

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STRAUMANN USA, LLC,
Petitioner,

v.

SMART DENTURE CONVERSIONS, LLC,
Patent Owner.

PGR2025-00054
Patent 12,156,781

**PATENT OWNER'S REQUEST
FOR DISCRETIONARY DENIAL
AND SUPPORTING BRIEF**

July 31, 2025

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2001	First Supplemental Complaint, <i>Smart Denture Conversions, LLC v. Straumann USA, LLC</i> , No. 1:24-cv-00507-JCB (D. Del. Feb. 4, 2025), ECF No. 34.
2002	Docket sheet, <i>Smart Denture Conversions, LLC v. Straumann USA, LLC</i> , No. 1:24-cv-00507-JCB (D. Del.).
2003	Complaint, <i>Smart Denture Conversions, LLC v. Straumann USA, LLC</i> , No. 1:24-cv-00507-JCB (D. Del. Apr. 23, 2024), ECF No. 1.
2004	Defendant Straumann USA, LLC's Opening Brief in Support of its Motion to Dismiss Plaintiff's Complaint for Failure to State a Claim for Relief under Fed. R. Civ. P. 12(b)(6), <i>Smart Denture Conversions, LLC v. Straumann USA, LLC</i> , No. 1:24-cv-00507-JCB (D. Del. July 29, 2024), ECF No. 13.
2005	Order, <i>Smart Denture Conversions, LLC v. Straumann USA, LLC</i> , No. 1:24-cv-00507-JCB (D. Del. Jan. 30, 2025), ECF No. 31 ("scheduling order").
2006	Stipulated Protective Order, <i>Smart Denture Conversions, LLC v. Straumann USA, LLC</i> , No. 1:24-cv-00507-JCB (D. Del. Mar. 4, 2025), ECF No. 44.
2007	Defendant Straumann USA, LLC's Initial Invalidation Contentions, No. 1:24-cv-00507-JCB (D. Del.) (served June 2, 2025).
2008	Order Regulating Practice for civil cases assigned to The Honorable J. Campbell Barker, <i>Smart Denture Conversions, LLC v. Straumann USA, LLC</i> , No. 1:24-cv-00507-JCB (D. Del. Dec. 16, 2024), ECF No. 22.
2009	Notice of <i>Sotera</i> Stipulation regarding U.S. Patent No. 12,156,781, <i>Smart Denture Conversions, LLC v. Straumann USA, LLC</i> , No. 1:24-cv-00507-JCB (D. Del. July 15, 2025), ECF No. 62.

I. INTRODUCTION

Pursuant to the “Interim Processes for PTAB Workload Management” Memorandum issued March 26, 2025 (the “PTAB Memorandum”) and 35 U.S.C. § 324(a), patent owner Smart Denture Conversions, LLC (“SDC”) respectfully requests that the Director exercise her discretion to deny institution of the Petition for Post Grant Review (Paper 2) of U.S. Patent No. 12,156,781 (“781 Patent” or the “Challenged Patent”) filed by Straumann USA, LLC (“Straumann” or “Petitioner”).

The Director should exercise her discretion to deny institution under 35 U.S.C. § 324(a) and *Fintiv*.¹ Among other reasons, the same parties are already litigating a parallel case in district court involving the Challenged Patent and

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). The same *Fintiv* factors govern the discretionary denial analysis in both IPR and PGR proceedings. *See, e.g.*, PTAB Memorandum at 1 (“[T]he Director will exercise her discretion on institution of AIA proceedings under 35 U.S.C. §§ 314(a) and 324(a) as outlined below.”); *Phison Elecs. Corp. v. Vervain, LLC*, IPR2025-00213 et al., Paper 14 (Director July 10, 2025) (applying *Fintiv* factors to deny institution of three IPR petitions and two PGR petitions).

another patent (“Parallel Litigation”).² That Parallel Litigation is well past its infancy. It will, in fact, reach a final resolution by jury trial weeks before any final written decision in this forum.

Straumann also filed a petition to initiate an inter partes review (“IPR”) of the other patent asserted in the Parallel Litigation, the parent patent of the Challenged Patent,³ and SDC filed a request for discretionary denial of that IPR petition. Patent Owner’s Request for Discretionary Denial and Supporting Brief, IPR2025-00956, Paper 8 (PTAB July 25, 2025).

Unsurprisingly, the parties have already made significant progress during more than a year of Parallel Litigation and will continue to do so. Before any institution decision is due regarding the Challenged Patent, the parties will have already finalized their infringement and invalidity contentions, fact discovery will be closed, and the parties will be in the middle of *Markman* briefing. Judge Barker has scheduled ***a jury trial nearly three months before the Board’s deadline for a final written decision here.*** Because the trial will be a jury trial rather than a bench

² *Smart Denture Conversions, LLC v. Straumann USA, LLC*, No. 1:24-cv-00507-JCB (D. Del.). Judge Campbell Barker of the Eastern District of Texas is hearing the case by designation.

³ *Straumann USA, LLC v. Smart Denture Conversions, LLC*, IPR2025-00956.

trial, a verdict will immediately follow the trial. And though Straumann has filed a *Sotera* stipulation,⁴ that stipulation does not eliminate the significant inefficiencies (and substantial burdens on SDC) that litigating *three* parallel proceedings on nearly identical timelines would create.

