

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 PGR2015-00019
Patent 8,876,991 B2

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION TO EXCLUDE**

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I. Introduction

Patent Owner opposes Petitioner's Motion to Exclude Evidence (Paper 40). Petitioner has not met its burden of establishing that it is entitled to the requested relief. 37 C.F.R. §§ 42.20(c), 42.62(a). Petitioner's motion to exclude Ex. 2034, Ex. 2035, Ex. 2036, Ex. 2038, and portions of Ex. 2047 should be denied for the reasons that follow.

II. Exhibit 2034

Ex. 2034 is a copy of the prosecution history for U.S. Patent Application Serial No. 14/522,013 (now U.S. Patent No. 9,314,316). Petitioner argues that Ex. 2034 contains inadmissible hearsay and lacks authentication. (Paper 40 at 1–3.)

Regarding authentication, Ex. 2034 is a record of the United States Patent and Trademark Office (PTO). As such, Ex. 2034 certification is not a requirement for admissibility. 37 C.F.R. § 42.61(b). Ex. 2034 is admissible in its entirety, including the documents filed on March 3, 2016 (Applicant's request for continued examination, amendments to the claims, and a declaration executed by Dr. Neill H. Luebke). Ex. 2034 at 372–405. Applicant's submission refers to an Office action mailed on September 4, 2015. *Id.* at 372. The Office action mailed on September 4,

2015 bears the seal of the PTO. *Id.* at 302. The Notice of Allowance, mailed by the PTO on March 14, 2016, refers to the documents filed on March 3, 2016. *Id.* at 410. It also bears the seal of the PTO. *Id.* at 445. Accordingly, the appearance, contents, substance, internal patterns, and/or other distinctive characteristics of Ex. 2034, taken together with all the circumstances, support a finding that it is what Patent Owner claims it is. As such, Ex. 2034 is also admissible under Fed. R. Evid. 901(a), 901(b)(4), and 902(1)(A).

Petitioner argues that Exhibit A to Dr. Luebke's declaration is inadmissible because there is no sworn testimony showing that Exhibit A is a true and correct copy of a report prepared by Knight Mechanical Testing (KMT). (Paper 40 at 2.) But testimony is not required. *See* Fed. R. Evid. 901 (listing testimony as one example). Rule 901 also states that distinctive characteristics and the like may satisfy the requirement of authenticating evidence. Exhibit A was signed by Nick Chadd and Nolan Knight on March 2, 2016. Ex. 2034 at 384. Exhibit A bears KMT Report No. TR1139-001 and is titled Gold Standard Nitinol Files ISO 3630-1 Section 7.5 Stiffness Testing Final Report. *Id.* Exhibit A is consecutively paginated from 1/10 to 10/10. *Id.* at 384–393. Each page is printed on corporate letterhead, which contains on the top of the page, the name *Knight Mechanical Testing*, the stylized trade logo *KMT*, and the address, telephone, and fax number. Because Exhibit A is signed and contains inscription affixed during the normal course of

business, there is no doubt as to the origin, ownership, and control of the document. And Petitioner has not pointed to any discrepancies or articulated any reason for questioning whether Exhibit A is what it purports to be. Therefore, Exhibit A is self-authenticating under Fed. R. Evid. 902(7). *See, e.g., Alexander v. CareSource*, 576 F.3d 551, 561 (6th Cir. 2009) (job description on a company letterhead was self-authenticating under Fed. R. Evid. 902(7) because it contained a trade inscription indicating the source of origin of the document); *Reitz v. Mt. Juliet*, No. 3:08-cv-0728, 2009 WL 5170200, at *5 n.7 (M.D. Tenn. Dec. 18, 2009) (stating that letters and memorandum on letterhead are self-authenticating under Fed. R. Evid. 902(7)).

Petitioner also argues that the identification, authenticity, and chain of custody of the endodontic file samples tested by KMT have not been confirmed. (Paper 40 at 3.) This argument ignores the record. Dr. Luebke testified that he obtained nickel titanium files and instructed Bodycote Thermal Processing of Sturtevant, Wisconsin to heat treat them in a furnace at 300C for 24 hours. *See* Ex. 2034 at 382 (Luebke decl. ¶4). After the heat treatment, the files were sent to KMT for testing according to ISO 3630-1. *See id.* (Luebke decl. ¶5). Exhibit A confirms that the file samples tested by KMT were provided by Bodycote Thermal Processing of Sturtevant, WI. *See id.* at 387 (Ex. A §3.1). Exhibit A includes photos of the file samples after testing and reports the angle of permanent deformation for

each of the tested files. *See id.* at 390 (test results) and 392 (photo).

Regarding hearsay, Petitioner argues that Dr. Luebke's declaration, including Exhibit A, is inadmissible because it was not submitted with testimony in this trial. (Paper 40 at 2.) First, the statements in Dr. Luebke's declaration were based on his personal knowledge, and sworn to be true with the knowledge that willful false statements would be punishable under the law. *See Ex. 2034 at 383* (¶7). Second, Exhibit A was signed by Nick Chadd and Nolan Knight in the ordinary course of business at the time the report was released. *See Ex. 2034 at 384–85*. Third, Petitioner cross-examined Dr. Luebke about this declaration. *See Ex. 1044*. Although that deposition was for the related district court litigation, Petitioner never requested Patent Owner to make Dr. Luebke, or any declarants, available for deposition in this trial. Therefore, even assuming *arguendo* that the statements in Ex. 2034 are hearsay, they are admissible under Fed. R. Evid. 807 because: (1) there are circumstantial guarantees of trustworthiness associated with submitting a declaration with the PTO; (2) the declaration was offered as evidence of a material fact; and (3) the declaration is more probative for showing 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,” than any other evidence. Accordingly, the interests of justice and the purposes of the hearsay rule will be best served by denying Petitioner's motion.

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