

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

SMART DENTURE CONVERSIONS, LLC,

Plaintiff,

v.

STRAUMANN USA, LLC,

Defendant.

Redacted - Public Version

C.A. No. 1:24-cv-00507-JCB



**DEFENDANT STRAUMANN USA, LLC'S
OPENING BRIEF IN SUPPORT OF ITS MOTION FOR A CONDITIONAL STAY
PENDING THE RESOLUTION OF PARALLEL PTAB PROCEEDINGS**

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TABLE OF CONTENTS

TABLE OF AUTHORITIES..... 3

I. NATURE AND STAGE OF PROCEEDINGS..... 5

II. SUMMARY OF ARGUMENT..... 6

III. STATEMENT OF FACTS 8

 A. The Litigation..... 8

 B. Straumann’s IPR Petition Against the ’992 Patent 9

 C. Straumann’s PGR Petition Against the ’781 Patent..... 9

IV. ARGUMENT 10

 A. A Stay Pending the Outcome of Instituted PTAB Proceedings Will Greatly Simplify the Issues for Trial..... 12

 B. The Status of the Litigation Favors Staying the Case at or Shortly After the Close of Fact Discovery..... 14

 C. SDC Will Not be Unduly Prejudiced by a Stay 15

 1. Straumann’s PTAB Petitions Were Timely..... 16

 2. Straumann’s Request For a Stay Is Timely..... 17

 3. Absent a Stay, Parallel PTAB Proceedings Would Impact the Litigation..... 17

 4. The Relationship Between the Parties 18

 D. A Stay Would Greatly Reduce the Burden on the Court and the Parties 19

 E. The Court Should Consider and Decide Whether to Grant a Stay Now..... 19

V. CONCLUSION..... 21

TABLE OF AUTHORITIES

Cases

Apple, Inc. v. Fintiv, Inc.,
 IPR2020-00019, 2020 Pat. App. LEXIS 13179 (P.T.A.B. Mar. 20, 2020) 20

Bio-Rad Labs. Inc. v. 10X Genomics, Inc.,
 No. 18-1679-RGA, 2020 U.S. Dist. LEXIS 96411 (D. Del. June 2, 2020)..... 18

Bos. Sci. Corp. v. Cook Grp. Inc.,
 No. 15-980-LPS-CJB, 2017 U.S. Dist. LEXIS 240047 (D. Del. Aug. 16, 2017)..... 16

Brit. Telecomms. PLC v. IAC/InterActive Corp.,
 No. 18-366-WCB, 2019 U.S. Dist. LEXIS 166651 (D. Del. Sep. 27, 2019) 11, 12, 15

Brit. Telecomms. PLC v. IAC/InterActive Corp.,
 No. 18-366-WCB, 2020 U.S. Dist. LEXIS 166996 (D. Del. Sept. 11, 2020) 11, 15

Celorio v. On Demand Books LLC,
 No. 12-821-GMS, 2013 U.S. Dist. LEXIS 121449 (D. Del. Aug. 21, 2013)..... 13

Cisco Sys. v. Ramot at Tel Aviv Univ., Ltd.,
 No. 21-1365-GBW, 2023 U.S. Dist. LEXIS 9187 (D. Del. Jan. 19, 2023)..... 14

Dental Monitoring v. Get-Grin Inc.,
 No. 22-647-WCB, 2024 U.S. Dist. LEXIS 67627 (D. Del. Apr. 9, 2024) 11, 13, 15, 18

Ethicon LLC v. Intuitive Surgical, Inc.,
 No. 17-871-LPS, 2019 U.S. Dist. LEXIS 45452 (D. Del. Mar. 20, 2019)..... 14, 15

Ethicon, Inc. v. Quigg,
 849 F.2d 1422 (Fed. Cir. 1988)..... 10

Ever Win Int’l Corp. v. Radioshack Corp.,
 902 F. Supp. 2d 503 (D. Del. Oct. 9, 2012) 13, 17, 19

Foras Techs. Ltd. v. Bayerische Motoren Werke AG,
 No. 23-CV-386-RP, 2024 U.S. Dist. LEXIS 72528 (W.D. Tex. Apr. 22, 2024) 14

IBM v. Rakuten, Inc.,
 680 F. Supp. 3d 531 (D. Del. July 5, 2023) 11

IOENGINE, LLC v. PayPal Holdings, Inc.,
 No. 18-452-WCB, 2019 U.S. Dist. LEXIS 141545 (D. Del. Aug. 21, 2019)..... 15, 18

Prolitec Inc. v. ScentAir Techs., LLC,
 No. 20-984-WCB, 2023 U.S. Dist. LEXIS 137647 (D. Del. Aug. 8, 2023)..... 12