Because granting Straumann’s Petition would require considerable and inefficient use of the Board’s resources, the advanced Parallel Litigation should proceed and this Petition (and Straumann’s co-pending IPR petition) should be denied. “To ensure that the PTAB continues to meet its statutory obligations as to *ex parte* appeals, while continuing to maintain its capacity to conduct AIA proceedings” (PTAB Memorandum at 1), SDC respectfully requests that the Director exercise her discretion to deny institution.

II. BACKGROUND

SDC is a small, family-run company that sells an innovative patented system to convert removable dentures into fixed prostheses much more quickly, and with better outcomes, than conventional conversion procedures. SDC’s system allows smaller holes to be drilled in the dentures and produces better bite alignment than conventional methods, resulting in a more durable and more comfortable

⁴ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential).

prosthesis. The system is life changing for individuals injured in accidents, aging patients, and anybody else who relies on dental prostheses. *See* Ex. 2001 (supplemental complaint), ¶ 1.

Petitioner, on the other hand, is the U.S. arm of The Straumann Group, an international conglomerate with 2024 revenues totaling 2.5 billion Swiss francs, or \$3.1 billion.⁵ After observing SDC’s contributions to, and success in, the dental prosthesis industry, Straumann used its considerable resources to replicate the functionality of SDC’s patented system, branding its product the “NeoConvert” system, then priced its knockoff to undercut SDC in the market. SDC commenced the Parallel Litigation to seek compensation for Straumann’s repeated infringement and to prevent further misappropriation and use of SDC’s patented innovations.

A. The ’781 Patent Prosecution

The ’781 patent describes a “temporary alignment system and method for holding a dental coping to an implant abutment using the same threads in the abutment that are used for definitive attachment.” Pet. Ex. 1001, at 1. “The disclosed temporary fasteners initially orient and hold a coping against an abutment,” and then “[t]he aligned coping can be picked-up in a closed-tray

⁵ The Straumann Group, 2024 Financial Report at 200, available at <https://shorturl.at/RuRjJ>.

impression process without unscrewing the temporary fastener.” Pet. Ex. 1001, at 1. “Embodiments” of these temporary fasteners “include threaded posts that release copings from the abutment through axial forces” as well as “a threaded post with separable cap that is picked-up with the coping.” Pet. Ex. 1001, at 1.

SDC’s ’781 patent, like the ’992 patent before it,⁶ underwent a thorough review during prosecution. There were several office actions, both non-final and final, some of which resulted in amendments. *See, e.g.*, Pet. Ex. 1020 (prosecution history), at 924–948, 986–1009, 1012–1015, 1023–1032, 1055–1071, 1076–1078, 1080–1090, 1095–1104, 1108–1122.

The examiner rejected multiple claims for obviousness in light of prior art. Pet. Ex. 1020, at 930–947. In two Information Disclosure Statements, SDC provided 122 prior-art references—including two of the prior art references Straumann relies on in its petition—all of which were considered. Pet. Ex. 1020 (prosecution history), at 881–894, 967–979. The examiner independently conducted her own detailed prior art searches. Pet. Ex. 1020 (prosecution history), at 950–966, 1124–1141. And in response to examiner concerns raised in

⁶ *See* Pet. Ex. 1015 (prosecution history for application 18/328,730); Patent Owner’s Request for Discretionary Denial and Supporting Brief, IPR2025-00956, Paper 8 at 4–5 (PTAB July 25, 2025) (summarizing prosecution history).

application 18/328,730, SDC explicitly addressed specification and disclosure issues similar to those that Straumann’s Petition raises. *See* Pet. Ex. 1015, at 292–301.

Ultimately, as with the ’992 patent, the examiner allowed the claims over several references to what she considered “[t]he closest prior art” and explained her reasoning. Pet. Ex. 1020, at 1016–1122. The ’781 patent issued December 3, 2024.

B. Parallel Litigation in the District of Delaware

The Parallel Litigation has been underway for more than a year. In April 2024, SDC filed its complaint alleging that Straumann’s NeoConvert devices infringe the ’992 patent, a parent of the ’781 patent. Ex. 2002 (docket sheet); Ex. 2003 (complaint). SDC briefly delayed formally serving the complaint to facilitate the parties’ settlement discussions. When settlement negotiations were unsuccessful, SDC served the complaint on June 10, 2024. Ex. 1002 (docket sheet).

Rather than answering, Straumann moved to dismiss under 35 U.S.C. § 112. It relied on a weak and technical argument that the ’992 patent’s claims at issue are “indefinite because they are all directed to an apparatus but also include a method step and therefore are impermissibly directed to two different statutory classes of patentable subject matter under 35 U.S.C. § 101.” Ex. 2004 (dismissal motion).

The parties fully briefed the motion and the Court heard oral argument in November 2024. Ex. 2002 (docket sheet). After interpreting the '992 patent's claim language, the Court denied Straumann's motion. *See Smart Denture Conversions, LLC v. Straumann USA, LLC*, 759 F. Supp. 3d 555 (D. Del. 2024). Straumann answered the complaint and the parties submitted a proposed scheduling order, which the Court adopted. Ex. 2002 (docket sheet); Ex. 2005 (scheduling order).

In January 2025, SDC filed a supplemental complaint that asserted both the '992 patent as well as the '781 patent at issue here. Ex. 2002 (docket sheet); Ex. 2001 (supplemental complaint). The parties negotiated a stipulated protective order in March 2025, which the Court adopted. Ex. 2002 (docket sheet); Ex. 2006 (protective order).

