

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

PATENT OWNER'S REQUEST FOR ORAL ARGUMENT

Pursuant to 37 C.F.R. § 42.70 and the Board's Scheduling Order, Patent Owner Ethicon LLC respectfully submits this Request for Oral Argument. The Board has currently scheduled the oral hearing in IPR2018-00934 for September 5, 2019. Patent Owner specifies the following issues to be argued:

- Whether claims 1-18 of U.S. Patent No. 8,998,058 (the "058 Patent") are unpatentable under 35 U.S.C. § 103 as obvious over U.S. Patent No. 5,383,880 ("Hooven") in view of U.S. Patent Application Publication No. 2005/0131390 A1 ("Heinrich").
- Whether the substitute claims in Patent Owner's Contingent Motion to Amend ("MTA") introduce new matter.
- Whether substitute claims 19-22 and 24-27 in Patent Owner's MTA are unpatentable under 35 U.S.C. § 103 as obvious over U.S. Patent No. 5,954,259 ("Viola") in view of Heinrich.
- Whether substitute claims 23 and 28 in Patent Owner's MTA are unpatentable under 35 U.S.C. § 103 as obvious over Viola in view of Heinrich and further in view of U.S. Patent No. 5,653,374 ("Young").
- Any other issue the Board deems necessary for issuing a final written decision.

The Board has also currently scheduled oral hearings on September 5, 2019, for two related proceedings: IPR2018-00933 and IPR2018-00935. Patent Owner requests that all three proceedings (IPR2018-00933, -00934, and -00935) be

consolidated into a single hearing.

Patent Owner requests forty-five minutes of time to address the issues identified above and the related issues identified in Patent Owner's Request for Oral Argument in IPR2018-00933 and IPR2018-00935. To the extent the Board schedules the hearing to last more than ninety minutes, however, Patent Owner requests that it be given half the length of the hearing to address these issues.

Patent Owner requests that five spaces be reserved at the oral hearing to accommodate its counsel and corporate representatives.

Date: August 6, 2019

Respectfully submitted,

/Anish R. Desai/

Anish R. Desai (Reg. No. 73,760)
Elizabeth S. Weiswasser (Reg. No. 55,721)
Weil, Gotshal & Manges LLP
767 Fifth Avenue
New York, NY 10153
Anish.Desai@weil.com
Elizabeth.Weiswasser@weil.com

Robert S. Magee (Reg. No. 70,227)
Adrian Percer (Reg. No. 46,986)
Weil, Gotshal & Manges LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065
Robert.Magee@weil.com
Adrian.Percer@weil.com

Christopher T. Marando (Reg. No. 67,898)
Christopher M. Pepe (Reg. No. 73,851)
Weil, Gotshal & Manges LLP
2001 M Street, N.W., Suite 600
Washington, DC 20036
Christopher.Marando@weil.com
Christopher.Pepe@weil.com

Counsel for Patent Owner Ethicon LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 6, 2018, the foregoing
PATENT OWNER'S REQUEST FOR ORAL ARGUMENT was served via
electronic mail, upon the following:

John C. Phillips
Ryan P. O'Connor
FISH & RICHARDSON
12390 El Camino Real
San Diego, CA 92130
phillips@fr.com
oconnor@fr.com

Steven R. Katz
FISH & RICHARDSON
3200 RBC Plaza, 60 South Sixth Street
Minneapolis, MN 55402
katz@fr.com

IPR11030-0049IP2@fr.com
PTABInbound@fr.com

/Bruce Davis/

Bruce Davis
Senior Paralegal
Weil, Gotshal & Manges LLP
2001 M Street, N.W., Suite 600
Washington, DC 20036
T: 202-682-7196
Bruce.Davis@weil.com