

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 SUR-REPLY TO PATENT'S OWNER'S REPLY
IN SUPPORT OF ITS CONTINGENT MOTION TO AMEND**

UPDATED EXHIBIT LIST

- 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
- IS1034 Transcript of deposition of Dr. William Cimino, August 1, 2019
(Cimino Dep. II)

I. The Substitute Claims Introduce New Matter

As explained in the Opposition, the substitute claim language “said motor configured for attachment to a power source independent of said housing connector attachment to the surgical instrument system” improperly introduces new matter because the specification discloses no such embodiment but rather teaches the exact opposite—namely, that “attachment” of the power source to the motor (*i.e.*, an electrical connection that allows current to flow there between) is *dependent* on the housing connector’s attachment to the surgical instrument system. Opp., 2-3.

In arguing to the contrary, PO adopts an absurd definition of “attachment,” namely, that even though the specification teaches that the motor and the power source are *electrically* decoupled when the housing connector is not attached to the surgical instrument system, they nevertheless remain *physically* attached in that state because “[t]he power source 526 ... is attached to the battery holder 524 ..., which is in physical contact with the switch portion 520 of the housing connector 200 ..., which is also in physical contact with the motor.” MTA Reply, 4. In other words, PO is asserting a claim construction of “attachment” that includes *indirect* physical connections regardless of how many intermediary components are between the two “attached” objects. Dr. Cimino’s testimony demonstrates just how incredible this construction is: Q: “[I]s the Empire State Building attached to the Great Wall of China?” A: “[T]here is ... attachment between the two.” Cimino

Dep. II, 177:20-178:8. Extrapolating Dr. Cimino's testimony, PO's apparent view is that every object is "attached" to every other object on Earth provided there is an indirect physical connection between them no matter how remote. Of course, this definition renders the term "attached" essentially meaningless as it would exclude, presumably, only objects floating in the air. Consequently, PO's definition of "attachment" logically cannot be correct. As such, the substitute claims introduce new matter because the embodiment contemplated by the substitute claims has no support in the patent.

The absurdity of PO's position is further revealed by its internal inconsistency. If every object on Earth is "attached" to every other object as PO asserts, then it is impossible for the housing to be unattached from the surgical instrument system because there necessarily is an indirect physical connection between them (*e.g.*, the supposedly unattached housing is resting on a table that touches the same floor that the surgical instrument system touches). Even PO's expert would agree with this conclusion. *See* Cimino Dep. II, 170:2-7 (testifying that a bottle of water resting on a table is "attached" to the table).

However, if the Board adopts PO's far-fetched definition of "attached," it must also find that, in the asserted prior art, the motor (*e.g.*, residing in the housing) remains "attached" to the power source (*e.g.*, residing in the surgical instrument system) independent of the housing connector's attachment to the

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