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 REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE

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I. Introduction

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner moved to: (1) exclude Exhibits 1005, 1014 and 1037; (2) 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; and (3) strike the first paragraph on page 10 in Paper 57. (Paper 63) Petitioner opposed. (Paper 67) Patent Owner hereby replies to Petitioner's opposition.

II. Exhibit 1005

First, Ex. 1005 is inadmissible hearsay. Petitioner neither explains why it is not hearsay, nor alleges any exception. Instead, Petitioner argues that Dr. Goldberg's reference to Ex. 1005 makes it admissible. Not so. While Dr. Goldberg may base his opinions on hearsay, FRE 703 does not make the hearsay itself admissible. *Advisory Committee Notes - 2000 Amendments* ("Rule 703 has been amended to emphasize that when an expert reasonably relies on inadmissible information to form an opinion or inference, the underlying information is not admissible simply because the opinion or inference is admitted.").

Second, Ex. 1005 is not relevant. Petitioner argues that Ex. 1005 is relevant to the knowledge of a person in the art. But differences between the cited references and the claimed invention must be viewed through the lens of a person of ordinary skill in the art *at the time of the invention*. 35 U.S.C. § 103. Ex. 1005 is dated two years *after* the effective priority date of the '773 patent. It is not prior art

and Dr. Goldberg's reliance on Ex. 1005 highlights the improper hindsight in his analysis. Petitioner's argument that a citation to an earlier Brantley 2001 article makes Ex. 1005 relevant must also fail because that article is not at issue here.

III. Exhibit 1014

Ex. 1014—which was published in 2011 and which Petitioner concedes is not prior art (Paper 67, 4)—is not relevant. Petitioner argues Ex. 1014 is relevant to its theory that a file with an elevated A_f temperature will exhibit permanent deformation after bending. As explained in Patent Owner's response, Petitioner's theory is wrong, and Dr. Sinclair has explained why the theory is scientifically unsound. Ex. 2026, ¶¶72-123 (Kuhn's heat-treated files have an elevated A_f and exhibit minimal, if any, deformation). And evidence disproves that theory. Exs. 2051-2052 (files heat treated per Kuhn's process have less than 1° of permanent deformation). Further, the '773 patent does not claim an increase in Af as Petitioner erroneously argues. Petitioner also argues Ex. 1014 is relevant to Matsutani and Pelton. But Ex. 1014 does not disclose heating only a tip portion of a file, like Matsutani. And Pelton, which expressly aims to optimize the superelasticity of NiTi wire, is not concerned with reducing superelasticity in files to allow for over 10 degrees of permanent deformation after bending.

IV. Exhibit 1037

Ex. 1037 is hearsay and Petitioner does not deny that it relies on Ex. 1037

for the truth of the matter asserted. Petitioner provides no authority establishing the applicability of FRE 803(8). Even if Ex. 1037 were admissible, it is not discussed in any expert declaration. So Petitioner's discussion of Ex. 1037 in Paper 57 is unsupported attorney argument that is entitled no weight. To the extent Ex. 1037 is relevant, it contradicts Petitioner's reason for modifying Matsutani, as it shows that partial heat-treatments are easy and well-known. Ex. 1037, 8:54–9:11.

V. Exhibits 1038, 2045, and 2046

The questions in Ex. 1038 at 66:18-67:14; 68:3-17; 154:12-155:2; 157:20-158:15; and 161:21-163:5 are outside the scope of Dr. Luebke's direct testimony (Ex. 2027) and are inadmissible under Rule 42.53(d)(5)(D)(ii). Ex. 2027 is a factual declaration, setting out Dr. Luebke's discovery of the claimed invention, his attempts to license and commercialize the technology, and his clarification of certain remarks made in the prosecution of a different patent. Dr. Luebke did not opine about the prior art or explain why the patents and publications cited in the Petition fail to anticipate or render obvious the invention claimed in the '773 patent in Ex. 2027. Indeed, Petitioner's summary of the topical headings of Dr. Luebke's declaration (Paper 67, 7-8) do not refer to the references or patentability.

Petitioner's attempt to associate its improper questions with Dr. Luebke's direct testimony falls short. Regarding 154:12–155:2, Petitioner argues that Matsutani "undermines [Dr. Luebke's] statements that the '773 patent [was] met

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