request and dismiss its false advertising claim, Ascentcare argues that the dismissal should be unconditional, and that the Court should award Ascentcare attorney’s fees as the prevailing party on the claim.

As a general principle, this Court will not force plaintiffs to pursue claims that they no longer wish to advance. *See Smoot v. Fox*, 340 F.2d 301 (6th Cir. 1964) (“No case has been cited

to us, nor have we found any, where a plaintiff, by his own motion, was denied the right to dismiss his case with prejudice.”); *York v. Ferris State Univ.*, 36 F. Supp. 2d 976, 979 (W.D. Mich. 1998). Of course, that general principle may give way to competing considerations of fairness when a plaintiff seeks voluntary dismissal of his claims *without* prejudice. *Grover by Grover v. Eli Lilly & Co.*, 33 F.3d 716 (6th Cir. 1994) (explaining that a district court abuses its discretion when it grants a plaintiff’s motion for voluntary dismissal without prejudice under circumstances causing the defendant to suffer “plain legal prejudice”); *Maldonado v. Thomas M. Cooley L. Sch.*, 65 F. App’x 955, 956 (6th Cir. 2003) (setting forth factors for a district court to consider in determining whether a voluntary dismissal without prejudice would result in “plain legal prejudice” to the defendant). But those are not the circumstances now before the Court.

Despite Ascentcare’s characterization of Solmetex’s motion for leave, the Court sees no reason to construe the motion as seeking anything other than dismissal of its false advertising claim *with* prejudice. True, Ascentcare’s voluntary cessation appears to have informed Solmetex’s decision to seek dismissal with prejudice. But that does not mean that Solmetex seeks to condition dismissal upon Ascentcare’s future conduct. Such a condition would be antithetical to a dismissal with prejudice. *See In re Mun. Stormwater Pond Coordinated Litig.*, 73 F.4th 975, 979 (8th Cir. 2023) (observing that “a conditional dismissal effectively leaves claims pending in the district court, and allows the plaintiff to avoid the usual consequences of a dismissal”). Of course, future conduct by Ascentcare could generate new claims based on new allegedly false statements. But even if that happened, it would not undo the dismissal of the existing claims with prejudice.

Turning to Ascentcare’s accusation with respect to Solmetex’s motivations, namely that Solmetex seeks to dismiss the false advertising claim in order to deprive Solmetex of its insurance-funded defense, the Court notes that the accusation is both speculative and irrelevant. To reiterate,

“[u]nder binding Sixth Circuit precedent, where a plaintiff moves to voluntarily dismiss his case with prejudice, a court has no discretion and must grant the motion.” *York*, 36 F. Supp. 2d at 979. And as for Ascentcare’s request for attorney’s fees, the Court finds that it would be more appropriate to address the question of attorney’s fees<sup>1</sup> upon final disposition of this case.

Ultimately, as Ascentcare emphasizes in its motion to stay, discussed *infra*, this case is still in its early stages. Solmetex seeks to dismiss its only non-infringement claim in an effort to streamline litigation, and it seeks to do so with prejudice. Rule 15(a) provides a liberal standard for amendment, and binding precedent requires this Court to grant Solmetex’s request for voluntary dismissal with prejudice. Accordingly, Solmetex’s Motion for Leave (ECF No. 46) is **GRANTED**. Solmetex’s Third Amended Complaint (ECF No. 46-1) is deemed filed and served as of the date of this Order. And the false advertising claim set forth in Solmetex’s prior complaints is **DISMISSED WITH PREJUDICE**. Because the amendment eliminates claims as opposed to adding them, the Court discerns no reason for altering the existing deadlines.

## II. Motion to Stay

Ascentcare has filed six petitions for *inter partes* review and one petition for post-grant review. A litigation stay pending re-issue or re-examination proceedings before the PTAB, whether *ex parte* or *inter partes*, is always within the discretion of the Court. *Viskase Corp. v. Am. Nat’l Can Co.*, 261 F.3d 1316, 1328 (Fed. Cir. 2001) (citing *Patlex Corp. v. Mossinghoff*, 758 F.2d 594 (Fed. Cir. 1985)). The parties agree on that point, and they agree on the factors this Court should balance in determining whether to stay this litigation: the stage of the litigation, the risk of prejudice to the party opposing the stay, and whether the stay will simplify issues in the case.

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<sup>1</sup> Including the unaddressed question of whether this qualifies as an “exceptional case” under the Lanham Act, 15 U.S.C. § 1117(a).

Ascentcare is correct in that this litigation is in its early stages, which ordinarily weighs in favor of a stay. Here, however, the Court is not persuaded that the factor is especially compelling. Even though the case is relatively new, there is a First CMO on file that will lead to a Markman hearing in December of this year and an anticipated Claims Construction Order before the next Rule 16 conference set for February of 2026. (ECF No. 20). PTAB is not obligated to make its decision on whether to grant reexamination on the seven utility patents until December of this year or January of next year. With no review process currently underway, this factor is neutral at best.

If the PTAB ultimately grants the pending requests for *inter partes* or post-grant review of the seven patents, it is certainly possible the end result of the process could simplify things in the litigation. Most obviously, if the PTAB invalidates the claims in the patents, it will make the patent decisions much easier for this Court. But again, there are significant countervailing considerations. First, there is no guarantee PTAB will grant the request, and even if it does there are all kinds of possible outcomes short of complete invalidation of every claim. Second, the requests for re-examination concern only the seven utility patents at issue; Solmetex pursues infringement claims on three additional design patents. Third, and perhaps most importantly, the patent claims are not the only significant issues in the case. Although Solmetex has decided not to pursue its false advertising claim, Ascentcare's false advertising claim remains. Ascentcare's false advertising claim is a theory of relief independent of Solmetex's infringement claims; PTAB proceedings would do nothing to address or simplify this claim.

This last point segues to the third consideration of prejudice to the party opposing the stay. The Court finds that Solmetex would suffer significant unfair prejudice if forced to put all of its claims on ice for a PTAB process that may or may not actually occur. Even if the PTAB

ultimately decides to engage with re-examination on the patents at issue, the process will be staggered and lengthy, prejudicing the ability of the patent holder to seek a prompt determination of his claims here in Court. Ascentcare will, of course, be able to argue all of its invalidity issues here in Court regardless of the outcome of any PTAB re-examination. True, some different standards and presumptions may apply, but that does not amount to unfair prejudice to Ascentcare. It is simply what patent law provides.

The Court has balanced the factors identified by the parties and, in the Court's view, that balance weighs against a stay at this time. Accordingly, the Motion to Stay (ECF No. 36) is **DENIED**.

**IT IS SO ORDERED.**

Dated: September 3, 2025

/s/ Robert J. Jonker  
ROBERT J. JONKER  
UNITED STATES DISTRICT JUDGE