Meanwhile, both parties proceeded with discovery and patent issues, as the scheduling order directed. In early 2025, Straumann and SDC both served multiple rounds of interrogatories and document requests, and produced thousands of pages of documents. The parties engaged in extensive back-and-forth and two meet-and-confer conferences to address those discovery requests. SDC served written responses to all of Straumann's discovery requests; Straumann has yet to respond in writing to SDC's second round of requests. The parties negotiated the search terms each side will use to identify and produce additional responsive documents.

In April, SDC served its initial infringement claim charts on Straumann. Ex. 2002 (docket sheet). Straumann served its initial invalidity contentions on June 2, 2025, then filed its Petition in this PGR proceeding two days later on June 4, 2025. Ex. 2002 (docket sheet); Ex. 2007 (invalidity contentions). The parties prepared detailed mediation statements and participated in an unsuccessful mediation later in June.

The scheduling order (entered nearly six months ago at this point) sets trial for **October 19, 2026** and a *Markman* hearing for **March 6, 2026**, just seven months away. The case will proceed to trial as follows:

August 29, 2025	Document production must be substantially completed.
September 19, 2025	Parties to exchange privilege logs.
September 26, 2025	Parties to exchange terms and claims that need construction, along with preliminary constructions and extrinsic evidence.
November 21, 2025	Parties to provide final infringement and invalidity contentions.
December 5, 2025	All non-expert discovery must be completed.
December 5, 2025	Parties to file a joint claim construction chart.
December 19, 2025	SDC to serve opening claim construction brief.
January 16, 2026	Straumann to serve answering claim construction brief.
January 30, 2026	SDC to serve reply brief.
February 13, 2026	Straumann to serve sur-reply brief.
February 20, 2026	Parties to file joint claim construction brief with Court.

March 6, 2026	<i>Markman</i> hearing and hearing on any motion for summary judgment of indefiniteness.
April 10, 2026	Initial Rule 26(a)(2) disclosures of expert testimony for parties with initial burden of proof.
May 8, 2026	Initial Rule 26(a)(2) disclosures of expert testimony for parties without initial burden of proof.
May 22, 2026	Reply expert reports for parties without initial burden of proof, as well supplemental disclosures to contradict or rebut evidence on same subject matter identified by another party.
June 5, 2026	Expert discovery must be completed.
June 19, 2026	Deadline for dispositive and <i>Daubert</i> motions.
July 17, 2026	Deadline for responsive briefs to dispositive and <i>Daubert</i> motions.
July 31, 2026	Deadline for reply briefs in support of dispositive and <i>Daubert</i> motions.
September 1, 2026	SDC to provide draft pretrial order to Straumann.
September 21, 2026	Straumann to provide responses to draft pretrial order.
September 28, 2026	SDC to file proposed pretrial order with clerk.
October 1, 2026	Parties to file joint proposed final pretrial order, as well as to file proposed voir dire, preliminary jury instructions, final jury instructions, and special verdict forms.
October 19, 2026	Jury selection and trial.

Ex. 2005 (scheduling order). The parties have successfully kept to the scheduling order thus far; there is no reason to believe that trial will not begin as scheduled on October 19, 2026.

III. THE DIRECTOR SHOULD EXERCISE HER DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 324(a)

Like § 314(a), which governs IPR proceedings, § 324(a) “invests the Director with discretion on the question *whether* to institute review.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 366 (2018). The Director and Board are “permitted, but never compelled, to institute an IPR proceeding” or a PGR proceeding. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016); *see also Cuozzo Speed Techs. v. Lee*, 579 U.S. 261, 273 (2016) (“the agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion”). The Director should exercise her discretion to deny institution on all grounds. As shown below, the *Fintiv* factors all weigh in favor of denying institution under 35 U.S.C. § 324(a). Taking all these factors collectively, this Petition presents a compelling case for discretionary denial.

A. Factor 1: The Parallel Litigation has not been stayed and will likely not be stayed even if this Petition is instituted

Factor 1 weighs against institution because a stay in the Parallel Litigation is unlikely. Petitioner is currently seeking a conditional stay that would take effect if the Board institutes this PGR or the co-pending IPR; SDC opposes that motion.

Judge Barker is unlikely to grant the stay, of course. The Eastern District of Texas, where Judge Barker normally sits, “has a ***consistent practice of denying motions to stay*** when the PTAB has yet to institute ... proceedings.” *Force Mos Tech., Co., Ltd. v. ASUSTek Computer, Inc.*, No. 2:22-CV-00460-JRG, 2024 WL 1586266, at *4 (E.D. Tex. Apr. 11, 2024) (emphasis added); *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (“This Court’s survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for *inter partes* review, the courts have ***uniformly denied motions for a stay.***” (emphasis added)). “Typically, when a party files such a premature motion to stay,” the Eastern District of Texas “will deny the motion ***without prejudice to refile the same following the PTAB’s institution decision*** regarding the last of the patents-in-suit to be acted upon by the PTAB.” *Force Mos*, 2024 WL 1586266, at *4 (emphasis added). Likewise, the District of Delaware has said repeatedly that requesting a stay before an institution decision is “premature” and futile, “as courts almost invariably deny requests for stays pending IPR proceedings when the stay requests are filed before the IPR is instituted.” *IOENGINE, LLC v. PayPal Holdings, Inc.*, Nos. 18-452 et al., 2019 WL 3943058, at *6 (D. Del. Aug. 21, 2019); *British Telecomm’s PLC v. IAC/InterActive Corp.*, No. 18-366, 2019 WL 4740156, at *5 (D. Del. Sept. 27, 2019) (same).

