

**UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF MICHIGAN  
SOUTHERN DIVISION**

SOLMETEX, LLC,  
Plaintiff/Counter-Defendant,

Case No. 1:24-cv-00954-RJJ-MV

v.

Hon. Robert J. Jonker

ASCENTCARE DENTAL PRODUCTS,  
INC.,  
Defendant/Counter-Plaintiff.

**PLAINTIFF/COUNTER-DEFENDANT SOLMETEX, LLC'S OPPOSITION TO  
ASCENTCARE'S MOTION TO STAY (ECF NO. 38)**

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## I. INTRODUCTION

Ascentcare's motion to stay should be denied as premature and speculative. Assuming Ascentcare's petitions are not discretionarily denied by the Patent Office Director (which is the most likely outcome), the Patent Trial and Appeal Board ("PTAB") will not issue institution decisions until December 2025 and January 2026. Ascentcare would have the Court stay this case until at least February 2026, leaving Solmetex's claims languishing and unresolved for months and potentially years. In situations like the present case where IPRs have been filed but the PTAB has not yet acted on them, the majority of district courts routinely deny stay requests as premature. That is because any potential efficiencies to be gained are speculative until the PTAB decides whether to institute a proceeding. The Court should do the same here.

Attempting to sidestep this case law, Ascentcare asks the Court to take its word that its petitions are "strong" and will be instituted. The opposite is true. Recent changes in the PTAB have led to the PTAB denying petitions at a much higher rate under its "discretionary denial" authority. Ascentcare's suggestion that these new procedures cannot impact its petitions could not be further from reality. For example, the petitions rely on references that the Patent Office already considered when allowing the patents, and some only proffer one "new" reference that is entirely cumulative of the others. This is a textbook case where the PTAB will deny institution. In sum, it is objectively unlikely that the PTAB will institute any of Ascentcare's petitions, let alone all of them.

Further, Ascentcare's proposed stay would lead to piecemeal and duplicitous litigation because the PTAB can only resolve a subset of the parties' disputes, whereas this Court can resolve all of them. Ascentcare also ignores the work the parties have put into this case, including serving voluminous infringement, invalidity, and non-infringement contentions, hundreds of requests for production, dozens of interrogatories, and third party subpoenas. A stay would also unduly

prejudice Solmetex because, as Ascentcare admits, the parties directly compete. On balance, all of the relevant factors weigh against a stay.

## **II. FACTUAL BACKGROUND**

### **A. The Parties**

Solmetex provides dental isolation systems under the DryShield brand, including mouthpieces that fit in a patient’s mouth during dental procedures and connect to the DryShield isolation system. ECF No. 18 at 2-3. Ascentcare sells isolation mouthpieces under the name “VacuLUX” that it markets as compatible with the DryShield isolation system and, therefore, directly competes with Solmetex’s DryShield mouthpieces. *Id.* at 4-5.

### **B. Procedural History**

The parties met and conferred in March and April 2025 and agreed to nearly all the deadlines in the current schedule, including for infringement and invalidity contentions and claim construction. ECF No. 18. The Court addressed the parties’ limited disputes during the scheduling conference and set deadlines for the substantial completion of document production and the close of fact discovery. ECF No. 20. Ascentcare then announced its intent to file IPRs and move to stay. Ex. 1 at 28:11-29:4.<sup>1</sup> Ascentcare had not previously informed Solmetex of its plan to effectively seek to undo the schedule that the parties (and the Court) had just spent time and resources negotiating and constructing. The parties have since served their respective infringement, invalidity, and non-infringement contentions.

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<sup>1</sup> All exhibits cited herein are attached to the Christopher Declaration (“Decl.”).