SAS Inst., Inc. v. Iancu,
584 U.S. 357 (2018)..... 12

Sirona Dental Sys. GmbH v. Dental Wings, Inc.,
No. 14-460-LPS-CJB, 2016 U.S. Dist. LEXIS 155706 (D. Del. Mar. 22, 2016)..... 18

TC Tech. LLC v. Sprint Corp.,
No. 16-153-WCB, 2021 U.S. Dist. LEXIS 190695 (D. Del. Oct. 4, 2021)..... 15

Vermeer Mfg. Co. v. Kubota N. Am. Corp.,
No. 24-cv-00799-P, 2025 U.S. Dist. LEXIS 49960 (N.D. Tex. Mar. 19, 2025) 18

VirtualAgility, Inc. v. Salesforce.com, Inc.,
759 F.3d 1307 (Fed. Cir. 2014)..... 12, 19

Statutes

35 U.S.C. § 102..... 9

35 U.S.C. § 103..... 9

35 U.S.C. § 112..... 9, 10

35 U.S.C. § 314(b)..... 9

35 U.S.C. § 315(b)..... 16

35 U.S.C. § 316(a)(11)..... 9

35 U.S.C. § 321(c)..... 16

35 U.S.C. § 324(c)..... 10

35 U.S.C. § 326(a)(11)..... 10

Regulations

37 C.F.R. § 42.100(b)..... 13

37 C.F.R. § 42.102(a)(1)..... 16

37 C.F.R. § 42.107(b)..... 9

37 C.F.R. § 42.200(b)..... 13

37 C.F.R. § 42.207(b)..... 10

Defendant Straumann USA, LLC (“Straumann”) respectfully moves the Court for a conditional stay of this case that would automatically take effect after the end of fact discovery if either or both of Straumann’s PTAB proceedings are instituted.

I. NATURE AND STAGE OF PROCEEDINGS

This is a patent infringement case in the area of dentistry products. Plaintiff Smart Denture Conversions, LLC (“SDC”) asserts that defendant Straumann infringes U.S. Patent Nos. 11,937,992 (“the ’992 patent”) and 12,156,781 (“the ’781 patent”), both related to a system used to convert a patient’s removable denture into a permanent dental prosthesis. *See* D.I. 34.

The parties are currently engaged in fact discovery, which will close on December 5, 2025. D.I. 31 at 4. A *Markman* hearing is scheduled for March 6, 2026; expert discovery is scheduled to close on June 5, 2026; dispositive and *Daubert* motions are scheduled to be fully briefed by July 31, 2026; and a jury trial is scheduled to begin on October 19, 2026. *See id.* at 1-3.

Straumann recently challenged the patentability of all of the claims of both patents-in-suit in the Patent Trial and Appeal Board (“PTAB”) of the U.S. Patent and Trademark Office. Specifically, Straumann filed a petition for *inter partes* review (“IPR”) of claims 1–12 of the ’992 patent (Case No. IPR2025-00956) on April 30, 2025, and a petition for post grant review (“PGR”) of claims 1–16 of the ’781 patent (Case No. PGR2025-00054) on June 4, 2025 (collectively, “the PTAB proceedings”). *See* Ex. 1; Ex. 2.

The PTAB is expected to issue its decision whether to institute trials in IPR2025-00956 and PGR2025-0054 by no later than December 2 and 26, 2025, respectively. If the PTAB institutes, the PTAB’s final decision regarding whether claims 1–12 of the ’992 patent are patentable is expected by early December 2026, and the PTAB’s final decision regarding whether claims 1–16 of the ’781 patent are patentable is expected by late December 2026.

II. SUMMARY OF ARGUMENT

Straumann respectfully moves for a conditional stay of this case pending the outcome of the PTAB proceedings. In particular, Straumann requests that the Court issue an order now that would automatically stay this case *if* the PTAB institutes either or both of the PTAB proceedings, with the stay to *take effect* on the later of the close of fact discovery (currently December 5, 2025) or the date of the PTAB’s earliest institution decision (likely by December 2, 2025), and with the stay to *remain in effect* until the PTAB issues its last final decision in the PTAB proceedings.

The factors traditionally considered by this Court favor staying this case until the PTAB decides whether the claims of the asserted patents are unpatentable:

1. A stay of this case in view of instituted PTAB proceedings will greatly simplify the issues for trial, regardless of the outcome of the PTAB proceedings. First, the PTAB proceedings would effectively terminate this case if the PTAB finds all of the asserted claims to be unpatentable. Alternatively, even if the PTAB finds that some asserted claims are unpatentable but that other claims are patentable, this would still reduce the number of claims and issues remaining for trial in this case. And even if the PTAB finds that all of the asserted claims are patentable, the Court will benefit from the PTAB’s analysis for purposes of claim construction and any remaining invalidity challenges (i.e. invalidity challenges that Straumann could not have brought in the PTAB proceedings¹).