As explained above, Petitioner has also challenged the other patent at issue in the Parallel Litigation, in a previously filed IPR petition. The institution decision in this case is due several weeks later than that one, on December 26, 2025—meaning that the Court would deny any motion to stay as premature until at least then. *See Force Mos*, 2024 WL 1586266, at *4 (“Typically, when a party files such a premature motion to stay, this Court will deny the motion without prejudice to refile the same following the PTAB’s institution decision ***regarding the last of the patents-in-suit to be acted upon by the PTAB.***” (emphasis added)).

It is also improbable that Judge Barker would grant a later stay request even if the Petition were instituted. At that point, Judge Barker’s analysis would center on three questions: (1) “whether the stay will ***unduly prejudice*** the nonmoving party,” (2) “whether the proceedings before the court have ***reached an advanced stage***, including whether discovery is complete and a trial date has been set,” and (3) “whether the stay will ***likely result in simplifying the case*** before the court.” *Nanoco Techs. Ltd. v. Samsung Elecs. Co., Ltd.*, No. 2:20-CV-00038-JRG, 2021 WL 3027335, at *1 (E.D. Tex. Jan. 8, 2021) (emphasis added).

Those considerations will lead the Court to deny any stay. For one thing, a stay would severely prejudice SDC because SDC and Straumann are head-to-head competitors in the same market; “direct competition weighs against granting a stay.” *Luminati Networks Ltd. v. NetNut Ltd.*, No. 2:20-cv-00188-JRG-RSP, 2021

WL 3128654, at *3 (E.D. Tex. July 23, 2021); Ex. 2001 (supplemental complaint) ¶¶ 27–31.

Furthermore, by **December 26, 2025**, when the Board acts on this Petition, the Parallel Litigation will be well on its way to the scheduled trial. Fact discovery will be closed (December 5, 2025), the parties will have submitted their joint claim construction chart (December 5, 2025), SDC will have filed its opening claim construction brief (December 19, 2025), and Straumann will be days away from the January 16 deadline for its answering claim construction brief. Meanwhile, the parties will be in the thick of expert discovery.

Accordingly, as of December 26, 2025, the parties already will have “expended significant resources” and the Court would not stay the Parallel Litigation. *See, e.g., Sonrai Memory Ltd. v. LG Elecs. Inc.*, No. 6:21-cv-00168-ADA, 2022 WL 2307475, at *3 (W.D. Tex. June 27, 2022) (denying stay when fact discovery opened two weeks before institution decision); *Intellectual Ventures II LLC v. FedEx Corp.*, No. 2:16-cv-00980, 2017 WL 4812434, at *2 (E.D. Tex. Oct. 24, 2017) (“The Court agrees that the Parties have ***already invested substantial effort and resources during discovery and in preparing claim construction briefing.*** ... These circumstances ***weigh against staying this case.***” (emphasis added)).

For these reasons, Factor 1 favors denying the Petition.

B. Factor 2: The Board likely would not issue a final written decision until over two months *after* trial

Factor 2 strongly weighs against institution because trial is scheduled to begin over *two months before the projected final written decision* in this proceeding. The Court has set the Parallel Litigation for a jury trial beginning October 19, 2026, meaning a verdict will immediately follow the trial. Ex. 2005 (scheduling order). The projected deadline for a final written decision here, on the other hand, is December 26, 2026. *See* Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response, Paper 5 (setting preliminary response date for September 25, 2025); 35 U.S.C. § 324(c) (setting expected institution decision for three months after preliminary response); 35 U.S.C. § 326(a)(11) (requiring final determination by one year after institution decision, extendable by six months). SDC will vigorously oppose any motions that will delay that trial date, because SDC’s ongoing damages require a remedy as quickly as possible.

“As such, it is unlikely that a final written decision in these proceedings will issue before the district court trial occurs,” which favors denying the Petition. *NXP USA, Inc. v. Redstone Logics LLC*, IPR2025-00485, Paper 11 (Director July 10, 2025) (denying institution on this basis); *see also Samsung Elecs. Co. Ltd. v. Os-New Horizon Personal Computing Sols. Ltd.*, IPR2025-00613, Paper 10 at 2 (Director July 17, 2025) (same); *Samsung Elecs. Co. Ltd. v. Mobile Data Techs.*,

LLC, IPR2025-00535, Paper 16 (Director July 10, 2025) (same); *Entegris, Inc. v. Inpria Corp.*, IPR2025-00267, Paper 12 (Director July 2, 2025) (same); *Lam Research Corp. v. Inpria Corp.*, IPR2025-00256 et al., Paper 12 (Director July 2, 2025) (same); *Samsung Elecs. Co. Ltd. et al. v. Cerence Op. Co.*, IPR2025-00458 et al., Paper 14 (Director June 25, 2025) (same); *Cisco Sys., Inc. v. WSOU Invs. LLC*, IPR2025-00429, Paper 15 (Director June 25, 2025) (same). In fact, *Fintiv* denied institution in part because, like this case, trial was scheduled to begin “approximately two months” before a final written decision. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, at 12–13 (PTAB May 13, 2020).

