

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Kyle P. Moore, et al.
U.S. Patent No.: 8,998,058 Attorney Docket No.: 11030-0049IP2
Issue Date: April 7, 2015
Appl. Serial No.: 14/282,494
Filing Date: May 20, 2014
Title: DETATCHABLE MOTOR POWERED SURGICAL
INSTRUMENT

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**PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT
NO. 8,998,058 PURSUANT TO 35 U.S.C. §§ 311–319, 37 C.F.R. § 42**

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EXHIBITS

- IS1001 U.S. Patent No. 8,998,058 to Moore, et al. (“the ’058 patent”)
- IS1002 Excerpts from the prosecution histories of U.S. Pat. Nos. 9,084,601 (Serial No. 13/832,522), 8,998,058 (Serial No. 14/282,494), 8,991,677 (Serial No. 14/283,729), 8,752,749 (Serial No. 13/118,210), 8,196,795 (Serial No. 12/856,099), and 7,793,812 (Serial No. 12/031,628)
- IS1003 Declaration of Dr. Gregory S. Fischer
- IS1004 U.S. Patent No. 5,383,880 to Hooven (“Hooven”)
- IS1005 U.S. Patent App. Pub. No. 2005/0131390 to Heinrich et al. (“Heinrich”)
- IS1006 U.S. Patent No. 5,865,361 to Milliman et al. (“Milliman”)
- IS1007 U.S. Patent No. 7,524,320 to Tierney et al. (“the ’320 patent”)
- IS1008 U.S. Patent No. 8,196,795 to Moore et al. (“the ’795 patent”)
- IS1009 U.S. Patent No. 8,752,749 to Moore et al. (“the ’749 patent”)
- IS1010 U.S. Patent No. 5,779,130 to Alesi et al. (“Alesi”)
- IS1011 [Reserved]
- IS1012 [Reserved]
- IS1013 U.S. Patent No. 6,783,524 to Anderson et al. (“the ’524 patent”)

Intuitive Surgical, Inc. (“Petitioner”) petitions for *Inter Partes* Review (“IPR”) of claims 1-18 of U.S. Patent 8,998,058 (“the ’058 patent”). The ’058 patent relates to a “detachable motor-powered surgical instrument” in general and to a “surgical cutting and stapling instrument” in particular. The claimed motor is “configured to receive power from a power source such that said electrical motor can only selectively receive power from said power source when said housing connector is attached to the surgical instrument system.” IS1001, Claim 6.

Such instruments were not new at the time of the alleged priority date of the ’058 patent. As explained below, claims 1-18 are obvious over U.S. Patent No. 5,383,880 to Hooven (“Hooven”) in view of U.S. Patent App. Pub. No. 2005/0131390 to Heinrich et al. (“Heinrich”). Petitioner therefore requests IPR of the challenged claims.

I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8

A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)

Intuitive Surgical, Inc. is the real party-in-interest. No other party had access to the Petition, and no other party had any control over, or contributed to any funding of, the preparation or filing of the present Petition.

B. Related Matters Under 37 C.F.R. § 42.8(b)(2)

Petitioner is not aware of any disclaimers, reexamination certificates, or petitions for IPR of the ’058 patent. The ’058 patent is the subject of Civil Action No. 1:17-cv-00871-LPS, filed on June 30, 2017 in the United States District Court

for the District of Delaware. Petitioner was served with the complaint in that action on July 12, 2017. Concurrently with this petition, Petitioner filed IPR petitions for U.S. Pat. Nos. 8,991,677 and 9,084,601, which are related to the '058 patent.

C. Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)

Petitioner provides the following designation of counsel.

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D. Service Information

Please address all correspondence and service to the address listed above.

Petitioner consents to electronic service by email at IPR11030-0049IP2@fr.com (referencing No. 11030-0049IP2 and cc'ing PTABInbound@fr.com, phillips@fr.com, katz@fr.com, and oconnor@fr.com).

II. PAYMENT OF FEES – 37 C.F.R. § 42.103

Petitioner authorizes the Office to charge Deposit Account No. 06-1050 for the petition fee set in 37 C.F.R. § 42.15(a) and for any other required fees.

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