### C. Ascentcare's PTAB Petitions

As summarized below, Ascentcare has filed petitions challenging seven of the ten Asserted Patents (“the Challenged Patents”):

Patent No.	Case No.	Petition Filing Date	PTAB Notice of Filing Date Accorded	Institution Decision Deadline
11,589,969	IPR2025-01020	May 20, 2025	Jun. 18, 2025	Dec. 18, 2025
11,589,970	IPR2025-01057	May 28, 2025	Jun. 23, 2025	Dec. 23, 2025
11,744,686	IPR2025-01059	May 28, 2025	Jun. 24, 2025	Dec. 24, 2025
11,826,217	IPR2025-01065	Jun. 6, 2025	Jul. 1, 2025	Jan. 1, 2026
12,011,329	IPR2025-01104	Jun. 7, 2025	Jul. 1, 2025	Jan. 1, 2026
12,167,948	PGR2025-00058	Jun. 19, 2025	Jul. 8, 2025	Jan. 8, 2026
12,290,418	IPR2025-01175	Jun. 24, 2025	Jul. 8, 2025	Jan. 8, 2026

Ascentcare's petitions are based on the following references: U.S. Patent Nos. 8,029,280 (“Black”), 3,101,543 (“Baughan”), 4,017,975 (“Johnson”), 8,911,232 (“Nguyen”), 9,532,858 (“Hirsch ‘585”); U.S. Patent Publication No. 2003/0134253 (“Hirsch ‘253”); Korean Patent No. 10-1082826 (“Park”); and Chinese Patent Publication No. 200420094338.X (“Zheng”). *See* Exs. 2-4 (asserting Black, Hirsch ‘253, Baughan, Johnson and Park); Ex. 5-6 (asserting same and Zheng); Exs. 7-8 (asserting Nguyen, Black, and Hirsch ‘858). Notably, nearly all of these references (or one of their counterparts) were already considered by the Patent Office prior to allowing the Challenged Patents. *See* Exs. 16-23 (previously considered references highlighted). By relying on references that were already considered, Ascentcare is, in effect, asking the Patent Office to second guess itself and “redo” examination.

Ascentcare represents that “[u]nder the PTAB’s rules,” the institution “decisions [will] occur between November 20, 2025, and mid-December 2025.” Mot. at 5. These dates are incorrect. Though Solmetex believes the Director will discretionarily deny the petitions beforehand (*infra*, § III.A.2), the PTAB will issue its institution decisions between December 18, 2025 and January 8,

2026.<sup>2</sup> In the unlikely event that all seven petitions are instituted, the Board will not issue its last final written decision until January 2027. 35 U.S.C. § 316(a)(11); 35 U.S.C. § 326(a)(11).

### III. ARGUMENT

A “stay is not a matter of right, but is rather an exercise of judicial discretion that requires examining the circumstances of the particular case.” *Ohio State Conf. of N.A.A.C.P. v. Husted*, 769 F.3d 385, 387 (6th Cir. 2014) (quoting *Nken v. Holder*, 556 U.S. 418, 433 (2009)). Courts generally consider three factors in determining whether to stay litigation pending IPRs, including “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.” *DeJule v. MillerKnoll, Inc.*, No. 1:23-CV-969, 2024 WL 5680071, at \*1 (W.D. Mich. Feb. 2, 2024) (J. Jonker). While each of these factors weigh against a stay, the most salient fact is that the PTAB has not yet acted on Ascentcare’s petitions. The majority of courts faced with similar stay requests deny them without prejudice as premature. Solmetex submits that the Court should do the same here.

#### A. Ascentcare Has Not Shown that a Stay Will Simplify the Issues

Ascentcare cannot show that a stay will simplify the issues because such an inquiry is inherently speculative until the PTAB decides that it will, in fact, institute proceedings. That alone should be dispositive. Moreover, based on recent changes in PTAB procedure, it is objectively unlikely the PTAB will institute the petitions. And even if the PTAB did institute, this would lead to inefficient piecemeal litigation because the PTAB cannot resolve all of the parties’ disputes.