Even where the trial date precedes the written decision deadline by only a month—or less—the Director correctly recognizes that “it will be inefficient to maintain two parallel proceedings when the district court scheduled trial date and the projected final written decision due date are in close proximity.” *Shenzen Tuozhu Tech. Co., Ltd. v. Stratasy, Inc.*, IPR2025-00354, Paper 11 (Director June 12, 2025). “Exercising discretion to deny the petition” in such cases “reduces the inefficiencies and burdens on the parties to maintain two parallel proceedings.” *Id.* That is even true where the trial date falls a month *after* the written decision deadline. *See Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9 (Director June 12, 2025). Likewise, it would be inefficient here to maintain two parallel proceedings—even more the *three* parallel

proceedings that Straumann seeks with its co-pending petition for IPR of the other patent-in-suit, the '992 patent.

Factor 2 therefore favors denial in this case, just as it did in in *NXP, Os-New, Mobile Data, Entegris, Lam Research, Cerence, WSOU*, and *Fintiv* itself.

C. Factor 3: The Court and parties have invested heavily in the Parallel Litigation and will continue to do so before the Board makes any institution decision

Factor 3 likewise favors denying the Petition because both parties and the Court have invested, and will continue to invest, significant resources into the Parallel Litigation. The Director weighs “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, IPR2020-00019, Paper 11 at 9.

By December 26, 2026, when the Board decides whether to institute this PGR, the parties will have:

- conducted settlement discussions (April 2024);
- briefed and argued a motion to dismiss (which the Court denied on December 12, 2024), *see Smart Denture Conversions*, 759 F. Supp. 3d 555;
- filed an amended complaint (February 2025);
- negotiated a stipulated protective order (February and March 2025);

- exchanged, negotiated, and responded to multiple rounds of discovery requests;
- briefed and participated in mediation before a JAMS mediator (June 2025);
- reviewed and produced tens (or hundreds) of thousands of pages of documents;
- exchanged privilege logs (September 19, 2025);
- provided final infringement and invalidity contentions (November 2025);
- completed fact discovery (December 5, 2025);
- filed a joint claim construction chart (December 5, 2025); and
- begun *Markman* briefing (SDC opening brief due December 19, 2025; Straumann answering brief due January 16, 2026).

And, of course, the parties will be quickly approaching expert discovery as well. The parties will therefore have invested significant resources into the Parallel Litigation. *See Samsung Elecs. Co. Ltd. v. Keyless Licensing LLC*, IPR2025-00526 et al., Paper 13 at 2 (Director July 17, 2025) (“[T]here has been meaningful investment in the parallel proceeding by the parties. For example, the parties are engaged in the *Markman* process and fact discovery is nearly closed.” (citations omitted)); *Kingston Tech. Co. v. Vervain LLC*, IPR2025-00614 et al., Paper 13 at 2

(Director July 16, 2025) (“Furthermore, there has been meaningful investment in the parallel proceeding by the parties. For example, the district court has held a *Markman* hearing, fact discovery is complete, and the parties have exchanged final infringement and invalidity contentions.”).

The Court has already entered multiple orders in the case, including an order denying Straumann’s dismissal motion (following oral argument), an order regulating practice, a scheduling order, and a protective order. *See Smart Denture Conversions*, 759 F. Supp. 3d 555; Ex. 2008 (order regulating practice); Ex. 2005 (scheduling order); Ex. 2006 (protective order). What’s more, in denying the dismissal motion, the Court conducted a hearing and issued a “substantive order[] related to the patent at issue” in the co-pending IPR petition—a parent of the ’781 patent—which further “favors denial.” *Fintiv*, IPR2020-00019, Paper 11 at 9–10.

Moreover, as explained above, a jury will resolve the issues in the Parallel Litigation weeks before the Board’s expected written decision. That means any final written decision would simply revisit the jury’s earlier validity findings. Such duplicative efforts contradict the basic purpose of post-grant review—to provide “quick and cost effective *alternatives* to litigation.” Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019)) (“Practice Guide”) at 56 (quoting H.R. Rep. No. 112-98, pt. 1, at 40 (2011), 2011 U.S.C.C.A.N. 67, 69) (emphasis

added). Thus, the Court and the parties have invested, and will continue to invest, significant resources in the Parallel Litigation.

Of course, the reason that the Parallel Litigation will have progressed so far by December 2025 is that Straumann delayed nearly *ten months* after being served with the complaint before filing its IPR petition, and then *over a month* to file this Petition, which largely recycles the IPR petition's arguments. The Petition therefore was hardly "filed ... expeditiously." *Fintiv*, IPR2020-00019, Paper 11 at 11.

Straumann may try to justify that delay by arguing that it "wait[ed] to file its petition until it learn[ed] which claims are being asserted against it in" the Parallel Litigation. *Fintiv*, IPR2020-00019, Paper 11 at 11. That would be disingenuous. The parent '992 patent has only twelve claims—and Straumann had no difficulty deciding which claims to challenge in filing its § 112 motion to dismiss the complaint. The '781 patent likewise has only sixteen claims. The timeline itself similarly undercuts any excuse: SDC served its infringement contentions on April 25, 2025, a mere five days before Straumann submitted its two-thousand-page IPR filing on April 30, and a few short weeks before Straumann submitted this two-thousand-page PGR filing on June 4. The Petition (and the IPR petition it repackages) was clearly in near-final form long before SDC served its preliminary infringement contentions.

