

Served on behalf of: Gold Standard Instruments, LLC

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Date served: Aug. 19, 2015

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 OBJECTIONS TO PETITIONER'S EVIDENCE

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner Gold Standard

Instruments, LLC, objects to the following evidence submitted by Petitioner with its Petition for Inter Partes Review of U.S. Patent No. 8,727,773 (Paper No. 2).

Evidence Submitted by Petitioner	Patent Owner's Objections
Ex. 1002 (Declaration of A. Jon Goldberg)	All portions of the Declaration not based on personal knowledge are objected to as improper hearsay (FRE 801). Paragraphs 88, 99-105, 113, 120-124, 126, 127, 129, 138, 140, 141-144, 146, 153-163, 165, 167, 168, 171, 175, 181, 183, 186, 187, 192-198, 206, 214, 217-221, and 223-227 are objected to as improper legal conclusions (FRE 702). Paragraphs 25-35, 37-40, 42-58, 65-70, 75-82, 86-127, 168-198, 226-227 are objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403). Paragraphs 39, 40, 134-137, 172, and 201 are objected to as lacking foundation, assuming facts not in evidence, containing testimony on matters in which the witness lacks personal knowledge, and conclusory (FRE 602, 703, 705). Paragraph 204 is objected to for lack of authentication (FRE 901).
Ex. 1003 (Harmeet Walia et al., <i>An Initial Investigation of the Bending and Torsional Properties of Nitinol Root Canal Files</i> , 14 J. ENDODONTICS 346 (1988))	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).

Evidence Submitted by Petitioner	Patent Owner's Objections
Ex. 1004 (Fujio Miura et al., <i>The super-elastic property of the Japanese NiTi alloy wire for use in orthodontics</i> , 90 AM. J. ORTHODONTICS & DENTOFACIAL ORTHOPEDICS 1 (1986))	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1005 (Satish B. Alapati, "An investigation of phase transformation mechanisms for nickel-titanium rotary endodontic instruments," PhD thesis, 2006)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1006 (Alan R. Pelton et al., <i>Optimisation of Processing and Properties of Medical-Grade Nitinol Wire</i> , 9 Minimally Invasive Therapies & Allied Techs. 107 (2000))	This exhibit is objected to as irrelevant because it is not analogous prior art (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1007 (U.S. Patent No. 5,697,906 to Ariola et al.)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1009 (Prosecution history of U.S. Patent No. 8,062,033)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1010 (Prosecution history of U.S. Patent No. 8,562,341)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1011 (US. Provisional Patent Application No. 60/578,091)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1012 (U.S. Patent Application Publication No. 2008/0032260 A1, Luebke)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).

Evidence Submitted by Petitioner	Patent Owner's Objections
Ex. 1013 (Prosecution history of U.S. Patent No. 8,083,873)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1014 (U.S. Patent Application Publication No. 2011/0271529 A1, Gao et al.)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1015 (U.S. Provisional Patent Application No. 61/332,954)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1017 (International Standard ISO 3630-1, 2nd ed. (2008))	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1018 (Salwa E. Khier et al., <i>Bending properties of superelastic and nonsuperelastic nickel-titanium orthodontic wires</i> , 99 AM. J. ORTHODONTICS & DENTOFACIAL ORTHOPEDICS 310 (1991))	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1020 (U.S. Patent No. 5,628,674 to Heath et al.)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1021 (Edgar Schäfer et al., <i>Bending properties of rotary nickel-titanium instruments</i> , 96 ORAL SURGERY ORAL MEDICINE ORAL PATHOLOGY 757 (2003))	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1024 (S. Miyazaki et al., <i>Characteristics of Deformation and Transformation Pseudoelasticity in Ti-Ti Alloys</i> , 43 J. PHYSIQUE COLLOQUES C4-255 (1982))	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).

Evidence Submitted by Petitioner	Patent Owner's Objections
Ex. 1025 (Franklin S. Weine, ENDODONTIC THERAPY, 6th Ed., 2004, Chapter 5)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1026 (Japanese Unexamined Patent Application Publication No. 2006-149675, Matsutani et al.)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403) and as improper hearsay (FRE 801).
Ex. 1027 (English translation of Japanese Unexamined Patent Application Publication No. 2006-149675, Matsutani et al.)	This exhibit is objected to as irrelevant to the grounds upon which trial has been instituted (FRE 401-403), as hearsay evidence (FRE 801), and for lack of authentication (FRE 901).

The foregoing objections are made within 10 business days of the institution of the trial in accordance with 37 C.F.R. § 42.64(b)(1).

Respectfully submitted,

Dated: August 19, 2015

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