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<sup>2</sup> Deadlines are calculated from the notice of filing date accorded (Exs. 9-15), not the petition filing date. 37 C.F.R. § 42.107(b); 35 U.S.C. § 314(b)(1); 37 C.F.R. § 42.207(b); 35 U.S.C. § 324(b)(1).

**1. The Court Should Follow the Majority Approach and Deny Ascentcare's Motion as Premature**

The PTAB has not yet instituted any IPRs or PGR, and it will not issue its last institution decision until January 8, 2026. *Supra*, § II.C. Ascentcare is nevertheless asking the Court to stay this case at least *six months* until February 2027. Mot. at 5 (requesting “the stay lasts until 30 days after the PTAB issues the last institution decision”). Faced with similar stay requests, “the majority of courts that have addressed the issue have postponed ruling on stay requests or have denied stay requests when the PTAB has not yet acted on the petition for review.” *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 WL 1069179, at \*5 (E.D. Tex. Mar. 11, 2015) (collecting cases); *see also IOENGINE, LLC v. PayPal Holdings, Inc.*, No. CV 18-452-WCB, 2019 WL 3943058, at \*6 (D. Del. Aug. 21, 2019) (“courts almost invariably deny requests for stays pending IPR proceedings when the stay requests are filed before the IPR is instituted”); *Wonderland Switzerland AG v. Britax Child Safety, Inc.*, No. 0:19-CV-02475-JMC, 2020 WL 7075122, at \*3 (D.S.C. Dec. 2, 2020) (adopting “the majority approach denying motions to stay without prejudice before the PTAB has granted IPR”).

These courts reason that any efficiencies that may be gained through IPRs are speculative until the PTAB acts on the petition. *See, e.g., Stoneridge Control Devices, Inc. v. ZF N. Am., Inc.*, No. 222CV10289TGBEAS, 2023 WL 3359611, at \*4 (E.D. Mich. May 10, 2023) (denying motion to stay based on “the mere speculative prospect that an IPR may be instituted”); *Magna Elecs., Inc. v. Valeo, Inc.*, No. 14-10540, 2015 WL 10911274, at \*2 (E.D. Mich. Sept. 30, 2015) (denying stay “since no IPR has been instituted by the PTO as to the patents in suit”). Indeed, this Court recently denied a pre-institution stay request in *DeJule v. MillerKnoll*. There, this Court declined to stay the case, at least in part, because “the PTAB has not yet granted any re-examination on any

of the four patents at issue and may never do so.” 2024 WL 5680071, at \*1. The Court should apply the same reasoning here and deny Ascentcare’s Motion as premature.

Ascentcare’s only cited case from this District staying litigation pre-institution is readily distinguishable. Mot. at 1 (citing *St. Martin Investments, Inc. v. Bandit Industries, Inc.*, No. 1:17-cv-472, 2017 WL 6816506 (W.D. Mich. Aug. 30, 2017)). First, in *St. Martin*, the court noted that “[n]o Rule 16 scheduling conference has been held, no Case Management Order has issued, and very little discovery has been conducted.” 2017 WL 6816506 at \*1. That is not the case here. See ECF Nos. 18-20; *infra*, § III.B. Second, the court reasoned that the IPR “will simplify the case by either invalidating them or estopping Bandit from contending that they are invalid in this litigation.” 2017 WL 6816506 at \*2. In this case, Ascentcare intends to continue to litigate the validity of the Challenged Patents if it does not prevail in the PTAB. *Infra*, § III.A.3. Third, in *St. Martin*, the patentee was not prejudiced because it had only “relatively slim chances of obtaining injunctive relief before the Patent expires,” 2017 WL 6816506 at \*3, whereas here, the Challenged Patents do not expire until 2033 or 2040, and a stay would unduly prejudice Solmetex. *Infra*, § III.C.

