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 REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE EVIDENCE UNDER 37 C.F.R. § 42.64(C)

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I. EXHIBIT 2006

Patent Owner argues that the Voskuil declaration "constitutes testimony in this proceeding," and that "Petitioner could have cross-examined Voskuil, but chose not to." Patent Owner has it backwards. Real party-in-interest Tulsa Dental could have submitted a declaration in this proceeding from its employee, Mr. Voskuil, but chose not to. Thus, Petitioner could not cross-examine him without requesting additional discovery and satisfying the relatively high "necessary in the interest of justice" hurdle. 35 U.S.C. ¶ 316(a)(5)(B). Further, FRE 807 is inapplicable to Voskuil's conclusory statement in Exhibit 2006, ¶ 9, which provides no details of the manufacturing process at issue. Notably, Patent Owner does not argue that this statement satisfies the requirements of FRE 807(3) and (4).

II. EXHIBIT 2026, ¶ 51

In Exhibit 2026, ¶ 51, Dr. Sinclair essentially parrots a statement from Dr. Lemon's declaration, *see* Ex. 2028, ¶ 33, the sole basis for which came from a hearsay statement made by Patent Owner's counsel and communicated to Dr. Lemon during a "background discussion." Paper 62, p. 6. Such biased hearsay statement is inadmissible under FRE 702/802, notwithstanding FRE 703. *Id.* at 3.

III. EXHIBIT 2027, ¶¶ 37-40, 42, 43, AND 45

The statements in paragraphs ¶¶ 37-40, 42, 43, and 45 of Exhibit 2027 are hearsay for which no exception applies. In ¶¶ 37-40, and 42-43, the declarants

allegedly asserted their lack of interest in commercializing the invention recited in the '773 patent, and Patent Owner seeks to prove the truth of those matters, i.e., that the invention met with skepticism. Regarding ¶¶ 42 and 43, FRE 801(d)(2) is inapplicable because Mr. Bennett's alleged statements would have been made as a representative of non-party D&S Dental, his employer at that time. Indeed, such statements were alleged to have been made prior to the formation of Petitioner US Endo. *See* Ex. 2010. Patent Owner does not attempt to argue that FRE 801(d)(2) applies to the alleged statement by non-party Derek Heath in ¶ 43. Regarding ¶ 45 and commercial success, Dr. Luebke admitted on cross-examination that the sole support for his statement regarding the Vortex Blue being covered by the '773 patent is a statement by Mr. Voskuil. Ex. 1038, 172:7-173:9. Dr. Luebke may not simply transmit such hearsay to the Board.

IV. EXHIBIT 2028, ¶¶ 33, 40, 48, AND 49

In the identified paragraphs from Exhibit 2028, Dr. Lemon merely parrots hearsay statements of Patent Owner's counsel (¶ 33) and of other endodontists (¶¶ 40, 48, and 49). *See* Paper 62, pp. 6-7. FRE 703 is inapplicable to at least ¶ 33 as it would not be reasonable for an expert to rely on such unsupported statements from Patent Owner's counsel. FRE 703 is also inapplicable because Dr. Lemon is a fact witness, not an expert witness. *See, e.g.*, Ex. 1039, 22:18-19 ("[A]s far as the details of the ['773] patent and its art, I am not an expert in that field.").

V. EXHIBIT 2040

Mr. Huddie's statements are not admissions of a party opponent. As Mr. Huddie's e-mail states, he and the Westbury Group were advisors for non-party D&S Dental. Such statements were made before Petitioner was even formed. *See* Ex. 2010. Further, Patent Owner fails to make the requisite showing of admissibility under FRE 807.

VI. EXHIBIT 2043

The identified statements in Exhibit 2043 are hearsay because Patent Owner relies on such statements to prove the truth of the matter asserted, i.e., that others praised the alleged invention of the '773 patent. No exception applies.

VII. EXHIBIT 2044

Mr. Bennett's statements were not made in his individual capacity, but in his capacity as a representative of non-party D&S Dental. Indeed, the e-mail is dated prior to the formation of Petitioner US Endo. *See* Ex. 2010. The exhibit is also irrelevant because the application for the '773 patent was not filed until nearly two years after the e-mail exchange. Finally, Patent Owner's claim of lack of prejudice is wrong. Paper 62, p. 9.

VIII. EXHIBIT 2050

Again, Patent Owner's claim of lack of prejudice resulting from its untimely disclosure of this exhibit is wrong. *Id.* at 10-11. Further, Patent Owner's

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