2. The timing of the requested stay—beginning at or shortly after the close of fact discovery—is opportune, because the parties will have collected any discovery that might go stale, while also avoiding the significant costs associated with claim construction, expert discovery,

¹ As described below in the Statement of Facts, Straumann has stipulated not to pursue in this case, if the PTAB institutes its respective petitions, invalidity challenges based on grounds that were raised or reasonably could have been raised during the PTAB proceedings (“*Sotera* stipulations”).

dispositive and *Daubert* motions, pretrial and trial, all of which are scheduled after the requested beginning of the stay.

3. SDC will not be unduly prejudiced by a stay, because Straumann’s PTAB petitions, as well as this motion, were timely brought; because the requested stay would only extend until the PTAB’s final decisions (expected by December 2026), *not* including subsequent appeals to the Federal Circuit; because absent a stay, contemporaneous PTAB decisions would have a significant effect on the issues in the litigation; and because even though the parties can, at least for purposes of this motion, be considered competitors, SDC’s decision not to pursue a preliminary injunction demonstrates that SDC will not be unduly prejudiced by a stay.

4. A stay would greatly reduce the burden on the parties and the Court by avoiding the prospect of parallel proceedings involving the same patents.

5. While a motion to stay is often brought after the PTAB institutes a trial, the Court should consider and decide this stay motion now. The pertinent facts are known at this point. On the other hand, some of the above-described benefits of a stay would be undermined if the motion were brought after institution, since the motion would be briefed and pending in parallel to at least the claim construction phase, and potentially also the expert discovery phase, of this case. A stay at or shortly after the close of fact discovery would be at a clean, logical breaking point, providing clarity and efficiency to both the Court and the parties.

6. A decision at this point would also be consistent with the interplay between litigation and PTAB proceedings. In deciding whether to institute a petition with respect to a patent at issue in litigation, the PTAB considers “whether the district court granted a stay, or whether evidence exists that one may be granted if a proceedings is instituted.” A decision by this Court now would enable the PTAB to make an informed finding on this issue. Conversely, waiting for institution

before deciding on a stay would result in a problematic “Catch 22”-situation: The Court considers whether the PTAB instituted in deciding whether to stay the case, and the PTAB considers whether the Court stayed the case in deciding whether to institute.

For all of these reasons, Straumann respectfully requests that the Court grant the requested conditional stay of this case.

III. STATEMENT OF FACTS

A. The Litigation

On April 23, 2024, SDC filed its original complaint, asserting only the '992 patent. *See* D.I. 1. The complaint was served on Straumann on June 10, 2024. *See* D.I. 7. On February 4, 2025, SDC filed a Supplemental Complaint, adding the '781 patent (which issued on December 3, 2024) to the case. *See* D.I. 34. Straumann filed its answer to both the original complaint and the supplemental complaint. *See* D.I. 24; D.I. 36.

On April 25, 2025, SDC served preliminary infringement contentions, identifying the asserted claims as claims 1–3, 5, 7 and 9–12 of the '992 patent and claims 1–6, 8, 10 and 12–16 of the '781 patent. *See* D.I. 49, Ex. 6 (SDC's Preliminary Infringement Contentions). Straumann served its initial invalidity contentions on June 2, 2025. *See* D.I. 56.

Under the Scheduling Order, fact discovery will close on December 5, 2025. *See* D.I. 31 at 4. Claim construction briefing will take place between December 19, 2025 and February 20, 2026, and the Court has scheduled a *Markman* hearing for March 6, 2026. *See id.* at 3–4. Expert reports will be exchanged between April 10 and May 22, 2026, with expert discovery closing on June 5, 2026. *See id.* at 2–3. Dispositive and *Daubert* motions will be briefed between June 19 and July 31, 2026. *See id.* at 2. Pre-trial submissions are due between September 1 and October 2, 2026, and a jury trial is scheduled to begin on October 19, 2026. *See id.* at 1–2.

B. Straumann’s IPR Petition Against the ’992 Patent

On April 30, 2025, Straumann filed an IPR petition with the PTAB (Case No. IPR2025-00956), asserting that all claims of the ’992 patent are unpatentable under 35 U.S.C. §§ 102 and/or 103 because they are anticipated by and/or would have been obvious in view of prior art. *See* Ex. 1. For each of the ’992 patent claims asserted in this case, Straumann’s IPR petition presents at least two unpatentability grounds. *See id.* The PTAB issued a “Notice of Filing Date Accorded to Petition,” accepting the IPR petition, on May 30, 2025. *See* Ex. 3.

