

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

Case IPR2018-00933 (Patent 9,084,601 B2)
Case IPR2018-00934 (Patent 8,998,058 B2)
Case IPR2018-00935 (Patent 8,991,677 B2)¹

Before JOSIAH C. COCKS, BENJAMIN D. M. WOOD, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

ORDER
Granting Motion to File Corrected Motions
35 U.S.C. § 42.5

¹ This Order applies to all of the listed cases. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this caption in any subsequent papers.

Case IPR2018-00933 (Patent 9,084,601 B2)

Case IPR2018-00934 (Patent 8,998,058 B2)

Case IPR2018-00935 (Patent 8,991,677 B2)

By email dated March 8, 2019, Patent Owner submitted an unopposed request to file a corrected motion to amend in IPR2018-00933 and corrected contingent motions to amend in IPR2018-00934 and IPR2018-00935. Ex. 3001. Patent Owner asserts that it timely filed a motion to amend in the -00933 proceeding and contingent motions to amend in the -00934 and -00935 proceedings, and each of these motions set forth written-description support for the proposed amended claims in the claim listings appended to each motion. *Id.* Patent Owner requests to file corrected versions of these motions, however, in light of a recent precedential Board decision² that interprets 37 C.F.R. § 42.121 to require written-description support for proposed amended claims to be set forth in a motion to amend itself rather than in the claim listing. *Id.* Accordingly, Patent Owner seeks leave to file corrected motions that conform to that interpretation.

Having considered Patent Owner's unopposed request and its stated reasons therefor, we determine that good cause exists to grant Patent Owner's request.³

Accordingly, it is:

ORDERED that Patent Owner's unopposed request to file a corrected motion to amend in IPR2018-00933 is *granted*, and

² *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, -0030 (PTAB Feb. 25, 2019) (Paper 15).

³ We informed the parties that this request was granted by email dated April 4, 2019.

Case IPR2018-00933 (Patent 9,084,601 B2)

Case IPR2018-00934 (Patent 8,998,058 B2)

Case IPR2018-00935 (Patent 8,991,677 B2)

FURTHER ORDERED that Patent Owner's unopposed request to file corrected contingent motions to amend in IPR2018-00934 and IPR2018-00935 is *granted*.

PETITIONER:

John C. Phillips

Steven R. Katz

Ryan P. O'Connor

Fish & Richardson

phillips@fr.com

katz@fr.com

oconnor@fr.com

PATENT OWNER:

Anish R. Desai

Elizabeth Stotland Weiswasser

Adrian Percer

Christopher T. Marando

Christopher M. Pepe

Weil, Gotschal & Manges LLP

anish.desai@weil.com

elizabeth.weiswasser@weil.com

adrian.percer@weil.com

christopher.marando@weil.com

christopher.pepe@weil.com