

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
U.S. Patent No. 8,998,058

**PETITIONER'S REPLY TO
PATENT OWNER'S RESPONSE**

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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”)
- 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

Patent Owner effectively concedes that Hooven in view of Heinrich renders obvious each of the challenged claims as they are written. It tries to save the claims by improperly injecting new limitations through claim construction. However, “it is important not [to use claim construction] to import into a claim limitations that are not part of the claim.” *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). “Claim terms should be given their plain and ordinary meaning to one of skill in the art at the relevant time and cannot be rewritten by the courts to save their validity.” *Hill-Rom Services, Inc. v. Stryker Corp.*, 755 F.3d 1367, 1374 (Fed. Cir. 2014).

II. Claim Construction

Petitioner proposed a single term for construction in its Petition—“means for removably attaching said housing to the surgical instrument,” present in claim 1. Petition, 15. Petitioner also proposed that all remaining terms in the challenged claims be given their plain and ordinary meaning under the BRI standard. *Id.*, 14. Patent Owner did not address the means plus function term in its Response, so Petitioner does not address it further in this Reply. *See* POR, 17.

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