SDC’s preliminary response is due by September 2, 2025. *See id.* at 1; 37 C.F.R. § 42.107(b). As such, the PTAB will decide whether to institute a trial by December 2, 2025. *See* 35 U.S.C. § 314(b). If the PTAB institutes, the PTAB is expected to hold an oral hearing around early September 2026 (*see* Ex. 5 (PTAB Consolidated Trial Practice Guide) at 6–7 and 97–98), and, absent special circumstances, is required by statute to issue its Final Written Decision by December 2, 2026. *See* 35 U.S.C. § 316(a)(11).

On June 4, 2025, Straumann filed a “*Sotera*-stipulation” regarding the ’992 patent with this Court, stipulating “that if the PTAB institutes an IPR in response to Straumann’s petition against SDC’s ’992 patent (IPR2025-00956), Straumann will not pursue in this litigation that the patent claims subject to the instituted IPR are invalid based on grounds that were raised or reasonably could have been raised during the IPR.” D.I. 57.

C. Straumann’s PGR Petition Against the ’781 Patent

On June 4, 2025, Straumann filed a PGR petition with the PTAB (Case No. PGR2025-00054), asserting that all claims of the ’781 patent are unpatentable under 35 U.S.C. § 103 because they would have been obvious in view of prior art, and unpatentable under 35 U.S.C. § 112 because

they do not comply with the written description, enablement, and/or definiteness requirements.² *See* Ex. 2. For each of the '781 patent claims asserted in this case, Straumann's PGR petition presents at least two unpatentability grounds. *See id.* The PTAB issued a "Notice of Filing Date Accorded to Petition," accepting the PGR petition, on June 25, 2025. *See* Ex. 4.

SDC's preliminary response is due by September 25, 2025. *See id.* at 1; 37 C.F.R. § 42.207(b). As such, the PTAB will decide whether to institute a trial by December 26, 2025. *See* 35 U.S.C. § 324(c). If the PTAB institutes, the PTAB is expected to hold an oral hearing around late September 2026 (*see* Ex. 5 at 6–7 and 97–98), and, absent special circumstances, is required by statute to issue its Final Written Decision by December 26, 2026. *See* 35 U.S.C. § 326(a)(11).

On July 15, 2025, Straumann filed a "Sotera-stipulation" regarding the '781 patent with this Court, stipulating "that, if the PTAB institutes a PGR in response to Straumann's petition against SDC's '781 patent (PGR2025-00054), Straumann will not pursue in this litigation that the patent claims subject to the instituted PGR are invalid based on grounds that were raised or reasonably could have been raised during the PGR." D.I. 62.

IV. ARGUMENT

District courts have inherent authority to manage their dockets and stay litigation proceedings pending review by the PTAB of the patentability of the patents-in-suit. *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426–27 (Fed. Cir. 1988). In this District, and throughout the country, courts routinely exercise this authority to stay cases while the Patent Office reconsiders patentability, particularly where, as here, the proceedings will address all of the claims at issue in the litigation. *Brit. Telecomms. PLC v. IAC/InterActive Corp.*, No. 18-366-WCB, 2020 U.S. Dist.

² Unlike IPR proceedings, PGR proceedings allow invalidity challenges based on 35 U.S.C. § 112. A PGR is only available if the challenged patent issued within the prior nine months (the '781 patent issued on December 3, 2024).

LEXIS 166996, at *12–13 (D. Del. Sept. 11, 2020) (“[C]ourts in many other cases have noted, and acted on, the liberal policy in favor of issuing stays pending post-grant proceedings.”). As Judge Bryson of the Federal Circuit stated in his capacity as a Delaware visiting Judge, “it makes sense to ask the agency that issued the patent in the first place to decide whether it made a mistake, rather than to ask a court and eight jurors—strangers to the original issuance decision—to take the lead in second-guessing the PTO’s issuance decision.” *Dental Monitoring v. Get-Grin Inc.*, No. 22-647-WCB, 2024 U.S. Dist. LEXIS 67627, at *13 (D. Del. Apr. 9, 2024).

