

Filed on behalf of: Gold Standard Instruments, LLC

Paper _____

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

US ENDODONTICS, LLC,
Petitioner,

v.

GOLD STANDARD INSTRUMENTS, LLC,
Patent Owner.

Case IPR2015-00632
Patent 8,727,773 B2

PATENT OWNER'S MOTION TO EXCLUDE

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I. Introduction

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner Gold Standard Instruments, LLC (“Patent Owner”) moves to exclude Exhibits 1005, 1014 and 1037. Patent Owner further moves to strike Exhibits 1038, 2045 and 2046 at 154:12-155:2; 157:20-158:15; 161:21-163:5; 66:18-67:14; and 68:3-17. Finally, Patent Owner moves to strike the first full paragraph on page 10 in Petitioner’s Reply in Support of Petition for *Inter Partes* Review (Paper 57) that relies on Exhibits 1005, 1014, and 1037.

II. Exhibit 1005

Exhibit 1005 is Satish B. Alapati, “An investigation of phase transformation mechanisms for nickel-titanium rotary endodontic instruments,” Ph.D. thesis, 2006. Patent Owner objected to Ex. 1005 in Patent Owner’s Objections to Petitioner’s Evidence (Paper 35) at page 3 on the two independently sufficient grounds that it is: (1) irrelevant to the grounds upon which trial has been instituted (FRE 401-403); and (2) is improper hearsay (FRE 801). Petitioner relies on Ex. 1005 in its Petition (Paper 2) at pages 3-4 and 46 and in its Reply (Paper 57) at page 10.

Exhibit 1005 is not prior art to U.S. Patent No. 8,727,773 (“the ’773 patent”). The Board correctly determined that the ’773 patent was entitled to at least the filing date of its related PCT application (filed June 7, 2005). *See* Institution Decision (Paper 29) at 13-4; *see also* Decision - Petitioner’s Request for Rehearing (Paper 41) at 2-4. Since Ex. 1005 is not prior art, it is not relevant to any ground upon which trial has been instituted. Exhibit 1005 should be excluded to prevent unnecessary prejudice to Patent Owner and to avoid confusion as to its status as non-prior art. For example, in its Institution Decision (Paper 29) at 5-6, the Board incorrectly identified Ex. 1005 as prior art.

Exhibit 1005 should also be excluded because it is hearsay, not subject to any exception. Petitioner improperly relied on Ex. 1005 in its Petition and again in its Reply for the truth of the matter asserted in the document. Petitioner has not cited to any hearsay exception, and none applies. Petitioner’s supplemental evidence (a library card catalog record obtained from Ohio State University) does not cure Patent Owner’s objection. Petitioner has not presented the testimony of any individual having first-hand knowledge of the statements and/or experiments described in Ex. 1005.

III. Exhibit 1014

Exhibit 1014 is U.S. Patent Application Publication No. 2011/0271529 A1, to Gao *et al.* Patent Owner objected to Ex. 1014 in Patent Owner’s Objections to

Petitioner's Evidence (Paper 35) at page 4 on the ground that it is irrelevant to the grounds upon which trial has been instituted (FRE 401-403). Petitioner relies on Ex. 1014 in its Petition (Paper 2) at pages 23-28 and in its Reply (Paper 57) at page 10.

Exhibit 1014 is not prior art to the '773 patent. As noted above, the Board correctly determined that the '773 patent was entitled to at least the filing date of its related PCT application (filed June 7, 2005). Since Ex. 1014 is not prior art, it is not relevant to any ground upon which trial has been instituted and should be excluded.

IV. Exhibit 1037

Exhibit 1037 is U.S. Patent No. 6,149,501 to Farzin-Nia *et al.* Patent Owner objected to Ex. 1037 in Patent Owner's Second Set of Objections to Evidence (Paper 59) at page 2 on the ground that it is improper hearsay (FRE 801). Petitioner relies on Ex. 1037 in its Reply (Paper 57) at page 10.

Exhibit 1037 is hearsay, not subject to any exception. Petitioner relied on Ex. 1037 in its Reply for the truth of the matter asserted in the document. Petitioner has not cited to a hearsay exception, and none applies. Petitioner has not served Patent Owner with supplemental evidence in order to cure Patent Owner's objection. Petitioner has not presented the testimony of any individual having first-hand knowledge of the statements in Ex. 1037.

V. Exhibit 1038

Exhibit 1038 is Deposition Transcript of Neill H. Luebke, D.D.S., M.S., dated December 9, 2015 (Public/Redacted Version). During Dr. Luebke's cross examination deposition, Patent Owner objected to certain questions that counsel for Petitioner asked because the questions were outside the scope of Dr. Luebke's direct declaration testimony and violated 37 C.F.R. § 42.53(d)(ii). Accordingly, Patent Owner moves to exclude those portions of Dr. Luebke's deposition transcript.

Dr. Luebke's Declaration (Ex. 2027, Declaration of Neill H. Luebke, D.D.S., M.S.) is narrowly focused and simply provides a brief background on endodontics, an overview of his development and subsequent commercialization of the invention described in the '773 patent, and the proper interpretation of the "wherein" clause of claims 1 and 13 of the '773 patent, including a discussion of a declaration submitted during the prosecution of a related patent application in which Dr. Luebke discussed testing that he performed on files. To be clear, Dr. Luebke did not opine about the prior art or about specific references asserted by Petitioner in this proceeding. Notwithstanding the narrow scope of Dr. Luebke's Declaration and the fact it does not discuss the various references at issue in this proceeding, including Kuhn (Ex. 1019) and Matsutani (Ex. 1023), counsel for Petitioner repeatedly asked Dr. Luebke questions about the prior art and specific

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