## 2. The PTAB Will Likely Deny Ascentcare’s Petitions

Ascentcare argues that its “IPR petitions are strong” and institution is certain. Mot. at 6. But this is merely attorney argument. It is also unsurprising that Ascentcare believes its petitions are “strong” because all PTAB petitioners invariably hold the same belief. But such confidence is often premature. Ascentcare’s reliance on the fact that “the PTAB instituted IPR/PGR on 74% of patents challenged” in 2024 illustrates the point because, if taken at face value, the odds of all seven petitions being instituted are approximately 12%.<sup>3</sup> Mot. at 9. Yet Ascentcare’s likelihood of

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<sup>3</sup> This figure assumes each of the seven petitions has a 74% chance of being instituted ( $0.74^7$ ).

success is actually even lower because its cited statistics are out-of-date and do not account for recent changes in PTAB practice.

The PTAB is not obligated to institute an IPR and may exercise its discretion to deny petitions. *See Cuozzo Speed Techs. v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (The Board is “permitted, but never compelled, to institute an IPR proceeding”). In March 2025, Interim Director Stewart issued a memorandum setting forth new procedures for exercising this discretion. Ex. 24 (“Director Memo”). The Director Memo establishes a separate briefing scheduling for discretionary issues and expands the factors the PTAB will consider for discretionary denial. *Id.* at 2-3; Mot. at 9 (acknowledging “changes to the PTAB’s discretionary denial policy”).

The Director Memo has led to a sharp decrease in the institution rate because of the corresponding increase in discretionary denials. For example, according to DocketNavigator statistics, the institution rate in June 2025 was only about 43%. Ex. 25 (showing 77 grants and 100 denials in June 2025). So far in July 2025, the institution rate has dropped to about 24%. Ex. 27 (showing 92 denials and 29 grants through July 24, 2025). In June and July 2025, Director Stewart issued over 100 discretionary denial decisions. Ex. 26; Ex. 28. In short, Ascentcare’s cited 74% institution rate from 2024 is not valid because that was prior to the new discretionary denial rules. Mot. at 9.

Despite knowing these changes are likely fatal to its petitions, Ascentcare baldly asserts that “none of the discretionary denial factors help Solmetex.” Mot. at 9. That is incorrect. Solmetex intends to present several grounds for discretionary denial. For example, Ascentcare’s petitions rely on the same references that the Patent Office already considered before granting the patents,

effectively asking the PTAB to “redo” the underlying examination. This presents a textbook case for discretionary denial. 35 U.S.C. § 325(d) (discretionary denial is warranted where “the same or substantially same prior art or arguments previously were presented to the Office”). Further, Solmetex also has a strong argument for discretionary denial because this case will be at an advanced stage by the time the PTAB would issue the last of its final written decisions in January 2027. *See* ECF No. 20; *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495, at \*1 (PTAB Mar. 20, 2020). There are additional discretionary factors and flaws in the petitions that Solmetex intends to raise in the PTAB as well.

Ascentcare claims that there will be no discretionary denial because its “IPRs assert a foreign prior art reference never considered by the Patent Office.” Mot. at 4. But Ascentcare’s petitions for the ‘217 and ‘948 Patents do not rely on this supposedly “new” foreign reference (Park). Exs. 7-8. Instead, these petitions exclusively rely on references that were already considered by the Patent Office when allowing these patents. Moreover, Ascentcare’s suggestion that its reliance on Park is dispositive for the other petitions is incorrect. Mot. at 4. Solmetex will contend, and the PTAB will likely find, that even if Park was not expressly considered, it is “substantially the same” as the art that was. *Advanced Bionics, LLC v. Med-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, 2020 WL 740292, at \*3 (PTAB Feb. 13, 2020).