Factor 3 favors discretionary denial. In these circumstances, a PGR is not an alternative to litigation; it is simply more litigation, in a separate forum.

D. Factor 4: There is significant overlap between the issues raised in this Petition and those in the Parallel Litigation

Factor 4 likewise weighs against institution, given the significant overlap between this Petition and the Parallel Litigation. The Parallel Litigation involves the same '781 patent as this proceeding, along with the '992 patent that is the subject of Straumann's co-pending petition for *inter partes* review.

Furthermore, the Parallel Litigation already involves the invalidity grounds raised in the Petition. The sixteen claims the Petition challenges (1–16) include all nine claims SDC asserts in the Parallel Litigation (1–6, 8, 10, 12–16). Straumann's initial invalidity contentions in the Parallel Litigation rely on the same four references to argue obviousness as the Petition here—Bernhard (Pet. Ex. 1003), Poovey (Pet. Ex. 1005), Gracco (Pet. Ex. 1006) and Derey (Pet. Ex. 1008); *see also* Ex. 2007 (invalidity contentions). In fact, Straumann's invalidity contentions explicitly incorporate this Petition: “Straumann further refers SDC, and incorporates by reference, Straumann's Petition for Post Grant Review of U.S. Patent No. 12,156,781, to be filed with the U.S. Patent and Trademark Office, Patent Trial and Appeal Board, on or shortly after the date of these contentions” Ex. 2007 (invalidity contentions).

Recognizing this obvious overlap, Straumann filed a *Sotera* stipulation in the Parallel Litigation. Ex. 2009 (stipulation). But that stipulation is not dispositive under the Director’s current policies for discretionary denials; rather, “the Board will consider such a stipulation as part of its holistic analysis under *Fintiv*.” Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (Mar. 24, 2025), at 2–3 (“March 2025 Memorandum”). And in light of the Federal Circuit’s recent decision in *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. 2025), which construed IPR estoppel narrowly, the value of a *Sotera* stipulation is even less than before. In short, the *Sotera* stipulation will not suffice to prevent substantial overlap between the district court proceedings and any PGR here.

For these reasons, when considered in light of the other *Fintiv* factors, Factor 4 does not tip the balance toward institution.

E. Factor 5: The parties are the same in both proceedings

Petitioner here and defendant in the Parallel Litigation “are the same party,” so “this factor weighs in favor of discretionary denial.” *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 12 (PTAB May 2, 2022).

F. Factor 6: Other circumstances weigh against institution

Fintiv’s last factor incorporates “a balanced assessment of all the relevant circumstances in the case, including the merits,” and any relevant “[]other facts

and circumstances.” *Fintiv*, IPR2020-00019, Paper 11 at 14, 16; *see also* PTAB Memorandum at 2–3 (permitting parties to address “[c]ompelling economic, public health, or national security interests” and “[a]ny other considerations bearing on the Director’s discretion”). Factor 6 favors discretionary denial as well because, as explained below, (1) the Petition does not present any compelling argument for unpatentability; (2) the Petition relies heavily on expert testimony to retroactively plug holes in the prior art; and (3) SDC has compelling economic interests in focusing its efforts and resources exclusively on the Parallel Litigation in its chosen forum.

1. The Petition lacks merit⁷

The Petition’s arguments have significant weaknesses and gaps in proof, as discussed briefly below and in more detail in SDC’s forthcoming Preliminary Response.

For example, the Petition does not present any compelling argument for unpatentability. The Petition, for example, does not present any anticipatory prior art under § 102. Instead, the Petition’s obviousness arguments rely principally on

⁷ SDC will file a Preliminary Response by September 25, 2025, to explain the Petition’s substantive weaknesses in detail. SDC’s arguments here focus on threshold deficiencies that are themselves dispositive.

various combinations of *four* prior art references (two of which, Bernhard and Poovey, were considered by the Examiner during the patent prosecution) to show obviousness under § 103, with nearly 250 pages of expert testimony attempting to back-fill the gaps between the references. Ironically, these strained obviousness arguments have the opposite of their intended effect; they highlight how novel the '781 patent's claims were.

Furthermore, Straumann's argument that the claims are not adequately described or enabled depends on its strained argument that the specification disclosed only a single embodiment of the temporary fastener shown in Figure 75. *See* Petition at 2 (“[T]he claims are not supported because they are much broader than the only embodiment in the specification, for several reasons.”); *id.* at 3 (referring to “the only disclosed embodiment”); *id.* at 58 (“As explained above, the specification discloses only one temporary fastener embodiment that can be pulled out of the abutment without being unscrewed: the embodiment of Figure 75.”).

As SDC will explain in further detail in its forthcoming Preliminary Response, the specifications disclose multiple embodiments of the temporary fastener. “[*I*]psis *verbis* disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question.” *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570 (Fed.