“Courts generally consider three factors to determine whether a stay is appropriate: (1) whether granting the stay will simplify the issues for trial; (2) the status of the litigation, particularly whether discovery is complete and a trial date has been set; and (3) whether a stay would cause the non-movant to suffer undue prejudice from any delay or allow the movant to gain a clear tactical advantage.” *IBM v. Rakuten, Inc.*, 680 F. Supp. 3d 531, 534 (D. Del. July 5, 2023). In the context of IPR and PGR proceedings, courts can also consider a fourth factor—whether a stay, or the denial thereof, will reduce the burden of litigation on the parties and on the court. *Id.* (citing *Brit. Telecomms. PLC v. IAC/InterActiveCorp.*, No. 18-366-WCB, 2019 U.S. Dist. LEXIS 166651, at *6 (D. Del. Sep. 27, 2019)). Although these factors inform the decision whether to issue a stay, “the test merely provides general guidance; it is not a rigid template for decision.” *Brit. Telecomms.*, 2020 U.S. Dist. LEXIS 166996 at *13.

Here, the four factors, overall, support staying this case at or shortly after the close of fact discovery in early December 2025, after institution of one or both of Straumann’s PTAB proceedings.

A. A Stay Pending the Outcome of Instituted PTAB Proceedings Will Greatly Simplify the Issues for Trial

A stay will greatly simplify the issues for trial because Straumann's petitions challenge all of the claims asserted in this case and therefore the PTAB proceedings have the potential to entirely dispose of this case, or at least reduce the number of asserted claims and issues for trial.

If the PTAB institutes an IPR or a PGR proceeding, the PTAB must issue a final decision that decides the patentability of all of the claims challenged in the petition. *See SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 361 (2018). Straumann's IPR and PGR petitions challenge all of the claims asserted in this case based on several unpatentability grounds for each claim. Therefore, if the PTAB institutes, the PTAB will address multiple unpatentability challenges for each asserted claim. Against this background, a stay of this case in view of instituted PTAB proceedings will greatly simplify the issues for trial, regardless of the outcome of the PTAB proceedings.

To begin with, a final decision by the PTAB that all of the asserted claims of both patents are unpatentable will entirely dispose of and end this litigation. A stay is particularly justified when, as is the case here, the outcome of a PTAB proceeding is likely to assist the court in determining patent validity or eliminate altogether the need to try infringement issues. *See Prolitec Inc. v. ScentAir Techs., LLC*, No. 20-984-WCB, 2023 U.S. Dist. LEXIS 137647, at *5 (D. Del. Aug. 8, 2023) (collecting cases). In fact, courts routinely grant a stay even in cases in which IPR proceedings are instituted for fewer than all of the asserted claims. *See Brit. Telecomms.*, 2019 U.S. Dist. LEXIS 166651, at *21 (collecting cases). Thus, the fact that Straumann's petitions challenge all of the asserted claims in this case, and therefore have the potential to dispose of this case entirely, strongly weighs in favor of a stay. *See VirtualAgility, Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1314 (Fed. Cir. 2014) (reasoning that a post-grant proceeding instituted for all claims could "dispose of the entire litigation" and would thus be the "ultimate simplification"); *Prolitec*,

2023 U.S. Dist. LEXIS 137647, at *13 (finding that because the post-grant review proceeding was instituted for all asserted claims, “[t]he simplification factor [was] thus at its apex”).

Even if the PTAB finds only some of the asserted claims to be unpatentable, but confirms other claims, the PTAB proceedings, and staying the case until the PTAB’s final decisions, would still greatly simplify the issues for trial, because the number of claims at issue would be reduced. *See Ever Win Int’l Corp. v. Radioshack Corp.*, 902 F. Supp. 2d 503, 505–506 (D. Del. Oct. 9, 2012). Moreover, Straumann would not be able to present the same invalidity challenges to the surviving claims in this case that it presented to the PTAB because of its *Sotera* stipulations.

And whatever the outcome—even if the PTAB confirms the patentability of all of the asserted claims—the Court will likely benefit from the PTAB’s analysis (and that of the experts involved in the PTAB proceedings), thus further simplifying the issues before the Court. *See Celorio v. On Demand Books LLC*, No. 12-821-GMS, 2013 U.S. Dist. LEXIS 121449, at *2–3, n.1 (D. Del. Aug. 21, 2013). In particular, this Court will have the benefit of the PTAB’s analysis for purposes of claim construction³ as well as any remaining invalidity challenges (i.e., invalidity challenges that statutorily could not have been brought in the PTAB proceedings).

Because waiting for the PTAB to resolve the pending petitions and decide whether the asserted claims are unpatentable would greatly simplify the issues remaining to be litigated, this factor weighs strongly in favor of a stay. *See Dental Monitoring*, 2024 U.S. Dist. LEXIS 67627, at *13 (“The *most important factor* bearing on whether to grant a stay is whether the stay is likely to simplify the issues at trial.”) (emphasis added).