### **3. A Stay is the Least Efficient Way to Litigate the Parties’ Disputes**

Staying this case is the least efficient path for resolving the parties’ disputes, which include the Challenged Patents, Solmetex’s design patents, and both parties’ Lanham Act claims. The cases cited by Ascentcare that granted stays despite additional non-patent claims are distinguishable on a critical point – the PTAB had already instituted an IPR. Mot. at 17 (citing *Regents of Univ. of Michigan v. St. Jude Med., Inc.*, No. 12-12908, 2013 WL 2393340 (E.D. Mich. May 31, 2013) and

*Merck Sharp & Dohme LLC v. Johns Hopkins Univ.*, No. CV 22-3059-JRR, 2024 WL 3252974, at \*1 (D. Md. June 29, 2024)).

With respect to the Challenged Patents, the parties (and the Court) will still need to address infringement, validity and claim construction unless the PTAB invalidates *every* currently asserted claim. Absent a total victory in the PTAB, Ascentcare will continue to litigate validity issues before this Court, which may not be subject to the statutory estoppel resulting from any final written decisions. 35 U.S.C. 315(e)(1); Ex. 29 (alleging invalidity based on § 112 and asserting alleged product prior art); Ex. 30 at 2 (confirming Ascentcare intends to raise overlapping invalidity issues here and in the PTAB). Congress intended for IPRs to be “a timely, cost-effective *alternative* to litigation.” 77 FR 48680-01, 2012 WL 3276880(F.R.) (Aug. 14, 2012) (emphasis added). But Ascentcare is merely using the PTAB as an *additional* forum so that it can delay Solmetex’s claims and litigate in its preferred forum while getting two bites at the apple on validity.

Even in a best-case scenario for Ascentcare where the PTAB finds every asserted claim is invalid (which is unlikely), the parties (and the Court) will still need to address Solmetex’s design patents and the Lanham Act claims. As Ascentcare admits, “discovery will be largely the same” for these additional claims regardless of what happens in the PTAB. Mot. at 16. There is no reason why this case should not move forward with that discovery so that all of the disputes can be resolved efficiently rather than languishing for months or years while the PTAB disputes play out. In other words, it would be far more efficient for this Court to conduct one proceeding that will resolve all of the parties’ disputes compared to piecemeal litigation in two forums that would only delay resolution and increase the burdens on the parties and the courts.

**B. Ascentcare Ignores the Parties' Progress in this Litigation**

The progress made in this case also weighs against a stay or is at best neutral. Ascentcare argues “discovery is only in its nascent stage.” Mot. at 11. But Ascentcare overlooks the work the parties have done in the case to date. Solmetex has provided approximately 500 hundred pages of initial infringement contentions. Ascentcare has provided 1,000+ pages of invalidity and non-infringement contentions. Notably, *Ascentcare agreed* to these exchanges despite knowing they would occur before a stay. ECF No. 18-1. If Ascentcare were truly concerned about efficiency, it would have been transparent about its plan and proposed a schedule minimizing substantive contentions prior to its contemplated stay. But Ascentcare stayed silent while the parties and the Court constructed the current schedule, demonstrating that Ascentcare is merely seeking a stay to gain a tactical advantage.

Additionally, the parties have collectively served 214 requests for production, 32 interrogatories, and a dozen third party subpoenas. In an attempt to suggest that Solmetex has not provided discovery, Ascentcare’s attorney declaration asserts that “[o]ther than the file histories required with the infringement contentions, Solmetex has not yet provided a single document in response to Ascentcare’s first requests for production.” ECF No. 39 at ¶ 9. This is misleading. Solmetex produced more than just the file histories with its initial infringement contentions on June 16, 2025. Decl. at ¶ 32. Further, the reason Solmetex had not produced more documents by that date is because Ascentcare inexplicably delayed serving any discovery requests until May 30, 2025 (i.e., more than 2 months after discovery opened) and thus Solmetex only recently responded to those requests.<sup>4</sup> ECF No. 26. One of two things is true: (1) Ascentcare intentionally delayed

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<sup>4</sup> Solmetex has recently produced additional documents. Ex. 31. The parties also had two meet and confers regarding discovery during the week of July 21.

seeking any discovery so that it could make this very point to bolster its stay request or (2) Ascentcare was not diligent in pursuing discovery. Either way, Ascentcare's delay should not be held against Solmetex, and this factor weighs against a stay, or is at best neutral.