Cir. 1996); *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995) (“[T]he prior application need not describe the claimed subject matter in exactly the same terms as used in the claims”). “One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

The specification makes clear that “[t]he inventive concepts disclosed are not meant to be restricted to a temporary attachment post with standard screws that both engage and disengage the threads in the implant abutment through rotations.” Pet. Ex. 1001, at 41. It states, for example, that “the threads could be designed to provide engagement with the implant abutment threads through *axial motion in the opposite direction to the arrow shown in FIG. 75*,” Pet. Ex. 1001, at 41 (emphasis added)—what the Petition would call a ‘reverse buttress thread’ instead of a buttress thread. “Alternate approaches for engaging a temporary attachment post with abutment threads through *axial insertion without rotation* are considered to be *part of this disclosure*.” Pet. Ex. 1001, at 41 (emphasis added). The disclosure also includes “an *interference fit* between the bottom of the post with the threads.” Pet. Ex. 1001, at 41 (emphasis added). Furthermore, “[t]he drawings featured in the figures,” including Figure 75, “are for the purpose of *illustrating certain convenient embodiments* of the present invention and are *not to be considered as limitation thereto*.” Pet. Ex. 1001 at 33 (emphasis added); *id.* at 42

(“Various embodiments have been described to illustrate the disclosed inventive concepts, not to limit the invention.”). The specification thus describes more than a temporary fastener with what the Petition calls a buttress thread; by its terms, it also *at least* includes a temporary fastener with a reverse buttress thread as well.

Furthermore, the specifications make clear that the disclosed embodiments include those *without* a “split post with deflecting legs,” as the Petition describes them. Petition at 46. It also includes embodiments with “an interference fit between the bottom of the [temporary fastener] post with the [abutment] threads.” Pet. Ex. 1001, at 41. An interference fit involves mechanical friction that results from inserting one part into an opening of a second part in which the opening is smaller than the first part, sometimes involving the first part’s deformation. And the specification does not describe the split-post structure as critical. For these reasons, the priority applications disclose more embodiments than just the one on which the Petition fixates. Properly interpreted, the specifications adequately describe and enable the ’781 patent claims.

Finally, even if the Petition’s merits were “a closer call” (they are not), that closeness would still “favor[] denying institution” because “other factors favoring denial are present.” *Fintiv*, IPR2020-00019, Paper 11 at 14. Indeed, the Director has denied institution even where “Petitioner’s obviousness challenges meet the standard for institution.” *Eunsung Global Corp. v. Hydrafacial LLC*, IPR2024-

01491, Paper 17 at 16–17 (PTAB Apr. 11, 2025); *see also Toyota Motor Corp. v. Emerging Auto. LLC*, IPR2024-00785, Paper 13 at 15–16 (PTAB Mar. 11, 2025) (denying institution under *Fintiv* and noting that “[a]lthough we determine that Petition adequately shows a reasonable likelihood of success . . . , we do not find the merits to be particularly strong on the current record”).

2. The Petition relies heavily on expert testimony

“The extent of the petition’s reliance on expert testimony” is also an important Factor 6 consideration. PTAB Memorandum at 2. Like the co-pending IPR petition before it, the Petition relies heavily on an expert declaration by John Brunski that is almost 250 pages long. *See* Pet. Ex. 1002 (Brunsky Decl.). The Petition’s obviousness arguments—based on Bernhard, Poovey, Gracco, and Derey—closely mimic, and offer little substance in addition to, the lengthy expert declaration. In all, the Petition cites Brunski *nearly 180 times*. This suggests that Brunski’s expert declaration is a none-too-subtle attempt to retroactively fill gaps in the prior art.

The Petition does not just cite Brunski, either. Many of the paragraphs in the Petition are identical or virtually identical to corresponding Brunski paragraphs.

For example:

Petition at 8	Brunski Decl. ¶ 53
<p>An open-tray technique using an impression tray is shown in Kumar (U.S. Patent No. 6,283,752) (Ex. 1004). Screws 216 inserted through openings 204 in impression tray 202 connect copings 210 to the abutments. <i>Id.</i>, 8:30–42, Fig. 2A. After impression material 104 sets, the dentist loosens screws 216 and removes impression tray 202 with copings 210. <i>Id.</i>, 8:43–48, Fig. 2B; Ex. 1002, ¶ 53.</p>	<p>An open-tray technique using an impression tray is described and shown in Kumar (U.S. Patent No. 6,283,752) (Ex. 1004), which published in 2001. As shown in Figure 2A below, the screws 216 inserted through the openings 204 in the impression tray 202 connect the copings 210 to the implant abutments. Kumar (Ex. 1004), 8:30–42, Fig. 2A. As shown in Figure 2B below, after the impression material 104 sets, the dentist loosens the screws 216 and removes the impression tray 202 with the copings 210. Ex. 1004, 8:43–48, Fig. 2B.</p>
Petition at 71	Brunski Decl. ¶ 229
<p>However, as explained above, based on the teachings of Poovey and Gracco, a POSA would have modified the threads of shaft 754 of threaded fastener 750 in two respects, so that the temporary screw would provide a stable, reliable and secure connection but still be able to be pulled out without being unscrewed. First, a POSA would have</p>	<p>However, as explained above, based on Poovey and Gracco, a POSA designing a temporary fastener based on the design of threaded fastener 750 would have modified the threads from those of the shaft 754 in two respects, so that the temporary fastener would provide a stable, reliable and secure connection, while retaining the ability to be pulled</p>