³ The PTAB will apply the same claim construction standard in IPR and PGR proceedings as the Court will apply to construe the claims in this case. *See* 37 C.F.R. §§ 42.100(b) and 42.200(b).

B. The Status of the Litigation Favors Staying the Case at or Shortly After the Close of Fact Discovery

The second factor that courts consider when deciding whether to stay a case is the status of the litigation. As described above, this case is in the middle of fact discovery, with claim construction briefing and hearing, as well as expert discovery, scheduled for after the close of fact discovery. The litigation will be at an early enough stage by the end of fact discovery for the Court and the parties to realize significant savings in time, money, and efforts by staying the case.

As discussed above, Straumann requests that the stay take effect—if the PTAB institutes—at or shortly after the close of fact discovery on December 5, 2025. The end of fact discovery represents “an efficient stopping point” when a stay is particularly appropriate. *See Ethicon LLC v. Intuitive Surgical, Inc.*, No. 17-871-LPS, 2019 U.S. Dist. LEXIS 45452, at *6 (D. Del. Mar. 20, 2019). Staying the case after the parties complete fact discovery avoids problems that can arise when a case is stayed at an earlier juncture. For example, waiting to stay a case until after fact discovery is finished helps reduce prejudice from evidence going stale. *See Cisco Sys. v. Ramot at Tel Aviv Univ., Ltd.*, No. 21-1365-GBW, 2023 U.S. Dist. LEXIS 9187, at *7 (D. Del. Jan. 19, 2023) (staying the case in light of parallel IPR proceedings, to take effect only after parties completed fact discovery).

On the other hand, the litigation milestones of claim construction, expert discovery, dispositive and *Daubert* motions, pretrial submissions, and trial are all scheduled to take place after the close of fact discovery. By staying the case at or shortly after the close of fact discovery, the Court and the parties would avoid having to incur the significant time, costs, and efforts associated with each of these milestones when the PTAB proceedings may negate the need for, or greatly simplify, them. *See Foras Techs. Ltd. v. Bayerische Motoren Werke AG*, No. 23-CV-386-RP, 2024 U.S. Dist. LEXIS 72528, at *6 (W.D. Tex. Apr. 22, 2024) (finding it “unwise” to allow

the case to proceed to claim construction, discovery, or trial when IPR proceedings “could negate the need for, or greatly simplify, those litigation milestones”); *see also Brit. Telecomms.*, 2019 U.S. Dist. LEXIS 166651 at *11, *26 (staying the case prior to claim construction, so as to have benefit of the PTAB’s constructions).

In fact, this Court routinely grants motions to stay pending PTAB proceedings at points in the schedule far later than the end of fact discovery. *See, e.g., TC Tech. LLC v. Sprint Corp.*, No. 16-153-WCB, 2021 U.S. Dist. LEXIS 190695, at *18, *29 (D. Del. Oct. 4, 2021) (granting stay approximately two months before trial, and after claim construction and fact discovery were complete); *Ethicon LLC*, 2019 U.S. Dist. LEXIS 45452, at *5–7, *9 (granting stay after a claim construction order, and after expert discovery had nearly concluded); *Brit. Telecomms.*, 2020 U.S. Dist. LEXIS 166996 at *14, *31 (granting stay where claim construction and fact discovery were complete, expert discovery was ongoing, and three months remained before trial).

Because this litigation will be at an efficient breaking point at or shortly after the close of fact discovery, this factor weighs strongly in favor of a stay.

C. SDC Will Not be Unduly Prejudiced by a Stay

The third factor looks at whether a stay would result in undue prejudice to the non-moving party or provide a clear tactical advantage to the moving party. This Court typically examines four sub-factors: (i) the timing of the request for review; (ii) the timing of the request for a stay; (iii) the status of the review proceedings; and (iv) the relationship between the parties. *See Dental Monitoring*, 2024 U.S. Dist. LEXIS 67627, at *20 (citing *IOENGINE, LLC v. PayPal Holdings, Inc.*, No. 18-452-WCB, 2019 U.S. Dist. LEXIS 141545, at *16 (D. Del. Aug. 21, 2019)). Considered together, these sub-factors weigh in favor of a stay.

1. Straumann's PTAB Petitions Were Timely

Straumann timely filed its PTAB petitions shortly after the parties exchanged *initial* infringement and invalidity contentions, and well within the deadlines established by Congress.

