

By: Joseph A. Hynds, Lead Counsel  
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@rothwellfigg.com  
slieberman@rothwellfigg.com  
ngifford@rothwellfigg.com  
ebrenner@rothwellfigg.com  
ddahlgren@rothwellfigg.com  
jnolan@rothwellfigg.com

Date filed: Oct. 7, 2016

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 REPLY IN SUPPORT OF ITS  
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**

Patent Owner Gold Standard Instruments, LLC (“GSI”), moved to exclude Exhibits 1005, 1006, 1016, 1017, 1020, 1021, 1025, 1034, 1036, and 1038 in Paper 36. GSI hereby replies to Petitioner’s opposition (Paper 44).

## **II. Exhibit 1005 is inadmissible hearsay**

Petitioner neither explains why Ex. 1005 is not hearsay, nor denies that it is relied on for the truth of the matter asserted. Nor does Petitioner allege any exception. Instead, Petitioner argues that Dr. Goldberg’s reference to Ex. 1005 makes it admissible. Not so. Fed. R. Evid. 703 does not make the hearsay itself admissible. *See Advisory Committee Notes—2000 Amendments* (“Rule 703 has been amended to emphasize that when an expert reasonably relies on inadmissible information to form an opinion or inference, the underlying information is not admissible simply because the opinion or inference is admitted.”). Because Fed. R. Evid. 703 was not intended to be a vehicle for evading the prohibition against hearsay, Ex. 1005 should be excluded.

Petitioner also argues that even if Ex. 1005 is hearsay, it was relied on to show that a person having ordinary skill in the art would look beyond the nickel titanium endodontic field when solving problems with endodontic instruments. But even assuming as much, whether a reference is “analogous art” is not an issue in this trial. Therefore, Ex. 1005 has no probative value in helping the Board evaluate

Dr. Goldberg's opinions. The exhibit should be excluded.

**III. Exhibits 1005, 1017, 1025, 1034, and 1036 are not prior art, and are not relevant**

Exhibits 1005, 1017, 1025, 1034, and 1036 are not prior art. Petitioner argues that GSI has not explained why Exs.1005, 1017, 1025, 1034, and 1036 are not prior art to US 8,876,991 (“the ’991 patent”). Petitioner is incorrect. As explained in Patent Owner’s Preliminary Response (Paper 14 at 31) and Patent Owner’s Response (Paper 27 at 39–40), the ’991 patent is entitled to an effective filing date of at least June 7, 2005. Because Exs.1005, 1017, 1025, 1034, and 1036 were published after June 7, 2005, they are not prior art.

The claimed invention must be viewed from the perspective of a person of ordinary skill in the art *at the time of the invention or filing*. See, e.g., *Allergan, Inc. v. Sandoz Inc.*, 796 F.3d 1293, 1304 (Fed. Cir. 2015) (obviousness); *id.* at 1308 (written description); *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1254 (Fed. Cir. 2004) (enablement). Petitioner has not alleged any exception to this rule. Thus, Exs.1005, 1017, 1025, 1034, and 1036 are not relevant to any instituted ground. Further, because Dr. Goldberg allegedly relied on these post-filing references in forming his opinions, his opinions are from the perspective of a person *after the time of invention and/or filing*. That is, Dr. Goldberg’s opinions are based on improper hindsight, which renders the exhibits prejudicial to GSI. Thus, these

exhibits should be excluded.

**IV. Exhibits 1005, 1006, 1016, 1017, 1020, 1021, 1025, 1034, 1036, and 1038 are not part of any instituted grounds, nor relevant**

Petitioner argues that Ex. 1005 is relevant to the knowledge of a person of skill in the art. Specifically, Petitioner argues that Ex. 1005 is relevant to its theory that a file with an elevated austenitic finish ( $A_f$ ) temperature will exhibit permanent deformation after bending. Petitioner's argument lacks merit for three reasons. First, it ignores the Board's finding that the relationship between  $A_f$  temperature and permanent deformation is "too attenuated." Paper 17 at 24. Second, it also ignores the fact that none of the claims in the '991 patent refer to  $A_f$  temperature. Indeed,  $A_f$  temperature is not mentioned anywhere in the '991 patent. Third, Dr. Goldberg conceded that the correlation Petitioner attempts to draw between  $A_f$  temperature, crystal structure, and permanent deformation is overstated. *See* Paper 37, ¶2 (citing, *e.g.*, Ex. 2047 at 49:9–17 ("Q. And so the question was is it fair to say that Exhibit 2043 at column 1, lines 22 to 30 stating that a nickel titanium alloy can be austenitic when it is below its A sub F, so long as it is above the martensitic start temperature? . . . A. Yes.")). Ex. 1005 is not relevant and should be excluded.

Petitioner also argues that Exs. 1006, 1016, 1017, 1020, 1021, and 1036 are relevant to enablement. However, except for a small portion of Dr. Goldberg's declaration citing Ex. 1006 (Paper 17 at 14), the Board did not rely on Exs. 1006,

# 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.