

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GC CORPORATION AND GC AMERICA, INC.,

Petitioner,

v.

ARDENT, INC.,

Patent Owner.

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CASE: IPR2018-00941

Patent No. 6,455,451 B1

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**JOINT SUBMISSION REGARDING STATUS OF RELATED DISTRICT  
COURT AND ITC PROCEEDINGS**

EXHIBIT LIST	
Exhibit	Description
1001	Declaration of Arthur E. Clark
1002	U.S. Patent No. 6,455,451 (“the ’451 patent”)
1003	International Publication No. WO 95/32678 (“Petticrew”)
1004	U.S. Patent No. 5,219,799 (“Beall”)
1005	L. M. Echeverria, <i>New Lithium Discilicate-Glass Ceramics</i> , Bol. de la Soc. Esp. de Ceramica, 183:188, 1992
1006	Prosecution History of the ’451 patent
1007	<i>Ivoclar N. Am., Inc. v. Jeneric/Pentron Incorporated</i> , 2000 WL 35516146 (W.D.N.Y.) Complaint
1008	Isabelle L. Denry, <i>Recent Advances in Ceramics for Dentistry</i> , Crit. Rev. Oral Biol. Med., vol 7, no. 2, pp. 134-43 (Apr. 1, 1996)
1009	Staff’s Opening Statement Demonstrative Exhibit, US ITC Inv. No. 337-TA-1050 (excerpt)
1010	U.S. Patent No. 6,420,288 (“Schweiger ’288”)
1011	J. Robert Kelly, <i>Ceramics in Dentistry: Historical Roots and Current Perspectives</i> , The Journal of Prosthetic Dentistry, vol. 75, no. 1, pp. 18-32 (Jan. 1996)
1012	<i>Curriculum Vitae</i> Arthur E. Clark
1013	<i>Notice of Commission Decision to Review in Part a Final Initial Determination Finding No Violation of Section 337; Schedule for Filing Written Submissions on the Issues Under Review and on Remedy, the Public Interest, and Bonding; Extension of Target Date</i> , US ITC Inv. No. 337-TA-1050 (Sept. 21, 2018)

EXHIBIT LIST	
Exhibit	Description
1014	<i>Notice of a Commission Determination of No Violation of Section 337; Termination of Investigation</i> , US ITC Inv. No. 337-TA-1050 (Dec. 18, 2018)
1015	<i>Commission Opinion</i> , US ITC Inv. No. 337-TA-1050 (Feb. 11, 2019) (public version)
1016	<i>Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond</i> , US ITC Inv. No. 337-TA-1050 (July 23, 2018)

Pursuant to the Board's order in Paper 8, the parties jointly submit this paper to provide the Board with an update regarding the current status of the related District Court and International Trade Commission ("ITC") proceedings. The parties also submit as exhibits the ITC documents identified by Petitioner in its May 7, 2019 email to the Board, as well as the Chief Administrative Law Judge's ("ALJ") underlying final initial determination ("ID").

**I. STATUS OF RELATED PROCEEDINGS**

**A. District Court Proceeding**

The only related District Court proceeding—*Ivoclar Vivadent AG v. GC America Inc.*, No. 1:17-cv-02083 (N.D. Ill.)—was dismissed without prejudice on January 8, 2019.

**B. ITC Proceeding, Inv. No. 337-TA-1050**

As counsel for Petitioner informed the Board, the Commission published on September 21, 2018 a "Notice of Commission Decision to Review in Part a Final Determination Finding No Violation of Section 337..." in Investigation No. 337-TA-1050 ("Notice to Review," attached hereto as Exhibit 1013) subsequent to the Board's Decision on Institution.

At the conclusion of its review of ID, the Commission published on December 18, 2018 a "Notice of a Commission Determination of No Violation of Section 337; Termination of Investigation" ("Notice of Termination," attached hereto as Exhibit

1014). The Notice of Termination summarizes the Commission's findings of no violation of section 337, which are more fully set forth in the Commission's Opinion (attached hereto as Exhibit 1015).

The Commission's opinion was appealed to the Federal Circuit by Patent Owner, but that appeal has been voluntarily dismissed. Therefore, the ITC's decision is not subject to any further changes or appeals.

## **II. ITC DETERMINATION'S RELEVANCE TO THIS IPR**

Neither the ID nor the Commission's Opinion directly address the '451 patent claims because all of the asserted claims of the '451 patent were terminated from the ITC Investigation prior to the issuance of the ID. *See* Ex. 1015 at 1. As this IPR proceeding asserts grounds of unpatentability based upon prior art references that were analyzed in the ID (Petticrew and Beall), the ITC's determinations regarding those references may be relevant to the Board in its analysis of the patentability of claims 1-4 and 57-61 of the '451 patent. *See* Ex. Ex. 1015 at 13 and Ex. 1016 at 84-92.

Dated: September 18, 2019

Respectfully submitted,

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