

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

ASCENTCARE DENTAL PRODUCTS, INC.,
Petitioner,

v.

SOLMETEX, LLC,
Patent Owner.

IPR2025-01104 (Patent 12,011,329 B2)
IPR2025-01175 (Patent 12,290,418 B2)

Before COKE MORGAN STEWART, *Deputy Under Secretary of
Commerce for Intellectual Property and Deputy Director of the United
States Patent and Trademark Office.*

DECISION
Referring the Petitions to the Board

IPR2025-01104 (Patent 12,011,329 B2)

IPR2025-01175 (Patent 12,290,418 B2)

Solmetex, LLC (“Patent Owner”) filed a request for discretionary denial (Paper 6, “DD Req.”) in the above-captioned cases, and Ascentcare Dental Products, Inc. (“Petitioner”) filed an opposition (Paper 8, “DD Opp.”).¹

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

Although the parties are engaged in a parallel proceeding involving the challenged patents, it is unclear whether a final written decision in the Board proceedings will issue after the district court trial occurs. In particular, the projected final written decision due date in the Board proceedings is January 8, 2027. DD Req. 19. The district court does not have a scheduled trial date, but time-to-trial statistics suggest that the trial could begin before the projected final written decision due date. *Id.* at 19–20. As such, these considerations neither favor nor counsel against discretionary denial.

Other considerations, however, favor referral to the Board. In particular, the challenged patents issued recently, in 2024 and 2025. Early challenges to patents favor robust, predictable patent rights and weigh against discretionary denial. Additionally, Petitioner provides persuasive reasoning, supported by evidence, that the Office materially erred during prosecution and, accordingly, discretionary denial is not appropriate. Specifically, during prosecution of the challenged claims in IPR2025-01104,

¹ Citations are to papers in IPR2025-01104. The parties filed similar papers in IPR2025-01175.

IPR2025-01104 (Patent 12,011,329 B2)

IPR2025-01175 (Patent 12,290,418 B2)

the patent examiner rejected the claims over Hirsch,² but indicated that a dependent claim recited the allowable subject matter of “wherein the first wall and the second wall of the main body portion that transition into the cheek-retractor portion are spaced apart from each other for a distance within the cheek-retractor portion before being connected to each other in the cheek-retractor portion.” DD Opp. 8–9; Ex. 1002, 156–186. Petitioner presents evidence, however, that Hirsch appears to teach this limitation. DD Opp. 9. Petitioner demonstrates that at least one of the challenged claims in IPR2025-01175 appears to recite the same limitation at issue. *See* IPR2025-01175, Paper 10 at 10–11. Accordingly, Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are referred to the Board to handle the cases in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner’s requests for discretionary denial are *denied*;

FURTHER ORDERED that the Petitions are referred to the Board;
and

² US 2003/0134253 A1, pub. July 17, 2003 (Ex. 1012).

IPR2025-01104 (Patent 12,011,329 B2)
IPR2025-01175 (Patent 12,290,418 B2)

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

IPR2025-01104 (Patent 12,011,329 B2)

IPR2025-01175 (Patent 12,290,418 B2)

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