Straumann filed its IPR petition against the '992 patent on April 30, 2025—just five days after SDC served its initial infringement contentions on April 25, 2025. *See* D.I. 49, Ex. 6. SDC's initial infringement contentions disclosed the asserted claims to Straumann for the first time, and informed Straumann about SDC's infringement theories and interpretation of the claim language. *See Bos. Sci. Corp. v. Cook Grp. Inc.*, No. 15-980-LPS-CJB, 2017 U.S. Dist. LEXIS 240047, at *19-21 (D. Del. Aug. 16, 2017) (finding this factor neutral, even where the Defendant filed an IPR one day before the statutory one-year deadline, because “it makes sense for Defendants to have waited to file for IPR until Plaintiffs produced their initial chart of asserted claims.”). Moreover, Straumann filed its IPR petition well before the statutory deadline of June 10, 2025, one year after SDC served the original complaint asserting the '992 patent on June 10, 2024. *See* 35 U.S.C. § 315(b).

Straumann served its initial invalidity contentions on June 2, 2025. D.I. 56. Two days later, and only six months after the '781 patent issued on December 3, 2024, Straumann filed its PGR petition against the '781 patent on June 4, 2025. Moreover, Straumann filed its PGR petition well before the statutory deadline of September 3, 2025, nine months after the '781 patent issued. *See* 35 U.S.C. § 321(c).⁴

⁴ Straumann could not have filed an IPR petition against the '781 patent until September 4, 2025, because the IPR procedure is not available until the PGR filing window closes nine months after the patent issues. *See* 37 C.F.R. § 42.102(a)(1).

Straumann's PTAB petitions were also timely in the context of the case schedule. Both petitions were filed with the PTAB more than six months before the close of fact discovery on December 5, 2025.

In sum, this sub-factor weighs in favor of a stay.

2. Straumann's Request For a Stay Is Timely

Straumann also timely filed this stay motion without unnecessary delay. The PTAB issued its "Notice of Filing Date Accorded the Petition"—the PTAB's notice that a petition meets the statutory requirements and has been accepted—in the IPR proceeding on May 30, 2025 and in the PGR proceeding on June 25, 2025. Ex. 3; Ex. 4. Straumann served (pursuant to the Motion filing rules in JCB-CV-7.3 (D.I. 52)) this stay motion shortly thereafter, and nothing in the timing of this motion prejudices SDC. *See Ever Win Int'l Corp.*, 902 F. Supp. 2d at 511 (“[T]he less time that a party waits to file a motion to stay pending reexamination, the less that the movant's conduct gives rise to an inference that the delay in doing so was impermissibly tactical.”). This sub-factor therefore weighs in favor of a stay.

3. Absent a Stay, Parallel PTAB Proceedings Would Impact the Litigation

The sub-factor regarding the status of the review proceedings also favors a stay.

If instituted, the PTAB proceedings are expected to result in PTAB Final Written Decisions by December 2, 2026 (IPR) and December 26, 2026 (PGR), respectively. And, as discussed above, even taking Straumann's *Sotera* stipulations into account, the PTAB's final decisions can be expected to affect issues such as claim construction and any remaining invalidity challenges. The trial in this case is currently scheduled for October 19, 2026. The PTAB's decisions will therefore likely overlap with post-trial briefing (under the current case schedule; in case the trial is pushed back, they would likely overlap with the pretrial and/or trial phase). In situations like this, “the

prospect that contemporaneous IPR decisions will have a significant effect on the issues presented in the litigation counsels in favor of a stay.” *IOENGINE, LLC*, 2019 U.S. Dist. LEXIS 141545, at *20 (“[W]hile the IPRs are not at an advanced stage, the potential for the IPRs to significantly affect the litigation is high.”).

Therefore, this sub-factor also weighs in favor of a stay.

4. The Relationship Between the Parties

The fourth sub-factor looks at the relationship between the parties, including whether or not they are direct competitors. In its operative complaint, SDC asserts that “Straumann competes head-to-head with SDC.” D.I. 34 at ¶ 28. For purposes of this motion, Straumann does not contest this. However, this Court and other courts frequently grant stays even when the parties are direct competitors. *See Bio-Rad Labs. Inc. v. 10X Genomics, Inc.*, No. 18-1679-RGA, 2020 U.S. Dist. LEXIS 96411, at *5 (D. Del. June 2, 2020) (“The parties are competitors, but I do not think that any resulting prejudice from a stay would be ‘undue.’”); *see also Sirona Dental Sys. GmbH v. Dental Wings, Inc.*, No. 14-460-LPS-CJB, 2016 U.S. Dist. LEXIS 155706, at *37 (D. Del. Mar. 22, 2016) (issuing a stay until a decision in related IPR proceedings, despite finding that direct competition mitigated somewhat against a stay); *see also Vermeer Mfg. Co. v. Kubota N. Am. Corp.*, No. 24-cv-00799-P, 2025 U.S. Dist. LEXIS 49960, at *8 (N.D. Tex. Mar. 19, 2025) (failing to find undue prejudice merely based on the parties being market competitors).