<p>chosen an asymmetric buttress thread, based on Gracco, as discussed above. Second, a POSA would have made or coated the threads with silicone or another flexible plastic to make the threads flexible, based on Poovey, as discussed above. [Brunski Decl.] ¶¶ 229–234.</p>	<p>out without having to be unscrewed to facilitate pick-up processing. First, a POSA would have modified the symmetric thread of the shaft 754 that matches the abutment threads to an asymmetric buttress thread, based on Gracco, as discussed above. Second, a POSA would have made or coated the buttress threads with silicone or another flexible plastic to make the threads flexible, based on Poovey, as discussed above.</p>
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This pattern—identical, nearly identical, or superficially reworded prose in both the Petition and Brunski declaration—continues throughout. *E.g., compare* Petition at 7–8 *with* Brunski Decl. ¶¶ 50–51; *compare* Petition at 8 *with* Brunski Decl. ¶¶ 52–53; *compare* Petition at 36 *with* Brunski Decl. ¶¶ 143–144. Repackaging expert testimony this way undercuts the Petition and weighs in favor of discretionary denial. *Cf. Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15–17 (PTAB Aug. 24, 2022) (according “little weight” to testimony that contained a “verbatim” restatement of a petition’s conclusory assertions without additional supporting evidence or reasoning); *Wowza Media Sys., LLC v. Adobe Sys. Inc.*, IPR2013-00054, Paper 12 at 12 (PTAB Apr. 8, 2013) (“The Declaration is 100 pages in length and appears, for the most part, simply to track and repeat the

arguments for unpatentability presented in the Petition. The lengthy Sherman Declaration is therefore no more helpful than the Petition in determining where the challenged recitation is found in the references.”).

Brunski’s conclusions will also be contested; SDC anticipates that its preliminary response will be accompanied by an expert declaration rebutting Brunski’s conclusory assertions about what a person of ordinary skill in the art (“POSA”) would and would not have been motivated to do in 2018.

The Office’s own guidance therefore supports discretionary denial, because “*extensive reliance* on expert testimony and/or reasonable *disputes between experts* on dispositive issues may suggest that the questions *are better resolved in an Article III court.*”⁸ This is consistent with centuries-old legal tradition assigning primary responsibility for resolving conflicting testimony to jurors, not judges. *See, e.g., United States v. Fortune*, 513 F.2d 883, 890 (5th Cir. 1975) (“The *responsibility* for evaluating the *conflicting expert testimony rests, of course, with the jury.*” (emphasis added)); *Mims v. United States*, 375 F.2d 135, 140 (5th Cir. 1967) (“[O]ne of the most generally accepted rules in all jurisprudence, state and federal, civil and criminal, is that the questions of the credibility and weight of

⁸ *FAQs for Interim Processes for PTAB Workload Management*, USPTO, <https://shorturl.at/H9Vz9> (last visited July 17, 2025) (emphasis added).

expert opinion testimony are for the trier of facts, and that such testimony is ordinarily not conclusive even where it is uncontradicted.”); *The Conqueror*, 66 U.S. 110, 133 (1897) (“[T]he *ultimate weight to be given to the testimony of experts is a question to be determined by the jury*; and there is no rule of law which requires them to surrender their judgment or to give a controlling influence to the opinions of scientific witnesses.” (emphasis added)).

Straumann’s substantial reliance on expert testimony underscores that these arguments are more appropriately considered and resolved by a jury in the Parallel Litigation. This further supports discretionary denial.

3. Compelling economic interests favor discretionary denial

The Director has stated that “[c]ompelling economic ...interests” are relevant to discretionary denial as well. PTAB Memorandum at 2. Dr. Kofford and Mr. Rudisill, the ’781 patent’s inventors, invested significant time and effort over several years to develop the products that SDC sells. And those investments paid off, for a time—until Straumann introduced its own knockoff product and undercut SDC’s prices.

The costs of vindicating patent rights in federal court are significant to a small family-run company like SDC with limited resources. Aware that its own finances likely dwarf SDC’s, Straumann’s strategy thus far has been to exploit that mismatch by making the Parallel Litigation expensive for SDC. Straumann’s PGR

and related IPR petitions are additional fronts in that broader war of attrition—and instituting an PGR would reward Straumann’s gamesmanship.

Compelling economic interests therefore favor denial. SDC should focus its limited resources on the Parallel Litigation—where Straumann will have every opportunity to present its obviousness arguments—without the distraction and burden of merely duplicative and ultimately slower proceedings in this PGR (and parallel IPR).

* * *

For all these reasons, a PGR would not be “an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential). It would instead be—as Straumann intended—an expensive, distracting, and unnecessary *addition* to the existing Parallel Litigation. The Director should exercise her discretion to deny the Petition and prevent Straumann from misusing the Board’s resources for tactical advantage.

IV. CONCLUSION

The *Fintiv* factors, including multiple additional circumstances, weigh against institution here. For these reasons, SDC respectfully requests that the Director exercise her discretion to deny the Petition for post-grant review of the ’781 patent.

Respectfully submitted,

Dated: July 31, 2025

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing Patent Owner's Request for Discretionary Denial and Supporting Brief contains, as measured by the word-processing system used to prepare this paper, 6,583 words, which is within the limit set in 37 C.F.R. § 42.24(b)(1). This word count does not include the items excluded by 37 C.F.R. § 42.24.

Respectfully submitted,

Dated: July 31, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on July 31, 2025, I caused a true and correct copy of the foregoing Patent Owner's Request for Discretionary Denial and Supporting Brief to be served via email on Petitioner at the following addresses:

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