

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

**PETITIONER'S MOTION TO EXCLUDE
EVIDENCE UNDER 37 C.F.R. § 42.64(C)**

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Pursuant to 37 C.F.R. § 42.64(c) and the Order Modifying Scheduling Order (Paper 21), Petitioner US Endodontics, LLC (“Petitioner”) moves to exclude the following evidence submitted by Patent Owner Gold Standard Instruments, LLC (“Patent Owner”): (1) portions of Exhibit 2034; (2) Exhibits 2035, 2036, and 2038; and (3) portions of the transcript of the September 12, 2016 cross-examination of Petitioner’s expert, Dr. Goldberg, identified by Patent Owner in Paper 37 as Exhibit 2047. Petitioner’s objections apply the rules set forth in 37 C.F.R. Part 42 and the Federal Rules of Evidence (“FRE”).

I. EXHIBIT 2034 IS INADMISSIBLE UNDER FRE 802, 805, AND 901

Exhibit 2034 is described by Patent Owner as “File History for U.S. Patent Application Serial No. 14/522,013.” Patent Owner relies on a portion of Exhibit 2034 to state that “Dr. Luebke submitted information to the Patent Office demonstrating that a heat-treatment at 300°C resulted in a file that satisfies the permanent deformation of the ‘wherein’ clause,” citing to Ex. 2034, pp. 43-64. *See* Paper 27, p. 4. Such pages do not appear to provide any support for Patent Owner’s assertion.

To the extent Patent Owner meant to cite to a declaration executed by Neill H. Luebke (“Luebke”) on March 3, 2016, and submitted during the prosecution of U.S. Patent Appl. Serial No. 14/522,013, one of Luebke’s later-filed applications not at issue in this proceeding, and to the extent that the Board is willing to

consider the same, Petitioner timely objected to the portions of Exhibit 2034 as constituting inadmissible hearsay under FRE 802 and 805, and for lack of authentication under FRE 901. *See* Paper 29, pp. 2-3.

Luebke's declaration constitutes inadmissible hearsay under FRE 802. No exceptions to the rule against hearsay are applicable to Luebke's statements contained therein. Such declaration was not submitted in this proceeding and Patent Owner offered no testimony, expert or otherwise, regarding the same.

Exhibit A to Luebke's declaration, a testing report purportedly prepared by Nick Chadd of Knight Mechanical Testing ("KMT"), also constitutes inadmissible hearsay under FRE 802. No exceptions to the rule against hearsay are applicable to Mr. Chadd's or KMT's statements therein. Patent Owner did not submit any testimony from Mr. Chadd or anyone at KMT in this proceeding. Further, the reliance on, and citation to, the KMT report in the Luebke declaration creates a classic hearsay-within-hearsay problem, making Exhibit A additionally inadmissible under FRE 805.

Exhibit A to Luebke's declaration submitted during the prosecution of U.S. Patent Appl. Serial No. 14/522,013 is also inadmissible for lack of authentication under FRE 901. Patent Owner failed to lay the proper foundation to show that Exhibit A is a true and correct copy of a report prepared by KMT. There is no sworn testimony from Mr. Chadd or anyone else at KMT with personal knowledge

to confirm this. Further, Patent Owner failed to lay the proper foundation to confirm the identification, authenticity, and chain of custody of the file samples purportedly received and tested by KMT.

Accordingly, the portions of Exhibit 2034 relied upon by Patent Owner should be excluded.

II. EXHIBIT 2035 IS INADMISSIBLE UNDER FRE 802, 805, AND 901

Exhibit 2035 is described by Patent Owner as “Kowalski Heat Treatment Company Certification, date [sic] January 15, 2016,” and purports to be a certification from Kowalski Heat Treatment Company (“Kowalski”), which contains an illegible “Approved by” signature from an unidentified individual dated January 15, 2016. Petitioner timely objected to Exhibit 2035 as constituting inadmissible hearsay under FRE 802 and 805, and for lack of authentication under FRE 901. *See* Paper 29, p. 3.

Patent Owner relies on Exhibit 2035 in support of its assertion that “Patent Owner replicated the process described by Kuhn and heated the same file specimens as set forth in Kuhn,” specifically, that “files were heated at 400°C in a salt bath for 10 minutes, [and] quenched in water.” Paper 27, pp. 5-6, 43.

Exhibit 2035 constitutes inadmissible hearsay under FRE 802. No exceptions to the rule against hearsay are applicable to the statements therein.

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