

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 REQUEST FOR ORAL ARGUMENT**

Pursuant to 37 C.F.R. § 42.70(a) and the Scheduling Order (Paper 10),

Petitioner submits this Request for Oral Argument on all of the instituted grounds of unpatentability of U.S. Patent No. 8,998,058. A request for Oral Argument in related IPR proceedings (IPR2018-00933 and IPR2018-00935) are being filed on this same day. Petitioner requests 90 minutes for each side (180 minutes total) to present arguments collectively for this proceeding and the concurrent proceedings.

With regard to this particular proceeding, Petitioner requests (without waiving consideration of any issue not listed below) to address the following issues:

1. Whether substitute claims 19-28 impermissibly introduce new matter;
2. Whether substitute claims 19-22 and 24-27 are obvious over Viola in view of Heinrich;
3. Whether substitute claims 23 and 28 are obvious over Viola in view of Heinrich and, if necessary, further in view of Young;
4. Whether claims 1-10 are obvious over Hooven in view of Heinrich;
5. Rebuttal to Patent Owner's presentation on all matters; and
6. Any additional issues on which the Board seeks clarification.

The Board has already scheduled Oral Hearing for September 5, 2019. *See* PTAB's Scheduling Order of December 7, 2018 (Paper 10).

Petitioner also respectfully requests the ability to use audio visual equipment to display demonstrative exhibits, including the use of a projector and screen that connects to a laptop computer. Petitioner's counsel will use a laptop computer with a VGA-type connector. In addition, Petitioner requests that an ELMO-type projector be made available for use.

Respectfully submitted,

Dated: August 1, 2019

/John C. Phillips/  
John C. Phillips, Reg. No. 35,322  
Steven Katz, Reg. No. 43,706  
Ryan O'Connor, Reg. No. 60,254  
Fish & Richardson P.C.  
3200 RBC Plaza, 60 South Sixth Street  
Minneapolis, MN 55402  
T: 858-678-5070  
F: 877-769-7945

Attorneys for Petitioner

**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on August 1, 2019, a complete and entire copy of this Petitioner's Request for Oral Argument was provided via email to the Patent Owner by serving the email correspondence addresses of record as follows

Anish R. Desai  
Elizabeth Stotland Weiswasser  
Robert S. Magee  
Adrian Percer  
Christopher T. Marando  
Christopher M. Pepe  
Weil, Gotshal & Manges LLP  
767 Fifth Avenue  
New York, NY 10153

Email: [Ethicon.IPR.Service@weil.com](mailto:Ethicon.IPR.Service@weil.com)

/Diana Bradley/  
Diana Bradley  
Fish & Richardson P.C.  
3200 RBC Plaza  
60 South Sixth Street  
Minneapolis, MN 55402  
(858) 678-5667