

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

**PETITIONER'S OPPOSITION
TO PATENT OWNER'S MOTION TO EXCLUDE**

TABLE OF CONTENTS

PAGE

I. EXHIBIT 1005 IS ADMISSIBLE..... 1

II. EXHIBIT 1014 IS ADMISSIBLE.....3

III. EXHIBIT 1037 IS ADMISSIBLE.....5

IV. THE OBJECTED-TO PORTIONS OF EXHIBITS 1038, 2045,
AND 2046 ARE ADMISSIBLE7

V. CONCLUSION.....15

Petitioner US Endodontics, LLC opposes Patent Owner's motion to exclude: Exhibits 1005, 1014, and 1037; a portion of Petitioner's Reply (Paper 57) that relies on such exhibits; and 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. Paper 63. For the reasons discussed herein, Patent Owner's motion should be denied in its entirety.

I. EXHIBIT 1005 IS ADMISSIBLE

Exhibit 1005 is a Ph.D. thesis from 2006 authored by Satish B. Alapati and entitled, "An investigation of phase transformation mechanisms for nickel-titanium rotary endodontic instruments" ("Alapati").

As an initial matter, Alapati was introduced during the cross-examination of Patent Owner's expert, Dr. Sinclair, and Patent Owner did not move to exclude such testimony. *See* Ex. 1040, 134:19-140:7. Patent Owner argues that since Alapati "is not prior art, it is not relevant to any ground upon which trial has been instituted." *See* Paper 63, p. 3. Patent Owner is wrong. Petitioner relies on Alapati as additional evidence that: (i) a skilled artisan would look beyond the endodontic field for useful nickel titanium ("Ni-Ti") art; (ii) Ni-Ti will be superelastic when in the austenite phase, *i.e.*, when the Ni-Ti alloy is in an environment where the ambient temperature is above the alloy's austenite finish (A_f) (*i.e.*, shape recovery) temperature; and (iii) equates raising the A_f (shape recovery) temperature of a Ni-Ti alloy to above body temperature with decreasing superelasticity such that the

Ni-Ti alloy will exhibit permanent deformation when bent. *See* Paper 2, pp. 3-4, 46; Paper 57, p. 10. *See also* Ex. 1002, ¶ 66. Such information further rebuts the arguments from Patent Owner and its expert, Dr. Sinclair, that the combination of Matsutani and Pelton would not result in “permanent deformation as required.” Paper 44, p. 52-54. *See also* Ex. 2026, ¶¶ 49-50, 179. For example, in the portion cited by Petitioner in its Reply brief, *see* Paper 57, p. 10, Alapati states:

“Heat treatment of NiTi rotary instruments between 400° and 600°C *increases the austenite-finish (A_f) transformation temperature* from approximately 25°C for as-received instruments to 50°C, which *results in the loss of shape memory* in the oral environment (Brantley, 2001).”

Ex. 1005, p. 59-60 of 76 (emphasis added). This contradicts Patent Owner’s and Dr. Sinclair’s assertions that the combination of Matsutani and Pelton does not “teach or suggest a heat-treated NiTi file that would exhibit at least 10 degrees of permanent deformation in the ISO Standard 3630-1 bend test.” Paper 44, pp. 52-53. *See also* Ex. 2026, ¶¶ 49-50, 179. Indeed, the quoted passage evidences the knowledge of a skilled artisan at least as of the earliest effective filing date of the ’773 patent, as it cites to a published article from 2001. Ex. 1005, pp. 59-60, 70 of 76 (citing “Brantley WA (2001). Orthodontic wires. In: Brantley WA, Eliades T, editors. Orthodontic Materials: Scientific and Clinical Aspects. Stuttgart: Thieme, pp. 77-103.”) Thus, Alapati is relevant, under FRE 401, because it has a tendency

to make it more probable that, on this issue, Patent Owner and its expert are incorrect, and Petitioner's position is the correct one.

Patent Owner also argues that Alapati is hearsay. *See* Paper 63, p. 3. However, even if the Board determines it is hearsay, which Petitioner disputes, Alapati is still admissible under FRE 703. Petitioner's expert, Dr. Goldberg, reasonably relied on Alapati in further support of his opinion that one of skill in the art would have looked to Ni-Ti art beyond the endodontic field when trying to solve problems within the endodontic field. *See* Ex. 1002, ¶ 66; Paper 2, p. 46. Thus, Alapati is admissible under FRE 703 as it served as a basis for Petitioner's expert's opinions.

Accordingly, Exhibit 1005 is admissible and should not be excluded.

II. EXHIBIT 1014 IS ADMISSIBLE

Exhibit 1014 is U.S. Patent Application Publication No. 2011/0271529 A1, Gao et al. ("Gao"), which is assigned to Dentsply International Inc. ("Dentsply"), a real party-in-interest in this proceeding.

Again, as an initial matter, Gao was introduced during the cross-examination of Patent Owner's expert and Patent Owner did not move to exclude such testimony. *See* Ex. 1040, 140:8-144:1. Patent Owner argues, as it did for Exhibit 1005, that Gao is not relevant because it is not prior art to the '773 patent. *See* Paper 63, p. 4. In view of the Board's decision regarding the effective filing date of

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