

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.

Petitioner

v.

ETHICON LLC

Patent Owner

Case IPR2018-00934

Patent 8,998,058

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S CONTINGENT MOTION TO AMEND**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE SUBSTITUTE CLAIMS INTRODUCE NEW MATTER	1
III.	THE SUBSTITUTE CLAIMS ARE OBVIOUS	3
	A. Substitute claims 19-22 and 24-27 are obvious over Viola in view of Heinrich	3
	B. Substitute claims 23 and 28 are obvious over Viola in view of Heinrich and, if necessary, further in view of Young	18
IV.	CONCLUSION.....	20

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”)
- IS1014-IS1028 Reserved
- IS1029 Webster’s Ninth New Collegiate Dictionary (1991)

- IS1030 Supplemental Declaration of Gregory S. Fischer (“Fischer
Supp. Decl.”)
- IS1031 U.S. Pat. No. 5,954,259 to Viola et al. (“Viola”)
- IS1032 U.S. Pat. No. 5,653,374 to Young et al. (“Young”)
- IS1033 Transcript of deposition of Dr. William Cimino, May 29, 2019

I. INTRODUCTION

The Board should deny Patent Owner’s Contingent Motion to Amend (“MTA”) seeking to substitute proposed claims 19-28 (“substitute claims”) for original claims 1-10. MTA at 1. For the reasons discussed below, Petitioner requests that the Board deny the MTA because each substitute claim: (1) introduces new matter; and (2) is obvious over the prior art.

II. THE SUBSTITUTE CLAIMS INTRODUCE NEW MATTER

An MTA may not present substitute claims that introduce new subject matter. 35 U.S.C. § 316(d); 37 C.F.R. § 42.121(A)(2)(ii). New matter is any addition to the claims without support in the original disclosure. *TurboCare Div. of Demag Delaval Turbomach. v. Gen. Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001). And a claim element without support in the original disclosure merits a rejection under 35 U.S.C. § 112 for lack of written description support. *In re Rasmussen*, 650 F.2d 1212, 1214 (C.C.P.A. 1981). When amending a claim to add a new claim element, the disclosure as filed must “actually or inherently disclose the claim element” to satisfy the written description requirement. *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306-07 (Fed. Cir. 2008). And pursuant to 35 U.S.C. § 316(d), the Board may properly consider Section 112 and rely on it to reject proposed substitute claims, as it should here. *See, e.g., Apple Inc. v. Valencell, Inc.*, Case No. IPR2017-00315, Paper 45 at 44 (PTAB May 31,

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