

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

IPR2018-00934
U.S. Patent No. 8,998,058

**PATENT OWNER'S CONTINGENT MOTION TO AMEND UNDER 37
C.F.R. § 42.121**

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LIST OF EXHIBITS

Exhibit	Description
Ex. 2001	U.S. Patent No. 5,964,394 (“Robertson”)
Ex. 2002	U.S. Patent No. 6,231,565 (“Tovey”)
Ex. 2003	Excerpts from Technology Tutorial filed in <i>Ethicon LLC, et al. v. Intuitive Surgical, Inc., et al.</i> , C.A. No. 17-871 (LPS)(CJB) (District of Delaware).
Ex. 2004	Statutory Disclaimer
Ex. 2005	Reserved
Ex. 2006	Declaration of Dr. William Cimino
Ex. 2007	Deposition of Gregory Fischer, Ph. D., Volume 1 (February 18, 2019)
Ex. 2008	Deposition of Gregory Fischer, Ph. D., Volume 2 (February 20, 2019)
Ex. 2009	Reserved
Ex. 2010	U.S. Pat. App. Pub. 2009/0206136 A1 (application publication of U.S. Appl. No. 12/031,628) (“the 628 Application”)
Ex. 2011	Reserved
Ex. 2012	Robert Glasgow et al., <i>The Benefits of a Dedicated Minimally Invasive Surgery Program to Academic General Surgery Practice</i> , Journal of Gastrointestinal Surgery, 869-73 (Nov. 2004)
Ex. 2013	U.S. Patent Application No. 2014/0252067 A1 (application publication of U.S. Appl. No. 14/282,494 (“the 494 Application”))

I. INTRODUCTION

Pursuant to 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, Patent Owner Ethicon LLC submits this contingent motion to substitute proposed claims 19-28 for original claims 1-10 (collectively, the “Challenged Claims”) of U.S. Patent No. 8,998,058 (“the 058 Patent”) should any of the Challenged Claims be found unpatentable.¹ Patent Owner has conferred with the Board prior to filing this motion, as required by 37 C.F.R. § 42.121, and the Board authorized the filing of this motion without a conference on February 25, 2019 via email.

In *Aqua Products, Inc. v. Joseph Matal*, 872 F.3d 1290, 1327-28 (Fed. Cir. 2017) (*en banc*), the Federal Circuit held that the burden of persuasion to establish that proposed amendments are patentable no longer rests with the patent owner. Instead, it is the petitioner’s burden to prove unpatentability of the proposed amendments. *Id.* In a motion to amend, a patent owner need only satisfy its burden of production under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121.

¹ Patent Owner submitted a statutory disclaimer for claims 11-18 – accordingly, claims 11-18 are treated as having never been part of the 058 Patent. *See* Paper 9 at 8-10. However in order to avoid confusion, Patent Owner begins numbering its substitute proposed claims at 19.

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