**C. A Stay Would Unduly Prejudice Solmetex**

The risk of prejudice to Solmetex strongly weighs against a stay. This Court has recognized plaintiffs under similar circumstances “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, and that cannot in any case address” all of the parties’ disputes, including the design patents and Lanham Act claims. *DeJule*, 2024 WL 5680071 at \*2; *supra*, § IIIA.

Additionally, “[c]ourts routinely deny requests for stay during the pendency of PTO proceedings where the parties are direct competitors.” *Everlight Elecs. Co. v. Nichia Corp.*, No. 12-CV-11758, 2013 WL 1821512, at \*8 (E.D. Mich. Apr. 30, 2013); *see also Int'l Test Sols., Inc. v. Mipox Int'l Corp.*, No. 16-CV-00791-RS, 2017 WL 1316549, at \*3 (N.D. Cal. Apr. 10, 2017) (“Where parties are direct competitors, ‘the likelihood of undue prejudice to the non-moving party is heightened”). This factor strongly weighs against a stay because, as Ascentcare admits, “Ascentcare and Solmetex are competitors in the field of dental isolation mouthpieces.” Mot. at 1.

Ascentcare argues that the parties’ competition is irrelevant because “monetary damages would be sufficient to cover any alleged harm to Solmetex” during a stay. Mot. 16. Not so. Courts recognize that “infringement among competitors can cause harm in the marketplace that is not compensable by readily calculable money damages.” *Avago Techs. Fiber IP (Singapore) Pte. Ltd. v. IPtronics Inc.*, No. 10-CV-02863-EJD, 2011 WL 3267768, at \*5 (N.D. Cal. July 28, 2011); *see also Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson*, No. 2:21-CV-00113-JRG, 2022 WL 17484264, at \*2 (E.D. Tex. July 7, 2022) (“a delay in recovering monetary damages is ‘far

from non-prejudicial”); *Ultratec, Inc. v. Sorenson Commc'ns, Inc.*, No. 13-CV-346-BBC, 2013 WL 6044407, at \*4 (W.D. Wis. Nov. 14, 2013) (rejecting argument “that because plaintiffs may be compensated by monetary damages for any injury during the stay, it will not cause them undue prejudice”).

Ascentcare markets the accused VacuLux mouthpieces as compatible with its own isolation system and Solmetex’s DryShield isolation system. A stay would unduly prejudice Solmetex, among other reasons, because each VacuLux mouthpiece sale to a DryShield isolation system customer diverts a sale that otherwise would have been made by Solmetex, causing loss of market share and customer goodwill. *Davol, Inc. v. Atrium Med. Corp.*, No. CIV.A. 12-958-GMS, 2013 WL 3013343, at \*4 (D. Del. June 17, 2013) (finding that “while eventual money damages might be sufficient to compensate Davol for lost sales, the prospect of lost market share and price erosion” weighed against a stay); *Ultratec*, 2013 WL 6044407, at \*4 (finding that a stay would allow accused infringer “to gain market share and other advantages over plaintiffs while allegedly infringing plaintiffs’ patents”). Indeed, Ascentcare appears poised to *increase* its sales of the accused VacuLux mouthpieces during its requested stay and thereby increase the resulting prejudice to Solmetex. *Peloton Interactive, Inc. v. Flywheel Sports, Inc.*, No. 2:18-CV-00390-RWS-RSP, 2019 WL 3826051, at \*4 (E.D. Tex. Aug. 14, 2019) (finding that a “potential increase in sales [by the accused infringer] suggests that a stay would be even more prejudicial to [the patentee] in the future”).

