

Served on behalf of: Gold Standard Instruments, LLC

Paper \_\_\_\_\_

By: Joseph A. Hynds, Lead Counsel                      Date filed: September 20, 2016  
Steven Lieberman, Back-up Counsel (*Pro Hac Vice*)  
C. Nichole Gifford, Back-up Counsel  
R. Elizabeth Brenner-Leifer, Back-up Counsel  
Derek F. Dahlgren, Back-up Counsel (*Pro Hac Vice*)  
Jason M. Nolan, Back-up Counsel  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
607 14th Street, N.W., Suite 800  
Washington, DC 20005  
Phone: 202-783-6040 | Facsimile: 202-783-6031  
Emails: jhynds@rfem.com  
          slieberman@rfem.com  
          ngifford@rfem.com  
          ebrenner@rothwellfigg.com  
          ddahlgren@rfem.com  
          jnolan@rfem.com

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 PGR2015-00019  
Patent 8,876,991 B2

---

**PATENT OWNER'S MOTION TO EXCLUDE**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

## **I. Introduction**

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner Gold Standard Instruments, LLC (“Patent Owner”) moves to exclude Exhibits 1005, 1006, 1016, 1017, 1020, 1021, 1025, 1034, 1036, and 1038.

## **II. Exhibit 1005**

Ex. 1005 is a Ph.D. thesis by Satish B. Alapati. Petitioner relied on Ex. 1005 on pages 5 and 6 of its Petition (Paper 1) and on page 10 of its Reply (Paper 31). Patent Owner objected to Ex. 1005 (1) under Fed. R. Evid. 401–403 as irrelevant to the instituted grounds, (2) under Fed. R. Evid. 801 as improper hearsay for which Petitioner has not established any exception, and (3) under Fed. R. Evid. 901 for lack of authentication. Paper 19. Petitioner has not cured these objections.

First, Ex. 1005 is not prior art to US 8,876,991 (“the ’991 patent”) and not part of any instituted ground. Thus, it should be excluded because it is not relevant to the proceeding. Second, it should be excluded because it is hearsay, not subject to any exception. Petitioner improperly relied on Ex. 1005 for the truth of the matter asserted in the document. Petitioner has not cited to any hearsay exception, and none applies. Here, Petitioner has not presented the testimony of any

individual having first-hand knowledge of the statements and/or experiments described in Ex. 1005. Finally, for the same reasons, Ex. 1005 should be excluded for lack of authentication. Petitioner has not presented any evidence of public availability for Ex. 1005. Petitioner also did not serve supplemental evidence to address Patent Owner's objections, such as providing evidence of cataloguing or other indexing.

### **III. Exhibit 1006**

Ex. 1006 is an article by Pelton *et al.* Petitioner relied on Ex. 1006 on pages 6, 10, 42, 65, 68, and 71 of its Petition (Paper 1) and on page 10 of its Reply (Paper 31). In Paper 19, Patent Owner objected to Ex. 1006 under Fed. R. Evid. 401–403 as irrelevant to the grounds upon which trial has been instituted. Petitioner has not and cannot cure these objections. In this trial, no ground relies upon Ex. 1006. Thus, Ex. 1006 should be excluded because it is not relevant to this proceeding.

### **IV. Exhibit 1016**

Ex. 1016 is an article by Schäfer *et al.* Petitioner relied on Ex. 1016 on pages 36 and 63 of its Petition (Paper 1). Patent Owner objected to Ex. 1016 under Fed. R. Evid. 401–403 as irrelevant to the grounds upon which trial has been instituted. Paper 19. Petitioner has not cured this objection. Nor can it. Ex. 1016 is

not part of any instituted ground in this trial. Thus, it should be excluded because it is not relevant.

#### **V. Exhibit 1017**

Ex. 1017 is an article by Testarelli *et al.* Petitioner relied on Ex. 1017 on pages 36 and 63 of its Petition (Paper 1). Patent Owner objected to Ex. 1017 under Fed. R. Evid. 401–403 as irrelevant to the instituted grounds. Paper 19. Petitioner has not served supplemental evidence addressing these objections, nor can it. Ex. 1017 is not prior art to the '991 patent and not part of any instituted ground. Thus, it should be excluded because it is not relevant to this proceeding.

#### **VI. Exhibit 1020**

Ex. 1020 is another article by Pelton *et al.* Petitioner relied on Ex. 1020 on page 44 of its Petition (Paper 1) and on page 14 of its Reply (Paper 31). Patent Owner objected to Ex. 1020 under Fed. R. Evid. 401–403 as irrelevant to the grounds upon which trial has been instituted. Paper 19. Petitioner cannot cure these objections. Ex. 1020 is not part of any instituted ground. Thus, it should be excluded because it is not relevant to this proceeding.

#### **VII. Exhibit 1021**

Ex. 1021 is an article by Miyazaki *et al.* Petitioner relied on Ex. 1021 on page 44 of its Petition (Paper 1) and on page 14 of its Reply (Paper 31). Patent Owner objected to Ex. 1021 under Fed. R. Evid. 401–403 as irrelevant to the

grounds upon which trial has been instituted. Paper 19. Petitioner has not cured this objection, nor can it. Here, Ex. 1021 is not part of any instituted ground. Thus, it should be excluded because it is not relevant to the proceeding.

### **VIII. Exhibit 1025**

Ex. 1025 is U.S. Patent Application Publication No. 2006/0115786 A1 to Matsutani *et al.* Petitioner relied on Ex. 1025 on pages 54–58 of its Petition (Paper 1). Patent Owner objected to Ex. 1025 under Fed. R. Evid. 401–403 as irrelevant to the grounds upon which trial has been instituted. Paper 19. Petitioner cannot cure this objection. Ex. 1025 is not prior art to the '991 patent, nor is it part of any instituted ground. As such, it should be excluded because it is not relevant to this proceeding.

### **IX. Exhibit 1034**

Ex. 1034 is an article by Bahia. Petitioner relied on Ex. 1034 on page 60 of its Petition (Paper 1). Patent Owner objected to Ex. 1034 under Fed. R. Evid. 401–403 as irrelevant to the grounds upon which trial has been instituted. Paper 19. Petitioner has not cured this objection, nor can it. Ex. 1034 is not prior art to the '991 patent and is not part of any instituted ground. Thus, it should be excluded because it is not relevant to this proceeding.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.