Furthermore, SDC did not seek a preliminary injunction, which demonstrates that it would not be severely prejudiced if this case were stayed between the end of fact discovery in December 2025 and the PTAB’s Final Written Decisions in December 2026 (i.e., about one year). *See Dental Monitoring*, 2024 U.S. Dist. LEXIS 67627, at *25–26 (“Other courts have considered the failure to seek a preliminary injunction as indicative that the plaintiff is not suffering severe prejudice from the fact that a competitor-defendant is putatively using its intellectual property to compete

with it in the market.”) (collecting cases); *see also VirtualAgility*, 759 F.3d at 1319 (“[N]ot pursuing a preliminary injunction . . . contradicts [plaintiff’s] assertion that it needs injunctive relief as soon as possible.”); *see also Ever Win Int’l Corp.*, 902 F. Supp. 2d at 511 (“Plaintiff never sought a preliminary injunction, which suggests that any prejudice to Plaintiff that might result from delaying the ultimate resolution of this dispute is not as severe as it contends.”). Of note, the requested stay would extend only until the PTAB issues its final decisions (expected in December 2026) and would *not* extend to appeals to the Federal Circuit, reducing any prejudice to SDC.

In sum, this sub-factor weighs against the issuance of a stay, but only slightly.

D. A Stay Would Greatly Reduce the Burden on the Court and the Parties

The final consideration is whether a stay, or the denial thereof, will reduce the burden of litigation on the Court and the parties. Here, assuming the PTAB institutes the petitions, proceeding forward with this case (rather than issuing a stay) while the parties litigate separate PGR and IPR proceedings in parallel would increase the burden on the Court and both parties.

Moreover, as described above in Section IV.A, simplification of the issues at the conclusion of the PTAB proceedings is likely to reduce the burden on the Court and the parties, either by ending the case outright, or simplifying the issues that remain to be tried. It would be a waste of judicial and party resources to litigate these issues in this case only to have them become moot in view of the PTAB’s final decisions.

Therefore, because staying the case to wait for the PTAB to decide the patentability of the asserted claims would reduce the burden on the Court and the parties, this factor also weighs in favor of a stay.

E. The Court Should Consider and Decide Whether to Grant a Stay Now

While a motion to stay is often brought only after the PTAB institutes an IPR or PGR, in this case the Court should consider and decide Straumann’s stay motion now instead of waiting.

The pertinent facts are known at this point. The Court has set the case schedule through trial, and the timeline for the PTAB proceedings is prescribed by statute. (Any postponement of the case schedule would only work to enhance the appropriateness of a stay, because the PTAB's final decisions would then likely precede trial.)

On the other hand, some of the above-described benefits of a stay would be undermined if the motion were brought and decided after institution, since the motion would be briefed and pending in parallel to at least the claim construction phase, and potentially also the expert discovery phase, of this case. A stay at or shortly after the close of fact discovery would be at a clean, logical breaking point, providing clarity and efficiency to both the Court and the parties.

A decision at this point would also be consistent with the interplay between litigation and PTAB proceedings. In particular, in deciding whether to institute a petition with respect to a patent at issue in litigation, the PTAB considers "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted." *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 Pat. App. LEXIS 13179 (P.T.A.B. Mar. 20, 2020) (precedential). A decision by this Court now regarding whether it will stay the case upon institution would enable the PTAB to make an informed finding on this issue.

Conversely, waiting for institution before deciding on a stay would result in a "Catch 22"-situation that would undermine Straumann's overall access to justice: The Court considers whether the PTAB instituted in deciding whether to stay the case, and the PTAB considers whether the Court stayed the case in deciding whether to institute.

In sum, if the Court will stay the case pending the outcome of the PTAB proceedings at the close of fact discovery, the Court should issue its stay decision now so that the PTAB can be informed that the Court will stay the case before the PTAB decides whether to institute.

V. CONCLUSION

For the foregoing reasons, Straumann respectfully requests that the Court issue an order now that would automatically stay this case *if* the PTAB institutes either or both of the PTAB proceedings, with the stay to *take effect* on the later of the close of fact discovery (currently December 5, 2025) or the date of the PTAB's earliest institution decision (likely by December 2, 2025), and with the stay to *remain in effect* until the PTAB issues its last final written decision in the PTAB proceedings.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on August 11, 2025, this document was served on the persons listed below in the manner indicated:

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