Contrary to Ascentcare’s suggestion, the fact that “[n]o preliminary injunction has been sought” is not dispositive under this factor. *Saint Lawrence Commc'ns LLC v. ZTE Corp.*, No. 2:15-CV-349-JRG, 2017 WL 3396399, at \*2 (E.D. Tex. Jan. 17, 2017) (“the failure to seek an injunction does not amount to an admission by plaintiff that it will not be prejudiced by a stay”); *Avago*, 2011

WL 3267768, at \*6 (“the Court will not hold against Avago its decision to spare the parties more litigation” in the form of a preliminary injunction request).

**D. Ascentcare’s Suggestions of Bad Faith by Solmetex are Meritless**

Ascentcare’s Motion accuses Solmetex of wrongdoing in the Patent Office and of asserting its patents in bad faith. While the Court need not reach these issues to deny the Motion, Solmetex is compelled to respond to Ascentcare’s baseless accusations and misstatements of law.

First, Ascentcare accuses Solmetex of “using the extraordinary cost of patent litigation to harm the much smaller Ascentcare.” Mot. at 4. This is untrue. Solmetex is asserting its presumptively valid patents in good faith against an infringer. Ascentcare’s rhetoric is also belied by its actions. *Ascentcare* chose to expand the scope and cost of the disputes by seeking to initiate seven additional proceedings in the PTAB despite the new discretionary denial trend. Ascentcare’s representations that this voluntary effort was “expensive” and required “hundreds of hours of attorney time” are not consistent with its stated concerns about “the extraordinary cost of patent litigation.” ECF No. 39 at ¶13; Mot. at 4.

Second, Ascentcare accuses Solmetex of engaging in “an aggressive, targeted continuation patent application practice” to obtain claims covering Ascentcare’s products. Mot. at 3-4. The purpose of this narrative is to suggest that there is something untoward with regard to such a strategy. However, as the Federal Circuit has explained:

[T]here is nothing improper, illegal or inequitable in filing a patent application for the purpose of obtaining a right to exclude a known competitor's product from the market; nor is it in any manner improper to amend or insert claims intended to cover a competitor's product the applicant's attorney has learned about during the prosecution of a patent application.

*Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 874 (1988).

Third, Ascentcare accuses Solmetex of misleading the Patent Office “into believing that Solmetex claimed a mouthpiece with enclosing sidewalls for seven years, while Solmetex now

contends its patent is broader” and that there were “improprieties” and “manipulation of the patent applications during prosecution.” Mot., 10, 12. These accusations are baseless. Solmetex is not asserting any claim reciting a “sidewall,” and it is well-settled that “continuing applications may present broader claims than were allowed in the parent.” *Hakim v. Cannon Avent Grp., PLC*, 479 F.3d 1313, 1317 (Fed. Cir. 2007).

Fourth, Ascentcare argues that it “is not liable for infringement after the issuance of the patents under the doctrine of prosecution history estoppel because Ascentcare made substantial investments in the VacuLUX before the patents issued.” Mot. at 5. Tellingly, Ascentcare cites no authority for this spurious assertion. “Prosecution history estoppel operates as a legal limitation on a patentee's ability to invoke the doctrine of equivalents” and is not a defense to literal infringement. *Trading Techs. Int'l, Inc. v. Open E Cry, LLC*, 728 F.3d 1309, 1318 (Fed. Cir. 2013). Ascentcare’s reference to “substantial investments,” appears to refer to the intervening rights doctrine, which is of no help to Ascentcare because the Asserted Patents were not reissued or reexamined. *Marine Polymer Techs., Inc. v. HemCon, Inc.*, 672 F.3d 1350, 1362 (Fed. Cir. 2012).

#### **IV. CONCLUSION**

For the foregoing reasons, Solmetex respectfully requests that the Court deny the Motion.

Dated: July 25, 2025

/s/ Angelo J. Christopher

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing document was served via ECF on July 25, 2025, to all counsel of record.

*/s/ Angelo J. Christopher*