

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 OPPOSITION
TO PATENT OWNER'S MOTION TO EXCLUDE**

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Petitioner US Endodontics, LLC opposes Patent Owner's motion to exclude Exhibits 1005, 1006, 1016, 1017, 1020, 1021, 1025, 1034, 1036, and 1038. For the reasons discussed herein, Patent Owner's motion should be denied in its entirety.

I. EXHIBIT 1005 IS ADMISSIBLE

Exhibit 1005 is a Ph.D. thesis completed in 2006, authored by Satish B. Alapati, and entitled, "An investigation of phase transformation mechanisms for nickel-titanium rotary endodontic instruments" ("Alapati"). Patent Owner argues that Alapati is irrelevant to the proceeding because it is "not part of any instituted ground." Paper 36, p. 2. Patent Owner also argues that Alapati is "not prior art to [the '991 patent]." *Id.* Patent Owner is wrong on both counts.

As an initial matter, Patent Owner provides no explanation for its assertion that Alapati is "not prior art" to the '991 patent. To the contrary, Alapati is prior art to the '991 patent since it is a thesis that was catalogued in an Ohio State University library on June 22, 2006, *see* Ex. 1005, p. 77—well before the January 29, 2014 effective filing date of the claims 12-16 of the '991 patent. *See* Paper 17, p. 21.

Alapati is relevant to several instituted grounds in this proceeding as exemplary prior art indicating that a person having ordinary skill in the art as of the January 29, 2014 effective filing date would know that martensite occurs at lower temperatures and austenite occurs at higher temperatures. *See* Paper 1, pp. 5-6. It

also serves as evidence that: (i) a skilled artisan would look beyond the endodontic field for useful nickel titanium (“Ni-Ti”) art; and (ii) a skilled artisan would understand that raising the austenite finish (A_f or shape recovery) temperature of a Ni-Ti alloy to above body temperature equates to decreasing its superelasticity such it will exhibit permanent deformation when bent. *See* Ex. 1002, ¶ 79; Paper 31, p. 10.

Patent Owner also argues that Alapati is hearsay. *See* Paper 36, p. 2. However, even if the Board determines it is hearsay, which Petitioner disputes, Alapati is still admissible under FRE 703. Petitioner’s expert, Dr. A. Jon Goldberg, reasonably relied on Alapati in further support of his opinion that one of ordinary skill in the art would have looked to Ni-Ti art beyond the endodontic field when trying to solve problems within the endodontic field. *See* Ex. 1002, ¶ 79. Thus, Alapati is admissible under FRE 703 as it served as a basis for Petitioner’s expert’s opinions.

Patent Owner also argues that Alapati should be excluded for lack of authentication because Petitioner has not presented any evidence of public availability, such as “evidence of cataloguing or other indexing.” Patent Owner is wrong. The last two pages of Exhibit 1005 is a library record that shows Alapati was catalogued in an Ohio State University library on June 22, 2006.

Accordingly, Exhibit 1005 is admissible and should not be excluded.

II. EXHIBIT 1006 IS ADMISSIBLE

Exhibit 1006 is an article published in 2000, authored by Alan R. Pelton et al., and entitled, “Optimisation of Processing and Properties of Medical-Grade Nitinol Wire” (“Pelton”). Patent Owner’s statement that “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)” omits a number of pages in Petitioner’s papers that contain a discussion of Pelton, including pages 43-45, 66-67, 69-70, 72, 78, and 79 of the Petition and pages 11, 13, and 14 of the Reply.

Patent Owner argues that Pelton is irrelevant to the instituted grounds because “no ground relies upon” it. Paper 36, p. 3. Patent Owner is wrong. Pelton is relevant to at least the ground of lack of enablement of claims 12-16 of the ’991 patent, on which the Board instituted this proceeding. *See, e.g.*, Paper 1, pp. 42-45; Ex. 1002, ¶¶ 102, 113-121, 125, and 130; Paper 31, pp. 13-14.

Pelton discloses that the transformation temperature of a NiTi alloy did not change significantly with a treatment temperature of 300°C, and reached only 25°C after three hours of heat-treatment. *See, e.g.*, Paper 1, pp. 42-43; Ex. 1002, ¶ 102. Additionally, Dr. Goldberg’s testimony on the issue of undue experimentation includes extensive discussion of Pelton. *See* Ex. 1002, ¶¶ 114-121, 125; *see also* Paper 31, p. 13-14. Since Dr. Goldberg reasonably relied upon Pelton in forming his opinions, Pelton is additionally admissible under FRE 703.

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