

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 RESPONSE TO PATENT OWNER'S
OBSERVATIONS ON CROSS-EXAMINATION**

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Petitioner US Endodontics, LLC submits this Response to Patent Owner's Observations on Cross-Examination concerning the testimony of Petitioner's expert, Dr. A. Jon Goldberg, in Exhibit 2047.

INTRODUCTION

Since each of Patent Owner's observations improperly raises new issues, re-argues issues, does not contradict Dr. Goldberg's or Petitioner's positions, mischaracterizes Dr. Goldberg's testimony, and/or is not relevant to this proceeding, the Board should accord the observations no weight. *See Medtronic, Inc. v. Nuvasive, Inc.*, IPR2013-00506, Paper 37, pp. 3-4 (P.T.A.B. Oct. 15, 2014) ("An observation is not an opportunity to raise new issues, to re-argue issues, or to pursue objections.").

Further, Patent Owner's Observation Nos. 2-7 and 13 rely upon cross-examination testimony that is the subject of Petitioner's Motion to Exclude Evidence Under 37 C.F.R. § 42.64(c), *see* Paper 40, pp. 6-8, for exceeding the scope of direct testimony in the Supplemental Declaration of A. Jon Goldberg, Ph.D. (Ex. 1042, hereinafter "Dr. Goldberg's Supplemental Declaration"), in violation of 37 C.F.R. § 42.53(d)(5)(ii), which requires "the scope of the [cross-examination to be] limited to the scope of the direct testimony." Accordingly, to the extent the Board grants Petitioner's motion to exclude such cross-examination testimony, it should deny Patent Owner's motion for observations of the same.

RESPONSES TO OBSERVATIONS

I. OBSERVATION NO. 1

This observation should be accorded no weight because it: (1) raises a new issue, and (2) does not contradict Dr. Goldberg's position that undue experimentation is needed to practice the claims of the '991 patent. Patent Owner raises a new argument that bears no relation to the direct testimony in Dr. Goldberg's Supplemental Declaration, and that Patent Owner could have, but failed to, raise in its Response. Further, in the portion of Exhibit 2047 that immediately follows the portion identified by Patent Owner, Dr. Goldberg testified that numerous variables can influence whether a bend-test would result in the claimed deformation. *See* Ex. 2047, 24:20-25:11. Thus, Dr. Goldberg's alleged "admission" in Exhibit 2047 at 23:24-24:19 is entirely consistent with the testimony in his declaration submitted with the Petition. *See* Ex. 1002, ¶¶ 111-125; Paper 31, pp. 11-15.

II. OBSERVATION NO. 2

This observation should be accorded no weight because it: (1) re-argues an issue; (2) raises a new argument; (3) mischaracterizes Dr. Goldberg's testimony; and (4) is not relevant to this proceeding. Patent Owner already argued this issue in its Response. *See* Paper 27, pp. 29-30. In citing Dr. Goldberg's testimony in Exhibit 2047 at 49:9-17, Patent Owner also raises a new argument based on a

document – Exhibit 2043 : that (1) was available to Patent Owner at the time it submitted its Response, but not raised therein; (2) Dr. Goldberg had never seen prior to his cross-examination, *see* Ex. 2047, 46:23-47:7; and (3) bears no relation to the direct testimony in Dr. Goldberg's Supplemental Declaration. Further, this observation is based on portions of Exhibit 2043 that Patent Owner's counsel read into the record. *See* Ex. 2047, 48:6-18. Dr. Goldberg did not "concede[]" that a nickel titanium alloy can remain superelastic below its austenite finish temperature." Rather, Dr. Goldberg testified that one can determine the crystal structure based on the A_f temperature as long as one is not "totally in a void" regarding "how [the sample has] been used." *Id.* at 49:18-25; 58:3-5. Dr. Goldberg further testified that information regarding whether the sample was being cooled or whether it was being heated to arrive at the current temperature is generally encompassed in "how [the sample] is being used." *Id.* at 57:6-17. In the prior art at issue in this proceeding, Dr. Goldberg explained, "it's either been directly described or implied what the situation was." *Id.* at 58:13-15. Thus, Dr. Goldberg's testimony cited by Patent Owner is not relevant to, and does not detract from, his opinions that the prior art renders the claims of the '991 patent unpatentable.

III. OBSERVATION NO. 3

This observation should be accorded no weight because it: (1) raises a new issue; (2) mischaracterizes Dr. Goldberg's testimony; and (3) is not relevant to this

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